



ST HELENA

REVISED EDITION OF THE LAWS, 2017

EMPLOYMENT & COMMERCE

TRADE MARKS (REGISTRATION) ORDINANCE, 1949¹

Ordinance 1 of 1949

In force 28 February 1949

Amended by L.N. 26/2009

Subsidiary legislation:

TRADE MARKS (REGISTRATION) RULES, 1949

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Legal Notice 3 of 1949

*Amended by L.N. 5/1957, L.N. 6/1997, L.N. 11/2005, L.N. 9/2009, L.N. 32/2012,
L.N. 9/2018*

TRADE MARKS (REGISTRATION) ORDINANCE, 1949

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AN ORDINANCE to provide for the registration in St Helena of trade marks registered in the United Kingdom.

¹ Under section 10 of the Revised Edition of the Laws Ordinance, 1999 this text is authoritative and is the sole authentic edition in respect of the law contained in it as at 1 May 2018.

Short title

1. This Ordinance may be cited as Trade Marks (Registration) Ordinance, 1949.

Interpretation

2. In this Ordinance, unless the context otherwise requires—
“**court**” means the St Helena Supreme Court;
“**register**” means the register to be kept under this Ordinance;
“**Registrar**” means the Registrar of the Supreme Court.

Application for registration

3. Any person—
 - (a) being the registered proprietor of a trade mark in the United Kingdom by virtue of an entry in the register of trade marks kept under the Trade Marks Act, 1994, or any Act amending or substituted for that Act; or
 - (b) deriving title from such registered proprietor by assignment or other mode of transfer,
may apply at any time during the existence of the registration in the United Kingdom to have such trade mark registered in St Helena in respect of some or all of the goods comprised in the United Kingdom registration.

Procedure on application

4. An application for registration of a trade mark under this Ordinance must be made to the Registrar and accompanied by a certified representation of the trade mark and a certificate of the Comptroller General of Patents, Designs and Trade Marks giving full particulars of the registration of the trade mark in the United Kingdom.

Issue of certificate

5. Upon receiving an application made under section 4, the documents mentioned in that section, and any prescribed fee, the Registrar must enter the prescribed particulars in the register and issue a certificate of registration to the applicant who then becomes the registered proprietor in St Helena of the trade mark in respect of the goods entered in the register.

Privileges of proprietor

6. Subject to this Ordinance, a registered proprietor has in St Helena such privileges and rights in the use of the trade mark in respect of the goods entered in the register as, with necessary modifications, would be conferred on the proprietor by the law in force in the United Kingdom.

Duration of privileges

7. (1) The privileges and rights conferred by section 6 date from the date of registration in the United Kingdom and continue in force, subject to section 15, for so long as

the registration in the United Kingdom remains in force in respect of the goods for which the trade mark is registered in St Helena:

(2) No action for infringement of a trade mark is to be entertained in respect of any use of the trade mark prior to the date of issue of the certificate of registration of the trade mark in St Helena.

Right of action for passing off

8. This Ordinance does not affect any right of action against any person for passing off goods as those of another person or any remedy in respect of such passing off.

Powers of court

9. The court may, upon the application of any person who alleges that the person's interests have been prejudicially affected by the issue of a certificate of registration, declare on any of the grounds on which the United Kingdom registration might be cancelled under the law in force in the United Kingdom, with necessary modifications, that the exclusive privileges and rights have not been acquired.

Assignment of privileges

10. Subject to this Ordinance, if a person becomes entitled by assignment or other mode of transfer to the privileges and rights conferred on a registered proprietor by this Ordinance, the Registrar must, on application being made in the prescribed manner, and on proof of title to the satisfaction of the Registrar, cause that person to be entered in the register as subsequent registered proprietor of the trade mark.

Application by registered user

11. Any person entered in the United Kingdom register of trade marks under Part 1 of the Trade Marks Act, 1994 as a registered user in respect of any goods of a trade mark in respect of which a certificate of registration under this Ordinance is in force may apply to be registered in St Helena as a registered user of the mark in respect of some or all of such goods, subject to any conditions or restrictions entered in the United Kingdom register.

Entry in register

12. Upon receiving an application under section 11, together with a certificate of the Comptroller General of Patents, Designs and Trade Marks giving full particulars of the entry in the United Kingdom register under Part 1 of the Trade Marks Act, 1994, the Registrar must cause the applicant to be entered in the register of St Helena as a registered user of the trade mark, and on such entry the registered user is entitled in St Helena, subject to any conditions or restrictions entered in the United Kingdom register, to such privileges and rights in respect of the goods for which the applicant is entered as would be conferred on the applicant by the law in force in the United Kingdom, with necessary modifications.

Powers of Governor in Council

13. Subject to this Ordinance, the Governor in Council may make rules and do all other things the Governor in Council considers expedient for -

- (a) regulating procedure under this Ordinance;
- (b) prescribing the fees to be paid in respect of proceedings under this Ordinance; and
- (c) generally, prescribing anything which by this Ordinance is to be prescribed.

Keeping and inspection of register

14. (1) There is to be kept in the Registrar's office a register in which must be entered in the prescribed form all matters which are by this Ordinance required to be registered.

(2) The register must be open to inspection at all hours during which the Registrar's office is open.

Renewal of registration

15. (1) If the registration in the United Kingdom of a trade mark registered under this Ordinance is renewed, the registered proprietor may, within a prescribed time after the date of renewal in the United Kingdom, notify the Registrar, who must then on sufficient evidence of the registration and on payment of the prescribed fee, renew the registration in the register in the prescribed manner.

(2) If the registration in the register is not renewed under subsection (1) it must be cancelled by the Registrar.

Powers of Registrar

16. The Registrar may, on request in writing made by the registered proprietor, and on payment of the prescribed fee—

- (a) cancel the registration of a trade mark or of a registered user under a trade mark either wholly or as regards any particular goods in respect of which the trade mark or the registered user is registered;
 - (b) correct any clerical error in or in connection with any application under this Ordinance or in any matter which is entered in the register;
 - (c) enter in the register any change in the name, description or address of the person who is registered as proprietor or user of a trade mark.
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TRADE MARKS (REGISTRATION) ORDINANCE, 1949**TRADE MARKS (REGISTRATION) RULES, 1949**

(Section 13)

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Citation

1. These rules may be cited as the Trade Marks (Registration) Rules, 1949.

Interpretation

2. In these rules, unless the context otherwise requires, “**agent**” means a person duly authorised to the satisfaction of the Registrar to represent another person.

Fees

3. The fees specified in the First Schedule to these Rules are payable in respect of proceedings under the Ordinance.

Forms

4. The forms in the Second Schedule to these Rules modified as may be necessary are to be used in matters to which they are applicable.

Register

5. In the register to be kept under section 14 of the Ordinance must be entered all registered trade marks, with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations, and any other matters relating to trade marks that are prescribed.

Agent

6. Any person entitled under the Ordinance to make application or give any notice may appoint an agent for the purpose and for representing the person in the matter of a trade mark by signing and sending to the Registrar an authority in writing to that effect in Form 1.

Application for registration

7. An application for the registration of a trade mark or a series of trade marks must be made in Form 2. A representation of the trade mark must be affixed to the application.

Certificate of registration

8. The certificate of registration to be issued by the Registrar under section 5 of the Ordinance must be in Form 3.

Application to the court

9. (1) Applications to the court under section 9 of the Ordinance must be made in accordance with the Civil Procedure Ordinance, 1968.

(2) The Registrar must, on production of an order of the court declaring that the exclusive privileges and rights consequent upon registration have not been acquired, make an entry in the register of a minute of the order and cancel the registration of the mark in conformity with the order.

Subsequent registered proprietors

10. (1) An application under section 10 of the Ordinance must be made in Form 4.

(2) In proof of title the applicant must produce the certificate of registration issued under section 5 of the Ordinance and the document or documents on which the applicant bases the title.

(3) Upon entry in the register of the name of the applicant as a subsequent registered proprietor of a trade mark the Registrar must endorse upon the certificate of registration issued under the Ordinance a statement of the alteration in the proprietorship of the trade marks.

Registered users

11. (1) An application under section 11 of the Ordinance must be made in Form 5.

(2) The Registrar may at the request of a registered user issue a certificate of the registration of that registered user in respect of the goods of a trade mark for which the user is entered in the register.

Renewal of registration

12. (1) Notification under section 15 of the Ordinance of renewal of registration must be made within 6 months of the date of renewal in the United Kingdom in Form 6 accompanied by a certificate of renewal under the hand of the Comptroller General of Patents, Designs and Trade Marks and the certificate of registration issued under the Ordinance.

- (2)** Upon receipt of such notification and certificates the Registrar must—
- (a) cause an entry of the fact of such renewal to be made in the register;
 - (b) make a similar endorsement on the certificate of registration; and
 - (c) return the certificate to the registered proprietor.

Powers of Registrar

13. (1) Applications under section 16 of the Ordinance must be made in Form 7. Every such application must be accompanied by the certificate of registration under the Ordinance and any evidence the Registrar considers sufficient.

- (2)** Upon receipt of such application the Registrar—
- (a) may cause the necessary alterations to be made in the register and in the certificate of registration; and
 - (b) in the case of a cancellation of a trade mark wholly, must cancel the certificate of registration and retain it.

Copies

14. Upon payment of the prescribed fee the Registrar must issue to any applicant a certified copy of or extract from any document filed or any entry in the register.

FIRST SCHEDULE²

(Rule 3)

FEES

- | | | |
|----|--|---------|
| 1. | For registration of a trade mark (including filing of all necessary documents, and the issue of a certificate of registration) | £100.00 |
| 2. | For the registration of a series of trade marks (including the filing of all documents, and the issue of a certificate of registration)— | |
| | For the first mark | £100.00 |
| | For every other mark in the series | £50.00 |
| 3. | For registration of an assignment of a single mark (including the filing of all necessary | £50.00 |

² *First Schedule amended by L.N. 9 of 2018*

documents and the endorsement on the certificate of registration)

4. For the registration of an assignment of more than one mark standing in the same name, the devolution of the title being identical in each case (including the filing of all necessary documents etc.):

For the first mark	£50.00
And for every other mark	£28.00
5. For registration of a registered user of a trade mark or of a series of trade marks—

For the first of the series	£50.00
And for every other mark	£28.00
6. For a certificate of registration of a registered user of a trade mark £50.00
7. For filing notification of renewal of a trade mark or a series of trade marks, including the endorsement on the certificate of registration £65.00
8. On an application under section 16 of the Ordinance:

For cancellation of the registration of a mark wholly	£38.00
For cancellation of the registration of a mark in part	£28.00
For correction of any clerical error	£28.00
For change of name and/or address	£28.00
9. For certified copies or extracts of any documents filed:

(a) if copies are photographic, per sheet	£3.00
(b) If copies are type-written, per folio of 100 words	£3.00
(c) In either case, minimum fee	£38.00
10. For every search of the Register £15.00

SECOND SCHEDULE

(Rule 4)

FORMS*Note: Forms are not supplied by the Registrar*

FORM 1

(Rule 6)

APPOINTMENT OF AGENT

ST HELENA

TRADE MARKS (REGISTRATION) ORDINANCE, 1949

To the Registrar of the Supreme Court,
St Helena

I (or we) hereby appoint of, to act as my
(or our) agent in St Helena for *, and request that all
notices, applications or communications relating thereto may be sent to such agent at the
above address.

Name(s):

Signed:

Dated the day of, 20.....

** Here state the particular purpose for which the agent is appointed, e.g. all purposes in
connection with the registration of the accompanying trade mark in the register and in
connection with any application to the court under section 9 of the Ordinance and any
assignment or renewals thereof, as the case may be.*

ST HELENA

TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 2

(Rule 7)

APPLICATION FOR REGISTRATION

To the Registrar of the Supreme Court,
St Helena

[Representation of the Trade Mark to be affixed here]

I (or we) of, do solemnly
and sincerely declare that I am (or we are, or A.B. is or are) the registered proprietor (or

proprietors) of the trade mark (or series of trade marks) registered in the United Kingdom under the Trade Marks Act, 1994 numbered, and bearing date, and referred to in the accompanying certificate of the Comptroller General of Patents, Designs and Trade Marks.

I (or we) hereby apply for registration of the said mark(s) in the register and that a certificate of registration may be issued to me (or to user, or A.B.) for the said mark(s).

Signed:

Dated theday of, 20.....

ST HELENA
TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 3
(Rule 8)

CERTIFICATE OF REGISTRATION

To

[Representation of the Trade Mark to be affixed here]

I, Registrar of the Supreme Court of St Helena, do hereby certify that the United Kingdom trade marks(s) numbered and dated (a specimen of which is hereunto affixed) has been registered in accordance with the provision of the above-named Ordinance in your name in the register in respect of

And I do hereby further certify that the privileges and rights conferred by this certificate issued under the said Ordinance are to date from theday, 20....., subject to the proviso to section 7 of the said Ordinance and shall continue in force for such time as the registration in the United Kingdom shall remain in force, subject to notification in St Helena of renewals of registration in the United Kingdom as required by section 15 of the said Ordinance.

Dated theday of, 20.....

In witness whereof I have hereunto set my hand this day of20....

Registrar

ST HELENA
TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 4
(Rule 10)

APPLICATION TO REGISTER SUBSEQUENT PROPRIETOR

To the Registrar of the Supreme Court,
St Helena

I (or we), hereby make application to you to enter my (or our) name (or names) in the register of trade marks as the proprietor (or proprietors) of the United Kingdom trade mark registered in St Helena under No. in respect of

I am (or we are) entitled to the privileges and rights conferred by the certificate of registration issued under the above-named Ordinance, in proof whereof I (or we) transmit the said certificate of registration and

Signed:

Dated theday of, 20.....

ST HELENA
TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 5
(Rule 11)

APPLICATION FOR REGISTRATION OF REGISTERED USER

To the Registrar of the Supreme Court,
St Helena

I (or we) of, do solemnly and sincerely declare that I am (or we are or A.B. is or are) (a) registered user(s) in respect of goods of the trade mark registered in the United Kingdom under the Trade Marks Act, 1994, numbered and bearing date, and more fully set out and referred to in the accompanying certificate of the Comptroller General of Patents, Designs and Trade Marks.

I (or we) hereby apply for registration of my name (or of A.B.) as a registered user of goods of the trade mark as set forth in the certificate accompanying the above declaration.

Signed:

Dated theday of, 20.....

ST HELENA
TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 6
(Rule 12)

NOTICE OF RENEWAL

To the Registrar of the Supreme Court,
St Helena

I (or we), hereby give you notice that registration in the United Kingdom of the trade mark registered in St Helena under No. in respect of, has been renewed in the United Kingdom. In proof whereof I (or we) transmit the accompanying certificate of the Comptroller General of Patents, Designs and Trade Marks dated The certificate of registration in St Helena is submitted for endorsement accordingly.

Signed:

Dated the day of, 20.....

ST HELENA
TRADE MARKS (REGISTRATION) ORDINANCE, 1949

FORM 7
(Rule 14)

APPLICATION UNDER SECTION 16 OF THE ORDINANCE

To the Registrar of the Supreme Court,
St Helena

In the matter of the United Kingdom trade mark registered under No. on

I (or we), the registered proprietor of the said trade mark hereby apply that the registration of said trade mark may be cancelled (or that the registration of the said trade mark may be cancelled in respect of or that you will correct the following clerical errors, viz. or that you will enter in the register as the name and/or address of the proprietor of the said trade mark).

Signed:

Dated the day of, 20.....