

A. From as early as 6 months before the expiry of the initial 10 year period of protection, the mark can be renewed on payment of a fee for a further 10 years. In this way, protection of a trade mark may be maintained indefinitely.

Q. Are there also non-exclusive trade marks?

A. In addition to the exclusive protection for the marks of individual traders, the Trade Marks Act also affords non-exclusive protection to special types of trade marks. These non-exclusive marks include collective trade marks, which may be registered by an association to identify products of its members that meet certain requirements set by the association and certification trade marks, which confirm compliance with defined standards. One example of a well-known certification mark is the "ISO 9000" certification developed by the International Organisation for Standardisation located in Switzerland, which indicates compliance with international quality management standards.

Q. How can statutory trade mark rights be enforced?

A. The Trade Marks Act is designed to deter the unauthorised use of registered trade marks through its enforcement provisions. Where, the owner of a locally registered trade mark discovers that his mark is being copied or used without his permission he will be entitled to apply to the High Court for the grant of an injunction to stop the infringement and/or an award of compensation.

The Act also makes provision for the Comptroller of Customs to seize and where necessary, dispose of illegitimate infringing goods where the owner of a locally registered trade mark gives notice to the Comptroller of his objection to the importation of such goods.

In addition, where any individual:

- falsifies or unlawfully removes a registered trade mark;
- makes a machine or instrument for the falsification of a trade mark knowing that it is likely to be used in committing an offence; or
- intentionally involves himself in the sale, importation or possession of goods bearing a falsified trade mark;

that individual will be liable upon conviction to a fine up to a maximum sum of \$250,000.00.

Q. What other important points should I bear in mind?

A. Searches: Before using a trade mark you should check the Register of Trade Marks or any online source to ensure that no one else has registered a mark which is the same or similar to yours for use with the same or similar goods and services. Care should also be taken to ensure that your mark is not the same or similar to the name of a business or corporate entity which trades in goods or services that are of the same type or similar to those on which you plan to use your mark. Manual searches of the Business Names, Companies and Trade Mark

Registers may be conducted at CIPO at costs ranging from \$2.00 to \$5.00.

National protection: Registration of a trade mark in St. Vincent and the Grenadines only gives it protection within the jurisdiction of St. Vincent and the Grenadines. Local registration would nonetheless be useful abroad as evidence of your mark's reputation in support of an action for passing off. Ideally, however, you should register your mark in every country where you will be using it.

Use of designations: While trade mark registration is certainly a wise course of action it is not compulsory. It is however important to note, that although the designation "TM" can also be used with an unregistered trade mark, the designation ® may only be used in relation to a mark registered in St. Vincent and the Grenadines. Where an unregistered trade mark is represented to be locally registered, the person who has applied that mark is liable to a fine of \$10,000.00.

Remember ...

A registered trade mark:

- helps to create brand identity for your products and services
- fosters customer loyalty
- facilitates expansion of business through the licensing of rights
- enables a swift response to unfair competition
- Considering all these benefits,

Why not go ahead and MAKE YOUR MARK?

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This brochure offers guidance on seeking registration of a trade mark under the Trade Marks Act, CAP. 315, which entered into force in St. Vincent and the Grenadines on 18th May 2004. It is not intended to serve as a definitive guide and should be read together with the applicable legislation.

Q. What is a trade mark?

A. A trade mark is a sign that distinguishes the goods or services of one enterprise from those of other enterprises. It may be a word, signature, name, letter, numeral, device, colour, sound, shape, aspect of packaging or a combination of any of these elements.

Q. What is the function of a trade mark?

A. A trade mark serves to gain market recognition for a particular product or service. As marketing tools, trade marks:

- enhance a consumers' ability to differentiate between competing products and services.
- brand a product or service from a particular source as one of special quality or reputation.
- foster customer loyalty and create goodwill that encourages repeat business.
- facilitate growth and expansion through franchising.
- add value to a business.

When we think of well known trade marks, such as the *Nike* mark used on sporting goods or the *KFC* mark used in the marketing of fried chicken prepared according to the "colonel's secret recipe", we can certainly appreciate how these marks add recognition and value to the products with which they are associated. The same is true of indigenous marks such as the mark *Erica's* used for a proprietary blend of seasoning and the *Windows to the sea logo* used by the Ministry of Tourism and Culture in the promotion of recreational and cultural activities in St. Vincent and the Grenadines. It is no accident that the images of these marks have been so well ingrained in our minds by advertising that there is no need to represent them here.

Q. How are trade marks rights protected?

A. Two types of legal protection are available for trade marks. The first is a *statutory right* arising from the registration of the mark, which entitles the registered owner to bring an action to stop infringement. The second type of protection is applicable to all trade marks, whether registered or unregistered, and is the *common law right* to bring an action for "passing off" against the unauthorised user of a mark. This second option can however be time consuming and costly as the trade mark owner is called upon to prove that he has developed a reputation in trade using the mark and that the contrary use of it by others will confuse or deceive members of the public.

Q. What is the reason for making statutory protection available for trade marks?

A. Underlying the statutory protection of trade marks is acceptance of the fact that an enterprise should have the right to prevent others from

benefiting from or undermining their hard work in building a good reputation for their products. It is also important that consumers be protected from being misled as to the true source of the goods or deceived into purchasing inferior products.

Q. What are the benefits of registering a trade mark?

A. A trade mark is a valuable marketing tool which over time becomes integral to the competitiveness of a business.

Registration helps to ensure that the business retains its integrity relative to the placement of its mark, by giving a trade mark owner an *exclusive right* to use his mark in relation to the goods and services specified in the registration. This puts the owner in a position to stop other people from using his mark or a confusingly similar one.

Also, because a registered mark is the personal property of the registered owner it can be *assigned* or *licensed* by the owner for financial gain.

Q. Will I need an Attorney-at-law?

A. Because professional know-how is particularly valuable in preparing and if necessary, defending an opposed trade mark application, it is a requirement of the Trade Marks Act, that a trade mark agent be an attorney-at-law who is admitted to the local Bar. A statutory form of *Authorisation of Agent* (Form 2) is used for this purpose and operates as a power of attorney in respect of the actions authorised.

Q. How much does trade mark protection cost?

A. The government fees payable on a successful application to register a word mark in relation to one class of goods, in circumstances where there is no opposition, would be \$305.00 made up as follows:

- Authorisation of Agent - \$5.00 stamp duty
- Application for registration - \$100.00
- Publication of mark on acceptance - \$100.00
- Certificate of Registration - \$100.00

The cost of trade mark protection however varies according to:

- the number of classes of goods or services on which the mark is to be used;
- the type of mark - whether a word only, a logo or a word and symbol combined;
- Whether there is a need to defend the application in the event of opposition by a third party.

Fees will also be payable to an Attorney-at-law for professional services.

Q. What does registration entail?

A. Individuals and companies who wish register a trade mark are required to submit an application for registration in the prescribed form (Form 1), along with the required filing fee to the Commerce & Intellectual Property Office (CIPO). CIPO is located on the First Floor of the Brewster's Building on Mc Coy Street, Kingstown.

Apart from basic information such as the name and address of the applicant and that of the filing attorney, an application is required to contain a clear representation of the mark for which protection is sought, including any colours or three-dimensional features and a list of the goods and/or services to which the mark is intended to apply, classified in accordance with the *Nice International Classification System* (<http://classifications.wipo.int/fulltext/nice>). The applicant may also seek assistance from TMclass for classification of goods. Unless your mark consists of a word that is not in any special format, your application must also be accompanied by 6 additional representations of the mark to facilitate various stages of the application's processing.

Q. Are there any requirements that a mark must meet to qualify for statutory protection?

A. In order to qualify for protection, a trade mark:

- must be capable of being graphically represented.
- must be distinctive and therefore capable of distinguishing the goods and services of the applicant for the trade mark from those of another.
- must not be such as would deceive or cause confusion among consumers;
- must not be scandalous in nature or its use contrary to law;
- must not be the same as or similar to a registered trade mark;
- must not consist of or contain a sign that is prescribed not to be used as a trade mark.

Each mark is examined to determine whether it conforms to the above mentioned requirements and all other requirements of the Act.

Every effort should be made to ensure the uniqueness of your trade mark as marked similarity to a registered mark may result in the refusal of registration. It should be noted that marks which are words or symbols that other enterprises in the same field of business should be free to use will not be registered, e.g. the word "Lawyer" would be refused as a trade mark in relation to the provision of legal services.

Where a mark meets the statutory criteria, it will be accepted for registration and its acceptance advertised on payment of a publication fee. Other persons will then have a period of 3 months from the date of advertisement to file a notice of opposition to the registration of the mark. Where there is no opposition or where opposition proceedings are determined in favour of the applicant, a further fee will be payable for the preparation of a *Certificate of Registration*.

Q. How long does statutory protection last?

A. On the issue of a Certificate of Registration, a trade mark is protected for a period of 10 years from the date of filing.

Q. How is registration maintained?