

No. 4]

Geographical Indications Act

[2000.

SAINT LUCIA

No. 4 of 2000

ARRANGEMENT OF SECTIONS

PART I

PRELIMINARY

1. Short title and commencement.
2. Interpretation.

PART II

REGISTRATION OF GEOGRAPHICAL INDICATIONS

3. Application for registration and contents of application.
4. Rights to file application and representation.
5. Examination; opposition and registration.
6. Right of use.
7. Cancellation and rectification of registration and publication.
8. Register and publication.
9. Correction of errors and extension of time.
10. Exercise of discretionary powers.
11. Competence of Court and appeals.

PART III

PROTECTION OF GEOGRAPHICAL INDICATIONS

12. Civil proceedings.
13. Availability of protection regardless of registration and presumption.
14. Homonymous geographical indications for wines.
15. Exclusion from protection.
16. Offences and penalties.

PART IV

SPECIAL PROVISIONS CONCERNING MARKS; EXCEPTIONS

17. Misleading marks.
18. Marks conflicting with a geographical indication for wines and spirits.
19. Exceptions regarding prior users.

PART V

REGULATIONS

20. Regulations.

SCHEDULE

I ASSENT

[L.S.]

PEARLETTE LOUISY,
Governor-General.

27th March, 2000.

SAINT LUCIA

No. 4 of 2000

AN ACT to provide for the registration and protection of geographical indications and related matters.

[On Proclamation]

BE IT ENACTED by the Queen's Most Excellent Majesty, by and with the advice and consent of the House of Assembly and the Senate of Saint Lucia, and by the authority of the same as follows:

PART I
PRELIMINARY

Short title and commencement

1. — (1) This Act may be cited as the Geographical Indications Act, 2000.

—
(2) This Act shall come into force on a date to be fixed by the Minister by Order published in the *Gazette*.

Interpretation

In this Act —

“applicant” means a person applying under section 3;

“competent authority” means an authority described under section 4 (1) (c);

“Court” means the High Court;

“geographical indication” means an indication which identifies a good as originating in the territory of a country, or a region or locality in this territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

“good” means any natural or agricultural product or any product of handicraft or industry;

“Minister” means the Minister to whom responsibility for intellectual property has been assigned;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“person” means a body corporate or an unincorporated body;

“producer” means —

(1) any producer of agricultural products or any other person exploiting natural products;

(2) any manufacturer of products of handicraft, or industry;
and

(3) any trader dealing in the said products;

“Register” means the Register of Geographical Indications.

“Registrar” means the Registrar of Companies and Intellectual Property.

PART II
REGISTRATION OF GEOGRAPHICAL INDICATIONS

Application for registration and contents of application

3. — (1) An application for the registration of a geographical indication shall be filed with the Registrar and shall specify —

- (1) the name, address and nationality of the natural person or legal entity filing the application, and the capacity in which the applicant is applying for registration;
- (2) the geographical indication for which registration is sought;
- (3) the geographical areas to which the geographical indication applies;
- (4) the goods for which the geographical indication applies;
- (5) the quality, reputation or other characteristic of the goods for which the geographical indication is used,

(1) An application for the registration of a geographical indication shall be subject to the payment of a prescribed fee.

Rights to file application and representation

4.— (1) The following shall have the right to file an application:

- (a) persons carrying on an activity as a producer in the geographical area specified in the application, with respect to the goods specified in the application, as well as a group of such persons;
- (b) a group of consumers; and
- (c) any authority competent to represent persons under (a).

(2) Where an applicant's ordinary residence or principal place of business is outside Saint Lucia he or she shall be represented by an attorney-at-law resident and practising in Saint Lucia.

Examination; opposition and registration

1. — (1) The Registrar shall examine an application to ascertain whether it complies with the requirements of sections 3, 4 and 15 and the Regulations.

(2) Any interested person or competent authority may, within the prescribed period and in the prescribed manner, give notice to the

Registrar of opposition to the registration of a geographical indication on the grounds that one or more of the requirements of sections 3 and 4 are not fulfilled.

(3) The Registrar shall send a copy of such notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counter-statement of the grounds on which he or she relies for his or her application and where the applicant fails to do so the application shall be deemed to be abandoned.

(4) If the applicant sends a counter-statement, the Registrar shall furnish a copy to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered.

(5) Where the Registrar finds that the conditions referred to in subsection (1) are fulfilled, and either —

- (a) the registration of the geographical indication has not been opposed within the prescribed time limit; or
- (b) the registration of the geographical indication has been opposed and the opposition has been decided in the applicant's favour,

the Registrar shall register the geographical indication, publish a reference to the registration and issue to the applicant a certificate of registration.

(6) An application that does not comply with the requirements of subsection (1) shall be refused by the Registrar.

Right to use

6. Only producers carrying on their activity in the geographical area specified in the Register shall have the right to use in the course of trade a registered geographical indication, with respect to the products specified in the Register, provided that such products possess the quality, reputation or other characteristic specified in the Register.

Cancellation and rectification of registration and publication

7.— (1) An interested person or a competent authority may apply to the Court for —

- (a) the cancellation of the registration of a geographical indication on the ground that it does not qualify for protection as such having regard to section 15; or
- (b) the rectification of the registration of geographical indication on the ground that the registration does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory.

(2) In any proceedings under this section, notice of the request for cancellation or rectification —

- (1) shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and
- (2) shall, by a publication in the prescribed manner, be given to all persons having the right to use the geographical indication under section 6.

(3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Court in the said notice, apply to join in the proceedings.

(4) The Registrar of the Court shall notify the Registrar of the decision of the Court or the decision on any appeal therefrom and the Registrar shall record it and publish a reference thereto as soon as possible.

Register and publication

8. — (1) The Registrar shall maintain a Register in which he or she shall record all matters required by this Act to be recorded and the Register may be consulted by any person, who may obtain an extract therefrom, under the conditions prescribed in the Regulations.

(2) The Registrar shall publish in the prescribed manner all the publications provided for in this Act.

Correction of errors and extension of time

9.— (1) The Registrar may, subject to Regulations made under this Act, correct any error of translation or transcription, clerical error or

mistake in any application or document filed with the Registrar or in any matter recorded pursuant to this Act or the Regulations.

(2) If the Registrar is satisfied that the circumstances justify it, notwithstanding that the time has expired, he or she may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the Regulations, upon notice to parties concerned and upon such terms as he or she may direct.

Exercise of discretionary powers

10. Where the exercise of a discretionary power by the Registrar under this Act is likely to adversely affect a party to a proceeding before the Registrar, the party shall be given an opportunity to be heard before the power is exercised.

Competence of Court and appeals

11. — (1) The Court shall have jurisdiction in cases of dispute relating to the application of this Act and in matters which under this Act are to be referred to the Court.

(2) Any decision taken by the Registrar under this Act may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within two months of the date of the decision.

PART III

PROTECTION OF GEOGRAPHICAL INDICATIONS

Civil proceedings

12. — (1) Any interested person or any interested group of producers or consumers may institute proceedings in the Court to prevent, in respect of geographical indication —

- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good;
- (b) any use which constitutes an act of unfair competition within the meaning of Article 10^{bis} of the Paris Convention contained in the Schedule;

- (c) the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translating or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.

(2) In proceedings under this section the Court may issue an injunction, award damages or grant any other remedy or relief as it may deem fit.

Availability of protection regardless of registration and presumption

13.— (1) Protection under this Act shall be available regardless of whether the geographical indication has been registered. However, registration of a geographical indication under Part II of this Act shall, in any proceedings under this Act, raise a presumption that such indication is a geographical indication within the meaning of section 2;

(2) Protection under this Act shall be available against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Homonymous geographical indications for wines

14.— (1) In the case of homonymous geographical indications of wines, protection shall be accorded to each indication, subject to subsection (2) of section 13.

(2) The Registrar in cases of permitted concurrent use of such indications, shall determine the practical condition under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

Exclusion from protection

15. The following shall not be protected as geographical indications —

- (a) indications which do not correspond to the definition in section 2;

- (b) indications which are contrary to public order or morality;
- (c) geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

Offences and penalties

16. A person who knowingly and with intent to deceive performs any of the acts referred to in section 12 commits of an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for two years.

PART IV

SPECIAL PROVISIONS CONCERNING MARKS; EXCEPTIONS

Misleading marks

17. The Registrar shall, on his or her own motion or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in Saint Lucia is of such a nature as to mislead the public as to the true place of origin.

Marks conflicting with a geographical indication for wines and spirits

18. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or of a trademark for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Registrar on his own motion or at the request of an interested party, with respect to such wines or spirits not having this origin.

Exceptions regarding prior users

19. — (1) Nothing in this Act shall prevent continued and similar use of a particular geographical indication of another country identifying wines or spirits, in connection with goods or services, by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that country either —

- (a) for at least ten years preceding April 15, 1994; or
- (b) in good faith preceding that date

(2) Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either —

- (a) before the date of entry into force of this Act; or
- (b) before the geographical indication is protected in its country of origin;

this Act shall not prejudice the registrability of or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

(3) Nothing in this Act shall apply —

- (a) in respect of a geographical indication of any country with respect to goods or services for which the relevant indications is identical with the term customary in common language as the common name of such goods or services in Saint Lucia; or
- (b) in respect of a geographical indication of any other country with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in Saint Lucia as of January 1, 1995.

(4) Any request for relief made under Part III of this Act in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in Saint Lucia or after the date of registration of the trademark in Saint Lucia. Provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in Saint Lucia and provided that the geographical indication is not used or registered in bad faith.

(5) This Act shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where the name is used in such a manner as to mislead the public.

PART V REGULATIONS

Regulations

20. The Minister may make Regulations prescribing all matters that are required or permitted by this Act to be prescribed, or are necessary or convenient to give effect to this Act.

SCHEDULE

(Section 12)

PARIS CONVENTION 1967

Articles 10^{bis}

[Unfair Competition]

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited :

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Passed in the House of Assembly this 21st day of December, 1999.

MATTHEW ROBERTS,
Speaker of the House of Assembly.

Passed in the Senate this 7th day of March, 2000.

HILFORD DETERVILLE,
President of the Senate.
