

- (b) order that the seized goods be forfeited to the Government.
- (4) If —
 - (a) the court decides that the trade mark was not infringed by the importation of the goods; and
 - (b) the designated owner of the goods, or any other defendant, satisfies the court that he or she has suffered loss or damage because the goods were seized;

the court may order the objector to pay to the designated owner or other defendant compensation, in the amount determined by the court, for any part of that loss or damage that is attributable to any period beginning on or after the day on which the action was brought.

(5) If, after three months from the day on which the action was brought, there is not in force at any time an order of the court preventing the goods from being released, the Comptroller shall release the goods to their designated owner.

(6) If the court orders that the goods be released, the Comptroller shall, subject to section 123, comply with the order.

Action for infringement by authorised user

121. If an authorised user of a notified trade mark is an objector in relation to any seized goods, the authorised user may start an action for the infringement of the trade mark in respect of the goods within the required period without first ascertaining whether the registered owner is willing to bring the action.

Disposal of forfeited goods

- 122.** If —
- (a) goods are forfeited to the Government under section 118; or
 - (b) the court orders under section 120 that goods be forfeited to the Government;
- the goods are to be disposed of as the Comptroller directs.

Power of Comptroller to retain control of goods

- 123.** Notwithstanding this Part, the Comptroller —
- (a) shall not release, or dispose of, any seized goods; or
 - (b) shall not take any action in relation to the goods to give effect to any order of a court under section 120;

if the Comptroller is required or allowed to retain control of the goods under any other law in force in Saint Lucia.

Insufficient security

124. If security given under section 116(3) by the objector or objectors who gave notice under section 115 in respect of a trade mark is not sufficient to meet the expenses incurred by the Government as a result of the action taken by the Comptroller under this Part because of the notice, the amount of the difference between those expenses and the amount of security —

- (a) is a debt due by the objector, or by the objectors jointly or each of them separately, to the Government; and
- (b) may be recovered by an action taken in a court of competent jurisdiction.

Government not liable for loss etc. suffered because of seizure

125. The Government is not liable for any loss or damage suffered by a person —

- (a) because the Comptroller seized, or failed to seize, goods under this Part; or
- (b) because of the release of any seized goods.

Power to require information

126.—(1) If goods that may be seized under this Part are imported into Saint Lucia, and the Comptroller, relying on information received, is satisfied on reasonable grounds that the use of a trade mark applied to or in relation to those goods is fraudulent, the Comptroller may ask the importer of the goods or an agent of the importer —

- (a) to produce any document in his or her possession relating to the goods; and
- (b) to give information about —
 - (i) the name and address of the person by whom the goods were consigned to Saint Lucia; and
 - (ii) the name and address of the person in Saint Lucia to whom the goods were consigned.

(2) If the importer or his or her agent intentionally or recklessly fails to comply with the request within the prescribed period, the importer or agent commits an offence and is liable on conviction to a fine of ten thousand dollars.

PART 14**OFFENCES****Falsifying etc. a registered trade mark**

127.—(1) A person shall not, intentionally or recklessly, falsify or unlawfully remove a trade mark that has been applied —

- (a) to any goods that are being, or are to be, dealt with or provided in the course of trade; or
- (b) in relation to any goods or services that are being, or are to be, dealt with or provided in the course of trade;

knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

(2) A person falsifies a registered trade mark if the person —

- (a) alters or defaces it;
- (b) makes any addition to it; or
- (c) partly removes, erases or obliterates it;

without the permission of the registered owner, or an authorised user, of the trade mark and without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

(3) A person unlawfully removes a registered trade mark if the person wholly removes, erases or obliterates it —

- (a) without the permission of the registered owner, or an authorised user, of the trade mark; and
- (b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

Falsely applying a registered trade mark

128.—(1) A person shall not, intentionally or recklessly falsely apply a registered trade mark —

- (a) to goods that are being, or are to be, dealt with or provided in the course of trade; or
- (b) in relation to goods or services that are being, or are to be, dealt with or provided in the course of trade;

knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

(2) A person falsely applies a registered trade mark to goods, or in relation to goods or services if the person applies the trade mark or a sign substantially identical with it to the goods or in relation to the goods or services without —

- (a) the permission of the registered owner, or of an authorised user, of the trade mark; and
- (b) being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

Manufacture and possession of die etc. for use in commission of offence

129.—(1) A person shall not make a die, block, machine or instrument —

- (a) knowing that it is likely to be used for, or in the course of, committing an offence against section 127 or 128; or
- (b) reckless of whether or not it is likely to be used for, or in the course of, committing an offence against section 127 or 128.

(2) A person shall not draw, or program a computer or other device to draw, a registered trade mark or part of a registered trade mark —

- (a) knowing that the trade mark or part of the trade mark is likely to be used for, or in the course of, committing an offence against section 127 or 128; or
- (b) reckless of whether or not the trade mark or part of a trade mark is likely to be used for, or in the course of, committing an offence against section 127 or 128.

(3) A person shall not intentionally have in his or her possession, or dispose of —

- (a) a die, block, machine or instrument;
- (b) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
- (c) a representation of a registered trade mark or of part of a registered trade mark

knowing that, or reckless of whether or not, the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, committing an offence against section 127 or 128.

Selling etc. goods with false marks

130. A person shall not intentionally —

- (a) sell goods; or
- (b) expose goods for sale; or
- (c) have goods in his or her possession for the purpose of trade or manufacture; or
- (d) import goods into Saint Lucia for the purpose of trade or manufacture;

knowing that, or reckless of whether or not a falsified registered trade mark is applied to them or in relation to them, or a registered trade mark has been unlawfully removed from them, or a registered trade mark is falsely applied to them or in relation to them.

Penalty for offence under section 127, 128, 129 or 130

131. A person who contravenes section 127, 128, 129 or 130 commits an offence and is liable upon conviction to a fine not exceeding two hundred and fifty thousand dollars.

False representations regarding trade marks

132.—(1) A person shall not intentionally or recklessly make a representation to the effect that a trade mark is a registered trade mark unless the person knows, or has reasonable grounds to believe, that the trade mark is registered in Saint Lucia.

(2) A person shall not intentionally or recklessly make a representation to the effect that a part of a registered trade mark is registered as a trade mark unless the person knows, or has reasonable grounds to believe, that the part is registered as a trade mark in Saint Lucia.

(3) A person shall not intentionally or recklessly make a representation to the effect that a trade mark is registered in respect of goods or services unless the person knows, or has reasonable grounds to believe, that the trade mark is registered in Saint Lucia in respect of those goods or services.

(4) A person shall not intentionally or recklessly make a representation to the effect that the registration of a trade mark gives, exclusive rights to use the trade mark in circumstances in which, having regard to conditions or limitations entered in the Register, the registration does not give those rights unless the person has reasonable grounds to

believe that the registration does give those exclusive rights.

(5) For the purposes of this section, the use in Saint Lucia in relation to a trade mark of the word registered, or of any other word or any symbol referring, either expressly or by implication, to registration is taken to be a representation that the trade mark is registered in Saint Lucia in respect of the goods or services in relation to which it is used except if the trade mark is registered in a country other than Saint Lucia in respect of those goods or services and —

- (a) the word or symbol by itself indicates that the trade mark is registered in that other country or in a country outside Saint Lucia; or
- (b) the word or symbol is used, together with other words or symbols of the same or a bigger size, to indicate that the trade mark is registered in that other country or in a country outside Saint Lucia; or
- (c) the word or symbol is used in relation to goods that are to be exported to that country.

(6) A person who contravenes a provision of this section commits an offence and upon conviction is liable to a fine of ten thousand dollars.

False entries in Register etc.

133.—(1) A person shall not intentionally —

- (a) make a false entry in the Register;
- (b) cause a false entry to be made in the Register; or
- (c) tender in evidence a document that falsely purports to be a copy of, or an extract from, an entry in the Register or a document in the Registry of Companies and Intellectual Property.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of one thousand dollars.

Disobeying summons etc.

134.—(1) A person —

- (a) who has been summoned to appear as a witness before the Registrar; and
- (b) to whom a reasonable sum has been tendered in payment for expenses;

shall not, without reasonable excuse, fail to appear in answer to the summons.

- (2) A person —
 - (a) who has been required by the Registrar to produce a document or any other thing; and
 - (b) to whom a reasonable sum has been tendered in payment for expenses;

shall not, without reasonable excuse, fail to produce the document or thing.

(3) A person who contravenes subsection (1) or (2) commits an offence and upon summary conviction is liable to a fine of two hundred and fifty dollars.

Refusing to give evidence etc.

135.—(1) A person appearing before the Registrar as a witness shall not, without reasonable excuse —

- (a) refuse to be sworn or to make an affirmation; or
- (b) refuse to answer questions that he or she is lawfully required to answer; or
- (c) fail to produce any document or thing that he or she is lawfully required to produce.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of two hundred and fifty dollars

Unauthorised persons not to act in trade mark matters

136.—(1) A person shall not —

- (a) apply for, or obtain, on behalf of another person —
 - (i) the registration of a trade mark;
 - (ii) the making of any entry in the Register; or
 - (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (b) prepare, or cause to be filed in accordance with this Act, a document necessary for another person to obtain or oppose —
 - (i) the registration of a trade mark;
 - (ii) the making of an entry in the Register;

- (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (c) give advice to another person about the validity of the registration of a trade mark or the infringement of a trade mark, unless the person is an attorney-at-law.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of ten thousand dollars.

False representation about Registry of Companies and Intellectual Property

137.—(1) A person —

(a) shall not —

- (i) place, or allow to be placed, on the building in which his or her office is situated;
- (ii) use when advertising his or her office or business; or
- (ii) place on a document, as a description of his or her office or business;

the words “Registry of Companies and Intellectual Property” or words of similar import, whether alone or together with other words; or

(b) shall not use in any other way, in connection with his or her business, words that would reasonably lead other persons to believe that his or her office is, or is officially connected with, the Registry of Companies and Intellectual Property.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of ten thousand dollars.

Employee not to prepare documents etc.

138.—(1) A public officer employed in an office of the Registry of Companies and Intellectual Property shall not prepare, or help prepare, a document to be filed under this Act unless required or authorised to do so by this Act, or any other Act, including the Regulations under that Act, a written direction of the Registrar or an order of a court.

(2) A public officer who contravenes subsection (1) is liable to disciplinary action by service commission which appointed him or her.

Conduct of directors, servants and agents

139.—(1) This section applies for the purposes of a prosecution for an offence under this Act.

(2) If it is necessary to prove the state of mind of a body corporate in relation to particular conduct, it is enough to show —

- (a) that the conduct was engaged in by a director, servant or agent of the body corporate within the scope of his or her actual or apparent authority; and
- (b) that the director, servant or agent had the state of mind.

(3) Any conduct engaged in on behalf of a body corporate by a director, servant or agent of the body corporate within the scope of his or her actual or apparent authority is taken to have been engaged in also by the body corporate, unless it proves that it took reasonable precautions and exercised due diligence to avoid the conduct.

(4) If it is necessary to prove the state of mind of an individual in relation to particular conduct, it is enough to show —

- (a) that the conduct was engaged in by a servant or agent of the individual within the scope of his or her actual or apparent authority; and
- (b) that the servant or agent had the state of mind.

(5) Any conduct engaged in on behalf of an individual by a servant or agent of the individual within the scope of his or her actual or apparent authority is taken to have been engaged in also by the individual, unless the individual establishes that he or she took reasonable precautions and exercised due diligence to avoid the conduct.

(6) In this section —

“director”, in relation to a statutory body that is constituted by one or more members means the member, or any of the members, constituting the body;

“engage in conduct” includes fail or refuse to engage in conduct;

“state of mind”, in relation to a person, includes—

- (a) the person’s knowledge, intention, opinion, belief or purpose; and
- (b) the person’s reasons for the intention, opinion, belief or purpose.

PART 15**COLLECTIVE TRADE MARKS****Object of Part**

140. This Part —

- (a) defines a collective trade mark; and
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to collective trade marks.

Collective trade mark

141. A collective trade mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

Application of Act

142.—(1) Subject to this Part, the provisions of this Act relating to trade marks, other than Part 10, apply to collective trade marks and so apply as if —

- (a) a reference to a trade mark included a reference to a collective trade mark;
- (b) a reference to a person doing something for the registration of a trade mark included a reference to an association doing that thing for the registration of the collective trade mark; and
- (c) a reference to a trade mark registered by a person included a reference to a collective trade mark registered by an association.

(2) For the purposes of this Act —

- (a) the use of a collective trade mark by a member of the association that is the applicant for the registration of the collective trade mark is taken to be a use of the collective trade mark by the applicant; and
- (b) the use of a registered collective trade mark by a member of the association that is the registered owner of the collective trade mark is taken to be a use of the collective trade mark by the registered owner.

(3) Section 25, applies in relation to a collective trade mark as if a reference to the applicant were a reference to the members of the association that applied for registration of the collective trade mark.

Application for registration

143. An application for the registration of a collective trade mark shall be made by the association to which the mark belongs —

Limitation on rights given by registered collective trade mark

144. A member of an association in whose name a collective trade mark is registered does not have the right to prevent another member of the association from using the collective trade mark in accordance with the rules of the association, if any.

Assignment etc. of collective trade mark

145. A collective trade mark may not be assigned or transmitted.

Infringement of collective trade mark

146. In an action by an association in whose name a collective trade mark is registered seeking relief for infringement of the collective trade mark, the association may take into account, in claiming damages, any damage or loss of profits sustained or incurred by the members of the association as a result of the infringement.

PART 16

CERTIFICATION TRADE MARKS

Object of Part

147. This Part —

- (a) defines a certification trade mark;
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to certification trade marks; and
- (c) outlines the role of the Registrar in the regulation of certification trade marks.

Certification trade mark

148. A certification trade mark is a sign used, or intended to be used, to distinguish goods or services —

- (a) dealt with or provided in the course of trade; and
- (b) certified by a person the owner of the certification trade mark, or by another person approved by that owner, in relation to quality, accuracy or some other characteristic, including, in the case of goods, the origin, material or mode of manufacture;

from other goods or services dealt with or provided in the course of trade but not so certified.

Application of Act

149. Subject to this Part, the provisions of this Act relating to trade marks, other than subsections (6), (7), (8), (9) and (10) of section 2, sections 10, 11 (1) (b), 17, 18, 25, 72 (2) (d), 105 and 110, and Part 9 and Part 17 apply to certification trade marks and so apply as if a reference to a trade mark included a reference to a certification trade mark.

Rights given by registration of a certification trade mark

150. Section 4 applies in relation to a certification trade mark as if subsection (1) were omitted and the following subsection were substituted —

“(1) If a certification trade mark is registered, the registered owner has, subject to this Part, the exclusive rights to use, and to allow other persons to use, the certification trade mark, in relation to the goods or services or both in respect of which the certification trade mark is registered. The registered owner may, however, use the certification trade mark only in accordance with the rules governing the use of the certification trade mark.”.

Rights of persons allowed to use certification trade mark

151.—(1) Where the registered owner of a registered certification trade mark allows another person to use the certification trade mark in relation to goods or services in respect of which it is registered, the approved user has a right to use the certification trade mark in relation to those goods or services in accordance with the rules governing the use of certification trade mark.

(2) In this Part —

“approved user” means the person allowed to use a registered certification trade mark pursuant to subsection (1).

Rules governing the use of certification trade marks

152.—(1) A person who has filed an application for the registration of a certification trade mark shall file, in accordance with the Regulations, a copy of the rules governing the use of the certification trade mark, and any document prescribed under section 11(2) .

- (2) The rules shall include provisions regarding —
- (a) the person's approved certifiers who may be approved for the purpose of certifying goods or services or both;
 - (b) the cases in which goods or services are to be certified;
 - (c) the conditions under which an approved user is to be allowed to use the certification trade mark in relation to goods or services;
 - (d) the use of the certification trade mark by the owner, if he or she intends to use it, and any approved user; and
 - (e) the settlement of any dispute arising from a refusal —
 - (i) to certify goods or services; or
 - (ii) to allow the use of the certification trade mark;

and any other provision that the Registrar requires or permits to be inserted.

- (3) In this Part —

“approved certifier” means a person approved for the purpose of certifying goods or services or both pursuant to subsection (2).

Grant of application to register

153.—(1) If after examining an application made pursuant to this Part , the Registrar is satisfied that —

- (a) the application has been made in accordance with this Act;
- (b) subject to subsection (2), the rules referred to in section 152 —
 - (i) would not be detrimental to the public; and
 - (ii) are satisfactory having regard to the criteria prescribed under section 152(2);
- (c) the applicant or the approved certifiers are competent to certify the goods or services or both in respect of which the certification trade mark is to be registered;

(d) the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from the goods or services not so certified;

(e) there are no other grounds for rejecting the application;

the Registrar shall register the certification trade mark and issue a certificate to that effect to the applicant and shall publish notice of the registration in the prescribed form in the Gazette.

(2) In deciding, pursuant to subsection (1) (d), whether or not a certification trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier, the Registrar shall take into account the extent to which —

(a) the certification trade mark is inherently adapted so to distinguish those goods or services; or

(b) because of its use or of any other circumstances the certification trade mark has become adapted so to distinguish those goods or services;

(3) The Registrar may require the applicant to make amendments to any of the rules referred to in section 152 as the Registrar considers necessary.

Refusal to register

154.—(1) The Registrar may, subject to subsection (2), reject an application made pursuant to this Part if he or she is not satisfied as to any of the grounds referred to in section 153(1).

(2) The Registrar may not reject an application made pursuant to this Part without giving the applicant an opportunity to be heard.

Variation of rules

155.—(1) Subject to subsection (2), the rules governing the use of a registered certification trade mark may be varied in accordance with the Regulations.

(2) The rules governing the use of a certification trade mark shall not be varied without the approval of the Registrar.

(3) Before deciding to approve a variation in the rules governing the use of a certification trade mark the Registrar shall be satisfied that the rules as varied —

- (a) would not be detrimental to the public;
 - (b) are satisfactory having regard to the criteria prescribed pursuant to section 152 (2)(b).
- (4) The Registrar shall —
- (a) notify the registered owner of the certification trade mark in, writing, of his or her decision to approve or not to approve the variation of the rules governing the use of a certification and trade mark; and
 - (b) cause notice, if applicable, of any variation in the rules, to be published in the *Gazette*.

Rules to be available for inspection

156. Rules governing the use of a registered certification trade mark must be available for inspection at the same time and in the same manner as the Register.

Assignment of registered certification trade mark

157.—(1) A registered certification trade mark shall not be assigned unless with the consent of the Registrar.

(2) An application to the Registrar for his or her consent to the assignment of a registered certification trade mark shall be in the prescribed form.

(3) The Registrar may, having regard to the matters provided for under the Regulations, grant or refuse consent .

(4) Appeal against a decision of the Registrar pursuant to this section lies to the High Court.

Rectification of the Register by order of court

158.—(1) Section 72 applies in relation to a certification trade mark as if the words “or on the ground that the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from goods or services not so certified” was added at the end of subsection (2)(a).

(2) In addition to its powers under Division 2 of Part 8 as affected by subsection (1) in relation to certification trade marks, High Court may, on the application of a person aggrieved, order that the Register be rectified by cancelling the registration of a certification trade mark, or removing or amending an entry in the Register relating to the certification trade mark, on the ground that —

- (a) the registered owner or an approved certifier is no longer competent to certify any of the goods or services or both in respect of which the mark is registered;
- (b) the rules governing the use of the certification trade mark are detrimental to the public; or
- (c) the registered owner or an approved user has failed to comply with a provision of the rules governing the use of the certification trade mark.

(3) Notice of an application to the High Court pursuant to subsection (1), shall be given to the Registrar.

(4) Except for cases in which the High Court directs the Registrar to appear, the Registrar may appear before the High Court and be heard at his or her discretion.

(5) A copy of any order made by the High Court under this section shall be given to the Registrar and the Registrar shall comply with the order.

Variation of rules by order of court

159.—(1) The High Court may, on the application of a person aggrieved, make such orders as it thinks fit for varying the rules governing the use of a certification trade mark.

(2) Notice of an application to the High Court shall be given to the Registrar.

Copy of order and rules

160.—(1) A copy of an order made by the High Court under section 159 shall be given to the Registrar.

(2) If the High Court orders that the rules are to be varied, the registered owner of the certification trade mark shall give to the Registrar a copy of the rules as varied to be certified by the Registrar as a true copy .

PART 17

DEFENSIVE TRADE MARKS

Object of Part

161. This Part —

- (a) provides for the registration of certain trade marks as defensive trade marks; and

- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to defensive trade marks.

Defensive trade mark

162.—(1) If, because of the extent to which a registered trade mark has been used in relation to all or any of the goods or services in respect of which it is registered, it is likely that its use in relation to other goods or services will be taken to indicate that there is a connection between those other goods or services and the registered owner of the trade mark, the trade mark may, on the application of the registered owner, be registered as a defensive trade mark in respect of any or all of those other goods or services.

(2) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if the registered owner does not use or intend to use the trade mark in relation to those goods or services.

(3) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if it is already registered otherwise than as a defensive trade mark in the name of the applicant in respect of those goods or services.

(4) A trade mark that is registered as a defensive trade mark in respect of particular goods or services may be subsequently registered otherwise than as a defensive trade mark in the name of the registered owner in respect of the same goods or services.

Application of Act

163. Subject to this Part, the provisions of this Act, other than section 4(1), 11(1)(b), 25, 43, 72(2)(d), 105 and 110, Part 9 and Part 16 apply to defensive trade marks and so apply as if a reference to a trade mark included a reference to a defensive trade mark.

Additional grounds for rejecting application for registration or opposing registration

164. In addition to any other ground on which —

- (a) an application for the registration of a trade mark as a defensive trade mark may be rejected; or
- (b) the registration of a trade mark as a defensive trade mark may be opposed; the application shall be rejected or the registration may be opposed;

- (c) if the trade mark is not registered as a trade mark in the name of the applicant; or
- (d) in the case of a registered trade mark, if it is not likely that the use of the trade mark in relation to the goods or services in respect of which its registration as a defensive trade mark is sought will be taken to indicate that there is a connection between those goods or services and the registered owner.

Amendment or cancellation of registration by order of court

165. Section 72 applies in relation to a defensive trade mark as if “or under section 164” were added at the end of subsection (2)(a).

Cancellation of registration by Registrar

166. The Registrar may cancel the registration of a trade mark as a defensive trade mark if the trade mark is not otherwise registered in the name of the registered owner of the defensive trade mark.

PART 18

JURISDICTION AND POWERS OF COURTS

Jurisdiction of the High Court

167.—(1) The High Court has jurisdiction with respect to matters arising under this Act.

(2) The jurisdiction of the High Court to hear and determine appeals against decisions, directions or orders of the Registrar is exclusive of the jurisdiction of any other court .

(3) A prosecution for an offence against this Act may not be started in the High Court.

Transfer of proceedings

168.—(1) A court in which an action or proceeding under this Act has been started may, on the application of a party made at any stage, by an order, transfer the action or proceeding to another court having jurisdiction to hear and determine the action or proceeding.

(2) When a court transfers an action or proceeding to another court—

- (a) all relevant documents of record filed in the transferring court shall be sent to the other court by the Registrar or other appropriate officer of the transferring court; and
- (b) the action or proceeding shall continue in the other court as if —

- (i) it had been started there; and
- (ii) all steps taken in the transferring court had been taken in the other court.

Appeals

169.—(1) An appeal lies to the High Court against a judgment or order of lower court exercising jurisdiction under this Act.

(2) Except with the leave of the Court of Appeal, an appeal does not lie to the Court of Appeal against a judgment or order of a single judge of the High Court in the exercise of its jurisdiction to hear and determine appeals from decisions or directions of the Registrar.

(3) With the special leave of the High Court, an appeal lies to the High Court against a judgment or order referred to in subsection (1).

(4) Except as otherwise provided by this section, an appeal does not lie against a judgment or order referred to in subsection (1).

Registrar may appear in appeals

170. The Registrar may appear and be heard at the hearing of an appeal to the High Court against a decision or direction of the Registrar.

Powers of High Court

171. On hearing an appeal against a decision or direction of the Registrar, the High Court may do anyone or more of the following —

- (a) admit further evidence orally, or on affidavit or otherwise;
- (b) permit the examination and cross-examination of witnesses, including witnesses who gave evidence before the Registrar;
- (c) order an issue of fact to be tried as it directs;
- (d) affirm, reverse or vary the Registrar's decision or direction;
- (e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;
- (f) order a party to pay costs to another party.

PART 19**ADMINISTRATION****Registrar of Companies and Intellectual Property**

172. The Registrar has the powers and functions that are given to him or her under this Act or any other Act and shall be responsible for the administration of this Act.

Registrar's powers

- 173.** The Registrar may, for the purposes of this Act —
- (a) summon witnesses;
 - (b) receive written or oral evidence on oath or affirmation;
 - (c) require the production of documents or articles; and
 - (d) award costs against a party to proceedings brought before the Registrar; and
 - (e) notify, as he or she considers fit, any person of any matter that, in his or her opinion, should be brought to the person's notice.

Exercise of power by Registrar

174. The Registrar may not exercise a power Under this Act in any way that adversely affects a person applying for the exercise of that power without first giving that person a reasonable opportunity of being heard.

Registrar to act as soon as practicable

175. If —

- (a) the Registrar is required Under this Act to do any act or thing; and
- (b) no time or period is provided within which the act or thing is to be done;

the Registrar is to do the act or thing as soon as practicable.

Deputy Registrar

176.—(1) Subject to any direction by the Registrar, a Deputy Registrar has all the powers and functions of the Registrar, except the powers of delegation Under section 177.

(2) A power or function of the Registrar, when exercised by a Deputy Registrar, is taken to have been exercised by the Registrar.

(3) The exercise of a power or function of the Registrar by a Deputy Registrar does not prevent the exercise of the power or function by the Registrar.

(4) If the exercise of a power or function by the Registrar is dependent on the opinion, belief or state of mind of the Registrar in relation to a matter, that power or function may be exercised by a Deputy

Registrar on his or her opinion, belief or state of mind in relation to that matter.

(5) If the operation of a provision of this Act or another Act is dependent on the opinion, belief or state of mind of the Registrar in relation to a matter, that provision may operate on the opinion, belief or state of mind of a Deputy Registrar in relation to that matter.

Delegation of Registrar's powers and functions

177.—(1) The Registrar may by signed instrument delegate all or any of his other powers or functions to -.

- (a) a prescribed person, or persons included in a prescribed class, holding or performing the duties of an office in the Registry of Companies and Intellectual Property; or
- (b) a prescribed public officer, or public officer included in a prescribed class, employed in the Registry of Companies and Intellectual Property.

(2) A delegate shall, if so required by the instrument of delegation, exercise or perform a delegated power or function under the direction or supervision of —

- (a) the Registrar; or
- (b) a person specified in the instrument, being a person referred to in subsection (1) (a) or (b).

PART 20

THE REGISTER AND OFFICIAL DOCUMENTS

The Register

178.—(1) A Register of Trade Marks is to be kept at the Registry of Companies and Intellectual Property.

(2) The Registrar shall enter in the Register in accordance with this Act —

- (a) all particulars of registered trade marks, and all other matters that were on the old register when the repealed Acts were repealed; and
- (b) particulars of trade marks, certification trade marks, collective trade marks and defensive trade marks, and all other matters, that are required to be registered under this Act; and

(c) other prescribed matters.

(3) If two or more trade marks were entered as associated trade marks in the old register, no equivalent entry designating them as associated trade marks is to be made in the Register.

(4) All particulars entered in the Register under subsection (2)(a) are taken to have been so entered at the commencement of this Act.

Register may be kept on computer

179.—(1) The Register may be kept in whole or in part by using a computer.

(2) Any record of a particular or other matter made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.

Inspection of Register

180.—(1) The Register shall be available at the Registry of Companies and Intellectual Property for inspection by any person during the hours when the Office is open for business.

(2) If the Register, or any part of the Register, is kept by using a computer, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

Register

181.—(1) The Register is prima facie evidence of any particular or other matter entered in it.

(2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

(3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any of the particulars comprised in the Register or in that part of the Register is admissible in any proceedings as evidence of those particulars.

Certified copies of documents

182.—(1) A certificate signed by the Registrar and stating that —

- (a) anything required or permitted to be done by the Act or the Repealed Act was done or not done on, or had been done or not been done by, a specified date;
- (b) anything prohibited by the Act or the repealed Act was done or not done on, or had been done or not been done by, a specified date; or
- (c) a document was available for public inspection at the Registry of Companies and Intellectual Property on a specified date or during a specified period;

is prima facie evidence of the matters so stated.

(2) A copy of, or an extract from, a document held in the Registry of Companies and Intellectual Property that is certified by the Registrar to be a true copy or extract is admissible in any proceedings as if it were the original.

PART 21**MISCELLANEOUS****Division 1***Applications and other documents***Making and signing applications etc.**

183. An application, notice or request required or permitted under this Act to be made or signed by a person shall be made or signed, on behalf of that person, by an attorney-at-law in accordance with the Regulations.

Filing of documents

184.—(1) A document is taken to be filed at the Registry of Companies and Intellectual property if it is filed at a sub-office of the Registry of Companies and Intellectual Property.

(2) A document may be filed at the Registry of Companies and Intellectual Property or any of its sub-offices by being delivered there —

- (a) personally;
- (b) by post; or
- (c) by any prescribed means.

Withdrawal of application etc.

185.—(1) A person who has filed an application, notice or request may withdraw it, in accordance with the Regulations, at any time while it is still being considered by the Registrar.

(2) If —

- (a) the right or interest on which the person relied to file the application, notice or request has become vested in another person; and
- (b) the other person notifies the Registrar in writing that the right or interest is vested in him or her;

the other person may withdraw the application, notice or request as provided in subsection (1).

Address for service

186.—(1) The address for service of a person who has filed an application, notice or request is —

- (a) the address for service stated in the application, notice or request; or
- (b) if the person subsequently notifies in writing another address to the Registrar, that other address.

(2) Where a trade mark is registered, or a claim to an interest in, or to a right in respect of, a registered trade mark that a person has recorded in the Register, the Registrar shall enter in the Register as the address for service of the registered owner or of the person —

- (a) if paragraph (b) does not apply, the address given, or last given, by the registered owner or the person to the Registrar under subsection (1); or
- (b) if, before the Registrar registers the trade mark or records the claim to the interest or right, the registered owner or person gives in writing to the Registrar another address as his or her address for service, that other address.

(3) The registered owner of a registered trade mark, or any person whose claim to an interest in, or to a right in respect of, a trade mark is recorded in the Register, shall notify the Registrar in writing of any change in his or her address for service and the Registrar shall amend the Register accordingly.

(4) The address for service of —

- (a) the registered owner of a registered trade mark; or
- (b) a person whose claim to an interest in, or to a right in respect of, a trade mark is recorded in the Register;

is the address set out from time to time in the Register as being the address for service of the registered owner or of the person.

(5) An address for service shall be an address in Saint Lucia.

(6) If this Act provides that a document is to be served on, or given or sent to, a person —

- (a) the document may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document may be served on an agent of the person in Saint Lucia or may be sent by post to any address of the person in Saint Lucia that is known to the Registrar.

(7) Subsection (6) does not affect the operation of section 23 of the Interpretation Act 1968, No. 18.

Change of name

187.—(1) If there is a change in the name of a person who has filed an application, notice or request, the person shall notify the Registrar in writing of the change.

(2) If there is a change in the name of —

- (a) the registered owner of a registered trade mark; or
- (b) a person whose claim to an interest in, or to a right in respect of, a trade mark is recorded in the Register;

the registered owner or the person shall notify the Registrar in writing of the change and the Registrar shall amend the Register accordingly.

Death of applicant etc.

188.—(1) If an applicant for the registration of a trade mark dies before registration is granted on the application, his or her legal representative may proceed with the application.

(2) If, at any time after a trade mark is registered, the Registrar is satisfied that the person in whose name the trade mark is registered had died, or, in the case of a body corporate, had ceased to exist, before registration was granted, the Registrar may amend the Register by

substituting for the name entered in the Register the name of the person who should be the registered owner of the trade mark.

Division 2

Proceedings before the Registrar or a court

Description of registered trade mark

189. In an indictment, information, pleading or proceeding relating to a registered trade mark, the trade mark may be identified by its registration number and it is not necessary to reproduce or describe the trade mark.

Evidence of trade usage

190. In an action or proceeding relating to a trade mark, evidence is admissible of the usage of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.

Death of party to proceeding before Registrar

191. If a person who is party to a proceeding pending before the Registrar dies, the Registrar may —

- (a) on being so asked, substitute in the proceeding another person in the place of the deceased party if the Registrar is satisfied that the interest of the deceased party has been transmitted to that other person; or
- (b) allow the proceeding to continue without any substitution if the Registrar is of the opinion that the interest of the deceased party is sufficiently represented by the surviving parties.

Costs awarded by Registrar

192.—(1) The Registrar may award costs in respect of the matters, and in the amounts, provided for in the Regulations against any party to proceedings brought before him or her.

(2) A party desiring to obtain costs shall apply to the Registrar in accordance with the Regulations.

(3) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

Security for costs

193. If a person who neither resides nor carries on business in Saint Lucia —

- (a) gives notice of opposition under this Act; or
- (b) applies to the Registrar under Part 9 for a trade mark to be removed from the Register;

the Registrar may require the person to give security for the costs of the proceeding and may, if security is not given, dismiss the proceeding.

Division 3*General***Fees**

194.—(1) The Regulations may prescribe the fees to be paid for the purposes of this Act and may prescribe different fees in respect of the doing of an act according to the time when the act is done.

(2) prescribed fees are payable in accordance with the Regulations.

(3) If a fee is payable in respect of the doing of an act by the Registrar or Comptroller, he or she shall not do the act until the fee has been paid.

(4) Subject to subsection (5), if —

- (a) a fee is payable in respect of the doing of an act by a person other than the Registrar or the Comptroller; or
- (b) a fee is payable in respect of the filing of a document;

the act is taken to have been done, or the document is taken to have been filed, in spite of the failure to pay the fee.

(5) If the Registrar or the Comptroller notifies the person concerned or his or her agent, in accordance with the Regulations, that the fee has not been paid, the act is not taken to have been done, or the document is not taken to have been filed, before the day on which the fee is paid.

Extension of time

195.—(1) If, because of an error or omission by a Registry of Companies and Intellectual Property, a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar shall extend the time for doing the act.

(2) If, because of —

- (a) an error or omission by the person concerned or by his or her agent; or
- (b) circumstances beyond the control of the person concerned;

a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the Regulations, extend the time for doing the act.

(3) If —

- (a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and
 - (b) on application made by that person in accordance with the Regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time;
- the Registrar may extend the time for doing the act.

(4) The time allowed for doing a relevant act may be extended, whether before or after that time has expired.

(5) If an application is made under subsection (2) or (3) for an extension of time for more than three months, the Registrar shall publish notice of the application in the Gazette.

(6) A person may, as prescribed, oppose the granting of the application.

(7) An appeal against the decision of the Registrar not to extend the time for the doing of an act, lies to the High Court.

(8) In this section —

“relevant act” means —

- (a) any act, other than a prescribed act, done in relation to a trade mark;
- (b) the filing of any document, other than a prescribed document; or
- (c) any proceedings, other than court proceedings.

Publication of documents

196. The Registrar may prepare, publish and sell documents relating to trade marks as the Registrar thinks fit.

Use of trade mark for export trade**197.**—(1) If —

- (a) a trade mark is applied in Saint Lucia —
 - (i) to, or in relation to goods that are to be exported from Saint Lucia;
 - (ii) in relation to services that are to be exported from Saint Lucia.; or
- (b) any other act is done in Saint Lucia to goods to be exported from Saint Lucia or services to be exported from Saint Lucia which, if done in relation to goods or services to be dealt with or provided in the course of trade in Saint Lucia, would constitute a use of the trade mark in Saint Lucia;

the application of the trade mark or the other act is taken, for the purposes of this Act, to constitute use of the trade mark in relation to the goods to be exported from Saint Lucia or services to be exported from Saint Lucia.

(2) Subsection (1) applies to an act done before the commencement of this Act as it applies to an act done on or after that day, but it does not affect —

- (a) a decision of a court made before that day; or
- (b) the determination of an appeal from such a decision.

Passing off actions**198.**—(1) Except as provided in subsection (2), this Act does not affect the law relating to passing off.

(2) In an action for passing off arising out of the use by the defendant of a registered trade mark of which he or she is the registered owner or an authorised user and that is substantially identical with or deceptively similar to, the trade mark of the plaintiff, damages may not be awarded against the defendant if the defendant satisfies the court-

- (a) that, at the time when the defendant began to use the trade mark, he or she was unaware, and had no reasonable means of finding out, that the trade mark of the plaintiff was in use; and
- (b) that, when the defendant became aware of the existence and nature of the plaintiff's trade mark, he or she immediately ceased to use the trade mark in relation to the goods or services in relation to which it was used by the plaintiff.

Expenses

199. Any expenses incurred pursuant to this Act shall be a charge on the Consolidated Fund.

Regulations

200.—(1) The Minister may after consultation with the Registrar, make Regulations —

- (a) prescribing matters required or permitted by this Act to be prescribed;
- (b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act;
- (c) prescribing matters necessary or convenient to be prescribed for the conduct of any business relating to the Registry of Companies and Intellectual Property or a sub-office of the Registry of Companies and Intellectual Property.

(2) Without limiting the generality of subsection (1), the Regulations may —

- (a) provide for appeals against decisions of the Registrar made under the Regulations;
- (b) require persons to make statutory declarations in support of any application, notice or request filed under this Act;
- (c) provide for the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act;
- (d) provide for the refund, in specific circumstances, of the whole or part of a fee paid under this Act;
- (e) provide for the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee;
- (f) provide for the expenses and allowances to be paid to witnesses or persons attending at proceedings before the Registrar;
- (g) give power to the Registrar —
 - (i) to require, in specified circumstances, a person applying under Part 9 for a trade mark to be removed from the Register to give security for any costs that may arise from the proceedings;

- (ii) not to proceed with the application if security is not given;
- (iii) to refund to the applicant any amount given as security and not applied in settling costs awarded against the applicant;
- (h) provide for the destruction of documents relating to a trade mark at least ten years after the registration of the trade mark has ceased;
- (i) prescribe as penalties for offences against the Regulations fines not exceeding two hundred and fifty dollars;
- (j) make transitional or consequential provision as necessary or convenient because of the repeal of the repealed Acts and the enactment of this Act.

Repeal

201. The Merchandise Marks Ordinance Cap.193 and Title X of the Commercial Code Cap. 244 are repealed.

Transitional

202.—(1) A trade mark that, immediately before the date of commencement of this Act, was registered under the repealed Acts are registered trade marks for the purposes of this Act.

(2) The registration of an existing trade mark expires on the day on which it would have expired under the repealed Act if these Acts had not been repealed.

(3) Division 2 of Part 7 applies in relation to the renewal of the registration of an existing trade mark.

(4) If an application for registration, other application, notice or request was pending under the repealed Acts, that application is to be dealt with in accordance with this Act and is taken to have been filed in accordance with this Act.

Passed in the House of Assembly this 27th day of March, 2001.

MATTHEW ROBERTS,
Speaker of the House of Assembly.

Passed in the Senate this 23rd day of March, 2001.

HILFORD DETERVILLE,
President of the Senate.