

No. 2]

Industrial Designs Act

[2001

SAINT LUCIA

No. 2 of 2001

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I ASSENT

[L.S.]

PEARLETTE LOUISY,
Governor-General.

15th February, 2001.

SAINT LUCIA

No. 2 of 2001

AN ACT to provide for the protection of Industrial Design and for related matters.

[On Order]

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:

Short title and Commencement

1.—(1) This Act may be cited as the Industrial Designs 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

2.—(1) In this Act

“Court” means the High Court;

“International Classification” means the classification according to the Locarno Agreement of October 8th 1968 establishing an International Classification for Industrial Designs;

“Minister” means the Minister with responsibility for intellectual property;

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

“prescribed” means prescribed in the Regulations;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“Register” means the Register of Industrial Design maintained pursuant to section 16;

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

“Regulations” means Regulations made pursuant to section 24.

Definition of industrial design

3.—(1) For the purposes of this Act, any composition of lines or colours or any three-dimensional form, or any material whether or not associated with lines or colours, is deemed to be an industrial design, where such composition, form or material gives a special appearance to a product of industry or handicraft, can serve as a pattern for a product of industry or handicraft, or appeals to and is judged by the eye.

(2) The protection of this Act does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

Registrable industrial designs

4.—(1) An industrial design is registrable if it is new.

(2) An industrial design shall be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if the disclosure:

(a) occurred within twelve months preceding the filing date or, where applicable, the priority date of the application; and

(b) was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

(4) An industrial design that is contrary to public order or morality is not registrable.

Right to registration and naming of creator

5.—(1) The right to registration of an industrial design shall belong to the creator.

(2) If two or more persons have jointly created an industrial design, the right to registration of that industrial design shall belong to them jointly.

(3) If and to the extent that two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to register the industrial design, as long as the said application is not withdrawn, abandoned or rejected.

(4) The right to an industrial design may be assigned, or may be transferred by succession.

(5) Where an industrial design is created in execution of an employment contract, the right to registration of the industrial design shall belong, in the absence of contractual provision to the contrary, to the employer.

(6) The creator shall be named as such in the registration of the industrial design, unless in a special written declaration signed by him and addressed to the Registrar he indicated that he wishes not to be named.

(7) A promise or undertaking by the creator made to any person to the effect that he will make a declaration referred to in subsection (6) shall be without legal effect.

Application

6.—(1) An application for registration of an industrial design shall be filed with the registrar and shall contain a request, drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used.

(2) The application may be accompanied by a specimen of the article embodying the industrial design where the industrial design is two dimensional.

(3) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

(4) The application may contain a declaration claiming priority, as provided for in the Paris Convention, of one or more earlier national or regional applications or international deposits filed by the applicant or his predecessor in title in or for any State party to that Convention.

(5) Where the application contains a declaration referred to in subsection 4), the Registrar may require that the applicant furnish, within the prescribed time limit, a copy of the earlier application or international deposit, certified as correct by the office with which it was filed, and the effect of that declaration shall be as provided for in the Paris Convention.

(6) Where the Registrar finds that the requirements under this section and the Regulations pertaining to a declaration are not fulfilled, the declaration shall be considered not to have been made.

(7) Two or more industrial designs may be the subject of the same application if they relate to the same class of International Classification or to the same set or composition of articles.

(8) An application, at the time of filing, may contain a request that the publication of the industrial design be deferred for a period not exceeding twelve (12) months from the date of filing or, if priority is claimed from the date of priority of the application.

(9) The applicant may withdraw the application at any time during its pendency.

(10) An application is subject to the payment of the prescribed application fee.

Examination

7.—(1) The Registrar shall accord as the filing date the date of receipt of application, provided that, at the time of receipt, the application contains indications allowing the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design.

(2) Where the Registrar finds that the application did not at the time of receipt fulfil the requirements referred to in subsection (1), he shall invite the applicant to file the required correction and shall accord as the filing date the date of receipt of the required correction, but if no correction is made the application shall be treated as if it had not been filed.

(3) After according a filing date, the Registrar shall examine the application for compliance with the requirements of section 6 and ascertain whether the application fee has been paid.

(4) The Registrar shall examine whether the industrial design complies with the provisions of section 3 and 4 (4).

Registration and publication

8.—(1) Where the Registrar finds that the conditions referred to in subsection (3) and 4 (4) are fulfilled, he or she shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design.

(2) Notwithstanding subsection (3), where a request has been made under section 6 (8) for deferment of publication, no representation of the design nor any file relating to the application shall be open to public inspection, and the Registrar shall publish a notice of deferment containing information identifying the registered owner, the filing date of the application, the length of time of which deferment has been requested and any other prescribed particulars.

(3) During the period of deferment of publication, legal proceedings on the basis of a registered industrial design may not be instituted unless the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

(4) At the expiry of the period of deferment, the Registrar shall publish the registered industrial design.

Rights conferred by registration

9.—(1) The exploitation of a registered industrial design in Saint Lucia by persons other than the registered owner shall require the agreement of the latter.

(2) For the purposes of this Act, “exploitation” of a registered industrial design means the making, selling, importing or otherwise distributing, for commercial purposes, articles bearing or embodying a design which is a copy, or substantially a copy, of the industrial design.

(3) The rights conferred by registration shall not extend to acts in respect of articles which have been put on the market in Saint Lucia by the registered owner or with his consent.

(4) The owner of a registered industrial design shall, in addition to any other rights remedies or actions available to him, have the right to institute court proceedings against any person who infringes the registration of the industrial design by performing without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

Duration and renewal of registration

10.—(1) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration.

(2) The registration may be renewed for two further consecutive periods of five years through the payment of the prescribed fee.

(3) A grace period of six months shall be allowed for the late payment of the renewal fee, on payment of the prescribed surcharge.

Surrender of registration

11.—(1) The owner of a registered industrial design may surrender it by written declaration to the Registrar who shall record the surrender in the Register and publish it appropriately.

(2) The surrender shall have effect from the date on which it is recorded.

Invalidation of registration

12.—(1) An interested person may apply to the Court for the invalidation of the registration of an industrial design.

(2) The Court shall invalidate the registration of an industrial design if the person requesting the invalidation proves that any of the requirements of sections 3 and 4 are not fulfilled or if the registered owner of the industrial design is not the creator or successor in title.

(3) An invalidated registration of an industrial design, or part thereof, shall be regarded as null and void from the date of the registration.

(4) The decision of the Court or the decision on any appeal therefrom shall be notified to the Registrar who shall record it and publish a reference to it as soon as possible thereafter.

Changes in ownership

13.—(1) A change in the ownership of the registration of an industrial design, or in the ownership of an application therefor, shall be in writing and shall, upon the request of any interested party made to the Registrar, be recorded and, except in the case of an application, published by the Registrar.

(2) A change under subsection (1) shall be of no effect against third parties until it has been recorded.

Licence contracts

14.—(1) Subject to this section, the owner of a registered industrial design on an application therefor may grant licences in respect of the design.

(2) A copy of each licence contract concerning a registered industrial design, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto and until the contract is so recorded it shall have no effect against third parties.

The Registrar

15. The Registrar shall be responsible for all functions relating to the procedure for the registration of industrial designs and for the administration of registered industrial designs as specified in this Act.

Register and publication

16.—(1) The Registrar shall maintain a Register of Industrial Designs in which he or she shall record all matters required by the Act to be recorded.

(2) The Register may be consulted by any person under the prescribed conditions and any person may obtain extracts upon payment of the prescribed fee.

(3) The Registrar shall publish in an appropriate manner all the publications provided for in this Act.

Correction of errors

17. The Registrar may, subject to any provisions in the Regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar on in any matter recorded pursuant to this Act.

Extension of time

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

(2) The extension may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary powers

19. The Registrar shall, before exercising any discretionary power vested in him or her by this Act adversely to any party to a proceeding before him, give that party an opportunity to be heard.

Representation

20. 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.

Competence of Court

21.—(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, in particular the decision to register an industrial design or to refuse an application for such a registration, may be the subject of an appeal by any interested party to the Court and such appeal shall be filed within three months of the date of the Registrar's decision.

Infringement and offences

22.—(1) Subject to section 9 (3), an infringement shall consist of the performance in Saint Lucia of any act referred to in section 9 (2) by a person other than the owner of the registered industrial design and without the agreement of the latter.

(2) On the request of the owner of the registered industrial design, or of a licensee, if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, the Court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law.

(3) A person who intentionally performs an act which constitutes an infringement as defined in subsection (1) commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for five years.

Application of international treaties

23. The provisions of any international treaties in respect of industrial property to which Saint Lucia is a party shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, the conflicting provision in this Act shall be construed to give effect to the provision of the relevant treaty.

Regulations

24. 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 be prescribed for giving effect to the purposes of this Act.

Repeals

25. Subject to the provisions of section 26, the provisions of the Commercial Code, Cap 244, Title X, where they apply to Designs are hereby repealed.

Transitional provisions

26.—(1) Notwithstanding the repeal of the former Act, industrial designs registered thereunder shall remain in force but shall, subject to subsection (2), be deemed to have been registered under this Act.

(2) Industrial designs registered under the former Act shall remain in force for the unexpired portion of the period of protection provided for under that Act and may be renewed in accordance with the provisions of this Act.

(3) A person who on the date of the coming into force of this Act is the owner of an industrial design that has been registered in the United Kingdom for a period not exceeding three years or has filed an application for registration of an industrial design in the United Kingdom may, within

twelve months from entry into force of this Act, file an application for the registration of the same industrial design under this Act and such application shall be accorded the filing date or priority date accorded to the application or registration in the United Kingdom.

(4) The Registrar shall, on and after the coming into force of this Act —

- (a) perform all the functions of and exercise all the powers conferred on the Registrar of the Supreme Court in relation to industrial designs under the former Act; and
- (b) be the custodian of the Register of Patents, Designs and Trade Marks kept under the former Act.

Passed in the House of Assembly this 12th day of December, 2000.

MATTHEW ROBERTS,
Speaker of the House of Assembly.

Passed in the Senate this 17th day of November, 2000.

HILFORD DETERVILLE,
President of the Senate.
