



ST. HELENA

## CHAPTER 127

# TRADE MARKS (REGISTRATION) ORDINANCE and Subsidiary Legislation

### Non-authoritative Consolidated Text

This is not an authoritative 'revised edition' for the purposes of the Revised Edition of the Laws Ordinance; it has been prepared under the supervision of the Attorney General for the purpose of enabling ready access to the current law, and specifically for the purpose of being made accessible via the internet.

Whilst it is intended that this version accurately reflects the current law, users should refer to the authoritative texts in case of doubt. Enquiries may be addressed to the Attorney General at Essex House, Jamestown  
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Visit our [LAWS page](#) to understand the St. Helena legal system and the legal status of this version of the Ordinance.

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<sup>1</sup> These contact details may change during 2011 or early in 2012. In case of difficulty, email [shgwebsite@sainthelena.gov.sh](mailto:shgwebsite@sainthelena.gov.sh) or telephone (+290) 2470.

**CHAPTER 127****TRADE MARKS (REGISTRATION) ORDINANCE**

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**CHAPTER 127****TRADE MARKS (REGISTRATION) ORDINANCE**

*(Ordinance 1 of 1949 and Legal Notice 26 of 2009)*

AN ORDINANCE TO PROVIDE FOR THE REGISTRATION IN ST. HELENA OF TRADE MARKS REGISTERED IN THE UNITED KINGDOM.

**Commencement**

*[28 February 1949]*

**Short title**

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

**Interpretation**

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

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<sup>2</sup> Definition of “Court” amended by L.N. 26 of 2009

### Application for registration

3. Any person 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, 1938, or any Act amending or substituted for that Act, or any person 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 shall be made to the Registrar and accompanied by a certified representation of the trade mark and a certificate of the Comptroller-General of the United Kingdom Patent Office (under his title of Registrar of Trade Marks) giving full particulars of the registration of the trade mark in the United Kingdom.

### Issue of certificate

5. Upon such application being lodged, together with the documents mentioned in section 4 of this Ordinance, the Registrar shall enter the prescribed particulars in the register, and shall issue a certificate of registration to the applicant who shall then be 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 the provisions of this Ordinance, a registered proprietor shall have in St. Helena such privileges and rights in the use of the trade mark in respect of the goods entered in the register as *mutatis mutandis* would be conferred on him by the law for the time being in force in the United Kingdom.

### Duration of privileges

7. The privileges and rights conferred by section 6 of this Ordinance shall date from the date of registration in the United Kingdom and shall continue in force, subject to the provisions of section 15 of this Ordinance, 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:

Provided that no action for infringement of the trade mark shall be entertained in respect of any use of the trade mark prior to the date of issue of the certificate of registration in St. Helena.

### Right of action for passing off

8. Nothing in this Ordinance shall be deemed to affect any right of action against any person for passing off goods as those of another person or any remedy in respect thereof.

## Powers of Court

9. The Court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration, to declare on any of the grounds *mutatis mutandis* on which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom that the exclusive privileges and rights have not been acquired.

## Assignment of privileges

10. Subject to the provisions of this Ordinance, where 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 shall, on application being made in the prescribed manner, and on proof of title to his satisfaction, cause such 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 section 28 of the Trade Marks Act, 1938, 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 such application being lodged, together with a certificate of the United Kingdom Registrar of Trade Marks giving full particulars of the entry in the United Kingdom register under the said section 28, the Registrar shall 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 shall be entitled in St. Helena, subject to the aforesaid conditions and restrictions, to such privileges and rights in respect of the goods for which he is entered as *mutatis mutandis* would be conferred on him by the law for the time being in force in the United Kingdom.

## Powers of Governor in Council

13. The Governor in Council may make such rules and do such things as he may think expedient, subject to the provisions of this Ordinance, for regulating procedure under this Ordinance, and prescribing the fees to be paid in respect of proceedings under this Ordinance, and generally for prescribing anything which by this Ordinance is to be prescribed.

## Keeping and inspection of register

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

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

**Renewal of registration**

**15.** If the registration in the United Kingdom of a trade mark registered under this Ordinance is renewed, the registered proprietor may, within such time after the date of renewal in the United Kingdom as may be prescribed, notify the Registrar, who shall then on sufficient evidence thereof and on payment of the prescribed fee, renew the registration in the register in the prescribed manner. If the registration in the register is not so renewed it shall 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 thereunder 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) RULES****ARRANGEMENT OF RULES****RULE**

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5. Register
6. Agent
7. Application for registration
8. Certificate of registration
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**TRADE MARKS (REGISTRATION) RULES – SECTION 13**

*(Legal Notices 3 of 1949, 5 of 1957, 6 of 1997, 11 of 2005 and 9 of 2009)*

**Short title**

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

**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;  
“**the Ordinance**” means the Trade Marks (Registration) Ordinance.

**Fees**

3. The fees specified in the First Schedule to these rules shall be paid in respect of proceedings under the Ordinance.

**Forms**

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

**Register**

5. In the register to be kept under section 14 of the Ordinance shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors,

This e-version of the text is not authoritative for use in court.

notifications of assignments and transmissions, the names, addressees and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to trade marks as may be 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 him in the matter of a trade mark by signing and sending to the Registrar an authority in writing to that effect in the Form No. 1.

### **Application for registration**

7. An application for the registration of a trade mark or a series of trade marks shall be made in the Form No. 2. A representation of the trade mark shall be affixed to the said application.

### **Certificate of registration**

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

### **Application to the Court**

9. (1) Applications to the Court under section 9 of the Ordinance shall be made in accordance with the provisions of the Civil Procedure Ordinance<sup>3</sup>.

(2) The Registrar shall 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 such order and cancel the registration of such mark in conformity with the said order.

### **Subsequent registered proprietors**

10. (1) An application under section 10 of the Ordinance shall be made in the Form No. 4.

(2)<sup>4</sup> In proof of his title the applicant shall produce the certificate of registration issued under section 5 of the Ordinance and the document or documents on which the applicant bases his title.

(3) Upon entry in the register of the name of the applicant as a subsequent registered proprietor of a trade mark the Registrar shall 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 shall be made in the Form No. 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 he is entered in the register.

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<sup>3</sup> Cap. 32

<sup>4</sup> Rule 10(2) amended by L.N. 5/1957

## Renewal of registration

**12. (1)** Notification under section 15 of the Ordinance of renewal of registration shall be made within six months of the date of renewal in the United Kingdom in the Form No. 6 accompanied by a certificate of renewal under the hand of the United Kingdom Registrar of Trade Marks and the certificate of registration issued under the Ordinance.

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

## Powers of Registrar

**13.** Applications under section 16 of this Ordinance shall be made in the Form No. 7. Every such application shall be accompanied by the certificate of registration under the Ordinance and such evidence as the Registrar may consider sufficient.

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

## Copies

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

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### FIRST SCHEDULE<sup>5</sup>

(Rule 3)

#### FEES

1.	For registration of a trade mark (including filing of all necessary documents, and the issue of a certificate of registration)	£50.00
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	£50.00
	For every other mark in the series	£27.50
3.	For registration of an assignment of a single mark (including the filing of all necessary documents and the endorsement on the certificate of registration)	£27.50
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	£27.50

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<sup>5</sup> First Schedule substituted by LN 11 of 2005 and LN 9 of 2009



	And for each other mark	£17.00
5.	For registration of a registered user of a trade mark or of a series of trade marks—	
	For the first of the series	£27.50
	And for each other mark	£17.00
6.	For a certificate of registration of a registered user of a trade mark	£27.50
7.	For filing notification of renewal of a trade mark or a series of trade marks, including the endorsement on the certificate of registration	£40.00
8.	On an application under section 16 of the Ordinance, as follows—	
	For cancellation of the registration of a mark wholly	£22.50
	For cancellation of the registration of a mark in part	£17.00
	For correction of any clerical error	£17.00
	For change of name and/or address	£17.00
9.	For certified copies or extracts of any documents filed—	
	(a) if copies are photographic, per sheet	£1.50
	(b) If copies are type-written, per folio of 100 words	£1.50
	(c) In either case, minimum fee	£22.50”.

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**SECOND SCHEDULE***(Rule 4)***FORMS***N.B.— Forms are not supplied by the Registrar***FORM NO. 1***(Rule 6)***APPOINTMENT OF AGENT**

ST. HELENA

**TRADE MARKS (REGISTRATION) ORDINANCE**

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

Dated the .....day of ....., 20..... .

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

(a) 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.

**FORM NO. 2***(Rule 7)***APPLICATION FOR REGISTRATION**

ST. HELENA

**TRADE MARKS (REGISTRATION) ORDINANCE***[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, 1938,  
numbered ....., and bearing date ....., and referred to in  
the accompanying certificate of the Comptroller-General of the United Kingdom  
Patent Office.

Dated the .....day of ....., 20..... .

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 use, or A.B.) for the said  
marks(s).

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

## FORM NO. 3

(Rule 8)

**CERTIFICATE OF REGISTRATION**

ST. HELENA

## TRADE MARKS (REGISTRATION) ORDINANCE

To

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 shall date from the .....day ....., 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 the .....day of ....., 20.....

Representation of mark

In witness whereof I have hereunto set my hand this day ..... of .....in the year of our Lord two thousand and .....

*Registrar*

## FORM NO. 4

(Rule 10)

**APPLICATION TO REGISTER SUBSEQUENT PROPRIETOR**

ST. HELENA

## TRADE MARKS (REGISTRATION) ORDINANCE

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 .....

Dated the .....day of ....., 20.....

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

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 FORM NO. 5

(Rule 11)

**APPLICATION FOR REGISTRATION OF REGISTERED USER**

ST. HELENA

## TRADE MARKS (REGISTRATION) ORDINANCE

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, 1938, numbered ..... and bearing  
date ....., and more fully set out and referred to in the accompanying  
certificate of the Comptroller General of the United Kingdom Patent Office.

Dated the .....day of ....., 20..... .

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.

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

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 FORM NO. 6

(Rule 12)

**NOTICE OF RENEWAL**

ST. HELENA

## TRADE MARKS (REGISTRATION) ORDINANCE

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 the United Kingdom  
Patent Office dated .....

The certificate of registration in St. Helena is submitted for endorsement  
accordingly.

Dated the .....day of ....., 20..... .

*Signed*

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

FORM NO. 7

(Rule 14)

APPLICATION UNDER SECTION 16 OF THE ORDINANCE

ST. HELENA

TRADE MARKS (REGISTRATION) ORDINANCE

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).

Dated the .....day of ....., 20..... .

*Signed*

TO THE REGISTRAR OF THE SUPREME COURT,  
ST. HELENA.

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