

SAINT LUCIA

No. 22 of 2001

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I ASSENT

[L.S.]

PEARLETTE LOUISY,
Governor-General.

26th October, 2001.

SAINT LUCIA

No. 22 of 2001

AN ACT to provide for the promotion and protection of trade marks and for related matters.

[3rd November, 2001]

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 1**PRELIMINARY****Short title and commencement**

1.—(1) This Act may be cited, as the Trade Marks Act, 2001.

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

PART 2**INTERPRETATION****Interpretation**

2.—(1) In this Act —

“applicant” in relation to an application, means the person in whose name the application is for the time being proceeding;

“applied to” has the meaning given to it in subsection (11);

“applied in relation to” has the meaning given to it in subsection (11);

“approved form” means a form approved by the Registrar for the purposes of the provision in which the expression appears;

“assignment” in relation to a trade mark, means an assignment by act of the parties concerned;

“association” does not include a body corporate;

“attorney-at-law” means an attorney-at-law as defined by the Legal Professions Act 2000;

“authorized use of a trade mark” has the meaning given to it by subsection (7);

“authorized user of a trade mark” has the meaning given to it by subsection (6) ;

“certification trade mark” has the meaning given to it by section 148;

“collective trade mark” has the meaning given to it by section 141 ;

“Companies and Intellectual Property (Registry) Act” means the Companies and Intellectual Property (Registry) Act 2000, No. 12;

“Comptroller” means the Comptroller of Customs appointed under the Customs (Control and Management Act 1990), No. 23;

- “Convention country” means a country which is a party to the Paris Convention for the Protection of Industrial Property 1883 ;
- “date of registration”, in relation to the registration of a trade mark in respect of particular goods and services, means the day from which the registration of a trade mark in respect of those goods or services is taken to have had effect under section 56(1) or (2);
- “deceptively similar” has the meaning given to it by sub-section (13);
- “defensive trade mark” has the meaning given to it by section 162;
- “Deputy Registrar” means the Deputy Registrar appointed under the Companies and Intellectual Property (Registry) Act;
- “designated owner” in relation to goods imported into Saint Lucia means the person identified as the owner of the goods on the entry made pursuant to the Customs (Control and Management) Act 1990;
- “divisional application” has the meaning given to it by section 29;
- “examine”, in relation to an application for the registration of a trade mark, means to carry out an examination under section 15 in relation to the application;
- “existing registered mark” means a mark that was registered under the repealed Acts and whose registration was due to expire after the coming into force of this Act;
- “file” means to file at the Registry of Companies and Intellectual Property;
- “filing date” means —
- (a) in relation to an application for the registration of a trade mark other than an application referred to in paragraph (b) of this definition, the day on which the application is filed;
 - (b) in relation to a divisional application for the registration of a trade mark, the day on which the initial application, within the meaning of Division 3 of Part 4 , was filed;
- “geographical indication”, has the meaning given to it in the Geographical Indications Act 2000, No. 4;
- “goods of a person” means goods dealt with or provided in the course of trade by the person;
- “limitations” means limitations of the exclusive right to use a trade mark, including limitations of that right as to —

(a) mode of use;

(b) use in Saint Lucia; or

(c) use in relation to goods or services to be exported;

“Minister” means Minister with responsibility for Intellectual Property;

“notified trade mark” means a trade mark in respect of which notice under section 115 is in force;

“objector”, in relation to seized goods, means any person who has given a notice under section 115 that is in force;

“old register” means the Register of Patents, Trademarks and Designs kept under the repealed Acts;

“opponent” in relation to the registration of a trade mark, means —

(a) the person who has filed, under section 36, a notice of opposition to the registration of the trade mark; or

(b) if section 37 applies, a person in whose name the notice of the opposition is taken to have been filed;

“originate” in relation to wine, has the meaning given to it by subsection (19);

“pending” in relation to an application for the registration of a trade mark under this Act has the meaning given to it by subsection (14);

“pending” in relation to an application for the registration of a trade mark under the repealed Acts has the meaning given to it by subsection (15);

“person” includes a body corporate or unincorporated body;

“predecessor in title” in relation to a person who claims to be the owner of a trade mark means —

(a) if the trade mark was assigned or transmitted to one or more than one person before it was assigned or transmitted to the first mentioned person, that other person or anyone of those other persons; or

(b) if paragraph (a) does not apply, the person who assigned the trade mark, or from whom the trade mark was transmitted, to the first mentioned person;

“prescribed” means prescribed in Regulations made under this Act;

“priority date” has the meaning given to it by subsection (16);

- “Register” means the Register of Trade Marks kept under section 178;
- “registered owner” in relation to a registered trade mark, means the person in whose name the trade mark is registered;
- “registered trade mark” means a trade mark whose particulars are registered in the Register under this Act;
- “Registrar” means the Registrar of Companies and Intellectual Property appointed pursuant to the Companies and Intellectual Property (Registry) Act 2000;
- “registration number” , in relation to a registered trade mark, means the number given to it Under section 52 (2);
- “Registry of Companies and Intellectual Property” means the Registry of Companies and Intellectual Property established under Companies and Intellectual Property (Registry) Act;
- “Regulations” means Regulations made pursuant to section 200;
- “remove from the Register”, in relation to a trade mark, has the meaning given to it by subsection (17);
- “repealed Acts” means the Acts repealed pursuant to section 201;
- “represented graphically” has the meaning given to it in subsection (3);
- “seized goods” means goods seized under section 116;
- “services of a person” means services dealt with or provided in the course of trade by the person;
- “sign” includes letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, color, and any combination thereof;
- “similar goods” has the meaning given to it by subsection (18)(a);
- “similar services” has the meaning given to it by subsection (18)(b);
- “trade mark” means a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;
- “transmission” means —
- (a) transmission by operation of law;
 - (b) devolution on the personal representative of a deceased person; or
 - (c) any other kind of transfer except assignment;

“use of trade mark” has the meaning effected by subsections (2), (3), and (4);

“use of trade mark in relation to goods” has the meaning given to it pursuant to subsection (5)(a);

“use of trade mark in relation to services” has the meaning given to it pursuant to subsection (5)(b);

“word” includes an abbreviation of a word.

(2) If the Registrar or the High Court, having regard to the circumstances of a particular case, thinks fit, the Registrar or the High Court may decide that a person has used a trade mark if it is established that the person has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark.

(3) A trade mark is capable of being represented graphically if it can be represented on paper.

(4) An authorised use of a trade mark by a person is taken, for the purposes of this Act, to be a use of the trade mark by the owner of the trade mark.

(5) In this Act —

“use of a trade mark in relation to goods” means use of the trade mark upon, or in physical or other relation to, the goods, including second-hand goods;

“use of a trade mark in relation to services” means use of the trade mark in physical or other relation to the services.

(6) A person is an authorised user of a trade mark if the person uses the trade mark in relation to goods or services Under the control of the owner of the trade mark.

(7) The use of a trade mark by an authorised user of the trade mark is an authorised use of the trade mark to the extent only that the user uses the trade mark under the control of the owner of the trade mark.

(8) If the owner of a trade mark exercises quality control over goods or services —

(a) dealt with or provided in the course of trade by another person; and —

(b) in relation to which the trade mark is used;

the other person is taken, for the purposes of subsections (6) and (7), to use the trade mark in relation to the goods or services under the control of the owner.

(9) If —

- (a) a person deals with or provides, in the course of trade, goods or services in relation to which a trade mark is used; and
- (b) the owner of the trade mark exercises financial control over the other person's relevant trading activities;

the other person is taken, for the purposes of subsection (6) and (7), to use the trade mark in relation to the goods or services under the control of the owner.

(10) Subsections (8) and (9) do not limit the meaning of the expression “under the control of” in subsections (6) and (7).

(11) For the purposes of this Act —

- (a) a trade mark is taken to be applied to any goods, material or thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing; and
- (b) a trade mark is taken to be applied in relation to goods or services if it is —
 - (i) applied to any covering, document, label, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade; or
 - (ii) used in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services; and
- (c) in addition to paragraphs (a) and (b), a trade mark is taken to be applied in relation to goods or services if it is used —
 - (i) on a signboard or in an advertisement, including a tele-vised advertisement; or
 - (ii) in an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document;

and goods are delivered, or services provided, as the case may be, to a person following a request or order made by referring to the trade mark as so used.

(12) In subsection (11) (b)(i) —

“covering” includes packaging, frame, wrapper, container, stopper, lid or cap;

“label” includes a band or ticket.

(13) For the purposes of this Act, a trade mark is taken to be deceptively similar to another trade mark if it so nearly resembles that other trade mark that it is likely to deceive or cause confusion.

(14) An application for the registration of a trade mark under this Act is pending from the time it is filed until —

(a) it lapses pursuant to section 21, is withdrawn pursuant to section 185 or is rejected under section 17;

(b) if the Registrar refuses, under section 39, to register the trade mark and there is no appeal against the decision, the end of the period allowed for the appeal;

(c) if the Registrar refuses, under section 39, to register the trade mark and —

(i) there is an appeal against the decision; and

(ii) the decision is confirmed on appeal;

the day on which the decision is confirmed on appeal; or

(d) the trade mark is registered under section 52;

(15) An application for the registration of a trade mark under the repealed Acts was pending immediately before the commencement date of this Act if, before that date —

(a) the application had not lapsed, been withdrawn, or refused; or

(b) had been refused but —

(i) the period allowed for appealing against the decision to refuse had not yet ended; or

(ii) an appeal had been made against the decision but had not been decided;

under the repealed Acts.

(16) The priority date of the registration of a trade mark in respect of particular goods or services is —

(a) if the trade mark is registered, the date of the registration of trade mark in respect of those goods or services;

- (b) if the registration of the trade mark is being sought, the day that would be the date of the registration of the trade mark in respect of those goods or services if the trade mark was registered.

(17) A trade mark is taken to have been removed from the Register if the Registrar makes an entry in the Register to the effect that all entries in the Register relating to the trade mark are taken to have been removed from the Register.

(18) For the purposes of this Act —

- (a) goods are similar to other goods if —
 - (i) they are the same as the other goods; or
 - (ii) they are of the same description as that of the other goods; or
- (b) services are similar to other services if —
 - (i) if they are the same as the other services; or
 - (ii) if they are of the same description as that of the other services.

(19) For the purposes of this Act —

- (a) a wine is taken to have originated in a foreign country or Saint Lucia only if the wine is made within the territory of that country or of Saint Lucia, as the case may be; and
- (b) a wine is taken to have originated in a particular region or locality of a foreign country or of Saint Lucia only if the wine is made from grapes grown in that region or locality.

PART 3

TRADE MARKS AND TRADE MARK RIGHTS

Categories of trade marks

3.—(1) A trade mark may be registered in accordance with this Act in respect of —

- (a) goods;
- (b) services; or
- (c) both goods and services.

(2) The registration of a trade mark may be in respect of goods or services of more than one class.

Rights given by registration of trade marks

4.—(1) If a trade mark is registered, the registered owner of the trade mark has, subject to this Act, the exclusive rights —

- (a) to use the trade mark;
- (b) to authorise other persons to use the trade mark in relation to goods or services or both in respect of which the trade mark is registered; and
- (c) to obtain relief under this Act if the trade mark has been infringed.

(2) The rights pursuant to subsection (1) are deemed to have accrued to the registered owner as from the date of the registration of the trade mark.

(3) If a trade mark is registered under this Act subject to conditions or limitations, the rights of the registered owner are restricted by those conditions or limitations.

(4) If a trade mark is registered in the name of two or more persons as joint owners of the trade mark, the rights granted to those persons under this section are to be exercised by them as if they were the rights of a single person.

Nature of registered trade mark as property

5.—(1) A registered trade mark is personal property.

(2) A right in respect of a registered trade mark is enforceable in the same way as rights in respect of any other personal property.

Power of registered owner to deal with trade mark

6.—(1) The registered owner of a trade mark may, subject only to any rights vested in another person, deal with the trade mark as its absolute owner and give in good faith discharges for any consideration for that dealing.

(2) This section does not protect a person who deals with the registered owner otherwise than —

- (a) as a purchaser in good faith for value; and
- (b) without notice of any fraud on the part of the owner.

Limitation on rights for similar trade marks

7. If trade marks that are substantially identical or deceptively similar have been registered by more than one person whether in respect of the

same or different goods or services, the registered owner of anyone of those trade marks does not have the right to prevent the registered owner of any other of those trade marks from using that trade mark except to the extent that the first mentioned owner is authorised to do so under the registration of his or her trade mark.

Trade mark as sign describing article

8.—(1) This section applies if a registered trade mark consists of, or contains, a sign that, after the date of registration of the trade mark, becomes generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service.

(2) If a trade mark consists of the sign referred to in subsection (1), the registered owner —

(a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to —

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) is taken to have ceased to have those exclusive rights from and including the day determined by the High Court under subsection (4).

(3) If a trade mark contains the sign referred to in subsection (1), the registered owner —

(a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to —

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) is taken to have ceased to have those exclusive rights from the day determined by the High Court under subsection (4).

(4) For the purposes of subsections (2) and (3), the High Court may determine the day on which a sign first became generally accepted within the relevant trade as the sign that describes or is the name of the article, substance or service.

Trade mark relating to article etc. formerly manufactured under patent

9.—(1) This section applies if —

- (a) a registered trade mark consists of, or contains, a sign that describes or is the name of —
 - (i) an article or substance that was formerly exploited under a patent; or
 - (ii) a service that was formerly provided as a patented process; and
 - (b) it is at least two years since the patent has expired or ceased; and
 - (c) the sign is the only commonly known way to describe or identify the article, substance or service.
- (2) If a trade mark consists of the sign referred to in subsection (1), the registered owner —
- (a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to —
 - (i) the article or substance or other goods of the same description; or
 - (ii) the service or other services of the same description; and
 - (b) is taken to have ceased to have those exclusive rights from the end of the period of two years after the patent expired or ceased.
- (3) If a trade mark contains the sign referred to in subsection (1), the registered owner —
- (a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to —
 - (i) the article or substance or other goods of the same description; or
 - (ii) the service or other services of the same description; and
 - (b) is taken to have ceased to have those exclusive rights from the end of the period of two years after the patent expired or ceased.

Powers of authorised user of registered trade mark

10.—(1) Subject to any agreement between the registered owner of a registered trade mark and an authorised user of the trade mark, the authorised user may —

- (a) use the trade mark in relation to the goods or services or both, in respect of which the trade mark is registered, subject to any

condition or limitation subject to which the trade mark is registered;

- (b) subject to subsection (2), bring an action for infringement of the trade mark if the registered owner refuses or neglects to do so within the prescribed period;
- (c) cause to be displayed on goods in respect of which the trade mark is registered, or on their package, or on the container in which they are offered to the public, a notice prohibiting any act that is under section 105(2) a prohibited act in relation to the goods;
- (d) either —
 - (i) give to the Comptroller a notice under section 115 objecting to the importation of goods that infringe the trade mark; or
 - (ii) revoke a notice given under subparagraph (i);
- (e) give permission to any person —
 - (ii) to make any addition to; or
 - (iii) to remove, erase or obliterate, wholly or partly;

a registered trade mark that is applied to any goods, or in relation to any goods or services, in respect of which the trade mark is registered;
- (f) give permission to any person to apply the trade mark to goods, or in relation to goods or services, in respect of which the trade mark is registered.

(2) Subject to subsection (3), if the authorised user of a trade mark brings an action for infringement of the trade mark, the authorised user shall make the registered owner of the trade mark a defendant in the action.

(3) The registered owner is not liable for costs if he or she does not take part in the proceedings for an action brought pursuant to subsection (2).

PART 4**APPLICATION FOR REGISTRATION*****Division 1******General*****Making of application**

11.—(1) A person may apply, in the prescribed form, for the registration of a trade mark in respect of goods or services or both if —

- (a) the person claims to be the owner of the trade mark; and
- (b) one of the following applies —
 - (i) the person is using or intends to use the trade mark in relation to the goods or services or both;
 - (ii) the person has authorised or intends to authorise another person to use the trade mark in relation to the goods or services or both;
 - (iii) the person intends to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods or services or both.

(2) Without limiting the particulars that may be included in an application made under subsection (1), the application shall —

- (a) include six (6) representations of the trade mark; and
- (b) specify, in accordance with the Regulations, the goods or services or both, in respect of which it is sought to register the trade mark.

(3) An application, other than an application under section 35 for the registration of two or more trade marks as a series, may be made in respect of goods and services of one or more of the classes prescribed in the Regulations.

Application by joint owners

12. If the relations between two or more persons interested in a trade mark are such that none of them is entitled to use the trade mark except —

- (a) on behalf of all of them; or
- (b) in relation to goods or services or both with which all of them are connected in the course of trade;

the persons may together apply for its registration under section 11 (1).

Claim for priority**13.—(1) If —**

- (a) a person has made an application for the registration of a trade mark in one or more than one Convention country; and
- (b) within six months after the day on which that application, or the first of those applications, was made, that person or that person's predecessor in title applies to the Registrar for the registration of the trade mark in respect of some or all of the goods or services or both in respect of which registration was sought in that country or those countries;

that person or that person's successor in title may, when filing the application, or within the prescribed period after filing the application but before the application is accepted, claim a right of priority for the registration of the trade mark in respect of any or all of those goods or services or both in accordance with the Regulations.

(2) The priority claimed pursuant to subsection (1) is for the registration of the trade mark in respect of the goods or services —

- (a) if an application to register the trade mark was made in only one Convention country from and including the day on which the application was made in that country; or
- (b) if applications to register the trade mark were made in more than one Convention country from and including the day on which the earliest of those applications was made.

Notice of application to be published

14. The Registrar shall publish notice, in the prescribed form, of an application to register a trade mark.

Registrar to examine, and report on, application

15. The Registrar shall, in accordance with the Regulations, examine and report on —

- (a) whether an application made pursuant to section 11 has been made in accordance with this Act; and
- (b) whether there are grounds under Division 2 for rejecting it.

Registrar to decide on disputed classification of goods etc.

16. If a question arises as to the class in which goods or services are comprised —

- (a) that question is to be decided by the Registrar; and .
- (b) the decision of the Registrar is not subject to appeal and may not be called into question in an appeal or other proceedings under this Act.

Application accepted or rejected

17.—(1) The Registrar shall, after the examination made pursuant to section 15, accept an application made pursuant to section 11 unless he or she is satisfied that —

- (a) the application has not been made in accordance with this Act;
or
- (b) there are grounds for rejecting it.

(2) The Registrar may accept an application made pursuant to section 11 subject to conditions or limitations.

(3) If the Registrar is satisfied that —

- (a) an application has not been made in accordance with this Act;
or
- (b) there are grounds for rejecting it;

the Registrar shall, subject to subsection (4), reject an application.

(4) The Registrar may not reject an application made pursuant to section 11 without giving the applicant an opportunity of being heard.

Notice etc. of decision

18. The Registrar shall —

- (a) notify an applicant in writing of his or her decision to accept or reject an application under section 17; and
- (b) publish notice of the decision in the *Gazette*.

Appeal

19. An applicant may appeal to the High Court against a decision of the Registrar —

- (a) to accept an application subject to conditions or limitations; or
- (b) to reject an application.

Deferment of acceptance

20. The Registrar may defer the acceptance of an application made pursuant to section 11 in the circumstances provided for, and for the period prescribed in the Regulations.

Lapsing of application

21.—(1) Subject to subsection (2), an application lapses if —

- (a) it is not accepted; or
- (b) no further action is taken on the application by the applicant;
- (c) the applicant fails to submit information requested by the Registrar;

within the prescribed period or within the period as extended by the Registrar in accordance with section 195.

(2) If, after the prescribed period or the prescribed period as extended has expired, the Registrar extends under section 195 the period within which an application may be accepted, the application —

- (a) is taken not to have lapsed when the prescribed period expired; and
- (b) lapses if it is not accepted within the extended period.

Revocation of acceptance

22.—(1) If, before a trade mark is registered, the Registrar is satisfied —

- (a) that an application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;

the Registrar may revoke the acceptance of the application-

(2) If the Registrar revokes the acceptance of an application —

- (a) the application is taken to have never been accepted; and
- (b) the Registrar shall examine, and report on, the application as necessary under section 15; and
- (c) sections 17 and 18 again apply in relation to the application.

Division 2*Grounds for rejecting an application***Trade mark containing certain signs**

23.—(1) An application for the registration of a trade mark shall be rejected if the trade mark contains or consists of a sign that is prescribed not to be used as a trade mark.

(2) An application for the registration of a trade mark may be rejected if the trade mark contains or consists of —

- (a) a sign that is prescribed for the purposes of subsection (1); or
- (b) a sign so nearly resembling —
 - (i) a sign referred to in paragraph (a) ; or
 - (ii) a sign referred to in subsection (1) ;
as to be likely to be taken for it.

Trade mark that cannot be represented graphically

24. An application for the registration of a trade mark shall be rejected if the trade mark cannot be represented graphically.

Trade mark not distinguishing applicant's goods or services

25.—(1) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

(2) An application for the registration of a trade mark shall be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered from the goods or services of other persons.

(3) In deciding the question whether or not a trade mark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar shall first take into account the extent to which the trade mark is inherently adapted to distinguish the designated goods or services from the goods or services of other persons.

(4) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services —

- (a) the Registrar is to consider whether, because of the combined effect of the following —
- (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services;
 - (ii) the use, or intended use, of the trade mark by the applicant; and
 - (iii) any other circumstances;

the trade mark does or will distinguish the designated goods or services as being those of the applicant; and

(b) If —

- (i) the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; or
- (ii) the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services, the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

(5) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply —

- (a) if the applicant establishes that, because of the extent to which the applicant has used the trade mark before the filing date in respect of the application, it does distinguish the designated goods or services as being those of the applicant, the trade mark is taken to be capable of distinguishing the designated goods or services from the goods or services of other persons;
- (b) in a case other than in paragraph (a), the trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons.

Trade mark scandalous or its use contrary to law

26. An application for the registration of a trade mark shall be rejected if —

- (a) the trade mark contains or consists of scandalous matter; or
- (b) its use would be contrary to law.

Trade mark likely to deceive or cause confusion

27. An application for the registration of a trade mark in respect of particular goods or services shall be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be, likely to deceive or cause confusion.

Identical etc. trade marks

28.—(1) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of goods shall be rejected if —

- (a) the applicant's trade mark is substantially identical with, or deceptively similar to —
 - (i) a trade mark registered by another person in respect of similar goods or closely related services; or
 - (ii) a trade mark whose registration in respect of similar goods or closely related services is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of services shall be rejected if —

- (a) it is substantially identical with, or deceptively similar to —
 - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
 - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
- (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.

(3) If the Registrar, in either case mentioned in subsection (1) or (2), is satisfied —

- (a) that there has been honest concurrent use of the two trade marks; or

(b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose and if the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

(4) If the Registrar in either case mentioned in subsection (1) or (2) is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period —

(a) beginning before the priority date for the registration of the other trade mark in respect of —

- (i) the similar goods or closely related services; or
- (ii) the similar services or closely related goods; and

(b) ending on the priority date for the registration of the applicant's trade mark;

the Registrar may not reject the application because of the existence of the other trade mark.

Division 3

Divisional applications

Definition of divisional application

29.—(1) A person who has made an application for the registration of a trade mark in respect of certain goods or services or both may, in accordance with this Division, make another application —

- (a) for the registration of a part only of the trade mark in respect of any or all those goods or services or both;
- (b) for the registration of the trade mark in respect of some only of the goods or services or both in respect of which registration is sought under the initial application; or
- (c) if the initial application has been amended to exclude some of the goods and services or both in respect of which registration was sought in the first place or the registration of the trade mark in respect of any or all of the goods or services or both that have been so excluded.

- (2) For the purposes of this Division —
- (a) the initial application is taken to be the application for which notice has been published by the Registrar under section 14; and
- (b) a divisional application is an application made under this Division.

Divisional application possible only if initial application is pending

30. A divisional application for the registration of a trade mark or a part of a trade mark may be made only if the initial application for the registration of the trade mark is pending.

Divisional application for registration of part of trade mark

31.—(1) This section provides for the making of a divisional application for the registration of a part only of the trade mark that is the subject of the initial application.

(2) If a part of a trade mark, by itself, may be registered as a trade mark, the applicant for the registration of the trade mark may, within the prescribed period but subject to subsection (3), make a divisional application for the registration of that part as a trade mark in respect of any or all of the goods or services or both specified in the initial application.

(3) If the initial application has been accepted, notice of the divisional application shall not be made after the acceptance is published in the *Gazette* pursuant to section 18.

Divisional application for registration of trade mark in respect of some of goods etc.

32.—(1) This section provides for the making of a divisional application for the registration of a trade mark in respect of some of the goods or services or both in respect of which registration of the trade mark is being sought by the initial application.

(2) The applicant for the registration of a trade mark may, subject to subsection (3), make a divisional application for the registration of the trade mark in respect of any, but not all, of —

- (a) the goods or services or both specified in the initial application; or —
- (b) if the initial application has been amended to exclude some of the goods or services or both specified in that application

before its amendment the goods or services or both specified in the initial application as amended.

(3) If the initial application has been accepted, the divisional application may not be made after the notice of acceptance is published in the *Gazette* pursuant to section 18.

Divisional application for registration of trade mark in respect of goods etc. excluded from the initial application

33.—(1) This section —

(a) applies if the initial application for the registration of a trade mark is amended to exclude some of the goods or services or both specified in that application before its amendment; and (b) it provides for the making of a divisional application in respect of any or all of the excluded goods or services or both.

(2) If the initial application is amended —

(a) before a decision is made about it under section 17; or

(b) if the initial application is accepted, before notice of its acceptance is published in the *Gazette* pursuant to section 18;

the applicant may, within the prescribed period but subject to subsection (3), make a divisional application for the registration of the trade mark in respect of any or all of the goods or services or both that have been excluded from the initial application.

(3) If the initial application has been accepted, the divisional application may not be made after the notice of the acceptance is published in the *Gazette* pursuant to section 18.

(4) If the initial application, whether it has already been amended or not, is amended after notice of its acceptance has been in the *Gazette* pursuant to section 18, the applicant may, within the prescribed period, make a divisional application for the registration of the trade mark in respect of any or all of the goods or services or both have been excluded from the application whose notice of acceptance was so published.

Filing date

34. A divisional application is taken to have been filed on the day on which the initial application concerned was filed.

Division 4*Application for registration of series of trade marks***Application—series of trade marks**

35.—(1) A person may make a single application under section 11 (1) for the registration of two or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters —

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) the colour of any part of the trade mark;
- (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.

(2) If —

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required, under section 52, to register the trade marks;

he or she shall register them as a series in one registration.

PART 5**OPPOSITION TO REGISTRATION****Division 1***General***Opposition**

36.—(1) If the Registrar has accepted an application for the registration of a trade mark, a person may oppose the registration by filing a notice of opposition.

(2) A notice of opposition filed pursuant to subsection (1) shall be in an approved form and shall be filed within the prescribed period or within that period as extended in accordance with the Regulations.

(3) The opponent shall serve a copy of the notice of opposition filed pursuant to subsection (1) on the applicant.

(4) The registration of a trade mark may be opposed on any of the grounds specified in Division 2 and on no other grounds.

Proceedings in name of a person other than the person who filed the notice

37.—If —

- (a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and
- (b) the other person —
 - (i) notifies the Registrar in writing that the right or interest is vested in him or her; and
 - (ii) does not withdraw the opposition;

the opposition is to proceed as if the notice of opposition had been filed in that other person's name.

Opposition proceedings

38.—(1) The Registrar shall give to the opponent and to the applicant an opportunity of being heard on the opposition.

(2) Subject to subsection (1), the proceedings for dealing with the opposition shall be in accordance with the Regulations.

Decision

39. Unless the proceedings are discontinued or dismissed, the Registrar shall, at the end, decide —

- (a) to refuse to register the trade mark; or
- (b) to register the trade mark, with or without conditions or limitations, in respect of the goods or services or both then specified in the application;

having regard to the extent, if any, to which any ground on which the application was opposed has been established.

Appeal

40. An applicant or opponent may appeal to the High Court against a decision of the Registrar under section 39.

Division 2*Grounds for opposing registration***Registration may be opposed on same grounds as for rejection**

41. The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Division 2 of Part 4, except the ground that the trade mark cannot be represented graphically.

Applicant not owner of trade mark

42. The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

Applicant not intending to use trade mark

43. The registration of a trade mark may be opposed on the ground that the applicant does not intend —

- (a) to use, or authorise the use of, the trade mark in Saint Lucia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia;

in relation to the goods or services or both specified in the application.

Trade mark similar to trade mark that has acquired a reputation

44. The registration of a trade mark in respect of particular goods or services may be opposed on the ground that —

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Saint Lucia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Trade mark containing or consisting of a false geographical indication

45.—(1) The registration of a trade mark in respect of particular goods may be opposed on the ground that the trade mark contains or consists of a sign that is a geographical indication for other goods originating in —

- (a) a country, or in a region or locality in a country, other than the country in which the relevant goods originated; or

- (b) a region or locality in the country in which the relevant goods originated other than the region or locality in which the relevant goods originated.
- (2) An opposition on a ground referred to in subsection (1) fails if the applicant establishes that —
- (a) the relevant goods originated in the country, region or locality identified by the geographical indication;
- (b) the sign has ceased to be used as a geographical indication for the designated goods in the country in which the designated goods originated; or
- (c) the applicant, or a predecessor in title of the applicant, used the sign in good faith in respect of the relevant goods, or applied in good faith for the registration of the trade mark in respect of the relevant goods, before —
- (i) the commencement of this Act; or
- (ii) the day on which the sign was recognised as a geographical indication for the designated goods in their country of origin;
- whichever is the later; or
- (d) if the registration of the trade mark is being sought in respect of wine or spirits and the sign is identical with the name that, on the date of commencement of this Act, was, in the country in which the wine or spirits originated, the customary name of a variety of grapes used in the production of the other wine or spirits.
- (3) In addition to subsection (2), an opposition on a ground referred to in subsection (1) fails if the applicant establishes that —
- (a) although the sign is a geographical indication for the designated goods, it is also a geographical indication for the relevant goods; and
- (b) the applicant has not used, and does not intend to use, the trade mark in relation to the relevant goods in a way that is likely to deceive or confuse members of the public as to the origin of the relevant goods.
- (4) In this section —
- “relevant goods” means the particular goods for which registration is opposed pursuant to subsection (1);

“designated goods” means the other goods referred to in subsection (1).

Application etc. defective etc.

46. The registration of a trade mark may be opposed on any of the following grounds —

- (a) that the application, or a document filed in support of the application, was amended contrary to this Act;
- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

PART 6

**AMENDMENT OF APPLICATION FOR REGISTRATION OF A TRADE MARK AND
OTHER DOCUMENTS**

Amendment of application for registration of trade mark

47.—(1) The Registrar may, at the written request of the applicant or of his or her agent, amend an application for the registration of a trade mark in accordance with section 48 or 49.

(2) If —

- (a) an application for the registration of a trade mark may be amended under section 49; and
- (b) the applicant has not asked in writing that the application be amended;

the Registrar may, on his or her own initiative but in accordance with the Regulations, amend the application as necessary to remove any ground on which the application could be rejected.

Amendment before notice of application are published

48. If —

- (a) the notice of an application has not yet been published under section 14; and
- (b) the request for the amendment is made within the prescribed period;

an amendment may be made to correct a clerical error or an obvious mistake.

Amendment after notice of application has been published

49.—(1) If the notice of an application has been published under section 14, the application may be amended as provided in this section.

(2) An amendment may be made to the representation of the trade mark if the amendment does not substantially affect the identity of the trade mark as at the time when the notice of the application was published.

(3) An amendment may be made to correct a mistake of fact or an error in the classification of any goods or services specified in the application.

(4) An amendment may be made to change the type of registration sought in the application.

(5) An amendment may be made to any particular specified in the application other than that referred to in subsection (4), unless the amendment would have the effect of extending the rights that, apart from the amendment, the applicant would have under the registration if it were granted.

Amendment of other documents

50. The Registrar may, at the written request of the person who has filed an application other than an application for the registration of a trade mark, a notice or other document for the purposes of this Act, or at the written request of the person's agent, amend the application, notice or document —

- (a) to correct a clerical error or an obvious mistake; or
- (b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

Appeal

51. An appeal lies to the High Court from a decision of the Registrar under this Part.

PART 7**REGISTRATION OF TRADE MARKS*****Division 1******Initial registration*****Obligation to register**

52.—(1) The Registrar shall, within the period prescribed, register a trade mark that has been accepted for registration —

- (a) if there has been no opposition to the registration; or
- (b) if there has been an opposition, and if the Registrar's decision, or in the case of an appeal against the Registrar's decision, the decision on appeal, is that the trade mark should be registered;

(2) On registering a trade mark pursuant to subsection (1), the Registrar shall give it a number by which it may be identified.

Registration—how effected

53.—(1) The trade mark shall be registered —

- (a) in the name of the applicant for registration;
- (b) in respect of the goods or services or both specified in the application at the time of registration; and
- (c) subject to the conditions, if any, and the limitations, if any, imposed by the Registrar in accepting the application for registration or deciding to register the trade mark.

(2) The Registrar shall, in addition to subsection (1), enter in the Register —

- (a) a graphical representation of the trade mark;
- (b) its registration number; and
- (c) any other particulars that are required by this Act to be entered in the Register.

(3) If two or more persons applied together for the registration of the trade mark, the applicants shall be registered as joint owners of the trade mark.

Colours in registered trade marks

54.—(1) A trade mark may be registered with limitations as to colour.

(2) The limitations pursuant to subsection (1) may be in respect of the whole, or a part, of the trade mark.

(3) To the extent that a trade mark is registered without limitations as to colour, it is taken to be registered for all colours.

Notification of registration

55. When a trade mark has been registered, the Registrar shall —

- (a) publish notice of the registration in the *Gazette*; and

- (b) give to the registered owner of the trade mark a certificate of registration in an prescribed form.

Date and term of registration

56.—(1) Subject to subsection (2), the registration of a trade mark in respect of the goods or services or both in respect of which the trade mark is registered is taken to have had effect from and including the filing date in respect of the application for registration.

(2) If —

- (a) an application for registration was in respect of a trade mark whose registration had also been sought in one or more than one Convention country;
- (b) the applicant claimed a right of priority under section 13 for the registration of the trade mark in respect of particular goods or services; and
- (c) the trade mark is registered under this Act;

the registration of the trade mark in respect of those goods or services is taken to have had effect if, an application to register the trade mark was made in only one Convention country from and including the day on which the application was made in that country, or if applications to register the trade mark were made in more than one Convention country from and including the day on which the earliest of those applications were made.

(3) Unless it is earlier cancelled, or the trade mark is earlier removed from the Register, the registration of a trade mark expires ten years after the filing date in respect of the application for its registration.

Ceasing of registration

57. The registration of a trade mark ceases if —

- (a) the trade mark is removed from the Register under section 62 or Part 9; or
- (b) the registration of the trade mark is cancelled.

Disclaimers

58.—(1) An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the trade mark.

(2) A disclaimer under subsection (1) affects only the rights given by this Act to the registered owner of the trade mark on registration of the trade mark.

(3) The Registrar shall, on registering the trade mark or on receiving notice of the disclaimer whichever is later, enter the particulars of the disclaimer in the Register.

(4) A disclaimer made in accordance with subsection (1) shall not be revoked.

Division 2

Renewal of registration Request for renewal

59. Any person may, within the prescribed period before the registration of a trade mark expires, make a request in the prescribed form to the Registrar for the renewal of the registration.

Notice of renewal date

60. If, at the beginning of the prescribed period, the Registrar has not received a request for the renewal of the registration of the trade mark, the Registrar shall, in accordance with the Regulations, notify the registered owner of the trade mark that the renewal is due.

Renewal before registration expires

61.—(1) If a request for the renewal of the registration of a trade mark is made in accordance with section 59, the Registrar shall renew the registration for a period of ten years from the day on which the registration of the trade mark would expire if it were not renewed.

(2) The Registrar shall give notice, in the prescribed form, of a renewal granted pursuant to subsection (1) to the registered owner of the trade mark.

Failure to renew

62. If the registration of a trade mark is not renewed, then —

- (a) subject to sections 63 and 64, the registration ceases to have effect when it expires; and
- (b) unless the registration is renewed under section 63, the Registrar shall remove the trade mark from the Register twelve months after the day on which the registration expired.

Renewal within 12 months after registration expires

63. If, within twelve months after the registration of a trade mark has expired, a person makes a request to the Registrar, in accordance with section 59, for the renewal of the registration of the trade mark, the Registrar shall renew the registration of the trade mark for ten years from the day on which the registration expired.

Status of unrenewed trade mark

64. If —

- (a) the registration of a trade mark has not been renewed; and
- (b) within twelve months after the registration expired, an application for the registration of a trade mark is made by a person other than the person who was registered as the owner of the unrenewed trade mark;

the unrenewed trade mark is taken to be a registered trade mark for the purposes of the application.

PART 8**AMENDMENT AND CANCELLATION OF REGISTRATION****Division 1*****Action by Registrar*****Correction of Register**

65. The Registrar may, on his or her own initiative, correct any error or omission made in entering in the Register any particular in respect of the registration of a trade mark.

Adaptation of classification

66. The Registrar may, in accordance with the Regulations, amend the Register, whether by making, removing or altering entries, for the purpose of adapting the designation of the goods or services in respect of which trade marks are registered to reflect any change that has occurred in the classification of goods or services for the purposes of this Act.

Amendment of particulars of trade mark entered in Register

67.—(1) Subject to Part II, the Registrar may, at the written request of the registered owner of a registered trade mark —

- (a) amend the representation of the trade mark as entered in the Register if the amendment does not substantially affect the identity of the trade mark as at the time when the notice of the

acceptance of the application for the registration of the trade mark was published under section 18;

- (b) amend any particulars entered in the Register relating to any goods or services in respect of which the trade mark is registered if the amendment does not have the effect of extending the rights that apart from the amendment the owner has under the registration; or
- (c) amend, or enter in the Register, any other particular in respect of the trademark if the amendment or entry does not have the effect of extending the rights that, apart from the amendment or entry, the owner has under the registration.

(2) An appeal lies to the High Court from a decision of the Registrar under subsection (1).

Cancellation of registration

68.—(1) The Registrar shall cancel the registration of a trade mark in accordance with the Regulations if the registered owner asks in writing that the registration be cancelled.

(2) Before cancelling the registration of the trade mark, the Registrar shall notify in accordance with the Regulations —

- (a) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark; and
- (b) if —
 - (i) an application has been made to the Registrar for a record of the assignment or transmission of the trade mark to a person to be entered in the Register under section 93; and
 - (ii) the assignment has not yet been recorded; the person to whom the trade mark has been assigned or transmitted.

Division 2

Action by court

Amendment to correct error or omission

69. The High Court may, on the application of an aggrieved person, order that the Register be rectified by —

- (a) entering in the Register particulars that were wrongly omitted from it; or
- (b) correcting any error in an entry in the Register.

Amendment or cancellation on ground of contravention of condition etc.

70. The High Court may, on the application of an aggrieved person, order that the Register be rectified by —

- (a) cancelling the registration of a trade mark; or
- (b) removing or amending any entry in the Register relating to the trade mark;

on the ground that a condition or limitation entered in the Register in relation to the trade mark has been contravened.

Amendment or cancellation—loss or exclusive rights to use trade mark

71.—(1) If section 8 or 9 applies in relation to a registered trade mark, the High Court may, on the application of an aggrieved person, but subject to subsection (2) and section 73, order that the Register be rectified by —

- (a) cancelling the registration of the trade mark; or
- (b) removing or amending any entry in the Register relating to the trademark;

having regard to the effect of section 8 or 9, on the right of the registered owner of the trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.

(2) If section 8 or 9 applies in relation to a trade mark because the trade mark contains a sign that —

- (a) has become generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service; or
- (b) describes or is the name of —
 - (i) an article or substance that was formerly exploited under a patent; or
 - (ii) a service that was formerly provided as a patented process;

the High Court may decide not to make an order under subsection (1) and allow the trade mark to remain on the Register in respect of the article or substance or goods of the same description, or the service or services of the same description, or subject to any condition or limitation that the High Court may impose.

Amendment or cancellation—Other specified grounds

72.—(1) Subject to subsection (2) and section 73, the High Court may, on the application of an aggrieved person, order that the Register be rectified by —

- (a) cancelling the registration of a trade mark;
- (b) removing or amending an entry wrongly made or remaining on the Register; or
- (c) entering any condition or limitation affecting the registration of a trade mark that ought to be entered.

(2) An application, referred to in subsection (1), may be made on any of the following grounds —

- (a) any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5;
- (b) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;
- (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which —
 - (i) the application for the registration of the trade mark could have been rejected under section 27 or 28; or
 - (ii) the registration of the trade mark could have been opposed under section 44;

(d) the following circumstances apply —

- (i) the Registrar accepted the application for the registration of the trade mark because he or she was satisfied, having regard to the extent to which the trade mark was inherently adapted to distinguish the goods or services of the applicant for registration from the goods or services of any other person and the intended use of the trade mark, that the trade mark would distinguish those goods or services as being those of the applicant;
 - (ii) the application for rectification is made at least ten years after the filing date; or
 - (iii) in the intervening period, the trade mark has not been used to an extent sufficient for it to distinguish, in fact, the goods or services of the registered owner from the goods or services of any other person;
- (e) the application is in respect of an entry in the Register and the entry was made, or has been previously amended, as a result of fraud, false suggestion or misrepresentation.

Rectification may not be granted in certain cases if registered owner not at fault etc.

73.—(1) The High Court may decide not to grant an application for rectification made —

- (a) under section 71 ; or
- (b) on the ground that the trade mark is liable to deceive or confuse; or
- (c) on the ground referred to in paragraph 72(2)(c);

if the registered owner of the trade mark satisfies the High Court that the ground relied on by the applicant has not arisen through any act or fault of the registered owner.

(2) In making a decision under subsection (1), the High Court —

- (a) shall also take into account any matter that is prescribed; and
- (b) may take into account any other matter that it considers relevant.

Duties and powers of Registrar

74.—(1) A person applying to the High Court under this Division shall give notice of the application to the Registrar.

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

(3) A person applying under this division shall give to the Registrar a copy of any order made by the High Court under this Division and the Registrar shall comply with the order.

Division 3

Amendment of certificate of registration

Amendment of certificate of registration

75. If the Registrar amends any particular entered in the Register in respect of a trade mark, the Registrar may also amend the certificate of registration if he or she thinks it appropriate to do so.

PART 9**REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE****Application for removal of trade mark from Register etc.**

76.—(1) A person aggrieved by the fact that a trade mark is or may be registered may, subject to subsection (3), apply to the Registrar for the trade mark to be removed from the Register.

(2) An application pursuant to subsection (1) —

(a) shall be as prescribed in the Regulations; and

(b) may be made in respect of any or all of the goods or services or both in respect of which the trade mark may be, or is, registered,

(3) An application shall not be made to the Registrar under subsection (1) if an action concerning the trade mark is pending in the High Court, but the person aggrieved may apply to the High Court for an order directing the Registrar to remove the trade mark from the Register.

(4) An application under subsection (1) or (3) may be made if —

(a) on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith —

(i) to use the trade mark in Saint Lucia;

(ii) to authorise the use of the trade mark in Saint Lucia; or

(iii) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia;

in relation to the goods or services or both to which the application relates and the registered owner has not used the trade mark in Saint Lucia or has not used the trade mark in good faith in Saint Lucia in relation to those goods or services or both at any time before the period of one month ending on the day on which the application is filed; or

(b) the trade mark has remained registered for a continuous period of three years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner —

(i) used the trade mark in Saint Lucia; or

(ii) used the trade mark in good faith in Saint Lucia;

in relation to the goods or services or both to which the application relates.

(5) If the right or interest on which a person relied to make an application under Subsection (1) or (3) to obtain the removal of a trade mark from the Register becomes vested in another person, the other person may, on giving notice of the relevant facts to the Registrar or the High Court as the case requires, be substituted for the first-mentioned person as the applicant.

Time for making application

77.—(1) Subject to subsection (2), an application for the removal of a trade mark from the Register may be made at any time after the filing date in respect of the application for the registration of the trade mark.

(2) An application on the ground referred to in section 76(4)(b) may not be made before a period of five years has passed from the filing date in respect of the application for the registration of the trade mark.

Referral to court

78. If —

- (a) an application has been made to the Registrar under section 76(1); and
- (b) the Registrar is of the opinion that the matter should be decided by High Court;

the Registrar may refer the matter to the High Court and the High Court may hear and determine the matter as if an application had been made to it under section 76(3),

Notification of application

79.—(1) If an application has been made to the Registrar under section 76, the Registrar shall give notice of the application in accordance with the Regulations.

(2) If the application, referred to in subsection (1), is in respect of a trade mark already entered on the Register, the Registrar shall publish a notice of the application in the *Gazette*.

(3) If the application, referred to in subsection (1), is in respect of a trade mark whose registration is being sought, the Registrar is to publish the notice of the application in the *Gazette* only if the trade mark is registered.

Notice of opposition

80.—(1) Any person may oppose an application under section 76 by filing a notice of opposition with the Registrar or the High Court, as the case requires.

(2) The notice of opposition —

- (a) shall be in a form approved by the Registrar or by the High Court; and
- (b) shall be filed in accordance with the Regulations or the rules of court as the case may be.

Removal of trade mark from the Register etc. if application unopposed

81.—(1) If there is no opposition to an application to the Registrar under section 76(1), the Registrar shall remove the trade mark from the Register in respect of the goods or services or both specified in the application.

(2) If there is no opposition to an application to the High Court under section 76(3), the High Court shall order the Registrar to remove the trade mark from the Register in respect of the goods or services or both specified in the application.

(3) The High Court shall cause a copy of the order made under section (2) to be served on the Registrar and the Registrar shall comply with the order.

Trade mark restored to Register if notice of opposition filed within extended time

82. If —

- (a) the Registrar has removed a trade mark from the Register under section 81(1) because no notice of opposition was filed within the period provided under the Regulations; and
- (b) the Registrar subsequently extends the period within which the notice may be filed;
- (c) a notice of opposition is filed within the extended period;

the Registrar shall restore the trade mark to the Register and the trade mark is taken not to have been removed from the Register.

Proceedings before Registrar

83. If an application to the Registrar is opposed, the Registrar shall deal with the matter in accordance with the Regulations.

Burden on opponent to establish use of trade mark etc.

84.—(1) In any proceedings relating to an opposed application, it is for the opponent to rebut —

- (a) any allegation made under section 76 (4)(a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith —
 - (i) to use the trade mark in Saint Lucia;
 - (ii) to authorise the use of the trade mark in Saint Lucia; or .
 - (iii) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia;

in relation to the goods or services or both to which the opposed application relates (in this section referred to as “relevant goods or services or both”); or

- (b) any allegation made under section 76 (4)(a) that the trade mark has not, at any time before the period of one month ending on the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both; or
- (c) any allegation made under section 76 (4)(b) that the trade mark has not, at any time during the period of three years ending one month before the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both.

(2) For the purposes of subsection (1)(b), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time before the period referred to in that subsection, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both if —

- (a) the opponent has established that the trade mark or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by its registered owner in relation to those goods or services before that period; or
- (b) in a case where the trade mark has been assigned but a record of the assignment has not been entered in the Register —
 - (i) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by the assignee

in relation to those goods or services before that period and that use was in accordance with the terms of the assignment; and

- (ii) the Registrar or the High Court is of the opinion that it is reasonable, having regard to all the circumstances of the case, to treat the use of the trade mark by the assignee before that period as having been a use of the trade mark in relation to those goods or services by the registered owner.

(3) For the purposes of subsection (1)(c), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time during the period referred to in that subsection, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both if —

- (a) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by its registered owner in relation to those goods or services during that period; or
- (b) in a case where the trade mark has been assigned but a record of the assignment has not been entered in the Register —
 - (i) the opponent has established that the trade mark, or the trade mark with additions or alterations not substantially affecting its identity, was used in good faith by the assignee of the trade mark in relation to those goods or services during that period and that use was in accordance with the terms of the assignment; and
 - (ii) the Registrar or the High Court is of the opinion that it is reasonable, having regard to all the circumstances of the case, to treat the use of the trade mark by the assignee during that period as having been a use of the trade mark in relation to those goods or services by the registered owner; or
- (c) the opponent has established that the trade mark was not used by its registered owner in relation to those goods or services or both during that period because of circumstances, whether affecting traders generally or only the registered owner of the trade mark, that were an obstacle to the use of the trade mark during that period.

Determination of opposed application-general

85.—(1) Subject to subsection (3) and to section 86, if —

- (a) the proceedings relating to an opposed application have not been discontinued or dismissed; and
- (b) the Registrar is satisfied that the grounds on which the application was made have been established;

the Registrar may decide to remove the trade mark from the Register in respect of any or all of the goods or services or both to which the application relates.

(2) Subject to subsection (3) and to section 86, if, at the end of the proceedings relating to an opposed application, the High Court is satisfied that the grounds on which the application was made have been established, the High Court may order the Registrar to remove the trade mark from the Register in respect of any or all of the goods or services or both to which the application relates.

(3) If satisfied that it is reasonable to do so, the Registrar or the High Court may decide that the trade mark should not be removed from the Register even if the grounds on which the application was made have been established.

Determination of opposed application-localised use of trade mark

86.—(1) This section applies if an application for the removal of a trade mark from the Register is made on the ground referred to in section 76(4)(b) and —

- (a) the applicant is the registered owner of a trade mark that is substantially identical with, or deceptively similar to, the challenged trade mark and is registered in respect of the goods or services or both specified in the application subject to the condition or limitation that the use of the trade mark is to be restricted to —
 - (i) goods or services or both to be dealt with or provided in a particular place in Saint Lucia, otherwise than for export from Saint Lucia; or
 - (ii) goods or services or both to be exported to a particular market; or
- (b) the Registrar or the High Court is of the opinion that such a trade mark may properly be registered in the name of the applicant with that condition or limitation.

- (2) If the Registrar or the High Court is satisfied —
- (a) that the challenged trade mark has remained registered for the period referred to in section 76(4)(b); and
 - (b) that during that period there has been no use, or no use in good faith, of the challenged trade mark in relation to —
 - (i) goods or services dealt with or provided in the particular place referred to in subsection (1) ; or
 - (ii) goods or services to be exported to the particular market referred to in subsection (1);

the Registrar may decide, or the High Court may order, that the challenged trade mark should not be removed from the Register but that the registration of the trade mark should be subject to the conditions or limitations that the Registrar or the High Court considers necessary to ensure that the registration does not extend to the use of the trade mark in relation to —
 - (c) goods or services dealt with or provided in the specified place; or
 - (d) goods or services to be exported to the specified market.
- (3) In this section —
- “challenged trade mark” means the trade mark in relation to which an application for removal is made pursuant to subsection (1).

Registrar to comply with order of court

87. If the High Court makes an order under section 85 or 86 the High Court shall cause a copy of the order to be served on the Registrar and the Registrar shall comply with the order.

Appeal

88. An appeal lies to the High Court from a decision of the Registrar under section 85 or 86.

Certificate—use of trade mark

89. —(1) If in any proceedings relating to an opposed application the Registrar or the High Court has found that —

- (a) a trade mark has been used in good faith during a particular period; or
- (b) a trade mark has not been used during a particular period solely because of circumstances that were an obstacle to its use;

the Registrar or the High Court shall, if so requested by the registered owner of the trade mark, give to the registered owner a certificate of those findings.

(2) In any subsequent proceedings in which non-use of the trade mark is alleged —

- (a) the certificate is, on being produced, evidence of the facts stated in it; and
- (b) if the proceedings are determined in favour of the opponent and, on or before filing the notice of opposition, the opponent notified the applicant of the contents of the certificate, the opponent is entitled, unless the Registrar or the court otherwise directs, to have the opponent's full costs paid by the applicant.

PART 10

ASSIGNMENT AND TRANSMISSION OF TRADE MARKS

Assignment etc. of trade mark

90.—(1) A registered trade mark, or a trade mark whose registration is being sought, may be assigned or transmitted in accordance with this section.

(2) An assignment or transmission pursuant to subsection (1) may be partial, that is, it may apply to some only of the goods or services or both in respect of which registration is sought or the trade mark is registered, but it may not be partial in relation to the use of a trade mark in a particular area.

(3) An assignment or transmission pursuant to subsection (1) may be with or without the goodwill of the business concerned in the relevant goods or services or both.

Applications for record to be made of assignment etc. of trade mark whose registration is sought

91. If a trade mark whose registration is being sought is assigned or transmitted —

- (a) the applicant for the registration of the trade mark; or
- (b) the person to whom it has been assigned or transmitted;

shall apply, in the prescribed form, to the Registrar for the assignment or transmission to be recorded.

Recording of assignment etc. of trade mark whose registration is sought

92.—(1) If an application made pursuant to section 91 complies with this Act the Registrar shall —

- (a) at or within, the time provided for in the Regulations, record in the manner that the Registrar thinks fit, but not in the Register, the particulars of the assignment or transmission; and
- (b) publish notice in the prescribed form of the assignment or transmission in accordance with the Regulations.

(2) On and after the day on which the Registrar records the particulars of the assignment or transmission, the person to whom the trade mark has been assigned or transmitted is taken, for the purposes of this Act, to be the applicant for the registration of the trade mark.

Application for record of assignment etc. of registered trade mark to be entered in Register

93. If a registered trade mark is assigned or transmitted —

- (a) the person registered as the owner of the trade mark; or
- (b) the person to whom the trade mark has been assigned or transmitted;

shall apply in the prescribed form to the Registrar for a record of the assignment or transmission to be entered in the Register.

Recording of assignment etc. of registered trade mark

94.—(1) If an application made pursuant to section 93 complies with this Act, the Registrar shall, at, or within, the time provided for in the Regulations —

- (a) enter the particulars of the assignment or transmission in the Register; and
- (b) register the person to whom the trade mark has been assigned or transmitted as the owner of the trade mark in relation to the goods or services or both in respect of which the assignment or transmission has effect.

(2) The particulars pursuant to subsection (1) (a) are taken to have been entered in the Register on the day on which the application was filed, and the registration of the beneficiary as the owner of the trade

mark pursuant to subsection (1) (b) is taken to have had effect from and including that day,

- (3) The Registrar shall publish notice of —
- (a) the recording of the assignment or transmission; and
 - (b) the registration of the beneficiary as the owner of the trade mark in the *Gazette*.

(4) In this section “beneficiary” means the person to whom a trade mark has been assigned or transmitted.

Notice of application to be given to person recorded as claiming interest in trade mark etc.

95. If an application made under section 91 or 93 in relation to the assignment or transmission of a trade mark complies with this Act, the Registrar shall notify in accordance with the Regulations any person recorded under Part 11 as claiming an interest in, or a right in respect of, the trade mark.

PART 11

VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN AND RIGHTS IN RESPECT OF TRADE MARKS

Division 1

Preliminary

Object of Part

- 96.** This Part makes provision —
- (a) for recording in the Register claims to interests in, and rights in respect of, registered trade marks that may not be so recorded under another Part; and
 - (b) for the Registrar to keep a record of claims to interests in, and rights in respect of, trade marks for which registration is sought.

Division 2

Interests in, and rights in respect of, registered trade marks

Application to have claims to interest etc. recorded

- 97.** If —
- (a) a person, other than the registered owner of the trade mark, claims to have an interest in, or a right in respect of, a registered trade mark; and

- (b) this interest or right may not be recorded in the Register under Part 10;

the person and the registered owner of the trade mark may together apply in the prescribed form to the Registrar to have particulars of the claim recorded in the Register.

Record of claims to interest etc.

98.—(1) If an application has been made in accordance with section 97, the Registrar shall enter in the Register the particulars of the claim set out in the application.

(2) If —

- (a) a trade mark is registered; and
- (b) immediately before the registration, particulars of a claim to an interest in, or right in respect of, the trade mark were recorded under Division 3;

the Registrar shall enter those particulars in the Register.

Amendment and cancellation

99. The Regulations may provide for the amendment and cancellation of particulars entered in the Register under this Division.

Record not proof etc. of existence of right etc.

100. The fact that a record has been made in the Register under this Part that a person claims an interest in, or a right in respect of, a registered trade mark is not proof or evidence that the person has that right or interest.

Division 3

Interests in, and rights in respect of unregistered trade marks

Application to have claims to interest etc. recorded

101. If —

- (a) a person has applied for the registration of a trade mark; and
- (b) another person claims to have an interest in, or a right in respect of, the trade mark;

they may together apply in the prescribed form to the Registrar for a record to be kept of the other person's claim.

Record of claims to interest etc.

102. If an application has been made in accordance with section 101, the Registrar shall record in the manner that the Registrar thinks fit, but not in the Register, the particulars of the claim set out in the application.

Amendment and cancellation

103. The Regulations may provide for the amendment and cancellation of particulars recorded under this Division.

PART 12**INFRINGEMENT OF TRADE MARKS****Infringement of trade mark**

104.—(1) A person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered.

(2) Subject to subsection (3) a person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to —

- (a) goods of the same description as that of registered goods;
- (b) services that are closely related to registered goods; or
- (c) services of the same description as that of registered services;
- or
- (d) goods that are closely related to registered services.

(3) A person is not taken to have infringed the trade mark if the person establishes that his or her use of the sign as in paragraphs (a), (b), (c) or (d) of subsection (2) is not likely to deceive or cause confusion.

(4) A person infringes a registered trade mark if —

- (a) the trade mark is well known in Saint Lucia; and
- (b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to —
 - (i) unrelated goods;
 - (ii) unrelated services; and

(c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated

goods or services and the registered owner of the trade mark;
and

(d) for that reason, the interests of the registered owner are likely to be adversely affected.

(4) In deciding, for the purposes of paragraph (3)(a), whether a trade mark is well known in Saint Lucia, one shall take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason.

(5) In this section —

“registered goods” means goods in respect of which a trade mark is registered;

“registered services” means services in respect of which a trade mark is registered;

“unrelated goods” means goods that are not of the same description as that of the registered goods or that are not so closely related to the registered services;

“unrelated services” means services that are not of the same description as that of the registered service or that are not so closely related to the registered goods.

Infringement of trade mark by breach of certain restrictions

105.—(1) This section applies to a registered trade mark if the registered owner, or an authorised user of the trade mark having power to do so, has caused to be displayed on goods in respect of which the trade mark is registered, or on their package, or on the container in which they are offered to the public, a notice of prohibition, prohibiting any act that is under subsection (2) a prohibited act in relation to the goods.

(2) Each of the following is a prohibited act —

(a) applying the trade mark to registered goods, or using the trade mark in physical relation to them after the state condition get-up or packaging in which they were originally offered to the public has been altered;

(b) altering or partially removing or obliterating, any representation of the mark applied to registered goods or used in physical relation to them;

(c) if the trade mark has been applied to registered goods, or used in physical relation to them, together with other matter

indicating that the registered owner or authorised user has dealt with the goods, removing or obliterating, totally or in part, any representation of the trade mark without totally removing or obliterating the other matter;

- (d) applying another trade mark to registered goods or using another trade mark in physical relation to them;
- (e) if the trade mark has been applied to registered goods or used in physical relation to them, using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the reputation of the trade mark.

(3) Subject to subsection (4) a person infringes a trade mark to which this section applies if the person —

- (a) is the owner of registered goods; and
- (b) is the course of trade, or with a view to dealing with the goods in the course of trade —
 - (i) does an act that is prohibited under the notice of prohibition; or
 - (ii) authorises that act to be done.

(4) The trade mark is not infringed if the owner of the goods:

- (a) acquired them in good faith and without being aware of the notice of prohibition; or
- (b) became the owner of the goods by virtue of a title derived from a person who had so acquired them.

(5) Notwithstanding section 104, a person does not infringe a registered trade mark when:

- (a) the person uses in good faith:
 - (i) the person's name or the name of the person's place of business; or
 - (ii) the name of a predecessor in business of the person or the name of the predecessor's place of business; or
- (b) the person uses a sign in good faith to indicate:
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or

- (c) the person uses the trade mark in good faith to indicate the intended purpose of goods or services; or
- (d) the person uses the trade mark for the purposes of comparative advertising; or
- (e) the person exercises a right to use a trade mark given to the person under this Act; or
- (f) the court is of the opinion that the person would obtain registration of the trade mark in his or her name if the person were to apply for it; or
- (g) the person, in using a sign referred to in section 104(1), (2) or (3) in a manner referred to in that section, does not, because of a condition or limitation subject to which the trade mark is registered, infringe the exclusive right of the registered owner to use the trade mark.

(6) Notwithstanding section 104, if a disclaimer has been registered in respect of a part of a registered trade mark, a person does not infringe the trade mark by using that part of the trade mark.

Goods etc. to which registered trade mark has been applied by or with consent of registered owner

106.—(1) Notwithstanding section 104, a person who uses a registered trade mark in relation to goods that are similar to registered goods does not infringe the trade mark if the trade mark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trade mark.

(2) Notwithstanding section 104, a person who uses a registered trade mark in relation to services that are similar to registered services does not infringe the trade mark if the trade mark has been applied in relation to the services by, or with the consent of, the registered owner of the trade mark.

Prior use of identical trade mark etc.

107.—(1) A person does not infringe a registered trade mark by using an unregistered trade mark that is substantially identical with, or deceptively similar to, the registered trade mark in relation to —

- (a) goods similar to registered goods ;
- (b) services closely related to registered goods;
- (c) services similar to registered services;
- (d) goods closely related to registered services;

if the person, or the person and the person's predecessor in title, have continuously used in the course of trade the unregistered trade mark in relation to those goods or services from a time before the date of registration of the registered trade mark, or the date the registered owner of the registered trade mark, or a predecessor in title, or a person who was a registered user of the trade mark under the repealed Acts, first used the trade mark, whichever is earlier.

(2) If the unregistered trade mark has continuously been used only in a particular area of Saint Lucia, subsection (1) applies only to the use of the trade mark by the person in that area.

What courts may hear action for infringement of registered trade mark

108.—(1) An action for an infringement of a registered trade mark may be brought in High Court.

(2) Subsection (1) does not prevent an action for infringement of a registered trade mark from being brought in any other court that has jurisdiction to hear the action.

What relief can be obtained from court

109. The relief that a court may grant in an action for an infringement of a registered trademark includes —

- (a) an injunction, which may be granted subject to any condition that the court thinks fit; and
- (b) at the option of the plaintiff but subject to section 110, damages or an account of profits.

Special case—plaintiff not entitled to damages etc.

110. If —

- (a) in an action for the infringement of a trade mark registered in respect of particular goods or services, the court finds that the defendant has infringed the trade mark;
- (b) the defendant has applied under section 76(3) for an order directing the Registrar to remove the trade mark from the Register in respect of those goods or services; and
- (c) the court finds that, because the trade mark has not during a particular period been used in good faith by its registered owner in relation to those goods or services, there are grounds under section 76(4) for so removing the trade mark from the Register;

the court may not grant relief to the plaintiff by way of damages or an account of profits in respect of any infringement of the trade mark that happened during the particular period.

Circumstances in which action may not be brought

111. If the registration of a trade mark is renewed, under section 63, within twelve months after it has expired, an action may not be brought in respect of an act that —

- (a) infringed the trade mark; and
- (b) was done after the registration had expired and before it was renewed.

Groundless threats of legal proceedings

112.—(1) If a person threatens to bring an action against another person on the ground that the threatened person has infringed —

- (a) a registered trade mark; or
- (b) a trade mark alleged by the person to be registered;

any person aggrieved by the threat may bring an action, either in the High Court or in any other court having jurisdiction, against the person making the threat.

(2) The purpose of an action pursuant to subsection (1) is to —

- (a) obtain from the court a declaration that the defendant has no grounds for making the threat;
- (b) obtain from the court an injunction restraining the defendant from continuing to make the threat; or
- (c) recover any damages that the defendant has sustained because of the defendant's conduct.

(3) An action may be brought whether or not the defendant is the registered owner, or an authorised user, of the trade mark alleged to have been infringed.

(4) The court may not find in favour of the plaintiff if the defendant satisfies the court that —

- (a) the trade mark is registered; and
- (b) the acts of the threatened person in respect of which the defendant threatened to bring an action constitute an infringement of the trade mark.

(5) An action may not be brought, or if brought may not proceed, under this section if the registered owner of the trade mark, or an authorised user of the trade mark having power to bring an action for infringement of the trade mark, with due diligence, begins and pursues an action against the threatened person for infringement of the trade mark.

(6) In this Part —

“plaintiff” means the person bringing an action pursuant to subsection (1) ;

“defendant” means the person making a threat and against whom the action is brought pursuant to subsection (1);

“threatened person” means the person against whom an action has been threatened pursuant to subsection (1);

Counterclaim by defendant in action on groundless threats

113. If the defendant in an action brought under section 112 would be entitled to bring against the plaintiff an action for infringement of the registered trade mark —

- (a) the defendant may file in the court a counterclaim against the plaintiff for any relief to which the defendant would be entitled in the action for infringement; and
- (b) the provisions of this Act applicable to actions for infringement apply in relation to the counterclaim as if it were an infringement action brought by the defendant against the plaintiff.

PART 13

IMPORTATION OF GOODS INFRINGING SAINT LUCIAN TRADE MARKS

Object of Part

114. The object of this Part is to protect registered trade marks by making provision allowing the Comptroller to seize and deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered trade mark. .

Notice of objection to importation

115.—(1) The registered owner of a registered trade mark may give to the Comptroller a notice in the form prescribed objecting to the importation after the date of the notice of goods that infringe the trade mark.

(2) If —

- (a) the registered owner of the registered trade mark has not given a notice under subsection (1); or
- (b) any notice given under subsection (1) is no longer in force ;

an authorised user of the trade mark having power to give a notice under subsection (1) may ask the registered owner to give such a notice in respect of the trade mark.

(3) If the registered owner does not comply with the request within the prescribed period, the authorised user may give the notice to the Comptroller together with —

- (a) any document prescribed for the purposes of subsection (1); and
- (b) any other prescribed document.

(4) A notice given by the registered owner of a trade mark remains in force for two years from the day on which the notice is given unless it is revoked, before the end of that period, by notice in writing given to the Comptroller by the person who is then the registered owner of the trade mark —

(5) A notice given by an authorised user of the trade mark remains in force for two years unless it is revoked, before the end of that period, by notice in writing given to the Comptroller —

- (a) if the authorised user has power to revoke the notice, by the authorised user; or
- (b) in any other case, by the person who is then the registered owner of the trade mark.

Comptroller may seize goods infringing trade mark

116.—(1) This section applies to goods manufactured outside Saint Lucia that —

- (a) are imported into Saint Lucia; and
- (b) are subject to the control of Customs under the Customs (Control and Management) Act 2000, No. 23.

(2) If goods to which this section applies —

- (a) have applied to them or in relation to them a sign that, in the opinion of the Comptroller, is substantially identical with, or deceptively similar to, a notified trade mark; and

- (b) are goods in respect of which the notified trade mark is registered;

the Comptroller shall seize the goods unless he or she is satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.

(3) The Comptroller may decide not to seize the goods if he or she has not been given by the objector, or by one or more of the objectors, security in an amount that he or she considers sufficient to repay to the Government the expense that may be incurred by the Government if the goods were seized.

(4) Goods seized under this section shall be kept in a secure place as directed by the Comptroller.

Notice of seizure

117. The Comptroller shall, as soon as practicable -

- (a) give, either personally or by post, to the designated owner of any seized goods a notice in writing identifying the goods and stating that they have been seized under section 116; and
- (b) give, either personally or by post, to the objector, or to each objector, a notice in writing —
- (i) identifying the goods and stating that they have been seized under section 116;
 - (ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller has and that he or she believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods; and
 - (iii) stating that the goods will be released to the designated owner unless the objector or one of the objectors, as the case requires, intends to bring an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller notice in writing of the intended action, within the period of ten working days after he or she has been given the notice or, if the Comptroller extends that period under section 120 (1), within the extended period.

Forfeiture of goods

118.—(1) The designated owner of any seized goods may, at any time before an objector starts an action for infringement of a notified trade mark in respect of the goods, consent to the goods being forfeited to the Government by giving notice in writing to that effect to the Comptroller.

(2) If the designated owner gives such a notice, the goods are forfeited to the Government.

Release of goods to owner-no action for infringement

119.—(1) The Comptroller shall release the seized goods to their designated owner if, within the action period, the objector has not, or none of the objectors has —

- (a) brought an action for infringement of the notified trade mark in respect of the goods; and
- (b) given to the Comptroller notice in writing of the action.

(2) The Comptroller shall also release the seized goods to their designated owner if —

- (a) before the end of the action period, the objector or each of the objectors has, by notice in writing to the Comptroller, consented to the release of the goods; and
- (b) at that time —
 - (i) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods; or
 - (ii) any action brought by an objector has been withdrawn.

(3) The Comptroller may release the seized goods to their designated owner at any time before the end of the action period if —

- (a) the Comptroller, having regard to information that has come to his or her knowledge after the goods were seized, is satisfied that there are no reasonable grounds for believing that the notified trade mark has been infringed by the importation of the goods; and
- (b) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods.

(4) In this section —

“action period”, in relation to seized goods, means —

- (a) if there is only one objector to the importation of the goods, the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under section 120(1); or
- (b) if there is more than one objector to the importation of the goods—the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under section 120 (1) and ending at the end of the last day on which an objector may bring such an action under section 120 (1).

Action for infringement of trade mark

120.—(1) An objector may bring an action for infringement of a notified trade mark in respect of seized goods and give notice of it to the Comptroller —

- (a) if paragraph (b) does not apply within the period of one month from the date of the notice given to the objector in respect of the goods under section 117; or
- (b) if —
 - (i) the objector has, before the end of the period specified in paragraph (a), applied in writing to the Comptroller for an extension of that period; and
 - (ii) the Comptroller, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended that period for a number of working days not exceeding ten;

within the period as so extended by the Comptroller.

(2) The court hearing an action brought pursuant to subsection (1) —

- (a) may, on the application of a person, allow the person to be joined as a defendant to the action; and
- (b) shall allow the Comptroller to appear and be heard.

(3) In addition to any relief that the court may grant apart from this section, the court may —

- (a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to the conditions, if any, that the court considers fit to impose; or

- (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.