



# Protection of Intellectual Property

By Maurisha A. Robinson and Midge Morton, Partners,  
Morton Robinson, L.P.,  
Nevis

**I**n today's ever-changing global market, it has become essential to protect one's intellectual property (IP). IP is an intangible asset which includes discoveries, creations, words/phrases, musical and artistic works. Through the protection of IP, the creator/owner of this intangible asset [property] is given a legally exclusive right over the use of this creation for a particular period of time depending on the jurisdiction in which the IP is registered. Moreover, as intellectual property attracts a particularly high value, the exclusive right given, allows the creator/owner to benefit financially from the "property" they have created.

In St Kitts and Nevis, the Intellectual Property Office ("IPO") is responsible for all matters regarding IP. There are a variety of legislations in place which deals with the different types of IP such as Trade Marks, Patents, Copyright etc. However, for the purposes of this paper, the focus shall be on how Trade Mark (which is the most popular IP product in St Kitts and Nevis) is protected.

The legislation which governs trade mark is The Marks, Collective Marks and Trade Names Act, 2009<sup>1</sup> ("the Act") and provides for the procedure involved in protecting trade marks. As can be inferred from the name of the Act, collective marks are recognised under the Act.

Now, let's take a look at what exactly can be registered and protected as a trade mark in St Kitts and Nevis. According to the Act, a "mark" must be "any visible sign capable of distinguishing the goods or services of an enterprise".<sup>2</sup> However, there are certain limitations/restrictions<sup>3</sup> to this definition as the Act goes further to detail the circumstances under which a mark would not be registrable, that is to say:- the mark is:

- a) incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- b) contrary to public order or morality;
- c) 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;
- d) 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 St. Kitts & Nevis for identical or similar goods or services of another enterprise or if it is well known and registered in St. Kitts & Nevis 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.<sup>4</sup>

The Act does not impose any restriction on who can own a mark, therefore any person, natural and or legal can own a trade mark in St. Kitts and Nevis.

So, provided, the "mark" falls within the realm of the Act, then steps are taken via the services of an agent (a qualified Attorney-at-law in St Kitts and Nevis) to register the mark. This process involves the filing of an application (together with the payment of the requisite application fees) with the IPO. The application includes the filing of a declaration which refers to details as to the ownership of the mark; a power of attorney thereby granting authority to the agent to handle the registration of the mark, a reproduction of the mark and a list of the goods or services for which registration of the mark is requested listed under the applicable class or classes of the international classification. In the case where priority is being claimed, a declaration<sup>5</sup> claiming the priority is filed along with the application.

Following the filing of the application with the Registrar of the IPO, the documents are examined with a view to determining whether the mark is registrable in accordance with the provisions of the Act. If the mark is indeed registrable, the Registrar will accept the application, register the mark in the register of marks; publish a reference to the registration in the Gazette and issues the applicant with a certificate of registration.

It is important to note that the owner's exclusive right to the use of the trade mark commences from the date of filing and the term for this exclusive right over use of the trade mark is 10 years from the filing date of the application for registration. Additionally, the owner's

exclusive right to use is renewed upon the written request of the registered owner and payment of the prescribed renewal fee for renewal of consecutive periods of 10 years.

Evidently, trade marks can be protected indefinitely in St Kitts and Nevis provided the trade mark is registered, the registration is renewed every 10 years and the owner continues to use the mark.

## Basics of trade mark protection in St Kitts and Nevis

### Relevant authorities and legislation

*What is the relevant St. Christopher (Kitts) and Nevis authority?*

The relevant St. Kitts and Nevis authority is the St. Kitts & Nevis Intellectual Property Office.

*What is the relevant St. Kitts and Nevis Trade mark Legislation?*

The relevant St. Kitts and Nevis Trade mark legislation is called the Marks, Collective Marks and Trade Names Act, Cap. 18:22 of the 2009 Revised Laws of the Federation of St. Christopher & Nevis.

### Application for a Trade Mark

*What can be registered as a Trade Mark?*

Any visible sign capable of distinguishing the goods or services of an enterprise can be registered as a trade mark in St Kitts and Nevis.

*What cannot be registered as a Trade Mark?*

A mark shall not be registrable if it is:

- a) incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- b) contrary to public order or morality;
- c) 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;
- d) identical to or confusingly similar to, or constitutes a translation of a mark, or trade name which is well known in St. Kitts & Nevis for identical or similar goods or services of another enterprise or if it is well known and registered in St. Kitts & Nevis 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

*What information/documentation is/are needed to register a Trade Mark?*

The following information is needed

to register a trade mark:

- a) a statement and declaration;
- b) a power of attorney;
- c) a reproduction of the mark;
- d) in the event that priority is claimed, a declaration claiming the priority;
- e) a list of the goods or services for which registration of the mark is requested listed under the applicable class or classes of the international classification; and
- f) the prescribed application fee.

*What is the general procedure for Trade Mark registration?*

The application documents are submitted to the Registrar. Upon submission of the documents, the Registrar examines the application to determine whether it complies with the relevant requirements. The Registrar also examines and determines whether the mark is registrable. Where the Registrar finds that the requirements have been fulfilled, he or she shall forthwith cause the application as accepted to be published in the Gazette in the prescribed manner.

*How are goods and services described?*

The goods and services are described by a list of the goods or services for which registration of the mark is requested as listed under the applicable class or classes of the international classification.

*What territories are or can be covered by a St Kitts and Nevis Mark?*

The only territory which can cover a St. Kitts and Nevis mark is the Federation of St. Kitts and Nevis.

*Who can own and St Kitts and Nevis trade mark?*

The Act does not impose any restriction on any person, natural and or legal, from owning a St. Kitts and Nevis trade mark.

*Can a trade mark acquire distinctive character through use?*

Yes it can.

*How long on average does registration take?*

On average registration in respect of a straightforward application in one class takes two to three years.

*What is the average cost of obtaining a St Kitts and Nevis trade mark?*

The average cost of obtaining a St. Kitts and Nevis trade mark in respect of registration of a mark in one (1) class is USD630. Additional costs apply for additional classes and marks.

*Is there more than one route to obtaining a registration in St. Kitts and Nevis?*

At present, a trade mark may be registered in St. Kitts and Nevis via one route, that is to say, by filing an application for registration with the Registrar at the St. Kitts and Nevis Intellectual Property Office.

*Does St Kitts and Nevis recognize Collective or Certification marks?*

St. Kitts and Nevis recognizes Collective marks. The legislation does not address certification marks.

### Absolute grounds of refusal

*What are the absolute grounds for refusal of registration?*

An application for registration may be refused on the ground that the application falls into the category of those matters which cannot be registered as a mark (See above).

### Opposition

*On what grounds can a trade mark be opposed?*

A trade mark may be generally be opposed on grounds as described above. *Who can oppose the registration of a trade mark?*

The registration of a trade mark may be opposed by any interested person, natural or legal.

### Registration

*What happens when a trade mark is granted registration?*

Once the trade mark has been granted registration, the Registrar:-

- i) registers the mark in the register;
- ii) publishes a reference to the registration in the Gazette; and
- iii) issues to the applicant a certificate of registration.

*From which date following the application does an applicant's trade mark right commence?*

The trade mark rights commence from the date of filing of the registration.

*What is the term of a trade mark?*

The term of a trade mark is 10 years from the filing date of the application for registration.

*How is a trademark renewed?*

It is renewed upon the written request of the registered owner and payment of the prescribed renewal fee for renewal of consecutive periods of 10 years.

## END NOTES

- 1 Cap. 18:22 of the Revised Laws of the Federation of St. Christopher (Kitts) and Nevis.
- 2 Section 2 (Interpretation section) of the Act
- 3 These restrictions are also the absolute grounds for refusal of registration of a mark by the Registrar of the IPO as well as the grounds upon which an application for opposition to the registration of the mark is filed.
- 4 Section 4 of the Act
- 5 The declaration filed claiming the priority must be as provided for in the Paris Convention of an earlier national or regional application filed by the applicant or his or her predecessor in title in or for any state party to the Convention or any member of the World Trade Organisation, in which case the Registrar may require that the applicant furnishes within the prescribed time limit a copy of the earlier application certified as correct by the office with which it was filed.