



# GUIDANCE NOTE 29

## Trade Marks

Updated November 2022

### Introduction

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.

Companies House Gibraltar, as Registrar of Trade Marks in Gibraltar, keeps a register of trade marks which is open to inspection at all hours during which the Registrar's office is open to the public. The information on the register is also publicly available online 24/7 via Companies House Gibraltar's e-Registry.

### The registration of trade marks

The Registrar of Trade Marks deals with the registration of trade marks under the Trade Marks Act ("the Act") and the Trade Mark Rules. Gibraltar is not a place where originating applications can be made. Section 3 of the Act provides for applications to register a trade mark in Gibraltar on the basis of a United Kingdom trade mark by any person who is the registered proprietor of a trade mark in the United Kingdom, or by any person deriving title from such registered proprietor. The registration in Gibraltar may cover some or all of the goods comprised in the United Kingdom registration.

### International Mark (UK), and Comparable Trade Mark (EU) and (UK)

The Gibraltar Trade Marks Act was updated in December 2020, with the provisions of the amendment coming into operation on the 1<sup>st</sup> January 2021. The update catered for Gibraltar's withdrawal from the European Union and to ensure the continued protection in Gibraltar of existing rights and privileges in respect of EU trade marks, and international trade marks with an EU designation. The amendments also included the implementation of the extension of the Madrid Protocol to Gibraltar in respect of designations of the UK in international applications made on or after the 1<sup>st</sup> January 2021.

The rights and privileges in respect of the following marks are therefore automatically extended to Gibraltar, as of the 1<sup>st</sup> January 2021, for so long as the registration of these marks in the UK remain in force:

- International trade marks registered under the Madrid Protocol and designating the UK as a result of an international application made on or after the 1<sup>st</sup> January 2021;
- Comparable trade marks (EU), being those comparable trade mark rights automatically created in the UK on the 1<sup>st</sup> January 2021 in respect of those EU trade marks with an existing EU trade mark registration immediately before the 1<sup>st</sup> January 2021; and
- Comparable trade marks (UK), being those comparable trade mark rights automatically created in the UK on the 1<sup>st</sup> January 2021 in respect of international trade marks designating the EU which had a

protected status in the UK under the Madrid Protocol immediately before the 1<sup>st</sup> January 2021.

A comparable trade mark (EU) or comparable trade mark (UK) is treated in the UK as if applied for and registered under UK law. Being a fully independent UK trade mark, it may be challenged, assigned, licensed or renewed separately from the original EU or international registration.

The changes made to the Act to cater for Gibraltar's withdrawal from the EU do not affect any trade mark which was already registered in the Gibraltar register prior to the 1st of January 2021 (as per section 18.(3) of the Act).

The fact that international trade marks designating the UK, and comparable trade marks (EU) and (UK) are automatically given the same protection in Gibraltar as in the UK does not preclude their registration in Gibraltar. The owners of such marks may seek to be registered in Gibraltar, in spite of their automatic protection, because once a trade mark is registered in Gibraltar it does, in certain important respects, acquire a life of its own. This means a trade mark may, for instance, be assigned to a different owner in Gibraltar to that in the UK, or certain classes can be assigned to owners different from that of the UK mark. This possibility gives brand owners a useful tool as to how they can deal with their trade marks and classes under their marks within the Gibraltar market.

### **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 section 15

### **Application for Registration of a trade mark in Gibraltar (under section 4)**

The following documents must be delivered to the Registry:-

- Application for Registration of a trademark (Form 1)
- Certified representation of the trade mark. Certificate of the Comptroller of the UK Patent Office (under his title of Registrar of Trade Marks) giving full particulars of the registration of the trade mark
- Two prints of the trade mark if the trade mark to be is a registered device.
- 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 section 12)**

The following documents must be delivered to the Registry:-

- Application for entry as Registered User (Form 3)
- Certificate of the UK Registrar of Trade Marks giving full particulars of the entry in the UK Register under section 28
- The filing fee of £20

A Certificate will be issued by the Registrar.

### **Notification of Renewal (under section 14)**

The following documents must be delivered to the Registry:-

- Notice of renewal by the registered proprietor (Form 4)
- Certificate from the Registrar in the UK that the Trade Mark has been renewed
- 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 section 10) (Rule 4)**

The following documents must be delivered to the Registry:-

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

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

### **Cancellation (under section 15)**

Sec 15 allows the Registrar upon a request in writing to cancel the registration of a trade mark or of a registered user thereunder either wholly or as 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:-

- Request under section 15 (Form 5)
- Filing fee of £13

### **Request Under section 15**

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

- correct any clerical error in or in connection with any application under the Trade Mark Act or in any matter which is entered in the register
- 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:-

- Request under section 15 (Form 5)
- Filing fee of £13

## **General considerations**

Every application or request to the Registrar of Trade Marks 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 trade mark is a device, every application or request shall be accompanied by two prints of the trade mark.

## **How to obtain information on a trade mark registered in Gibraltar**

Any person may conduct a search of the file of a trade mark registered in Gibraltar, request a profile or copies of any documents kept on the public record of such a mark. For this, a request will need to be made to Companies House Gibraltar. This information is also available online via Companies House Gibraltar's e-Registry. Access to the e-Registry requires a paid subscription.

For more details on any of these services please visit [www.companieshouse.gi](http://www.companieshouse.gi), or contact Companies House Gibraltar.

## **Payment Method**

Please refer to Guidance Note 36 for payment methods accepted by Companies House Gibraltar.

## **Guidance only**

This Circular is intended for general guidance only. Companies House Gibraltar 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.

## **Registry Contact Details:**

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