

**SAINT LUCIA**

No. 16 of 2001

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**I ASSENT**

[L.S.]

PEARLETTE LOUISY,  
*Governor-General.*

*27th August, 2001.*

## **SAINT LUCIA**

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### **No. 16 of 2001**

**AN ACT** to give effect to certain international conventions on patents, and for related matters.

[ ON ORDER ]

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

PART I  
PRELIMINARY

**Short title and commencement**

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

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

(3) The Minister may fix different dates for the coming into force of the different Parts or provisions of this Act.

**Interpretation**

2.— (1) In this Act —

“Convention on International Exhibitions” means the Convention relating to International Exhibitions signed in Paris on 22<sup>nd</sup> November, 1928, as amended or supplemented by any protocol to that convention which is for the time being in force;

“Court” means the High Court;

“date of filing”, in relation to —

(a) an application for a patent made under this Act, means the date of filing that application by virtue of section 22; and

(b) any other application, means the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application in that country or is equivalent to the date of filing an application in that country, whatever the outcome of the application;

“Deputy Registrar” means the Deputy Registrar of Companies and Intellectual Property appointed under the Companies and Intellectual Property (Registry) Act 2000, No.12;

“designate”, in relation to an application for a patent, means designated country or countries, pursuant to the Patent Co-operation Treaty, in which protection is sought for the invention which is the subject of the application or patent;

“employee” means a person who works or, where the employment has ceased, worked under a contract of employment or in employment under or for the purposes of a Government department;

- “employer”, in relation to an employee, means the person by whom the employee is or was employed;
- “examiner” means a person, organisation, or foreign or international patent office or organisation as may be prescribed to whom the Registrar may refer questions relating to patents, including search and examination of applications for patents;
- “existing patent” means a patent which was registered or granted pursuant to the repealed enactment, and which was due to expire after the coming into force of this Act;
- “exclusive licence” means a licence from the proprietor of, or applicant for a patent conferring on the licensee, or on the licensee and persons authorised by the licensee, to the exclusion of all other persons, including the proprietor or applicant, any right in respect of the invention to which the patent or application relates, and “exclusive licensee” and “non-exclusive licence” shall be construed accordingly;
- “filing fee” means the fee prescribed for the purposes of section 21;
- “formal requirements” means those requirements designated as such by Regulations made for the purposes of section 24;
- “Government” when used with a capital “G” means Government of Saint Lucia;
- “international application for a patent” means an application made under the Patent Co-operation Treaty;
- “international application for a patent (Saint Lucia)” means an application of that description which, on its date of filing, designates Saint Lucia;
- “International Bureau” means the secretariat of the World Intellectual Property Organisation established by the convention signed at Stockholm on 14<sup>th</sup> July, 1967;
- “international exhibition” means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;
- “inventor”, in relation to an invention, means the actual deviser of the invention and “joint inventor” shall be constructed accordingly;

- “Minister” means the Minister responsible for Intellectual Property;
- “mortgage”, when used as a noun, includes a charge for securing money or money’s worth and, when used as a verb, shall be construed accordingly;
- “Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20<sup>th</sup> March, 1883;
- “patent” means a patent under this Act and includes a patent in force by virtue of section 110;
- “Patent Co-operation Treaty” means the treaty of that name signed at Washington on 19<sup>th</sup> June, 1970;
- “patented invention” means an invention for which a patent is granted and “patented process” shall be construed accordingly;
- “patented product” means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;
- “person” includes the Government;
- “prescribed” means prescribed pursuant to the Regulations;
- “priority date” means the date determined as such under section 13;
- “published” means made available to the public ,whether in Saint Lucia or elsewhere, and a document shall be taken to be published under any provision of this Act if it can be inspected as of right at any place in Saint Lucia by members of the public, whether on payment of a fee or not, and “republished” shall be construed accordingly;
- “Register”, when used as a noun, means the Register of Patents kept under section 38;
- “Registrar” means the Registrar of Companies and Intellectual Property appointed pursuant to the Companies and Intellectual Property (Registry) Act 2000, No. 12;
- “Registry” means the Registry of Companies and Intellectual Property established under the Companies and Intellectual Property (Registry) Act 2000, No.12 ;

“repealed enactment” means Title X of the Commercial Code, CAP. 244 which was repealed pursuant to the Trademarks Act 2001;

“right”, in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

“scientific adviser” means a person with any scientific qualification, a medical practitioner, engineer, architect, surveyor, accountant, actuary or any other specially skilled person;

“services of the Government” and “use of the services of the Government” have the same meanings as in section 58(2), including, in respect of any period of emergency within the meaning of section 61, the meanings assigned to them by that section;

(2) The Regulations may provide for stating in the *Gazette* that an exhibition falls within the definition of “international exhibition” in subsection (1) and any such statement shall be conclusive evidence that the exhibition falls within that definition.

(3) For the purposes of this Act, a matter shall be taken to have been disclosed in any relevant application within the meaning of section 13 or in the specification of a patent if it was either claimed or disclosed, otherwise than by way of disclaimer or acknowledgment of prior art, in that application or specification.

(4) References in this Act to an application for a patent, as filed, are references to such an application in the state it was on the date of filing.

(5) References in this Act to an application for a patent being published are references to it being published under section 23.

(6) References in this Act to the Paris Convention or the Patent Cooperation Treaty are references to that Convention or Treaty or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement, including in either case any protocol or annex, to which Saint Lucia is a party, or in accordance with the terms of any such convention or agreement and include references to any instrument made under any such convention or agreement.

(7) The Arbitration Ordinance CAP. 14 shall not apply to any proceedings before the Registrar under this Act.

PART II  
ADMINISTRATION

**Delegation by Registrar**

3.— (1) The Registrar may, in relation to a particular matter or class of matters, by writing under his or her hand, delegate all or any of his or her powers or functions under this Act, except this power of delegation, to any public officer so that the delegated powers and functions may be exercised by the delegate with respect to the matter or class of matters specified in the instrument of delegation.

(2) A delegation under this section is revocable at will and no delegation shall prevent the exercise of a power or function by the Registrar or a Deputy Registrar.

**Powers of Registrar**

4. The Registrar may, for the purposes of this Act —

- (a) summon witnesses;
- (b) receive evidence on oath, whether orally or otherwise;
- (c) require the production of documents or articles.

**Disobedience to summons**

5. — (1) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, fail to appear in obedience to the summons.

(2) A person who has been required by the Registrar to produce a document or article shall not, without lawful excuse, fail to produce the document or article.

(3) A person who contravenes subsection (1) or (2) commits an offence and is liable on conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding six months or to both.

**Refusal to give evidence**

6.— (1) A person who appears before the Registrar shall not, without lawful excuse, refuse to swear an oath or to make an affirmation, or to

produce documents or articles, or to answer questions, which that person is lawfully required to produce or answer.

(2) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding six months or to both.

**Persons employed in Registry not to traffic in inventions**

7.— (1) A person employed in the Registry shall not buy, sell, acquire or traffic in an invention or patent, whether granted in Saint Lucia or elsewhere, or in a right to, or licence under a patent, whether granted in Saint Lucia or elsewhere.

(2) A person who contravenes subsection (1), commits an offence and is liable on conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding six months or to both.

(3) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.

(4) This section shall not apply to the actual inventor or to an acquisition by bequest or devolution in law.

**Persons employed in Registry not to furnish information**

8.— (1) A person employed in the Registry shall not, except when required or authorised by this Act, or under a direction in writing of the Registrar or by order of a court —

- (a) furnish information on a matter which is being, or has been, dealt with under this Act;
- (b) prepare, or assist in the preparation of, a document required or permitted by or under this Act to be filed with the Registrar;

unless required or authorised to do so under this Act, or by virtue of a written direction from the Registrar or an order of the Court.

(2) A person who contravenes subsection (1), commits an offence and is liable on conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding six months or to both.

PART III  
PATENTABILITY

**Patentable inventions**

**9.**— (1) Subject to subsections (2) and (3), a patentable invention is one that satisfies the following conditions —

- (a) the invention is new;
- (b) it involves an inventive step; and
- (c) it is capable of industrial application.

(2) The following, among other things, are not inventions for the purposes of this Act —

- (a) anything which consists of—
  - (i) a discovery, scientific theory or mathematical method;
  - (ii) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
  - (iii) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
  - (iv) the presentation of information; or
- (b) anything which consists of diagnostic, therapeutic and surgical methods for the treatment of humans or animals.

(3) The Minister may, by Order published in the *Gazette*, vary the provisions of subsection (2) for the purposes of maintaining them in conformity with developments in science and technology.

**Novelty**

**10.**— (1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter, whether a product, a process, information about a product or process, or anything else, which has at any time before the priority date of that invention been made available to the public whether in Saint Lucia or elsewhere, by written or oral description, by use, or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied —

- (a) that matter was contained in the application for that other patent both as published; and
- (b) the priority date of that matter is earlier than that of the invention.

(4) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

#### **Inventive step**

**11.** An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 10(2) and without regard to section 10(3).

#### **Industrial application**

**12.—** (1) Subject to subsection (2), an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture, fishery and handicraft.

(2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.

(3) Subsection (2) shall not prevent a product consisting of a substance or composition being treated as capable of industrial application merely because it is invented for use in any method mentioned in that subsection.

#### **Priority date**

**13.—** (1) For the purposes of this Act, the priority date of an invention to which an application for a patent relates and also of any

matter, whether or not the same as the invention, contained in the application is, except as provided by the provisions of this Act, the date of filing the application.

(2) If in or in connection with an application for patent, in this section referred to as the application in suit, a declaration is made, whether by the applicant or his or her predecessor in title, complying with the relevant requirements of the Regulations and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or his or her predecessor in title and each having a date of filing during the period of twelve months immediately preceding the date of filing the application in suit, then —

- (a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall instead of being the date of filing the application in suit be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.
- (b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

(3) Where an invention or other matter contained in the application in suit was also disclosed in two earlier relevant applications filed by the same applicant, as in the case of the application in suit, or his or her predecessor in title and the second of those relevant applications was specified in or in connection with the application in suit, the second of those relevant applications shall, so far as it concerns that invention or matter, be disregarded unless —

- (a) it was filed in or in respect of the same country as the first; and
- (b) not later than the date of filing the second, the first, whether or not so specified, was unconditionally withdrawn, or was abandoned or refused, without —
  - (i) having been made available to the public whether in Saint Lucia or elsewhere;

- (ii) leaving any rights outstanding; and
- (iii) having served to establish a priority date in relation to another application, wherever made.

(4) This section shall apply for determining the priority date of an invention for which a patent has been granted as it applies for determining the priority date of an invention to which an application for that patent relates.

(5) In this section and section 14, “relevant application” means any of the following applications which has a date of filing —

- (a) an application for a patent under this Act; or
- (b) an application in or for a convention country specified pursuant to section 85 for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.

**Disclosure of matter, etc., between earlier and later applications**

**14.**— (1) For the avoidance of doubt that where an application, being the application in suit, is made for a patent and a declaration is made in accordance with section 13(2) in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted pursuant to it shall not be invalidated by reason only of the relevant intervening acts.

(2) In subsection (1), “relevant intervening acts” means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 13(3).

PART IV  
RIGHT TO APPLY FOR AND OBTAIN PATENT

**Right to apply for and obtain patent**

**15.**— (1) A person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted —

- (a) primarily to the inventor or joint inventors;
- (b) in preference to paragraph (a), to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it, other than equitable interests, in Saint Lucia;
- (c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) and (b) or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person.

(3) Except so far as the contrary is established, a person who makes an application for patent shall be taken to be the person who is entitled under subsection (2) to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

**Determination before grant of questions about entitlement to patents, etc.**

**16.**— (1) At any time before a patent has been granted for an invention —

- (a) any person may refer to the Registrar the question whether he or she is entitled to be granted, alone or with any other persons, a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or
- (b) any of two or more co-proprietors of an application for a patent for that invention may refer to the Registrar the question whether any right in or under application should be transferred or granted to any other person;

and the Registrar shall determine the question and may make such order as he or she thinks fit to give effect to the determination.

(2) Where a person refers a question relating to an invention under subsection (1) (a) to the Registrar after an application for a patent for the invention has been filed and before a patent is granted pursuant to the application, then, unless the application is refused or withdrawn before the reference is disposed of by the Registrar, the Registrar may, without prejudice to the generality of subsection (1) and subject to subsection (6) —

- (a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant or any specified applicant;
- (b) where the reference was made by two or more persons, order that the application shall proceed in all their names jointly;
- (c) refuse to grant a patent pursuant to the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred; or
- (d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

(3) Where a question is referred to the Registrar under subsection (1) (a) and —

- (a) the Registrar orders an application for a patent for the invention to which the question relates to be so amended;
- (b) any such application is refused under subsection (2) (c) before the Registrar has disposed of the reference, whether the reference was made before or after the publication of the application; or
- (c) any such application is refused under any other provision of this Act or is withdrawn before the Registrar has disposed of the reference, but after the publication of the application;

the Registrar may order that any person by whom the reference was made may within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier applications, subject in either case to section 80, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

(4) Where a person refers a question under subsection (1) (b) relating to an application, any order under subsection (1) may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (2) (d) or (4) fails to do anything necessary for carrying out any such directions within fourteen days after the date of the directions, the Registrar may, on application made to him or her by any other person in whose favour or on whose reference the directions were given, authorise that other person to do that thing on behalf of the person to whom the directions were given.

(6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted, whether alone or with any other persons, a patent for the invention or has or would have any right in or under any patent, an order shall not be made under subsection (2) (a), (b) or (d) on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is party to the reference.

(7) If it appears to the Registrar on a reference of a question under this section that the question involves matters which would more properly be determined by the Court, he or she may decline to deal with it and, without prejudice to the Court's jurisdiction to determine any such question and make a declaration, the Court shall have jurisdiction to do so.

(8) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

**Determination after grant of questions referred before grant**

**17.** If a question with respect to a patent or application is referred by any person to the Registrar under section 16, and is not determined before the time when the application is first in order for a grant of a patent pursuant to the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the Registrar under section 43 any question mentioned in that section which the Registrar thinks appropriate.

**Handling of application by joint applicants**

**18.** If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Registrar may, on a request made by any of the parties, give such directions as the Registrar thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, as the case may require.

**Effect of transfer of application under section 16 or 18**

**19.—** (1) Where an order is made or directions are given under section 16 or 18 that an application for a patent shall proceed in the name of one or some of the original applicants, whether or not it is also to proceed in the name of some other person, any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.

(2) Where an order is made or directions are given under section 16 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant, on the ground that the original applicant or applicants was or were not entitled to be granted the patent, any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3), lapse on the registration of the person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.

(3) If before registration of a reference under section 16 resulting in the making of any order mentioned in subsection (2) —

- (a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in Saint Lucia or made effective and serious preparations to do so; or
- (b) a licensee of the applicant, acting in good faith, worked the invention in Saint Lucia or made effective and serious preparations to do so;

the original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence, but not an exclusive licence, to continue working or, as the case may be, to work the invention.

(4) A licence pursuant to subsection (3) shall be granted for a reasonable period and on reasonable terms.

(5) Where an order is made as mentioned in subsection (2), the person in whose name the application is to proceed or any person claiming that he or she is entitled to be granted any such licence may refer to the Registrar the question whether the latter is so entitled and whether any such period is or terms are reasonable, and the Registrar shall determine the question and may, if he or she considers it appropriate, order the grant of such a licence.

#### **Mention of inventor**

**20.**— (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with the Regulations in a prescribed document.

(2) Unless an applicant for a patent has already given the Registrar the information mentioned in this subsection, that applicant shall, within the prescribed period, file with the Registrar a statement —

- (a) identifying the person or persons whom the applicant believes to be the inventor or inventors; or
- (b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of the applicant's or applicants' right to be granted the patent;

and if the applicant fails to do so, the application shall be treated as having been abandoned.

(3) Where a person has been mentioned as a sole or joint inventor pursuant to this section, any other person who alleges that the former ought not to have been mentioned may at any time apply to the Registrar for a certificate to that effect, and the Registrar may issue such a certificate.

### **PART V**

#### **APPLICATIONS FOR PATENTS**

#### **Making of application**

**21.**— (1) An application for a patent —

- (a) shall be made in the prescribed form and shall be filed with the Registrar in the prescribed manner; and
- (b) shall be accompanied by the prescribed fee for the purposes of this subsection.

(2) Where an application is not accompanied by the fee mentioned in subsection (1) (b), the fee shall be paid within the prescribed period.

(3) An application for a patent shall contain —

- (a) a request for the grant of a patent;
- (b) a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim; and
- (c) an abstract;

but this subsection shall not prevent an application being initiated by documents complying with section 22 (1).

(4) The specification of an application for a patent shall disclose the invention in a manner which is clear and complete for the invention to be performed by a person skilled in the art.

(5) An application for a patent shall —

- (a) define the matter for which the applicant seeks protection;
- (b) be clear and concise;
- (c) be supported by the description; and
- (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

(6) Without prejudice to the generality of subsection (5) (d), the Regulations may provide for treating two or more inventions as being so linked as to form a single inventive concept for the purposes of this Act.

(7) The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 10 (3), and the Registrar may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.

(8) An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked.

**Date of filing application**

**22.—** (1) The date of filing an application for a patent shall, subject to the provisions of this Act, be taken to be the earliest date on which the following considerations are satisfied in relation to the application —

- (a) the documents filed at the Registry contain an indication that a patent is sought pursuant to the application;
- (b) those documents identify the applicant or applicants for the patent; and
- (c) those documents contain a description of the invention and one or more claims whether or not the description or the claim or claims complies with the other provisions of this Act and with any relevant Regulations.

(2) An application for a patent shall be examined on filing to determine whether —

- (a) the filing fee has been paid; and
- (b) the application satisfies the requirements for the accordancy of a filing date.

(3) If a date of filing cannot be accorded pursuant to subsection (2), the Registrar shall give the applicant an opportunity to correct the deficiencies, and if the deficiencies are not corrected within the prescribed period, the application shall be treated as having been abandoned.

(4) If the filing fee has not been paid within the period prescribed under section 21 (2), the application shall be treated as having been abandoned.

(5) If before the grant of a patent under section 26 it is found that any drawing referred to in any such application is filed later than the date which by virtue of subsection (1) is to be treated as the date of filing the application, the Registrar shall give the applicant an opportunity of requesting, within the prescribed period, that the date on which the drawing is filed shall be treated for the purposes of this Act as the date of filing the application, and —

- (a) if the applicant makes any such request, the date of filing the drawing shall be so treated; but
- (b) otherwise any reference to the drawing in the application shall be treated as omitted.

(6) Where, after an application for a patent has been filed and before the patent is granted, a new application is filed by the original applicant or his or her successor in title in accordance with the Regulations in respect of any of the matters contained in the earlier application and the conditions mentioned in subsection (1) are satisfied in relation to the new application, without the new application contravening section 80, the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

(7) Nothing in subsection (5) shall be construed as affecting the power of the Registrar under section 101 (1) to correct errors or mistakes with respect to the filing of drawings.

#### **Publication of application**

**23.**—(1) Subject to section 29, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the Registrar shall, unless the application is —

- (a) withdrawn;
- (b) treated as having been abandoned; or
- (c) refused;

before preparations for its publication have been completed by the Registrar, publish it as filed, including not only the original claims but also any amendments of those claims and new claims subsisting immediately before the completion of those preparations, and the Registrar may, if so requested by the applicant, publish it as aforesaid during that period, and in either event shall publish the fact and date of its publication in the *Gazette*.

(2) The Registrar may omit from the specification of a published application for a patent any matter —

- (a) which in his or her opinion disparages any person in a way likely to damage that person; or
- (b) the publication or exploitation of which would in his or her opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

PART VI  
PROCEDURE FOR GRANT OF PATENT

**Examination as to form**

24.— (1) Where an application for a patent has a date of filing and is not withdrawn or treated as having been abandoned, the Registrar shall, as soon as practicable after the end of the prescribed period, examine the application so as to determine whether the application complies with those requirements pursuant to this Act which are designated by the Regulations as formal requirements for the purposes of this Act.

(2) Where, after an examination under subsection (1), it is determined that not all the formal requirements are complied with, the Registrar shall give the applicant an opportunity to make observations and to amend the application within such period as the Registrar may specify so as to comply with those requirements, subject, however, to section 80, and if the applicant fails to do so, the Registrar may refuse the application.

**Search and examination and corresponding international applications**

25.— (1) Where an application for a patent complies with all the formal requirements referred to in section 24(1), the Registrar shall notify the applicant who shall —

- (a) file a request in the prescribed form and pay the prescribed fee for a search report within the prescribed period;
- (b) file a request in the prescribed form and pay the prescribed fee for a search and examination report within the prescribed period; or
- (c) where the applicant has filed, alone or jointly with any other person, a corresponding international application for a patent, not designating Saint Lucia, or a corresponding application for a patent at any prescribed patent office, furnish such detail as prescribed and within the prescribed period, of all the corresponding international applications and the other corresponding applications filed by him or her;

and if the applicant fails to make such request, pay the prescribed fee or furnish the prescribed detail within the prescribed period, the application shall be treated as having been abandoned at the end of the period prescribed under paragraph (a), (b) or (c), whichever is the latest.

(2) Where the applicant has filed a request and paid the fee under subsection (1) (a), the Registrar shall cause the application to be subject to a search by an examiner to discover the relevant prior art contained in such documentation as may be prescribed.

(3) Upon receipt of the report of the search carried out under subsection (2), the Registrar shall send to the applicant a copy of the report, and the applicant may, within the prescribed period, file a request and pay the prescribed fee for an examination report on the application so as to determine whether the conditions specified in sections 9 and 21(4) and (5) have been complied with, taking into consideration all the relevant prior art, if any, referred to in the search report; and upon receipt of the report, the Registrar shall send to the applicant a copy of the report.

(4) Where the applicant has furnished the prescribed details under subsection (1) (c), he or she shall, subject to subsection (5), within the prescribed period, file the prescribed information in or translated into the English Language relating to any one of the corresponding international applications or other corresponding applications referred to in subsection (1) (c).

(5) The applicant may, instead of filing the prescribed information referred to in subsection (4), within the prescribed period, either —

- (a) file a copy of a search report in respect of any one of the corresponding international applications or other corresponding applications referred to in subsection (1) (c), together with a request in the prescribed form and the prescribed fee, for an examination report; or
- (b) file a request in the prescribed form and pay the prescribed fee for a search and examination report.

(6) Where the applicant has filed a request and paid the fee under subsection (1) (b) or (5) (b), the Registrar shall cause the application to be subject to —

- (a) a search by an examiner to discover the relevant prior art contained in such documentation as may be prescribed;
- (b) an examination by an examiner so as to determine whether the conditions specified in sections 9 and 21 (4) and (5) have been complied with, taking into consideration all the relevant prior art, if any, discovered in the search, and upon receipt of the search and examination report, the Registrar shall send to the applicant a copy of the report.

(7) Where the applicant has filed a request and paid the fee under subsection (5) (a), the Registrar shall cause the application to be subject to an examination by an examiner so as to determine whether the conditions specified in sections 9 and 21 (4) and (5) have been complied with, taking into consideration all the relevant prior art, if any, referred to in the search report and upon receipt of the examination report, the Registrar shall send to the applicant a copy of the report.

(8) Where an international application for a patent (Saint Lucia) has been filed by the applicant and the international preliminary examination report is not established, the applicant may, within the prescribed period file a request in the prescribed form and pay the prescribed fee, for an examination report on the application so as to determine whether the conditions specified in sections 9 and 21 (4) and (5) have been complied with, taking into consideration all the relevant prior art, if any, referred to in the international search report, and upon receipt of the examination report, the Registrar shall send to the applicant a copy of the report.

(9) For the purposes of this Part, “corresponding international application” and “corresponding application”, in relation to an invention, mean an application for protection filed, respectively, under the Patent Co-operation Treaty or with any prescribed patent office in respect of the same or substantially the same invention as that which is the subject of the application in suit, the application filed under the Patent Co-operation Treaty or with the prescribed patent office being —

- (a) the basis for a priority claim pursuant to section 13 in the application in suit; or
- (b) subject to a priority claim based on the application in suit or an application which is also the basis for a priority claim pursuant to section 13 in the application in suit.

#### **Grant of patent**

**26.—** (1) Where before the end of the prescribed period the conditions in subsection (2) are satisfied, the Registrar shall grant a patent to the applicant.

(2) The conditions referred to in subsection (1) are —

- (a) that all the formal requirements have been complied with;
- (b) in the case of an international application for a patent (Saint Lucia) where Saint Lucia has been elected in accordance with

Chapter II of the Patent Co-operation Treaty, that the international preliminary examination report of the application has been received by the Registrar;

- (c) in any other case, that the following reports or information have been received by the Registrar —
  - (i) the search and examination report referred to in section 25 (6);
  - (ii) the search report and the examination report referred to in section 25 (3);
  - (iii) the search report referred to in section 25 (5) and the examination report referred to in section 25 (7);
  - (iv) the examination report referred to in section 25 (8); or
  - (v) the prescribed information relating to any one of the corresponding international applications or other corresponding applications referred to in section 25 (4); and
- (d) that the prescribed fee for the grant of a patent has been paid.

(3) Notwithstanding subsection (1), the Registrar may refuse to grant a patent —

- (a) pursuant to more than one application where two or more applications for a patent for the same invention having the same priority date have been filed by the same applicant or his or her successor in title; or
- (b) in respect of any thing referred to in section 9 (2) or any invention referred to in section 9(3).

#### **General power to amend application before grant**

**27.**— (1) If it appears to an examiner, during the examination of an application, that the conditions specified in sections 9 and 21(4) and (5) have not been complied with, the examiner shall give the applicant at least one written opinion to that effect, and the application shall before the examination report is issued have the right to —

- (a) respond to the written opinion within any prescribed period; and
- (b) amend the specification of the application in accordance with the prescribed conditions and subject to section 80.

(2) Notwithstanding subsection (1), at any time before a patent is granted pursuant to an application, the applicant may, in accordance with the prescribed conditions and subject to section 80, amend the application of his or her own volition.

**Failure of application**

**28.**— (1) Where an application for a patent has not, before the end of such period as may be prescribed, complied with the requirements of section 26(2), the application shall be treated as having been abandoned at the end of that period.

(2) If at the end of the period prescribed pursuant to subsection (1), an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period —

- (a) where such an appeal is pending, or is brought within the said time or before the expiration of any extension of that time granted, in the case of a first extension, on an application made within that time or, in the case of a subsequent extension, on an application made before the expiration of the last previous extension, shall be extended until such date as the court may determine;
- (b) where no such appeal is pending or is so brought, shall continue until the end of the said time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

**Information prejudicial to defence of Saint Lucia or safety of public**

**29.**— (1) Where an application for a patent is filed with the Registrar, whether under this Act or any treaty or international convention to which Saint Lucia is a party, and it appears to the Registrar that the application contains information of a description notified to him or her by the Minister as being information the publication of which might be prejudicial to the national security of Saint Lucia, the Registrar shall give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.

(2) If it appears to the Registrar that any application so filed contains information the publication of which might be prejudicial to the safety of the public, the Registrar may give directions prohibiting or

restricting the publication of that information or its communication to any specified person or description or persons until the end of a period not exceeding three months from the end of a period prescribed for the purposes of section 23.

(3) While directions are in force under this section with respect to an application —

- (a) if the application is made under this Act, it will be held in abeyance after the formal requirements of this Act and the Regulations have been met and will not proceed to be processed in accordance with section 25 until the directions are revoked under subsection (4) (e); and
- (b) if it is an international application for a patent, a copy of it shall not be sent to the International Bureau or any international searching authority appointed under the Patent Co-operation Treaty.

(4) Where the Registrar gives directions under this section with respect to any application, he or she shall give notice of the application and of the directions to the Minister, and the following provisions shall then have effect —

- (a) the Minister shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of Saint Lucia or the safety of the public;
- (b) if the Minister determines under paragraph (a) that the publication or communication of that information would be prejudicial to the safety of the public, he or she shall notify the Registrar who shall continue his directions under subsection (2) until they are revoked under paragraph (e);
- (c) if the Minister determines under paragraph (a) that the publication of the application or the publication or communication of that information would be prejudicial to the defence of Saint Lucia or the safety of the public, the Minister shall, unless a notice under paragraph (d) has previously been given by the Minister to the Registrar, reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;

- (d) if on consideration of an application at any time it appears to the Minister that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the defence of Saint Lucia or the safety of the public, he or she shall give notice to the Registrar to that effect; and
- (e) on receipt of such a notice the Registrar shall revoke the directions, and may, subject to such conditions, if any, as he or she thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the application, whether or not that time has previously expired.

(5) The Minister may at any time, for the purpose of enabling him or her to decide the question referred to in subsection (4) (c), do one or both of the following, that is to say, inspect or authorise any person to inspect the application and any documents sent to the Registrar in connection with it and where a person is authorised to carry out such inspection, he or she shall as soon as practicable report on his or her inspection to the Minister.

(6) Where directions given under this section in respect of an application for a patent for an invention are revoked, and the application is brought in order for the grant of a patent and a patent is granted for the invention, then —

- (a) if while the directions are in force the invention is worked by, or with the written authorization of or to the order of, a Government department, the provisions of Part XII shall apply as if —
  - (i) the working was use made pursuant to section 57;
  - (ii) the application had been published at the end of the prescribed period or at the time the directions were revoked, whichever is earlier; and
  - (iii) a patent had been granted for the invention at the time the application is brought in order for the grant of a patent, taking the terms of the patent to be those of the application as it stood at the time it was so brought in order; and
- (b) if it appears to the Minister that the application for the patent has suffered hardship while the directions were in force, the Minister may make such payment, if any, by way of

compensation to the applicant as appears to the Minister to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(7) Where a patent is granted pursuant to an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.

(8) Any person who fails to comply with any direction under this section commits an offence and is liable on conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding one year or to both.

(9) Nothing in this section shall prevent the disclosure of information concerning an invention to a Government department or authority for the purpose of obtaining advice as to whether directions under this section with respect to an application for a patent for that invention should be made, amended or revoked.

**Restrictions on applications abroad by Saint Lucia residents**

**30.**— (1) Subject to this section, a person resident in Saint Lucia shall not, without written authority granted by the Registrar, file or cause to be filed outside Saint Lucia an application for a patent for an invention unless —

- (a) an application for a patent for the same invention has been filed in the Registry not less than two months before the application outside Saint Lucia; and
- (b) no directions have been given under section 29 in relation to the application in Saint Lucia or all such directions have been revoked.

(2) Subsection (1) shall not apply to an application for a patent for an invention for which an application for a patent has first been filed in a country outside Saint Lucia by a person who is resident outside Saint Lucia.

(3) A person who files, or causes to be filed an application for the grant of a patent in contravention of this section commits an offence and is liable on conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding one year or to both.

(4) In this section —

- (a) a reference to an application for a patent includes a reference to an application for other protection for an invention;
- (b) a reference to either kind of application is a reference to an application under this Act, under the law of any country other than Saint Lucia or under any treaty or international convention to which Saint Lucia is a party; and
- (c) “person resident in Saint Lucia” includes a person who, at the material time, is residing in Saint Lucia by virtue of a valid permit lawfully issued to him or her under the Immigration Act to enter and remain in Saint Lucia for any purpose.

## PART VII

### PROVISIONS AS TO PATENTS AFTER GRANT

#### **Publication and certificate of grant**

**31.**— (1) As soon as practicable after a patent has been granted under this Act, the Registrar shall publish, in the *Gazette*, a notice that it has been granted.

(2) The Registrar shall, as soon as practicable after he or she publishes a notice under subsection (1), send the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor.

(3) The Registrar shall, at the same time as he or she publishes a notice under subsection (1) in relation to a patent, publish in the *Gazette* the specification of the patent, the names of the proprietor and, if different, the inventor and any other matters, including the prescribed information under sections 25 and 26 constituting or relating to the patent which in the Registrar’s opinion it is desirable to publish.

#### **Term of patent and notice for renewal fee**

**32.**— (1) A patent granted under this Act shall be treated for the purposes of this Act as having been granted, and shall take effect on the date on which notice of its grant is published in the *Gazette* and, subject to subsection (2), shall continue in force until the end of the period of twenty years beginning with the date of filing the application for the patent or with such other date as may be prescribed.

(2) A patent shall cease to have effect at the end of the prescribed period if the renewal fee is not paid.

(3) If during the period of six months immediately following the end of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Act as if it had never expired, and accordingly —

- (a) anything done under or in relation to it during that further period shall be valid;
- (b) an act which would constitute an infringement of it, if it had not expired, shall constitute such an infringement; and
- (c) an act which would constitute the use of the patented invention for the services of the Government if the patent had not expired shall constitute that use.

(4) The Registrar shall notify the registered proprietor of a patent that a renewal fee has not been received from that proprietor before the end of the prescribed period.

**Patent not to be impugned for lack of unity**

**33.** A person shall not in any proceeding object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate —

- (a) to more than one invention; or
- (b) to a group of inventions which are not linked as to form a single inventive concept.

**General power to amend specification after grant**

**34.—** (1) Subject to this section and to section 80, the Registrar may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as the Registrar thinks fit.

(2) An amendment pursuant to subsection (1) shall be allowed under this section where there are pending before the court or the Registrar proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the date of grant of the patent.

(4) A person may give notice to the Registrar of his or her opposition to an application under this section by the proprietor of a patent, and if the person gives notice the Registrar shall notify the proprietor and consider the opposition in deciding whether to grant the application.

#### **Restoration of lapsed patents**

**35.**— (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the Registrar within the prescribed period.

(2) An application under this section may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect, and where the patent was held by two or more persons jointly, the application may, with the leave of the Registrar, be made by one or more of them without joining the others.

(3) Notice of the application shall be published by the Registrar in the prescribed manner.

(4) If the Registrar is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that the fee and any prescribed additional fee were paid within the six months immediately following the end of that period, the Registrar shall, subject to subsection (5), restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

(5) A restoration pursuant to subsection (4) may be made subject to such conditions as the Registrar thinks fit, including a condition requiring compliance with any provisions of the Regulations relating to registration which have not been complied with, and if the proprietor of the patent does not comply with any such condition of the order, the Registrar may revoke the order and give such directions consequential on the revocation as he or she thinks fit.

(6) The effect of an order for the restoration of a patent during the period between expiry and restoration is that the patent shall be treated as valid.

(7) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.

(8) Anything done during that period which would have constituted an infringement if the patent had not expired shall be treated as an infringement —

- (a) if done at a time when it was possible for the patent to be renewed under section 32 (3);
- (b) if it was a continuation or repetition of an earlier infringing act.

(9) If after it was no longer possible for the patent to be renewed, and before publication of notice of the application for restoration, a person —

- (a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired; or
- (b) made in good faith effective and serious preparations to do such an act;

the person has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent, but subject to subsection (10) this right does not extend to granting a licence to another person to do the act.

(10) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (9) may —

- (a) authorise the doing of that act by any of his or her partners for the time being in that business; and
- (b) assign that right, or transmit it on death, or in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(11) Where a product is disposed of to another person in exercise of the rights conferred by subsection (9) or (10), that other person and any person claiming through him or her may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

(12) Subsections (7) to (11) shall apply in relation to the use of a patent for the services of the Government as they apply in relation to infringement of the patent.

#### **Surrender of patents**

**36.**— (1) The proprietor of a patent may at any time by notice given to the Registrar offer to surrender his or her patent.

(2) A person may give notice to the Registrar of his or her opposition to the surrender of a patent under this section, and the Registrar shall notify the proprietor of the patent and determine the question.

(3) If the Registrar is satisfied that the patent may properly be surrendered, the Registrar may accept the offer and, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for the services of the Government.

### **PART VIII**

#### **PROPERTY IN PATENTS AND APPLICATIONS FOR PATENTS AND REGISTRATION**

#### **Nature of and transactions in, patents and applications for patents**

**37.**— (1) A patent or an application for a patent is personal property, without being a thing in action, and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with this section.

(2) Subject to section 42 (3), a patent or an application for, or any right in a patent, may be assigned or mortgaged.

(3) A patent or an application for or right in a patent shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(4) Subject to section 42 (3), a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application, and —

- (a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and
- (b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(5) Subsections (2) to (4) shall have effect subject to the provisions of this Act.

(6) Any of the following transactions —

- (a) an assignment or mortgage or a patent or any such application, or any right in a patent or any such application;
- (b) an assent relating to any patent or any such application or right;

shall be void unless it is in writing and is signed by or on behalf of the parties to the transactions, or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative, or in the case of a body corporate is so signed or is under the seal of that body.

(7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 63 or 72 for a previous infringement or to bring the proceedings under section 60 for a previous act.

#### **Register of patents**

**38.**— (1) There shall be kept at the Registry a Register of Patents which shall comply with the Regulations and shall be kept in accordance with such Regulations.

(2) Without prejudice to any other provisions of this Act, the Regulations may make provision with respect to the following matters, including provision imposing requirements as to any of those matters—

- (a) the registration of patents and of published applications for patents;
- (b) the registration of transactions, instruments or events affecting rights in or under patents and applications;

- (c) the furnishing to the Registrar of any prescribed documents or description of documents in connection with any matter which is required to be registered;
- (d) the correction of errors in the register and in any documents filed with the Registrar in connection with registration; and
- (e) the publication and advertisement of anything done under this Act or the Regulations in relation to the Register.

(3) Notwithstanding anything in subsection (2) (b), no notice of any trust, whether express, implied or constructive, shall be entered in the Register and the Registrar shall not be affected by any such notice.

(4) The Register need not be kept in documentary form.

(5) Subject to the Regulations, the public shall have a right to inspect the Register at the Registry at all convenient times.

(6) Any person who applies for a certified copy of an entry in the Register or a certified extract from the Register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts, and the Regulations may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(7) Applications under subsection (6), or the Regulations made by virtue of that subsection shall be made in such manner as may be prescribed.

(8) In relation to any portion of the Register kept otherwise than in documentary form —

- (a) the right of inspection conferred by subsection (5) is a right to inspect the material on the Register; and
- (b) the right to a copy or extract conferred by subsection (6) or the Regulations is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

**Effect of registration, etc. on rights in patents**

**39.**— (1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as

against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event —

- (a) the earlier transaction, instrument or event was not registered;
- (b) in the case of any application which has not been published, notice of the earlier transaction, instrument or event had not been given to the Registrar; and
- (c) in any case, the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event.

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent, by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section shall apply to the following transactions, instruments and events —

- (a) the assignment of a patent or application for a patent, or a right in a patent;
- (b) the mortgage of a patent or application for a patent;
- (c) the grant or assignment of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application for a patent;
- (d) the death of the proprietor or one of the proprietors of any such patent or application for a patent or any person having a right in or under a patent or application for a patent and the vesting by an assent of personal representatives of a patent, application for or right in or under a patent; and
- (e) any order or directions of a court or other competent authority —
  - (i) transferring a patent or applications or any right in or under it to any person; or
  - (ii) that an application should proceed in the name of any person;

and in either case the event by virtue of which the court or authority had power to make any such order or give any such directions.

(4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1) (a), registration of the application shall be treated as registration of the transaction, instrument or event.

**Rectification of register**

**40.**— (1) The court may, on the application of any person aggrieved, order the Register to be rectified by the making, or the variation or deletion, of any entry in it.

(2) In proceedings under these section, the court may determine any question which may be necessary or expedient to decide in connection with the rectification of the Register.

**Evidence of register, documents, etc.**

**41.**— (1) The Register shall be prima facie evidence of anything required or authorised by this Act or the Regulations to be registered.

(2) A certificate purporting to be signed by the Registrar and certifying that any entry which he or she is authorised by this Act to make has or has been made, or that any other thing which he or she is so authorised to do has or has not been done, shall be prima facie evidence of the matter so certified.

(3) Each of the following —

- (a) a copy of an entry in the Register or an extract from the Register which is supplied under section 38 (6);
- (b) a copy of any document kept in the Registry or an extract from any such document; or
- (c) any specification of a patent or any application for a patent which has been published;

which purports to be a certified copy or a certified extract shall be admitted in evidence without further proof and without production of the original.

(4) In this section, “certified copy” and “certified extract” mean a copy and an extract certified by the Registrar and stamped by the Registrar.

**Co-ownership of patents and applications for patents**

**42.**— (1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Where two or more persons are proprietors of a patent, then, subject to this section and subject to any agreement to the contrary —

(a) each of them shall be entitled, by himself or herself or his or her agents, to do in respect of the invention, for his or her own benefit and without the consent of or the need to account to the other or others, any act which would, apart from this subsection and section 57, amount to an infringement of the patent; and

(b) any such act shall not amount to an infringement of the patent.

(3) Subject to sections 16 and 43, and to any agreement for the time being in force, where two or more persons are proprietors of a patent, one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to sections 16 and 43, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means relating to an essential element of the invention for putting the invention into effect and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him or her shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) and (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) This section shall have effect in relation to an application for a patent which is filed as it has effect in relation to a patent and —

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

- (b) the reference in subsection (5) to a patented product shall be construed accordingly.

**Determination of right to patent after grant**

**43.**— (1) After a patent has been granted for an invention, any person having or claiming a proprietary interest in or under the patent may refer to the Registrar the question —

- (a) who is or are the true proprietor or proprietors of the patent;
- (b) whether the patent should have been granted to the person or persons to whom it was granted; or
- (c) whether any right in or under the patent should be transferred or granted to any other person or persons;

and the Registrar shall determine the question and make such order as he or she thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1), an order under that subsection may contain provisions —

- (a) directing that the person by whom the reference is made under that subsection shall be included whether or not to the exclusion of any other person among the persons registered as proprietors of the patent;
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
- (c) granting any licence or other right in or under the patent; and
- (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom directions have been given under subsection (2) (d) fails to do anything necessary for carrying out any such directions within fourteen days after the date of the order containing the directions, the Registrar may, on an application made to him or her by any person in whose favour or on whose reference the order containing the directions was made, authorise him or her to do that thing on behalf of the person to whom the directions were given.

(4) Where the Registrar finds on a reference under this section that the patent was granted to a person not entitled to be granted that patent, whether alone or with other persons, and on an application made under section 76 makes an order on that ground for the conditional or unconditional revocation of the patent, the Registrar may order that the person by whom the application was made or his or her successor in title may, subject to section 80, make a new application for patent —

- (a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and
- (b) in the case of conditional revocation, for the matter which in the opinion of the Registrar should be excluded from that specification by amendment under section 79;

and where such a new application is made, it shall be treated as having been filed on the date of filing the application for the patent to which the reference relates.

(5) On any reference under subsection (1), no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled, and no order shall be made under subsection (4) on that ground if the reference was made after the end of the period of two years beginning with the date after the end of the period that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him or her that he or she was not entitled to the patent.

(6) An order under this section shall not be so made as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) Where a question is referred to the Registrar under this section, an order shall not be made by virtue of subsection (2) or under subsection (4) on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent, except those who are parties to the reference.

(8) If it appears to the Registrar on a reference under this section that the question referred to him or her would more properly be determined by the court, he or she may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, the court shall have jurisdiction to do so.

(9) The court shall not in the exercise of any such declaratory jurisdiction determine a question whether a patent was granted to a person not entitled to be granted the patent if the proceedings in which the jurisdiction is invoked were commenced after the end of the period of two years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him or her that he or she was not entitled to the patent.

**Effect of transfer of patent under section 43**

**44.**— (1) Where an order is made under section 43 that a patent shall be transferred from any person or persons, the old proprietor or proprietors, to one or more persons, whether or not including an old proprietor, then, except in a case falling within subsection (2), any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 39 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred, the new proprietor or proprietors.

(2) Where an order is so made that a patent shall be transferred from the old proprietor or proprietors to one or more persons none of whom was an old proprietor, on the ground that the patent was granted to a person not entitled to be granted the patent, any licences or other rights in or under the patent shall, subject to the provisions of the order and subsection (3), lapse on the registration of that person or those persons as the new proprietor or proprietors of the patent.

(3) Where an order is so made that a patent shall be transferred as mentioned in subsection (2) or that a person other than an old proprietor may make a new application for a patent and before the reference of the question under that section resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith —

- (a) worked the invention in question in Saint Lucia;
- (b) or made effective and serious preparations to work the invention in question in Saint Lucia;

the old proprietor or proprietors or the licensee shall, on making a request to the new proprietor or proprietors within the prescribed period, be entitled to be granted a licence, but not an exclusive licence, to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.

(4) A licence pursuant to subsection (3) shall be granted for a reasonable period and on reasonable terms.

(5) The new proprietor or proprietors of the patent or any person claiming that he or she is entitled to be granted a licence pursuant to subsections (3) and (4) may refer to the Registrar the question whether that person is so entitled and whether any such period is or terms are reasonable, and the Registrar shall determine the question and may, if he or she considers it appropriate, order the grant of such a licence.

## PART IX

### EMPLOYEES INVENTIONS

#### **Right to employees inventions**

**45.**— (1) Notwithstanding anything in any rule of law, an invention made by an employee shall be taken to belong to his or her employer for the purposes of this Act and all other purposes if —

- (a) the invention was made in the course of the normal duties of the employee or in the course of duties falling outside his or her normal duties, but especially assigned to him or her, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his or her duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his or her duties and the particular responsibilities arising from the nature of his or her duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention, other than those mentioned in subsection (1), made by an employee shall be taken for those purposes of this Act to belong to the employee.

(3) Where by virtue of this section an invention belongs to an employee, nothing done —

- (a) by or on behalf of the employee or any person claiming under him or her for the purposes of pursuing an application for a patent; or
- (c) by any person for the purpose of performing or working the invention;

shall be taken to infringe any copyright or design right to which his or her employer is entitled in any model or document relating to the invention.

(4) In subsection (3), the reference to an application for a patent includes an application for other protection for an invention, and includes an application for a patent or any other protection under the law of a country other than Saint Lucia or under any treaty to which Saint Lucia is a party.

**Supplementary provisions**

**46.—** (1) This Part shall not apply to an invention made before the commencement of this Act.

(2) This Part shall not apply to an invention made by an employee unless at the time he or she made the invention one of the following conditions was satisfied —

- (a) the employee was mainly employed in Saint Lucia; or
- (b) the employee was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in Saint Lucia to which the employee was attached, whether or not the employee was also attached elsewhere.

(3) In this Part, except so far as the context otherwise requires, references to the making of an invention by an employee are references to the employee making it alone or jointly with any other person, but do not include references to the employee merely contributing advice or other assistance in the making of an invention by another employee.

(4) A reference in section 45 to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of Saint Lucia or the law in force in any other country or under any treaty or international convention.

(5) Nothing in this Part shall be construed as precluding the operation of an agreement or a contract in relation to the right to an invention.

## PART X

## CONTRACTS AS TO PATENTED PRODUCTS

**Avoidance of certain restrictive conditions**

**47.**— (1) Subject to this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far as it purports —

- (a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his or her nominee, or prohibit him or her from acquiring from any specified person, or from acquiring except from the supplier or his or her nominee, anything other than the patented product;
- (b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his or her nominee, or prohibit him or her from acquiring from any specified person, or from acquiring except from the licensor or his or her nominee, anything other than the product which is the patented invention or, if it is a process, other than any product obtained directly by means of the process or to which the process has been applied;
- (c) in either case, to prohibit the person supplied or the licensee from using articles, whether patented products or not, which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his or her nominee, or to restrict the right of the person supplied or the licensee to use any such articles or process.

(2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or a licence under the patent granted by the plaintiff or with his or her consent and containing in either case a condition or term void by virtue of this section.

(3) A condition or term of a contract or licence shall not be void by virtue of this section if —

- (a) at the time of the making of the contract or granting of the licence, the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or the licensee, on reasonable

terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1); and

- (b) the person supplied or the licensee is entitled under the contract or licence to relieve himself or herself of his or her liability to observe the condition or term on giving to the other party three months notice in writing, and subject to payment to that other party of such compensation, being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence, as may be determined by an arbitrator appointed by the Minister.

(4) If in any proceedings it is alleged that any condition or term of a contract or licence is void by virtue of this section, it shall lie on the supplier or licensor to prove the matters set out in subsection (3) (a).

(5) A condition or term of a contract or licence shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specific person or, in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor or licensor, or his or her nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

#### **Determination of parts of certain contracts**

**48.**— (1) Any contract for the supply of a patented product or licence to work a patented invention, or contract relating to any such supply or licence, may at any time after the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or licence or in any other contract, be determined, to the extent, and only to the extent, that the contract or licence relates to the product or invention, by either party on giving three months notice in writing to the other party.

(2) In subsection (1), “patented product” and “patented invention” include respectively a product and an invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence, on an application which had been filed before that time, as it applies to a patent in force at that time.

(3) If, on an application under this section made by either party to a contract or licence falling within subsection (1), the court is satisfied that, in consequence of the patent or patents ceasing to be in force, it would be unjust to require the applicant to continue to comply with all the terms and conditions of the contract or licence, the court may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.

(4) Without prejudice to any other right of recovery, nothing in subsection (1) shall be taken to entitle any person to recover property let under a hire-purchase agreement.

(5) This section shall apply to contracts and licences whether made before or after the commencement of this Act.

(6) This section shall be without prejudice to any rule of law relating to the frustration of contracts and any rights of determining a contract or licence exercisable apart from this section.

## PART XI

### LICENCES OF RIGHT AND COMPULSORY LICENCES

#### **Licences of right**

**49.**— (1) At any time after the grant of a patent, its proprietor may apply to the Registrar for an entry to be made in the register to the effect that licences under the patent are to be available as of right.

(2) Where an application under subsection (1) is made, the Registrar shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, shall make the entry.

(3) Where an entry under subsection (2) is made in respect of a patent —

- (a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the Registrar on the application of the proprietor of the patent or the person requiring the licence;
- (b) the Registrar may, on the application of the holder of any licence granted under the patent before the entry was made,

order the licence to be exchanged for a licence of right on terms so settled;

- (c) if, in proceedings for infringement of the patent, the defendant undertakes to take a licence on terms pursuant to subsection (3)(b), no injunction shall be granted against him or her and the amount (if any) recoverable against him or her by way of damages shall not exceed twice the amount which would have been payable by him or her as licensee if such a licence on those terms had been granted before the earliest infringement;
- (d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.

(4) An undertaking under subsection (3) (c) may be given at any time before final order in the proceedings, without any admission of liability.

(5) The licensee under a licence of right may, unless, in the case of a licence the terms of which are settled by agreement, or the licence otherwise expressly provides, request the proprietor of the patent to take proceedings to prevent any infringement of the patent, and if the proprietor refuses or neglects to do so within two months after being so requested, the licensee may institute proceedings for the infringement in his or her own name as if he or she were the proprietor, making the proprietor a defendant.

(6) A proprietor so added as defendant shall not be liable for any costs or expenses unless he or she enters an appearance and takes part in the proceedings.

#### **Cancellation of entry made under section 49**

**50.**— (1) At any time after an entry has been made pursuant to section 49 in respect of a patent, the proprietor of the patent may apply to the Registrar for cancellation of the entry.

(2) Where an application under subsection (1) is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the Registrar may cancel the entry if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Within the prescribed period after an entry had been made under section 49 in respect of the patent any person who claims that the property of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Registrar for cancellation of the entry.

(4) Where the Registrar is satisfied, on an application under subsection (3), that the proprietor of the patent is and was so precluded, he or she shall cancel the entry, and the proprietor shall then be liable to pay, within a period specified by the Registrar, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(5) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall after the cancellation be the same as if the entry had not been made.

(6) Where an application has been made under this section —

- (a) in the case of an application under subsection (1), any person; and
- (b) in the case of an application under subsection (3), the proprietor of the patent;

may, within the prescribed period, give notice to the Registrar of opposition to the cancellation, and the Registrar shall, in considering the application, determine whether the opposition is justified.

#### **Compulsory licences**

**51.**— (1) At any time after the expiration of three years, or of such other period as may be prescribed, from the date of the grant of a patent, any person may apply to the Registrar —

- (a) for a licence under the patent;
- (b) for an entry to be made in the register to the effect that licences under the patent are to be available as of right; or
- (c) where the applicant is a Government department, for the grant to any person specified in the application of a licence under the patent;

if it appears at the time such application is filed, one or more of the grounds specified in subsection (2) are met.

- (2) The grounds referred to in subsection (1) are —
- (a) that there is no production of the patented product or application of the patented process in Saint Lucia without any legitimate reason;
  - (b) that there is no product produced in Saint Lucia under the patent for sale in Saint Lucia or there are some but they are sold at unreasonably high prices or do not meet the public demand without any legitimate reason;
  - (c) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms —
    - (i) a market for the export of any patented product made in Saint Lucia is not being supplied;
    - (ii) the working or efficient working in Saint Lucia of any other patented invention which makes a substantial contribution to the art is prevented or hindered; or
    - (iii) the establishment or development of commercial or industrial activities in Saint Lucia is unfairly prejudiced; and
  - (d) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in Saint Lucia, is unfairly prejudiced.
- (3) Subject to subsections (4) to (6), if the Registrar is satisfied that any of those grounds under subsection (2) are established, the Registrar may —
- (a) where the application is made pursuant to subsection (1) (a), order the grant of a licence to the applicant on such terms, including the transfer of know-how associated with the patented invention, as the Registrar thinks fit;
  - (b) where the application is made pursuant to subsection (1) (b), make such an entry as is there mentioned; or
  - (c) where the application is made pursuant to subsection (1) (c), order the grant of a licence to the person specified in the application on such terms, including the transfer of know-how associated with the patented invention, as the Registrar thinks fit.

(4) Where —

- (a) an application is made on the ground that there is no production of the patented product or application of the patented process in Saint Lucia; or
- (b) there is insufficient or no product produced under the patent for sale in Saint Lucia;

and it appears to the Registrar that the time which has elapsed since the publication in the *Gazette* of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked, the Registrar may by order adjourn the application for such period as will in the Registrar's opinion give sufficient time for the invention to be so worked.

(5) No entry shall be made in the register under this section on the ground mentioned in subsection (2) (c) (i), and any licence granted under this section on that ground shall contain such provisions as appear to the Registrar to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee.

(6) No order or entry shall be made under this section in respect of a patent on the ground mentioned in subsection (2) (c) (ii) unless the Registrar is satisfied that the proprietor of the patent for the other invention is able and willing to grant to the proprietor of the patent and his or her licensees a licence under the patent for the other invention on reasonable terms.

(7) An application may be made under this section in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent, and no person shall be stopped or barred from alleging any of the matters specified in subsection (2) by reason of any admission made by him or her, whether in such a licence or otherwise, or by reason of his or her having accepted such a licence.

**Inventions relating to food or medicine or surgical or curative device**

**52.**— (1) At any time after the date of the grant of a patent in respect of —

- (a) a substance capable of being used as food or medicine or in the production of food or medicine;
- (b) a process for producing any substance mentioned in paragraph (a); or

- (c) any invention capable of being used as or as part of a surgical or curative device;

the Registrar may, on application made to him or her by any person, order the grant to the applicant of a licence under the patent on such terms as the Registrar thinks fit, unless it appears to the Registrar that there are good reasons for refusing the application.

(2) A licence granted under this section shall entitle the licensee to make, use or dispose of the invention as a food or medicine, or for the purpose of the production of food or medicine or as part of a surgical or curative device.

(3) An application under this section may be made notwithstanding that the applicant is already the holder of a licence under the patent.

(4) A licence granted under this section and section 51 may permit the licensee to import the patented product.

#### **Provisions as to licences under section 51 or 52**

**53.**— (1) Where the Registrar is satisfied, on an application made under section 51 or 52 in respect of a patent, that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or the use of the patented process, the Registrar may, subject to those sections, order the grant of licences under the patent to such customers of the applicant as the Registrar thinks fit as well as to the applicant.

(2) Where an application under section 51 or 52 is made in respect of a patent by a person who holds a licence under the patent, the Registrar may —

- (a) if he or she orders the grant of a licence to the applicant, order the existing licence to be cancelled; or
- (b) instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.

(3) Section 49 (5) and (6) apply to a licence granted pursuant to an order under section 51 or 52 and to a licence granted by virtue of an entry under section 51 as it applies to a licence granted by virtue of an entry under section 49.

**Exercise of powers on application under section 51**

**54.**— (1) The powers of the Registrar on an application under section 51 in respect of a patent shall be exercised with a view to securing the following general purposes —

- (a) that inventions which can be worked on a commercial scale in Saint Lucia and which should in the public interest be so worked shall be worked without undue delay such that they are available in Saint Lucia to an adequate extent and supplied on reasonable terms;
- (b) that the interests of any person for the time being working or developing an invention in Saint Lucia under the protection of a patent shall not be unfairly prejudiced;
- (c) that the royalty and other remuneration, if any, reserved to the inventor or other person beneficially entitled to a patent is reasonable having regard to the nature of the invention.

(2) Subject to subsection (1), the Registrar shall, in determining whether to make an order or entry pursuant to such an application, take account of the following matters —

- (a) the nature of the invention, the time which has elapsed since the publication in the journal of a notice of the grant of the patent and the measures already taken by the proprietor of the patent or any licensee to make full use of the invention;
- (b) the ability of any person to whom a licence would be granted under the order to work the invention to the public advantage; and
- (c) the risks to be undertaken by that person in providing capital and working the invention if the application for an order is granted;

but shall not be required to take account of matters subsequent to the making of the application.

**Opposition appeal and arbitration**

**55.**— (1) The proprietor of a patent or any other person wishing to oppose an application under sections 51 to 54 may, in accordance with the Regulations, give to the Registrar notice of opposition, and the Registrar shall consider the opposition in deciding whether to grant the application.

(2) Where an appeal is brought from an order made by the Registrar pursuant to an application under sections 51 to 54 or from his or her decision to make an entry in the register pursuant to such an application or from his or her refusal to make such an order or entry, the Attorney-General or such other counsel as he or she may appoint, shall be entitled to appear and be heard.

(3) Where an application under sections 51 to 54 is opposed under subsection (1), and either —

- (a) the parties consent; or
- (b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the Registrar conveniently be made before him or her;

the Registrar may at any time order the whole proceedings, or any question or issue of fact arising pursuant to the proceedings, to be referred to an arbitrator agreed on by the parties or, in default of agreement, appointed by the Registrar.

(4) The arbitrator to whom any reference is made under subsection (3) shall report his or her findings to the Registrar.

(5) The expenses of and incidental to a reference to an arbitrator under subsection (3) shall, in default of agreement between the parties, be borne equally by the parties to the reference.

#### **Supplementary provisions**

**56.**— (1) The Registrar may make an entry in the register under sections 51 to 54 notwithstanding any contract which would have precluded the entry on the application of the proprietor of the patent under section 49.

(2) An entry made in the register under sections 51 to 54 shall for all purposes have the same effect as an entry made under section 49.

(3) Where a licence has been granted under section 49, 51 or 52 and the proprietor of the patent and the licensee are unable to agree within a reasonable time on the amount of royalty or compensation to be reserved to the proprietor of the patent, the Registrar shall determine the royalty or compensation payable.

(4) No order or entry shall be made pursuant to an application under sections 51 to 54 which would be at variance with any treaty or international convention relating to patents to which Saint Lucia is a party.

## PART XII

### USE OF PATENTED INVENTIONS FOR SERVICES OF GOVERNMENT

#### **Use of patented inventions for services of Government**

**57.** — (1) Notwithstanding anything in this Act, any Government department and any person authorised in writing by a Government department may, for the services of the Government and in accordance with this section, do any of the following acts in Saint Lucia in relation to a patented invention without the consent of the proprietor of the patent —

- (a) where the invention is a product, may —
  - (i) make, use, import, obtain or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing, obtaining or keeping it; or
  - (ii) in any event, sell or offer to sell it for foreign defence purposes or for the production or supply of any drug and medicine, or dispose or offer to dispose of it for any purpose whatever;
- (d) where the invention is a process, may use it or, in relation to any product obtained directly by means of the process, do anything mentioned in paragraph (a);
- (c) without prejudice to paragraphs (a) and (b), where the invention or any product obtained directly by means of the invention is a drug or medicine, may sell or offer to sell the drug or medicine;
- (d) may supply or offer to supply to any person any of the means, relating to an essential element of the invention, for putting the invention into effect;
- (e) may dispose or offer to dispose of anything which was made, used, imported, obtained or kept in the exercise of the powers conferred by this section and which is no longer required for the purpose for which it was made, used, imported, obtained or kept, as the case may be;

and anything done by virtue of this subsection shall not amount to an infringement of the patent.

(2) Any act done in relation to an invention by virtue of this section is in this section referred to as use of the invention; and “use”, in relation to an invention, in sections 58 to 60 shall be construed accordingly.

(3) So far as the invention has before its priority date been duly recorded by or tried by or on behalf of a Government department otherwise than in consequence of a relevant communication made in confidence, any use of the invention by virtue of this section may be made free of any royalty or other payment to the proprietor.

(4) So far as the invention has not been so recorded or tried, any use of it made by virtue of this section at any time either —

- (a) after the publication of the application for the patent for the invention; or
- (b) without prejudice to paragraph (a), in consequence of a relevant communication made after the priority date of the invention otherwise than in confidence;

shall be made on such terms as may be agreed either before or after the use by the Government department and the proprietor of the patent or as may in default of agreement be referred to an arbitrator agreed on by the parties or, in default of agreement, appointed by the Registrar.

(5) The arbitrator to whom any reference is made under subsection (4) shall report his or her findings to the Registrar.

(6) The expenses of and incidental to an arbitrator under subsection (4) shall, in default of agreement between the parties, be borne equally by the parties to the reference.

(7) Where an invention is used by virtue of this section at any time after publication of an application for a patent for the invention but before such a patent is granted, and the terms for its use agreed or determined as mentioned in subsection (4) include terms as to payment for the use, then, notwithstanding anything in those terms, any such payment shall be recoverable only —

- (a) after such a patent is granted; and

(b) if, apart from this section, the use would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent but also the claims, as interpreted by the description or claims, in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Registry.

(8) The authority of a Government department in respect of an invention may be given under this section either before or after the patent is granted and either before or after the use in respect of which the authority is given is made, and may be given to any person whether or not he or she is authorised, directly or indirectly, by the proprietor of the patent to do anything in relation to the invention.

(9) Where any use of an invention is made by or with the authority of a Government department under this section, then, unless it appears to the department that it would be contrary to the public interest to do so, the department shall notify the proprietor of the patent as soon as practicable after the second of the following events, that is to say, the use is begun and the patent is granted, and furnish him or her with such information as to the extent of the use as he or she may from time to time require.

(10) A person acquiring anything disposed of in the exercise of the powers conferred by this section, and any person claiming through him or her, may deal with it in the same manner as if the patent were held on behalf of the Government.

(11) In determining under this section any dispute between a Government department and any person as to the terms for the use of an invention for the services of the Government, the arbitrator shall have regard —

- (a) to any benefit or compensation which that person or any person from whom he or she derives title may have received or may be entitled to receive, directly or indirectly, from any Government department in respect of the invention; and
- (b) to whether that person or any person from whom he or she derives title has in the arbitrator's opinion without reasonable cause failed to comply with a request of the department to use the invention for the services of the Government on reasonable terms.

(12) On a reference under this section, the arbitrator may refuse to grant relief by way of compensation in respect of the use of an invention for the services of the Government during any further period specified under section 32(3), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that section.

(13) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, the arbitrator shall not grant relief by way of compensation under this section in respect of any such use before the decision to allow the amendment unless the Registrar is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

(14) In considering the amount of any compensation for the use of an invention for the services of the Government after publication of an application for a patent for the invention and before such a patent is granted, the arbitrator shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 23, that a patent would be granted conferring on the proprietor of the patent protection for an act of the same description as that found to constitute that use, and if the arbitrator finds that it would not have been reasonable, he or she shall reduce the compensation to such amount as he or she thinks just.

(15) Where, by virtue of a transaction, instrument or event to which section 39 applies, a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent, the new proprietor or licensee, and a Government department or a person authorised by a Government department subsequently makes use of the patented invention under this section, the new proprietor or licensee shall not be entitled to any compensation under subsection (4), as it stands or as modified by section 59 (3), in respect of a subsequent use of the invention before the transaction, instrument or event is registered unless —

- (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
- (b) the Registrar is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

(16) In this section, “relevant communication”, in relation to an invention, means a communication of the invention, directly or indirectly, by the proprietor of the patent or any person from whom he or she derives title.

(17) Subsection (4) is without prejudice to any rule of law relating to the confidentiality of information.

**Interpretation, etc., of provisions about Government use**

**58.**— (1) Any reference in section 57 to a patented invention, in relation to any time, is a reference to an invention for which a patent has before that time been, or is subsequently, granted.

(2) In this Part, unless the context otherwise requires, “the services of the Government” includes —

- (a) the supply of anything for foreign defence purposes;
- (b) the production or supply of drugs and medicines required for the provision of pharmaceutical, medical or dental services in any prescribed dispensary, hospital or other medical institution maintained by or on behalf of the Government and in any dispensary, hospital or medical institution which the Minister may specify by notification in the *Gazette*; and
- (c) such purposes relating to the production or use of atomic energy or research into matters connected therewith as the Minister thinks necessary or expedient;

and “use for the services of the Government” shall be construed accordingly.

(3) In subsection (2) (a) and section 57 (1) (a), references to a sale or supply of anything for foreign defence purposes are references to a sale or supply of the thing —

- (a) to the government of any country outside Saint Lucia pursuant to an agreement or arrangement between the Government and the government of that country, where the thing is required for the defence of that country, where the thing is required for the defence of that country or of any other country whose government is party to any agreement or arrangement with the Government in respect of defence matters; or
- (b) to the United Nations, or to the government of any country belonging to that organisation, pursuant to an agreement or

arrangement between the Government and that organisation or government of the country belonging to that organisation, where the thing is required for any armed forces operating pursuant to a resolution of that organisation or any organ of that organisation.

**Rights of third parties in respect of Government use**

**59.**— (1) In relation to —

- (a) any use made for the services of the Government of an invention by a Government department, or a person authorised by a Government department, by virtue of section 57; or
- (c) anything done for the services of the Government to the order of a Government department by the proprietor of a patent in respect of a patented invention or by the proprietor of an application in respect of an invention for which an application for a patent has been filed and is still pending;

the provisions of any licence, assignment or agreement to which this subsection applies shall be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use, and the reproduction or publication of any model or document in connection with the said working or use shall not be deemed to be an infringement of any copyright or design right subsisting in the model or document.

(2) Subsection (1) shall apply to any licence, assignment or agreement which is made, whether before or after the commencement date, between, on the one hand, any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title, and, on the other hand, any person other than a Government department.

(3) Where an exclusive licence granted otherwise than for royalties or other benefits determined by reference to the working of the invention is in force under the patent or application, then —

- (a) in relation to anything done in respect of the invention which, but for this section and section 57, would constitute an infringement of the rights of the licensee, section 57 (4) shall have

effect as if for the reference to the proprietor of the patent there were substituted a reference to the licensee; and

- (b) in relation to anything done in respect of the invention by the licensee by virtue of an authority given under section 57, that section shall have effect as if section 57(4) were omitted.

(4) Subject to subsection (3), where a patent, or the right to the grant of a patent, has been assigned to the proprietor of the patent or application in consideration of royalties or other benefits determined by reference to the working of the invention, then —

- (a) in relation to any use of the invention by virtue of section 57, subsection (4) of that section shall have effect as if the reference to the proprietor of the patent included a reference to the assignor, and any sum payable by virtue of that subsection shall be divided between the proprietor of the patent or application and the assignor in such proportion as may be agreed on by them or as may in default of agreement be determined by the court on a reference under section 57; and
- (b) in relation to any act done in respect of the invention for the services of the Government by the proprietor of the patent or application to the order of a Government department, section 57(4) shall have effect as if the act was use made by virtue of an authority given under that section.

(5) Where section 57(4) applies to any use of an invention and a person holds an exclusive licence under the patent or application, other than such a licence as is mentioned in subsection (3) authorising him or her to work the invention, then subsections (7) and (8) shall apply.

(6) In subsections (7) and (8), “the section 57(4) payment” means such payment, if any, as the proprietor of the patent or application and the Government department agree under section 57, or the arbitrator determines under that section, should be made by the department to the proprietor in respect of the use of the invention.

(7) The licensee shall be entitled to recover from the proprietor of the patent or application such part, if any, of the section 57(4) payment as may be agreed on by them or as may, in default of agreement, be determined by the court under section 57 to be just having regard to any expenditure incurred by the licensee —

- (a) in developing the invention; or
- (b) in making payments to the proprietor in consideration of the licence, other than royalties or other payments determined by reference to the use of the invention.

(8) Any agreement by the proprietor of the patent or application and the Government department under section 57 (4) as to the amount of the section 57 (4) payment shall be of no effect unless the licensee consents to the agreement; and any determination by the arbitrator under section 57 (4) as to the amount of that payment shall be of no effect unless the licensee has been informed of the reference to the arbitrator and is given an opportunity to be heard.

(9) Where any model, document or information relating to an invention is used in connection with —

- (a) any use of the invention which falls within subsection (1) (a);  
or
- (b) with anything done in respect of the invention which falls within subsection (1) (b);

section 57 (4) shall, whether or not it applies to any such use of the invention, apply to the use of the model, document or information as if for the reference in it to the proprietor of the a patent there was substituted a reference to the person entitled to the benefit of any provision of an agreement which is rendered in operative by this section in relation to that use, and in section 57 the references to terms for the use of an invention shall be construed accordingly.

(10) Nothing in this section shall be construed as authorising the disclosure to a Government department or any other person of any model, document or information to the use of which this section applies in contravention of any such licence, assignment or agreement as is mentioned in this section.

#### **References of disputes as to Government use**

**60.**— (1) Any dispute as to —

- (a) the exercise by a Government department or a person authorised by a Government department of the powers conferred by section 57; or
- (b) the right of any person to receive any part of a payment made or agreed to be made pursuant to subsection (4) of section 57 or determined by the arbitrator pursuant to that subsection;

may be referred to the court by either party to the dispute after a patent has been granted for the invention.

(2) If in proceedings pursuant to subsection (1) any question arises whether an invention has been recorded or tried as mentioned in section 57, and the disclosure of any document recording the invention, or of any evidence of the trial thereof, would in the opinion of the Government department be prejudicial to the public interest, the disclosure may be made confidentially to counsel for the other party or to an independent expert mutually agreed upon.

(3) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (4), grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used for the services of the Government.

(4) Where in proceedings pursuant to subsection (3) it is found that a patent is only partially valid, the court shall not grant relief by way of costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses.

(5) As a condition of any such relief, the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 79, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

(6) In any proceedings under this section, the court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as the court may direct, to an arbitrator, and references to the court in this section shall be construed accordingly.

(7) One of the two or more joint proprietors of a patent or an application for a patent may, without the concurrence of the others, refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings, but any of the others if made a defendant shall not be liable for any costs or expenses unless he or she enters an appearance and takes part in the proceedings.

**Special provisions as to Government use during emergency**

**61.**— (1) During any period of emergency within the meaning of this section, the powers exercisable in relation to an invention by a Government department or a person authorised by a Government department under section 57 shall include power to use the invention for any purpose which appears to the department necessary or expedient —

- (a) for the efficient prosecution of any war in which Saint Lucia may be engaged;
- (b) for the maintenance of supplies and services essential to the life of the community;
- (c) for securing a sufficiency of supplies and services essential to the well-being of the community;
- (d) for promoting the productivity of industry, commerce and agriculture;
- (e) for fostering and directing exports and reducing imports, or imports of any class, from all or any countries and for redressing the balance of trade;
- (f) generally for ensuring that the whole resources of the community are available for use, and are used, in a manner best calculated to serve the interests of the community; or
- (g) for assisting the relief of suffering and the restoration and distribution of essential supplies and services in any country or territory outside Saint Lucia which is in grave distress as a result of a war;

and any reference in this Act to the services of the Government shall, in respect of any period of emergency, include a reference to those purposes.

(2) In this section, “the use of an invention” includes, in addition to any act constituting such use by virtue of section 57, any act which would, apart from that section and this section, amount to an infringement of the patent or, as the case may be, give rise to a right under section 72 to bring proceedings in respect of the application, and any reference in this Act to “use for the services of the Government” shall, as respects any period of emergency, be construed accordingly.

(3) In this section, “period of emergency” means any period beginning with such date as may be declared by the Minister by order published in the *Gazette* to be the commencement, and ending with such

date as may be so declared to be the termination, of a period of emergency for the purposes of this section.

PART XIII  
INFRINGEMENT OF PATENTS

**Meaning of infringement**

**62.**— (1) Subject to the provisions of this Act, a person infringes a patent for an invention if, but only if, while the patent is in force, he or she does any of the following things in Saint Lucia in relation to the invention without the consent of the proprietor of the patent —

- (a) where the invention is a product, that person makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;
- (b) where the invention is a process, that person uses the process or offers it for use in Saint Lucia when he or she knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent;
- (c) where the invention is a process, that person disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(2) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not do so if —

- (a) it is done privately and for purposes which are not commercial;
- (b) it is done for experimental purposes relating to the subject-matter of the invention;
- (c) it consists of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;
- (d) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing Saint Lucia, (including the air space above it and its territorial waters, or the use of accessories for such a relevant aircraft, hovercraft or vehicle;

- (e) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the territorial waters of Saint Lucia;
- (f) it consists of the import, use, disposal or offer to dispose of, of any patented product, or of any product obtained by means of patented process or to which a patented process has been applied, which is produced by or with the consent, conditional or otherwise, of the proprietor of the patent or any person licenced by him or her, and for this purpose “patent” includes a patent granted in any country outside Saint Lucia in respect of the same or substantially the same invention as that for which a patent is granted under this Act and “patented product”, “patented process” and “licenced” shall be construed accordingly.

(3) In this section, “relevant ship,” “relevant aircraft,” “relevant hovercraft” or “relevant vehicle” mean respectively a ship, aircraft, hovercraft or vehicle registered in, or belonging to, any country other than Saint Lucia which is a party to the Paris Convention.

#### **Proceedings for infringement of patent**

**63.**— (1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and, without prejudice to any other jurisdiction of the court, in those proceedings a claim may be made —

- (a) for an injunction restraining the defendant from any apprehended act of infringement;
- (b) for an order for the defendant to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
- (c) for damages in respect of the infringement;
- (d) for an account of the profits derived by the defendant from the infringement; and
- (e) for a declaration that the patent is valid and has been infringed by the defendant.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

(3) The proprietor of a patent and any other person may by agreement with each other refer to the Registrar the question whether that other person has infringed the patent and on the reference, the proprietor of the patent may make any claim mentioned in subsection (1) (c) or (e).

(4) In this Act, unless the context otherwise requires —

- (a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) and the making of such a reference;
- (b) any reference to a plaintiff includes a reference to the proprietor of the patent; and
- (c) any reference to a defendant includes a reference to any other party to the reference.

(5) If it appears to the Registrar on a reference under subsection (3) that the question referred to the Registrar would more properly be determined by the court, the Registrar may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.

(6) Subject to this Part, in determining whether or not to grant any kind of relief claimed under this section and the extent of the relief granted, the court or the Registrar shall apply the principles applied by the court in relation to that kind of relief immediately before the date of commencement of this Act.

#### **Reversal of burden of proof**

**64.** — (1) In any proceedings for the infringement of a patent, where the subject-matter of the patent is a process for obtaining a new product, the burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used.

(2) In considering whether a party has discharged the burden imposed upon him or her by this section, the court shall not require him or her to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

**Restrictions on recovery of damages for infringement**

**65.**— (1) In proceedings for infringement of a patent, damages shall not be awarded and no order shall be made for an account of profits against a defendant who proves that at the date of the infringement he or she was not aware, and had no reasonable grounds for supposing, that the patent existed, and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words.

(2) The court or the Registrar may, if the court or the Registrar thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified pursuant to section 32(3), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

(3) Where an amendment of the specification of a patent has been allowed under any of the provisions of this act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the court or the Registrar is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

**Relief for infringement of partially valid patent**

**66.**— (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the Registrar may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the court or the Registrar shall not grant relief by way of damages, costs or expenses, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the Registrar may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the Registrar as to costs or expenses and as to the date from which damages should be reckoned.

(3) As a condition of relief under this section, the court or the Registrar may direct that the specification of the patent shall be amended to the court's or the Registrar's satisfaction upon an application made for that purpose under section 79, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

**Right to continue use begun before priority date**

**67.**— (1) Where a patent is granted for an invention, a person who is in Saint Lucia before the priority date of the invention —

- (a) does in good faith an act which would constitute an infringement of the patent if it were in force; or
- (b) makes in good faith effective and serious preparations to do such an act;

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent, but this right does not extend to granting a licence to another person to do the act.

(2) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may —

- (a) authorise the doing of that act by any of his or her partners for the time being in that business; and
- (b) assign that right, or transmit it on death, or in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) and (2), that other and any person claiming through him or her may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

**Certificate of contested validity of patent**

**68.**— (1) If in any proceedings before the court or the Registrar the validity of a patent is found by the court or the Registrar to be wholly or partially valid, the court or the Registrar may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the Registrar for infringement of the patent or for revocation of the patent, a final order or judgement is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the Registrar otherwise directs, be entitled to his or her costs or expenses as between solicitor and own client other than the costs or expenses of any appeal in the subsequent proceedings.

**Proceedings for infringement by co-owner**

**69.**— (1) In the application of section 62 to a patent of which there are two or more joint proprietors, the reference to the proprietor shall be construed —

- (a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 42 or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and
- (b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 42 or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an alleged infringement of the patent, but shall not do so unless the others are made parties to the proceedings, but any of the others if made a defendant shall not be liable for any costs or expenses unless he or she enters an appearance and takes part in proceedings.

**Proceedings for infringement by exclusive licensee**

**70.**— (1) Subject to this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence and references to the proprietor of the patent in this Act relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings, the court or the Registrar shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived

from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section, the proprietor of the patent shall be made a party to the proceedings, but if made a defendant shall not be liable for any costs or expenses unless he or she enters an appearance and takes part in the proceedings.

**Effect of non-registration on infringement proceedings**

**71.** Where by virtue of a transaction, instrument or event to which section 39 applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, the court of the Registrar shall not award him or her damages or order that he or she be given an account of the profits in respect of such a subsequent infringement occurring before the transaction, instrument or event is registered unless —

- (a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
- (b) the court or the Registrar is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

**Infringement of rights conferred by publication of application**

**72.—** (1) Where an application for a patent for an invention is published —

- (a) subject to this section, the applicant shall have, as from the publication and until the grant of the patent, the same right as he or she would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the Registrar for damages in respect of any act which would have infringed the patent; and
- (b) references in sections 62 to 65 and 69 to 71 to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.

(2) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only —

- (a) after the patent has been granted; and
- (b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims, as interpreted by the description and drawings referred to in the description or claims, in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Registry.

(3) Section 65 (2) and (3) shall not apply to an infringement of the rights conferred by this section, but in considering the amount of any damages for such an infringement, the court or the Registrar shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 23, that a patent would be granted conferring on the proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court or the Registrar finds that it would not have been reasonable, it or he or she shall reduce the damages to such an amount as it or he or she thinks just.

**Remedy for groundless threats of infringement proceedings**

**73.**— (1) Where a person, whether or not the proprietor of, or entitled to any right in, a patent, by circulars, advertisements or otherwise, threatens another person with proceedings for any infringement or a patent, a person aggrieved by the threats, whether or not he is the person to whom the threats are made, may, subject to subsection (4), bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (3).

(2) In any such proceedings, the plaintiff shall, if he or she proves that the threats were so made and satisfies the court that he or she is a person aggrieved by them, be entitled to the relief claimed unless —

- (a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and
- (b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The relief pursuant to subsection (2) is —

- (a) a declaration to the effect that the threats are unjustifiable;

- (b) an injunction against the continuance of the threats; and
- (c) damages in respect of any loss which the plaintiff has sustained by the threats.

(4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.

(5) It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(6) Nothing in this section shall render a person liable to an action under this section in respect of an act done by the person in his professional capacity on behalf of a client.

#### **Declaration as to non-infringement**

**74.**— (1) Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the Registrar in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown —

- (a) that the person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him or her with full particulars in writing of the act in question; and
- (b) that the proprietor has refused or failed to give any such acknowledgment.

(2) A declaration made by the Registrar under this section shall have the same effect as a declaration made by the court.

### **PART XIV**

#### **REVOCATION OF PATENTS AND VALIDITY PROCEEDINGS**

##### **Information on result of corresponding international applications**

**75.**— (1) The Registrar may, on the application of any interested person and on the payment of the prescribed fee, request the proprietor of a patent to furnish to the Registrar, within such period as the Registrar

may specify, the prescribed information on all corresponding international applications or corresponding applications for a patent made by him or her, or his predecessor in title at any prescribed patent office with respect to which details had been furnished to the Registrar under section 25 (1) (c).

(2) Where the proprietor of a patent has furnished the prescribed information under subsection (1) or where such information is available at the Registry, the Registrar shall as soon as practicable send to the interested person the prescribed information so furnished or available.

(3) Where the proprietor of a patent fails without good cause to comply with the request of the Registrar under subsection (1), the Registrar may by order revoke the patent with effect from the date of the grant of the patent.

(4) For the purpose of this section, “corresponding international application” and “corresponding application” have the same meanings as in section 25 (9).

#### **Power to revoke patents on application**

**76.**— (1) Subject to the provisions of this Act, the Registrar may, on the application of any person, by order revoke a patent for an invention on, but only on, any of the following grounds —

- (a) the invention is not a patentable invention;
- (b) the patent was granted by a person who was not entitled to be granted that patent;
- (c) the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;
- (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent, as filed, or, if the patent was granted on a new application filed under section 16 (3), 43(4) or 110, or as mentioned in section 22 (6), in the earlier application made under this Act;
- (e) the protection conferred by the patent has been extended by an amendment which should not have been allowed;
- (f) the applicant for the patent has failed to inform the Registrar about any corresponding international application or corresponding application filed by him as required under section 25

(1) (c) or has furnished any information which in any material particular was false; or

(g) the patent was obtained on a misrepresentation.

(2) On the application of any person for an order to revoke a patent on any of the grounds specified in subsection (1) (a), (c), (d) and (e), the Registrar may, subject to subsections (3) and (4), cause the patent to be re-examined by an examiner so as to determine whether the patent should be revoked on any of those grounds and require the applicant to pay the prescribed re-examination fee.

(3) The Registrar shall not cause a patent to be re-examined under subsection (2) where, within the prescribed period, the applicant for the revocation of the patent fails to give such security for the costs or expenses of the proceedings as the Registrar may specify, in which case, the application for revocation shall be treated as having been abandoned.

(4) An application for the revocation of a patent on the ground mentioned in subsection (1) (b) —

(a) may only be made by a person found by the court in an action for a declaration or found by the court or the Registrar on a reference under section 43, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and

(b) may not be made if that action was commenced or that reference was made after the end of the period of two years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him or her that he or she was not entitled to the patent.

(5) An order under this section may be —

(a) an order for the unconditional revocation of the patent; or

(b) where one of the grounds mentioned in subsection (1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 79 to the satisfaction of the Registrar.

(6) A decision of the Registrar or on appeal from the Registrar shall not stop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1), whether or not any of the issues involved were decided in the decision.

(7) An order under this section revoking a patent shall have effect from the date of the grant of the patent.

(8) Where an applicant for the revocation of a patent discontinues or withdraws his or her application, he or she shall pay such costs or expenses of the proceedings as the Registrar may determine.

(9) An application for an order to revoke a patent shall be —

- (a) made in the prescribed form and filed at the Registry in the prescribed manner; and
- (b) accompanied by the prescribed fee.

(10) Section 89 shall not apply in relation to the decision of the Registrar to cause a patent to be re-examined under this section.

#### **Registrar's power to revoke patents**

**77.** If it appears to the Registrar that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 10(3), the Registrar may on his or her own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observation and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 80.

#### **Proceedings in which validity of patent may be put in issue**

**78.—** (1) Subject to this section, the validity of a patent may be put in issue —

- (a) by way of defence, proceedings for infringement of the patent under section 63 or proceedings under section 72 for infringement or rights conferred by the publication of an application;
- (b) in proceedings under section 73;
- (c) in proceedings in which a declaration in relation to the patent is sought under section 74;
- (d) in proceedings before the Registrar under section 76 for the revocation of the patent; or

(e) in proceedings under section 57 or 60.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted, whether under this Act or otherwise, seeking only a declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue, whether in proceedings for revocation under section 76 or otherwise, are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground mentioned in section 76 (1) (b) unless —

- (a) it has been determined in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue that the patent should have been granted to him or her and not some other person; and
- (b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced before the end of the period of two years beginning with the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him or her that he or she was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence or counterclaim, the court or the Registrar shall, if it or he or she thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4) (a).

(6) In subsection (4), “entitlement proceedings”, in relation to a patent, means a reference under section 43 (1) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted.

(7) Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1), no proceedings may be instituted without the leave of the court before the Registrar with respect to that patent under section 63(3), 72, 74 or 76.

(8) For the purposes of this Act the validity of a patent is not put in issue merely because the Registrar is considering its validity in order to decide whether to revoke it under section 77.

## PART XV

### AMENDMENT OF PATENTS AND APPLICATIONS

#### **Amendment of patent in infringement or revocation proceedings**

**79.**— (1) In any proceedings before the court or the Registrar in which the validity of a patent is put in issue, the court or, as the case may be, the Registrar may, subject to section 80, allow the proprietor of the patent in such manner, and subject to such terms as to the publication and advertisement of the proposed amendment and as to costs, expenses or otherwise, as the court or Registrar thinks fit.

(2) A person may give notice to the court or the Registrar of his or her opposition to an amendment proposed by the proprietor of the patent under this section, and if he or she does so the court or the Registrar shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Where an application for an order under this section is made to the court, the applicant shall notify the Registrar, who shall be entitled to appear and be heard and shall appear if so directed by the court.

#### **Amendments of applications and patents not to include added matter**

**80.**— (1) An application for a patent which —

- (a) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and
- (b) discloses additional matter, that is matter extending beyond that disclosed in the earlier application made under this Act;

may be filed under section 16 (3), or 43 (4) or as mentioned in section 22 (6), but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.

(2) An amendment of an application for a patent shall not be allowed under section 27 if it results in the application disclosing any matter extending beyond that disclosed in the application as filed.

(3) An amendment of the specification of a patent shall not be allowed under section 34 (1), 77 or 79 if it —

- (a) results in the specification disclosing any additional matter; or
- (b) extends the protection conferred by the patent.

## PART XVI

### INTERNATIONAL APPLICATIONS FOR PATENTS

#### **Effect of filing international application for patent**

**81.** — (1) An application for a patent (Saint Lucia) for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to sections 82 and 83, be treated for the purposes of this Act as an application for a patent under this Act.

(2) If an application, or the designation of Saint Lucia in it, is withdrawn, except as mentioned in subsection (3), deemed to be withdrawn under the Patent Co-operation Treaty, it shall be treated as withdrawn under this Act.

(3) An application shall not be as withdrawn under this Act if it or the designation of Saint Lucia in it, is deemed to be withdrawn under the Patent Co-operation Treaty —

- (a) because of an error or omission in an institution having function under the Treaty; or
- (b) because, owing to circumstances outside the applicant's control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty; or
- (c) in such other circumstances as may be prescribed.

(4) If an international application for a patent which designates Saint Lucia is refused a filing date under the Patent Co-operation Treaty and the Registrar determines that the refusal was caused by an error or omission in an institution having functions under that Treaty, the Registrar may direct that the application shall be treated as an application under this Act, having such date of filing as he or she may direct.

(5) The Registry shall act as a receiving Office under Article 2 of the Patent Co-operation Treaty in respect of International applications filed by citizens of Saint Lucia or persons resident in Saint Lucia.

(6) The prescribed transmittal fee, in addition to the fees prescribed by the Patent Co-operation Treaty, shall be paid to the Registry by any person filing an international application under that Treaty.

**International and national phases of application**

**82.**— (1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Act apply to an international application for a patent (Saint Lucia) during the international phase of the application.

(2) The international phase of the application means the period from the filing of the application in accordance with the Patent Co-operation Treaty until the national phase of the application begins.

(3) The national phase of the application begins —

- (a) when the prescribed period expires, provided any necessary translation of the application into English has been filed with the Registrar and the prescribed fee has been paid by the applicant; or
- (b) on the applicant expressly requesting the Registrar to proceed earlier with the national phase of the application, paying the prescribed fee and filing with the Registrar —
  - (i) a copy of the application, if none has been sent to the Registry in accordance with the Patent Co-operation Treaty; and
  - (ii) any necessary translation of the application into English.

(4) For the purposes of subsection (3), “a copy of the application” includes a copy published in accordance with the Patent Co-operation Treaty in a language other than that in which it was originally filed.

(5) If the prescribed period expires without the conditions mentioned in subsection(3) (a) being satisfied, the application shall be taken to be withdrawn.

(6) Where during the international phase the application is amended in accordance with the Patent Co-operation Treaty, the amendment shall be treated as made under this Act if —

- (a) when the prescribed period expires, any necessary translation of the amendment into English has been filed with the Registrar; or
- (b) where the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, there is then filed with the Registrar —
  - (i) a copy of the amendment, if none has been sent to the Registry in accordance with the Treaty; and
  - (ii) any necessary translation of the amendment into English;

otherwise the amendment shall be disregarded.

**Adaptation of provisions in relation to international applications**

**83.**— (1) Where an international application for a patent (Saint Lucia) is accorded a filing date under the Patent Co-operation Treaty —

- (a) that date or, if the application is re-dated under the Treaty to a later date, that later date shall be treated as the date of filing the application under this Act;
- (b) any declaration of priority made under the Treaty shall be treated as made under section 13(2), and where in accordance with the Treaty any extra days are allowed, the period of twelve months specified in 13(2) shall be treated as altered accordingly; and
- (c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 20(2).

(2) If the application, not having been published under this Act, is published in accordance with the Patent Co-operation Treaty, it shall be treated, for purposes other than those mentioned in subsection (3), as published under section 23 when the conditions mentioned in section 82 (3) (a) are complied with.

(3) For the purposes of section 57 and section 72 the application, not having been published under this Act, shall be treated as published under section 23 —

- (a) if it is published in accordance with the Patent Co-operation Treaty in English, on its being so published; and
- (b) if it is published in accordance with the Patent Co-operation Treaty in a language other than English —
  - (i) on the publication of the translation of the application in accordance with section 82 (7); or
  - (ii) on the service by the applicant of a translation into English of the specification of the application on the Government department concerned or, as the case may be, on the person committing the infringing act.

(4) The reference in subsection (3) (b) (ii) to the service of a translation to a Government department or other person is to its being sent by post or delivered to that department or person.

(5) During the international phase of the application, section 16 does not apply but after the end of the international phase that section shall apply.

#### **Evidence of Patent Co-operation Treaty and its instruments**

**84.** — (1) Judicial notice shall be taken of the Patent Co-operation Treaty and any *Gazette*, bulletin or journal published under the Treaty, and any such document shall be admissible as evidence of any instrument or other act thereby communicated of any institution having functions under the Treaty.

(2) Evidence of any instrument issued under the Patent Co-operation Treaty by any institution or of any document in the custody of any institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry or extract from such a document, may be given in any legal proceedings by production of a copy certified as a true copy by an official of that institution, and any document purporting to be such a copy shall receive in evidence without proof of the official position or handwriting of the person signing the certificate.

(3) Evidence of any instrument mentioned in subsection (2) may also be given in any legal proceedings —

- (a) by production of a copy purporting to be printed by the Government Printers;

- (b) where the instrument is in the custody of a Government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so;

and any document purporting to be such a copy as is mentioned in paragraph (b) of an instrument in the custody of a Government department shall be received in evidence without proof of the official position or of the handwriting of the person signing the certificate, or of his or her authority to do so, or of the document being in the custody of the department.

(4) In this section, “legal proceedings” includes proceedings before the Registrar.

#### **Convention countries**

**85.**— (1) The Minister may, with a view to the fulfilment of any treaty, convention, arrangement or engagement, by Order published in the *Gazette* declare that any country specified in the Order is a convention country for purposes of section 13.

(2) For the purposes of this section, every colony, protectorate and territory subject to the authority or under the suzerainty of another country, and every territory administered by another country under the trusteeship system of the United Nations shall be taken to be a country in the case of which a declaration may be made under this section.

## PART XVII

### LEGAL PROCEEDINGS

#### **Proceedings before Court or Registrar**

**86.**— (1) Any proceedings before the Court relating to patents and other matters under this Act shall be dealt with by a judge sitting alone or, if the judge thinks fit, with one or more scientific advisers selected from the panel appointed under subsection (2).

(2) The Regulations may make provision for the appointment of a panel of scientific advisers to assist the Court and the Registrar in proceedings under this Act, for regulating the functions of such advisers and for remunerating such advisers.

**Appeals from Registrar**

**87.** — (1) An appeal shall lie to the Court from any decision of the Registrar under this Act except any of the following decisions —

- (a) a decision falling within section 21(7);
- (b) a decision under 23(2) to omit any matter from a specification;
- (c) a decision to give direction under section 29 (1) or (2);
- (d) a decision under the Regulations which is excepted by the Regulations from the right of appeal conferred by this section.

(2) An appeal shall not lie to the Court of Appeal from a decision of the Court on appeal from the decision of the Registrar under this Act—

- (a) except where the decision of the Registrar was given under section 16, 34, 43, 63, 76, 77 or 79; or
- (b) except where the ground of appeal is that the decision of the Court is wrong in law;

but an appeal shall only lie to the Court of Appeal under this section if leave to appeal is given by the Court or Court of Appeal.

**General powers of Court**

**88.**— (1) The Court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

(2) In all proceedings before the Court under this Act, the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

**Exercise of Registrar's discretionary powers**

**89.** Without prejudice to any rule of law, the Registrar shall give any party to a proceeding before him or her an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Act.

**Right of audience in patent proceedings**

**90.** Any party to any proceedings before the Registrar under this Act or any treaty to which Saint Lucia is a party may appear before the Registrar in person or be represented by any attorney-at-law.

**Extension of privilege for communications with attorney-at-law**

**91.**— (1) The rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an attorney-at-law or a person acting on his or her behalf, or in relation to information obtained or supplied for submission to an attorney-at-law or a person acting on his or her behalf, for the purpose of any pending or contemplated proceedings before a court in Saint Lucia extends to communications so made for the purpose of any pending or contemplated proceedings before the Registrar under this Act.

(2) In this section, “legal proceedings” includes proceedings before the Registrar, and references to “legal proceedings” and “pending or contemplated proceedings” include references to applications for a patent and to international applications for a patent.

**Costs and expenses in proceedings before the Registrar**

**92.** The Registrar may, in proceedings before him or her under this Act, by order award to any party such costs as he or she may consider reasonable and direct how and by what parties they are to be paid.

**Security for Cost**

**93.** If any person by whom —

- (a) a reference is made to the Registrar under section 16 or 43;
- (b) an application is made to the Registrar for the revocation of a patent; or
- (c) notice of opposition is given to the Registrar under section 34(4), 36(2), 50(6), 55(1) or 101(2);

neither resides nor carries on business in Saint Lucia, the Registrar may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.

**Licences granted by order of Registrar**

**94.** Any order of the Registrar for the grant of a licence under this Act shall, without any prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order.

**PART XVIII****OFFENCES****Falsification of register, etc.**

**95.** If a person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced tendered in evidence any such writing, knowing the or writing to be false, that person commits an offence and is liable on conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding one year or to both.

**Unauthorised claim of patent rights**

**96.** — (1) A person shall not falsely represent that anything disposed of by him or her for value is a patent product.

(2) Subject to this section, a person who contravenes subsection (1), commits an offence and is liable on conviction to a fine not exceeding ten thousand dollars or to imprisonment for a term not exceeding three years or to both.

(3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word “patent” or “patented” or anything implying or expressing that the article is a patented product, shall be taken to represent that the article is a patented product.

(4) Subsection (1) shall not apply where the representation is in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made or does not continue to be made.

(5) In proceedings for an offence under this section, it shall be a defence for the accused to prove that he or she used due diligence to prevent the commission of the offence.

**Unauthorised claim that patent has been applied for**

**97.**— (1) If a person represents that a patent has been applied for in respect of any article disposed of for value by him or her and —

- (a) no such application has been made; or
- (b) any such application has been refused, withdrawn or treated as having been abandoned;

then subject to this section, he or she commits an offence and is liable on conviction to a fine not exceeding ten thousand dollars or to imprisonment for a term not exceeding three years or to both.

(2) Subsection (1) (b) shall not apply where the representation is made or continues to be made before the expiry of a period which commences with the refusal, withdrawal or abandonment and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made or does not continue to be made.

(3) For the purpose of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words “patent applied for” or “patent pending”, or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of it.

(4) In any proceedings for an offence under this section, it shall be a defence for the accused to prove that he or she used due diligence to prevent the commission of the offence.

**Misuse of title “Registry of Companies and Intellectual Property”**

**98.** If any person uses on his or her place of business, or on any document issued by him or her, or otherwise, the words, “Registry of Companies and Intellectual Property” or any other words suggesting that his or her place of business is, or is officially connected with, the Registry of Companies and Intellectual Property, he or she commits an offence and is liable on conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding one year or to both.

**Offences by corporations and partnerships**

**99.**— (1) Where an offence under this Act which has been committed by a body corporate is provided to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or any similar officer of the body corporate, or any person who was purporting to act in any such capacity, he or she, as well as the body corporate, commits that offence and is liable to be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his or her functions of management as if he or she is a director of the body corporate.

(3) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought in the name of the partnership and not in that of the partners, but without prejudice to any liability of the partners under subsection (5).

(4) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(5) Where a partnership commits an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, also commits an offence and is liable to be proceeded against and punished accordingly.

**PART XIX****MISCELLANEOUS AND GENERAL****Immunity of Government, persons employed in Registry and examiners**

**100.** The Government, any officer of the Registry and examiner shall not —

- (a) be taken to warrant the validity of any patent granted under this Act or any treaty to which Saint Lucia is a party;
- (b) incur some liability by reason of or in connection with any examination or investigation required or authorised by this Act or any such treaty or any report or other proceedings consequent on any such examination or investigation.

**Correction of errors in patents and applications**

**101.** — (1) The Registrar may, subject to any provision of the Regulations, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

(2) Where the Registrar is requested to correct an error or mistake pursuant to subsection(1), any person may in accordance with the Regulations give the Registrar opposition to the request and the Registrar shall determine the matter.

**Information about patent applications and patents and inspection of documents**

**102.**— (1) After publication of an application for a patent in accordance with section 23, the Registrar shall, on request being made to him in the prescribed manner and payment of the prescribed fee, if any, give the person making the request such information, and permit him or her to inspect such documents, relating to the application or to any patent granted pursuant to the application as may be specified in the request, subject, however to any prescribed restrictions.

(2) Subject to this section, until an application for a patent is published, documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent —

- (a) the Registrar from publishing or communicating to others any bibliographic information about an unpublished application for a patent; or
- (b) the Minister from inspecting or authorising the inspection of an application for a patent or any connected document under section 29(5).

(4) Where a person is notified that an application for a patent has been made, but not published in accordance with section 23, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his or her doing an act specified in the notification after the application is so published, that person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

(5) Where an application for a patent is filed, but not published, and a new application is filed in respect of any part of the subject-matter of the earlier application, either in accordance with the Regulations or pursuant to an order under section 16, and is published, any person may make a request under subsection (1) relating to the earlier application and on payment of the prescribed fee the Registrar shall give him or her such information and permit him or her to inspect such documents as could have been given or inspected if the earlier application had been published.

(6) The publication of a whole or part of a specification of a patent or an application for a patent shall not constitute an infringement of any copyright subsisting under the Copyright Act 1995, No. 10 in any literary or artistic work.

#### **Service by post**

**103.** Any notice required or authorised to be given by this Act, and any application or other document so authorised or required to be given, made or filed, may be given, made or filed, by post.

#### **Extension of time**

**104.**— (1) The Minister may prescribe an extension of time for any period of time specified for the doing of an act in relation to an application for a patent or in proceedings under this Act, not being proceedings in court.

(2) The Regulations may contain any provision that the Minister thinks fit regulating the circumstances in which such an extension may be granted and may also provide for the protection and compensation of persons affected by the grant of an extension of time and may authorise the Registrar to grant an extension of time notwithstanding that the period has already expired.

#### **Work done after hours of business**

**105.** Any business done under this Act on any day after the hours of business of the Registry specified in the Companies and Intellectual Property (Registry) Act 2000, No. 12 in relation to the business of that class, or on a day which is an excluded day in relation to business of that class, shall be taken to have been done on the next following day not being an excluded day, and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

**Government's right to sell forfeited articles**

**106.** Nothing in this Part shall affect the right of the Government or any person deriving title, directly or indirectly, from the Government to dispose of or use articles forfeited under the laws relating to customs or excise.

**Extent of invention**

**107.**— (1) For the purposes of this Act, an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by the patent or application for a patent shall be determined accordingly.

(2) It is hereby declared for the avoidance of doubt that where more than one invention is specified in any such claim, each invention may have a different priority date under section 13.

**Availability of samples of micro-organisms**

**108.**— (1) The Minister may prescribe the circumstances in which the specification of an application for a patent, or of a patent, for an invention which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) The Regulations may in particular require the applicant or patentee —

- (a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism; and
- (b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The Regulations may provide that, in such cases as may be prescribed, samples need only be made available to such persons or description of persons as may be prescribed, and the Regulations may identify a description of persons by reference to whether the Registrar has given his certificate as to any matter.

(4) An application of a revocation of a patent under section 76 (1) (c) may be made if any of the requirements of the Regulations ceases to be complied with.

### **Regulations**

**109.**— (1) The Minister may make such Regulations as he or she thinks expedient for regulating the business of the Registry in relation to patents and applications for patents, including international applications for patents, and for regulating all matters placed by this Act under the direction or control of the Registrar.

(2) Without prejudice to the generality of subsection(1), the Regulations may make provision —

- (a) prescribing the form and content of applications for patents and other documents which may be filed at the Registry and requiring copies to be furnished of any such documents;
- (b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or the Registry and authorising the rectification of irregularities of the procedure;
- (c) requiring fees to be paid in connection with the provision of any service by the Registry and providing for the remission of fees in the prescribed circumstances;
- (d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;
- (e) requiring the Registrar to publish any proposed amendments of patents and any other prescribed matters including any prescribed steps in any such proceedings;
- (f) providing for the appointment of scientific advisers to assist the court and the Registrar in any proceeding before it or him and for the remuneration of such advisers;
- (g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Act or the Regulations;
- (h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;
- (i) providing for the publication and sale of documents in the Registry and information about such documents;

- (j) prescribing, in relation to international applications, matters necessary or convenient to be prescribed for carrying out or giving effect to the Patent Co-operation Treaty;
- (k) excluding or varying the operation of the provisions of this Act in relation to international applications and applications for patents made under section 110;
- (l) requiring and regulating the translation of documents in connection with any application for a patent and the filing and authentication of any such translation; and
- (m) prescribing the scale of costs for proceedings before the Registrar.

(3) The Regulations may make different provisions for different cases.

(4) The Regulations may require or authorise the Registrar to make arrangements for the publication of reports of cases relating to patents decided by him or by any court or body whether in Saint Lucia or elsewhere.

#### **Transitional**

**110.**— (1) A patent that immediately before the date of commencement of this Act was registered or granted under the repealed enactment is deemed to be granted under this Act.

(2) An existing patent expires on the day on which it would have expired under the repealed enactment if the repealed enactment had not been repealed.

(3) Sections 32 and 35 apply in relation to the renewal of the registration of an existing patent.

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

(5) Notwithstanding any rule of law to the contrary any international application under the Patent Co-operation Treaty designating Saint Lucia and filed in Saint Lucia prior to the date of commencement of this Act, fulfilling the requirements under the said

Treaty and being accorded an international filing date shall be treated as a patent application under this Act as of the international filing date, which date shall be considered to be the actual filing date in Saint Lucia.

(6) Notwithstanding any rule of law to the contrary any international application referred to in subsection (5) shall be deemed to have been lawfully and validly filed and no legal proceedings or other action whether pending or not shall be entertained in respect of the validity of the filing of such application for the reason that any such application has been filed before the commencement date of 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.*