

Circular No. 29

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Trade Marks

A trade mark is a name or symbol used to identify the goods or services produced by a particular manufacturer or distributed by a particular dealer, to distinguish them from products associated with competing manufactures or dealers.

The Registrar of Trade Marks in Gibraltar shall keep a register of trade marks, which shall be open to inspection at all hours during which the Registrar's office is open to the public

- **The registration of trade marks**

The Registrar of Trade Marks deals with the registration of trade marks under the Trade Marks Act and the Trade Mark Rules. This legislation has not however been updated for many years. In this particular field this is problematic due to the international nature of trade marks and trade mark registrations.

Gibraltar is not a place where originating applications can be made. Indeed on a strict interpretation of section 3 of the Trade Marks Act the only trade marks that can be extended to have effect in Gibraltar by registration are trade marks registered in the UK under the Trade Marks Act 1994 ("the 1994 Act"). This of course covers national registration in the UK.

Please note that Trade Marks registered in other EU national Trade Marks Registries are not registrable in Gibraltar – (Unless it is a Community Trade Mark or is registered under The Madrid Protocol and designates the United Kingdom or the EU).

- **Community Trade Mark**

Council Regulation (EU) No40/94 on the community trade mark was introduced on 1 April 1996. Under these regulations it is possible to obtain a single trade mark registration, which is effective throughout the territory of the EU.

A Community Trade Mark ("CTM") is not recognized in the UK under the 1994 Act but is nevertheless effective in the UK because it is a member state of the EU.

A CTM should also be effective in Gibraltar under EU law without the need for registration locally because of Gibraltar's status within the EU under Article 299(4) of the Treaty of Rome.

The Office for Harmonization in the Internal Market website confirms that a CTM extends to Gibraltar. It would therefore seem that registration in Gibraltar is not strictly necessary. We make this statement subject to the caveat that we are not in a position to advise on EU law and therefore advice should be obtained where appropriate.

As a matter of policy the Registrar of Trade Marks Gibraltar will however allow a CTM to be registered in Gibraltar. We cannot however comment on the validity of such a registration in the absence of local statutory guidance.

- **The Madrid Protocol**

The UK signed the Madrid Protocol, which deals with the international registration of trade marks on 1 December 1995. This was ratified in respect of the UK and the Isle of Man but not Gibraltar.

The EU became a signatory to the Madrid Protocol on 1 October 2004.

- **Registration of a Madrid Protocol trade mark designating the UK**

A Madrid Protocol trade mark designating the UK is effective as a UK registration under the 1994 Act and may therefore be registered in Gibraltar under section 3 of the Trade Marks Act.

- **Registration of a Madrid Protocol trade mark designating the EU**

According to the UK Intellectual Property Office a Madrid Protocol trade mark designating the EU is not registered under the 1994 Act. However such a registration should have the same legal effect as a CTM and consequently should be effective in Gibraltar without registration under EU law. We make this statement subject to the same caveat that we are not in a position to advise on EU law and therefore advice should be obtained where appropriate.

The Registrar of Trade Marks will therefore allow registration of a Madrid Protocol trade mark designating the EU in Gibraltar for the same policy reasons

that we allow CTM's to be registered. However, in the absence of local statutory guidance, we cannot comment on the validity of such a registration.

- **Registration of a CTM or a Madrid Protocol trade mark designating the EU**

As stated above the Registrar of Trade Marks will allow registration of a CTM and a Madrid Protocol trade mark designating the EU in Gibraltar.

There is no statutory guidance on the procedures and therefore the Registry will follow the procedures for the registration of UK trade marks outlined above to the extent possible.

Where official documentation is required the Registry will accept the original or certified true copy certification issued by:

1. the Office for Harmonization in the Internal Market (OHIM) based in Alicante, Spain in the case of a CTM; or
2. the Internal Bureau of the World Intellectual Property Organisation (WIPO) based in Geneva, Switzerland in the case of a Madrid Protocol trade mark designating the EU.

- **Forms**

Form 1 Application for Registration

Form 2 Application for the entry of the assignment, transfer or devolution of the proprietorship

Form 3 Application for entry as Registered User

Form 4 Notification of Renewal

Form 5 Request Under Sec 15

- **Application for Registration in Gibraltar of a UK trade mark or a Madrid Protocol trade mark designating the UK (under Sec 4)**

The following documents must be delivered to the Registry:-

- (I) Application for Registration of a trademark (**Form 1**)
- (ii) Certified representation of the trademark. Certificate of the Comptroller

- of the United Kingdom Patent Office (under his title of Registrar of TradeMarks) giving full particulars of the registration of the trademark
- (iii) Two prints of the trademark if the trademark to be is a registered device.
 - (iv) The filing fee of £30

The Registrar shall issue a certificate of Registration under section 5 of the Trade Marks Act.

- **Application for entry as Registered User (under Sec 12)**

The following documents must be delivered to the Registry:-

- (I) Application for entry as Registered User (**Form 3**)
- (ii) Certificate of the United Kingdom Registrar of TradeMarks giving full particulars of the entry in the United Kingdom Register under Sec 28
- (iii) The filing fee of £20

A Certificate will be issued by the Registrar

- **Notification of Renewal (under Sec 14)**

The following documents must be delivered to the Registry:-

- (i) Notice of renewal by the registered proprietor (**Form 4**)
- (ii) Certificate from the Registrar in the UK that the Trade Mark has been renewed
- (iii) The filing fee of £20

A Certificate of renewal will be issued by the Registrar

- **Application for the entry of the assignment, transfer or devolution of the proprietorship (under Sec 10) (Rule 4)**

The following documents must be delivered to the Registry:-

- (i) Application for the entry of the assignment, transfer or devolution of the proprietorship (**Form 2**)
- (ii) Certified copy of the document (s) showing the assignment or transfer of the privileges and rights
- (iii) The filing fee of £20.00

The Registrar shall cause such person to be entered on the register as subsequent registered proprietor of the Trademark, and issue a certificate.

- **Cancellation (under Sec 15)**

Sec 15 allows the Registrar upon a request in writing to:-

- (a) cancel the registration of a trade mark or of a registered user thereunder either wholly or a regards any particular goods in respect of which the trade mark or registered user is registered

The following documents must be delivered to the Registry:-

- (i) Request under Sec 15 (Form 5)
- (ii) Filing fee of £13

- **Request Under Sec 15**

Sec 15 also allows the Registrar upon a request in writing to:-

- (b) correct any clerical error in or in connection with any application under the Trade Mark Ordinance or in any matter which is entered in the register
- (c) enter in the Register any changes in the name, description or address of the person who is registered as proprietor or user of a trade mark

The following documents must be delivered to the Registry:-

- (i) Request under Sec 15 (Form 5)
- (ii) Filing fee of £13

Every application or request to the Registrar of Trademarks shall be made in writing and shall be signed by the party applying or by a person duly authorised on his behalf or by a solicitor

Where the Trademark is a device, every application or request shall be accompanied by two prints of the Trademark

- **Payment Method**

Payment Method – UK clearing cheques should be crossed and made payable to Companies House (Gibraltar) Limited

- **Guidance only**

This Circular is intended for general guidance only. Companies House (Gibraltar) Limited does not assume legal responsibility for the accuracy of any particular statement. In the case of a specific problem we recommend that you seek professional advice.

- **Act**

Trade Mark Act 1984 Edition

- **Registry**

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