

A Basic Guide for a Mark Application

A mark is defined as a visible sign that is capable of distinguishing goods (trade mark, TM) or services (service mark, SM) of an enterprise, group or person. It can be words, images, numbers, colours, etc or a combination of all or any of those. Once a mark is registered, it is protected for ten years from the date that the application was filed and can be renewed for consecutive periods of ten years.

Under SKN law, registration gives the mark owner the exclusive right to use or authorize use of the TM and enables court proceedings where there is infringement. It is important to note that those rights are territorial i.e. actionable only in the territory that they are registered in.

TYPES OF MARKS

While any visual representation of a mark is able to be registered, our Office generally registers three types of marks:

- (a) Word, letter or number marks: protection covers the word, letter or numbers only. The way that they are reproduced is immaterial e.g. “White Cup” or “57”
- (b) Word, letter or number marks stylized: These are words, letters or numbers only written in a specific font, character, colour or spacing that is crucial to the mark. Protection covers the style not the words, letters or numbers

e.g. **WHITE CUP** or **57**

- (c) Image/figurative marks: drawings, shapes, logos with or without words, etc. Protection covers the image as a whole. The important elements of the mark should be identified in the statement.

Classifying the marks in this way, while not crucial to your application assists our Office’s processing efforts, particularly during data entry and prior rights searches. Applicants should be clear about what they are seeking to protect to ensure that the appropriate number of applications are made.

THE REGISTRATION PROCESS

Pre- Application Search (recommended but not compulsory) → Application → Acknowledgement of Receipt → Formality/Substantive Examination → Publication → Period of Opposition → Registration!

THE APPLICATION

- 1. Mandatory Documents to be Submitted:
 - A. A statement from the owner of the mark¹ in support of the application

¹ Or a duly authorized representative where the owner/proprietor is a company, group or organization

- B. A sworn declaration from the owner of the mark supporting the statement
- C. A cheque with the relevant fees

Applicants are not required to submit a cover letter outlining which documents which have been submitted and their email or telephone information but it is advised for completion of files. We are legally obliged to acknowledge receipt of your application.

2. Circumstantial Documents that may be required:

- A. Copies of the figurative/image mark: If colours are important to the mark, please provide colour copies. Three high quality copies are required.
- B. If the applicant is resident overseas or the application is being completed by someone on behalf of the applicant: Original Power of Attorney
- C. If the owner is claiming the right of priority, certified copies of the priority documents
- D. If the owner of the mark is deceased: certified copy of the grant of administration
- E. If the mark contains an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of or official sign or hallmark adopted by St. Kitts and Nevis e.g. the flag, Kittitian, SKN, Oualie, coat of arms, etc, a letter of authorization from the Attorney General

The Statement must contain:

- The name, calling and address of the applicant
- Request that the mark be registered
- The mark and description of the mark (a brand may be made up of multiple marks leading to multiple applications e.g. Nike: the word, the stylized word and swoosh are three separate applications). For figurative marks be sure to identify the elements of the mark that you intend to protect.
- The class of goods and services (latest edition of the Nice International Classification of Goods and Services²: <https://www.wipo.int/classifications/nice/en/>)
- The **PARTICULAR** description or descriptions of goods/services in such class or classes, that the mark will be used on (e.g. in class 25: leggings, hats, T-shirts). Class headings, wide language (e.g. “clothing including but not limited to”) and terms such as “all goods/services in Class” are **NOT ACCEPTABLE**. If the list is too long, attach a separate page and refer to it in the statement as an attachment

² Marks are classified according to the international classification of goods and services called the Nice Classification. A registered mark has protection according to the particular class that it is registered so for example if “White Cup” is registered in Class 9 for computers, no other computers or products in Class 9 can register that name or something that is confusingly similar to it. However, if there is a event planning company called “White Cup” seeking protection in Class 41, it may be registered if the Registrar determines that to register the event planning company mark would not mislead or confuse the public on the origin of the respective goods and services.

- A statement that you intend to use the mark **OR** the number of years that the mark has been in use
- Must be signed and dated by **the applicant**

If you are not sure which class your goods and/or services belongs, you may find the “TM Class” tool useful. It is designed and maintained by the European Union Intellectual Property Office. Go to <http://euipo.europa.eu/ec2/> and insert your good or service in the “search term” tab and click search. Possible classes will be suggested. Please be as specific as possible e.g. “masks” can be Class 1, 9, 10, 25 or 28 depending on the type of masks. If you sell masks for carnival, that would be Class 28 but scuba masks are Class 9.

The Declaration must contain:

- Name, calling and address of applicant
- Declaration that the contents of the statement are true
- That you intend to rely on a priority date (if applicable)
- Must be sworn to on oath or signed before a notary public and dated
- Where an application is made by or on behalf of a company, body corporate or group of persons **the statement and declaration shall be made by the secretary or other principal officer of the body of persons**, and the Registrar may require such proof as he or she thinks fit that the application made is duly authorised by such body of persons (Rule 11)

FORMALITY/ SUBSTANTIVE EXAMINATION

The prospective mark will be examined by the IPOSKN to ascertain whether it meets the requirements of the Marks, Collective Marks and Trade Names Act (Cap. 18.22). A mark cannot be registered if it is:

- Incapable of distinguishing the goods and services of one enterprise from another
- Contrary to public order or morality
- Likely to mislead the public or trade circles, in particular, as regards the geographical origin of goods or services concerned or their nature or characteristics;
- identical to, or is an imitation of, or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of or official sign or hallmark adopted by, any State,

inter-governmental Organisation or Organisation created by an international convention, unless authorised by the competent authority of that State or Organisation;

- E. Identical to, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Saint Christopher and Nevis for identical or similar goods or services of another enterprise, or if it is well-known and registered in Saint Christopher for goods or services which are not identical, or similar to those in respect of which registration is applied for, provided, in the latter case, that
- (i) use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark; and
 - (ii) the interests of the owner of the well-known mark are likely to be prejudiced by such use; or
- F. identical to a mark belonging to a different owner and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

It is important to note that:

- All documents in a foreign language must be accompanied by certified translations in English. Translator must verify that the translation is, to the best of his or her knowledge, complete and faithful. (s.18)
- If the mark contains elements that are too generic or commonplace for the particular class, the IPOSKN will require the applicant to complete a disclaimer in which they declare that they do not claim exclusive use to the element of concern
- The IPOSKN will conduct a search of registered marks to ascertain whether any prior rights would be affected

PUBLICATION AND REGISTRATION

1. If the prospective mark passes the formalities tests, it will proceed to publication in the official Gazette for a period of three months. During that time, any interested person can file a notice of opposition with our Office in which they should outline reasons why they object to the registration of the prospective mark. If such an objection is duly submitted, the applicant will be given an opportunity to respond and the Registrar will make a determination on whether the mark should be registered.
2. If no notices of opposition are received, the proposed mark is ripe for registration. The applicant will then be required to pay the registration and certification fees forthwith, if he has not done so before. On receipt of those funds, the mark will be registered and a certificate of registration issued.

TEMPLATE

THE INTELLECTUAL PROPERTY OFFICE

ST. CHRISTOPHER AND NEVIS

A.D. 2020

In the Matter of an Application under the Marks, Collective Marks and Trade Names Act (Cap. 18.22) for the Registration of the
(word only/ word stylized/ image mark) by
(Name of Proprietor) in Class(es) xyz

STATEMENT ON APPLICATION FOR REGISTRATION OF A TRADE MARK

I,(name of trademark proprietor)....., of(address)..... apply to be registered as proprietor of a trademark which is represented in the paper annexed hereto.

I desire that the said trade mark may be registered in respect of the description of goods following, contained in the following Class/Classes.

Class(class number)....., that is to say in favour of(class descriptions which apply).....

The mark can be described as:

.....(For stylized or image marks, describe the mark, being sure to highlight the features that are crucial to the mark e.g. specific colour shades, shapes, characters, font, placements, etc)

.....
.....
.....

I have used the said trade mark in respect of the said goods/services for(number)..... years before the date of this statement.

Dated the day of 2020

.....
Signature

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(word only/ word stylized/ image mark) by
(Name of Proprietor) in Class(es) xyz

**DECLARATION TO ACCOMPANY STATEMENT ON APPLICATION FOR REGISTRATION OF A
TRADE MARK**

I,(name of trademark proprietor)....., of(address)..... do hereby and solemnly
and sincerely declare, to the best of my knowledge and belief as follows:

1. The statement signed by me and dated the day of 2020 and
marked with the letter “A” and shown to me at the time of making this declaration is
true.
2. The description of the trade mark in such statement is a true description of the trade
mark for the registration of which I apply.
3. I am lawfully entitled to the use of the trade mark of which the said description is a
true description.

SWORN by (name of trademark proprietor)

On this day of 2020

At the High Court Registry at East Independence
Square Street, Basseterre, St. Kitts

(Signature)

BEFORE ME:

The Intellectual Property Office of St. Kitts and Nevis
Ministry of Justice and Legal Affairs

Basseterre, St. Kitts

iposkn@gmail.com
www.ipo.gov.kn

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(Name and signature of Commissioner of Oaths)

Fees in Eastern Caribbean Currency

Application fee for one mark or the first of a number of applications being filed simultaneously (includes one class)	500.00
Application fee for a second and subsequent application filed simultaneously with a first application for the same applicant (includes one class)	160.00
Fee per additional class	80.00
Registration fee	240.00
Certificate of registration or renewal (new or replacement)	240.00
For entering notice of opposition	250.00
For registering subsequent proprietor	240.00
For altering address on the register	60.00
For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged	120.00
Additional fee to continue a mark that has expired within six months after expiration of the mark	640.00
For inspecting Register, for every fifteen minutes	15.00 (payable in stamps)

**The Intellectual Property Office of St. Kitts and Nevis
Ministry of Justice and Legal Affairs**

Basseterre, St. Kitts

**iposkn@gmail.com
www.ipo.gov.kn**

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