

SAINT VINCENT AND THE GRENADINES
TRADE MARKS ACT, 2003

[Act No. 46 of 2003 as amended by Act. No. 50 of 2004 - Unofficial Consolidation]

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SAINT VINCENT AND THE GRENADINES

ACT NO. 46 OF 2003

I ASSENT

[L.S.]

DR.FREDERICK BALLENTYNE
Governor-General
30th December, 2003

AN ACT to repeal and replace the Registration of United Kingdom Trade Marks Act (Cap. 113) and the Merchandise Marks Act (Cap. 106) and to provide for the promotion and protection of Trade Marks and for related matters.

[30th December, 2003]

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

Short title and commencement 1. This Act may be cited as the Trade Marks Act, 2003 and shall come into force on a day to be appointed by the Governor-General by order published in the *Gazette*, and different days may be appointed for different provisions and different purposes.

PART I

PRELIMINARY

Interpretation 2. (1) In this Act

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

“approved form” means a form approved by the Registrar of the Commerce and Intellectual Property;

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

“attorney at law” means a person duly admitted and entitled to practise law in Saint Vincent and the Grenadines;

“authorised user of trade mark” means a person who uses the trade mark under the control of the owner of the trade mark;

“authorised use of a trade mark” means the use of the trade mark to the extent only that the user uses the trade mark under the control of the owner of the trade mark ;

“Comptroller” means the Comptroller of Customs appointed under the Customs (Control and Management) Act 1999;

“Convention Country” means a country which is a party to the Paris Convention for the Protection of Industrial Property 1883;

“Court” means High Court;

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

“date of registration” in relation to the registration of a trade mark in respect of particular goods or services, means the day from which the registration of the trade marks in respect of those goods and services is to have had taken effect under section 52;

“designated owner” in relation to goods imported into Saint Vincent and the Grenadines means the person identified as the owner of the goods in the entry made pursuant to the Customs (Control and Management) Act 1999;

“existing registered trade mark” means a mark that was registered under Registration of United Kingdom Trade Marks Act Cap. 113 and whose registration is due to expire after the coming into force of this Act;

“file” means to lodge with the Commerce and Intellectual Property Office;

“filing date” means

(a) in relation to an application for the registration of a trade mark other than a divisional application, the day on which the application is filed;

(b) in relation to a divisional application for the registration of a trade mark the day on which the initial application within the meaning of section 27 was filed;

“geographical indication” in relation to goods originating in a particular country or in a region or locality of that country, means a sign recognised in that country as a sign indicating that the goods

indicating that the goods

(a) originated in that country, region or locality; and

(b) have a quality, reputation or other characteristic attributable to their geographical origin;

“goods of a person” means goods dealt with or provided by the person in the course of trade;

“label” includes a band or ticket;

“limitations” means limitations of the exclusive right to use a trade mark given by the registration of the trade mark including limitations of that right as to

(a) mode of use; or

(b) extent of use in Saint Vincent and the Grenadines;

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

“Minister” means the Minister with responsibility for Intellectual Property;

“notified trade mark” means a trade mark in respect of a notice under section 1 is in force;

“objector” in relation to seized goods, means any person who has given a notice under section 33 that is in force;

“official journal” means a publication issued by or at the direction of the Commerce and Intellectual property Office containing the matters that are required by this Act to be advertised and included advertisement in the Gazette;

“old register” means the Register of Trade Marks kept under the Registration of United Kingdom Trade Marks Act;

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

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

(b) where section 33 (5) applies, a person in whose name the notice of opposition is taken to have been filed;

“originate” in relation to wine, has the meaning given by section 2 (7) (1) (c) (ii);

“pending” in relation to an application for the registration of a trade mark, under this Act has the meaning given by section 2 (4);

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

- (a) if the trade mark was assigned or transmitted to one or more than one person before it was assigned or transmitted to the first-mentioned person, that other person or any one of those other persons; or
- (b) if paragraph (a) does not apply, the person who assigned the trade mark, or from whom the trade mark was transmitted, to the first-mentioned person;

“priority date” has the meaning given by section 2 (6);

“Register” means the Register of Trade Marks kept under section 170;

“registered owner” in relation to a registered trade mark, means the person in whose name the trade mark is registered;

“registered trade mark” means a trade mark whose particulars are entered in the Register under this Act;

No. 43 of 2003

“Registrar” means the Registrar of Commerce and Intellectual Property designated under the Commerce and Intellectual Property Office Act;

“registration number” in relation to a registered trade mark, means the number given to it under section 49 (2);

“seized goods” means goods seized under section 112;

“services of a person” means services dealt with or provided in the course of trade by the person;

“sign” includes a letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour or sound and any combination thereof;

“State” means the state of Saint Vincent and the Grenadines;

“trade mark” means a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person;

“transmission” means

- (a) transmission by operation of law; or
- (b) devolution on the personal representative of a deceased person; or

(c) any other kind of transfer except assignment;

“use of trade mark in relation to goods” means use of the trade mark upon, or in physical or other relation to, the goods, including secondhand goods;

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

(2) For the purposes of this Act

(a) a trade mark is taken to be applied to any goods, material or thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing; and

(b) a trade mark is taken to be applied in relation to goods or services if it is

(i) applied to any covering, document, label, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade; or

(ii) used in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services; and

(c) a trade mark is taken also to be applied in relation to goods or services if it is used

(i) in an advertisement including an advertisement by electronic means;

(ii) in an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document;

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

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

(4) (1) An application for the registration of a trade mark under this act is pending from the time it is filed until

(a) it lapses, is withdrawn or is rejected;

(b) if the Registrar refuses under section 36 to register the trade mark and there is no appeal against the decision, the end of the period allowed for the appeal; or

- (c) the Registrar refuses to register the trade mark; and
 - (i) there is an appeal against the decision; and
 - (ii) the decision is confirmed on appeal;
 the day on which the decision is confirmed on appeal;
 or
- (d) the trade mark is registered.

(2) An application for the registration of a trade mark under the Registration of United Kingdom Trade Marks Act Cap. 113 is pending if immediately before the commencement date of this Act the application had not been withdrawn;

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

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

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

(7) (1) For the purposes of this Act

- (a) goods are similar to other goods if
 - (i) they are the same as the other goods; or
 - (ii) they are of the same description as that of the other goods;
- (b) services are similar to other services
 - (i) if they are the same as the other services; or
 - (ii) if they are of the same description as that of the other services; and
- (c) a wine is taken to have originated
 - (i) in a foreign country or in the state only if the wine is made within the territory of that country or the state, as the case may be; and
 - (ii) a wine is taken to have originated in a particular

region or locality of a foreign country or of the state only if the wine is made from grapes grown in that region or locality.

Authorised use
of a trade mark

3. (1) If the owner of a trade mark exercises quality control over goods or services

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

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

the other person is taken, for the purposes of subsection (1), to use the trade mark in relation to the goods or services under the control of the owner.

(2) If

(a) a person deals with or provides, in the course of trade, goods or services in relation to which a trade mark is used; and

(b) the owner of the trade mark exercises financial control over the other person's relevant trading activities;

the other person is taken, for the purposes of section 4 (3), to use the trade mark in relation to the goods or services under the control of the owner.

(3) Subsections (1) and (2) do not limit the meaning of the expression "under the control of" under section 4 (3) and in the definition of "authorised use of a trade mark" under section 2.

Use of trade
mark

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

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

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

PART 2

TRADE MARKS AND TRADE MARK RIGHTS

Categories of
trade marks
which may be

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

registered

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

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

Rights accrued
by registered
trade mark

6. (1) If a trade mark is registered, the registered owner of the trade mark shall have, subject to this Part, the exclusive rights

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

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

(3) If the trade mark is registered subject to conditions or limitations, the rights of the registered owner shall be restricted by those conditions or limitations.

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

Nature of
registered trade
mark as
property

7. A registered trade mark shall be deemed to be the personal property of the owner of the trade mark and any rights in respect of it shall be enforceable in the same way as rights in respect of any other personal property.

Power of
registered
owner deal with
trade mark

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

(2) Subsection (1) applies only to a person who deals with the registered owner as a purchaser in good faith for value, and without notice of any fraud on the part of the owner.

Limitation of
rights for
similar trade
marks registered
by different

9. If the trade marks that are substantially identical or deceptively similar have been registered by more than one person whether in respect of the same or different goods or services, the registered owner of any one of those trade marks shall not have the right to prevent the registered owner of any other of those trade marks from using that trade mark

persons except to the extent that the first-mentioned owner is authorised to do so under the registration of his trade mark.

Trade mark as a sign describing article 10. (1) This section shall apply if a registered trade mark consists of, or contains, a sign that, after the date of registration of the trade mark, becomes generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service.

(2) If the trade mark consists of the sign, the registered owner

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

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

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

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

(3) If the trade mark contains the sign, the registered owner

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

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

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

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

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

Trade mark relating to article formerly manufactured under patent 11. (1) This section shall apply if

(a) a registered trade mark consists of, or contains, a sign that describes or is the name of

(i) an article or substance that was formerly exploited under a patent; or

(ii) a service that was formerly provided as a patented process; and

(b) it has been at least two years since the patent has expired or ceased; and

(c) the sign is the only commonly known way to describe or identify the article, substance or service.

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

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

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

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

(b) shall be deemed to have ceased to have those exclusive rights from the end of the period of two years after the patent has expired or ceased.

Powers of
authorized user
of registered
trade mark

12. (1) Subject to any agreement made between the registered owner of a registered trade mark and an authorised user of the trade mark, the authorised user may do any of the following:

(a) use the trade mark in relation to the goods or services in respect of which the trade mark is registered, subject to any conditions or limitations made when the trade mark was registered;

(b) subject to subsection (2), bring an action for infringement of the trade mark at any time, within the prescribed period if the registered owner refuses or rejects to do so within the prescribed period;

(c) cause to be displayed on goods in respect of which the trade mark is registered, or on their package, or on the container in which they are offered to the public, a notice prohibiting any act that is under section 101 a prohibited act in relation to the goods;

(d) either

(i) give to the Comptroller a notice under section 101 objecting to the importation of goods that infringe the trade mark; or

(ii) revoke the notice given under sub-section (1);

(e) give permission to any person:

(i) to alter or deface; or

(ii) to make any addition to; or

(iii) to remove, erase or obliterate, wholly or partly;

a registered trade mark that is applied to any goods, or in relation to any goods or services, in respect of which the trade mark is registered;

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

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

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

PART 3

APPLICATION FOR REGISTRATION

13. (1) A person may apply to the Registrar for the registration of a trade mark in respect of goods or services if:

- (a) the person claims to be the owner of the trade mark; and
- (b) either
 - (i) is using or intends to use the trade mark in relation to the goods or services;
 - (ii) has authorised or intends to authorise another person to use the trade mark in relation to the goods or services; or
 - (iii) intends to assign the trade mark to a body corporate that is about to be constituted so that the trade mark could be used by the body corporate in relation to goods or services.

(2) The application shall:

- (a) be in accordance with the regulations; and
- (b) be filed, together with any prescribed document, in accordance with the regulations.

(3) Without limiting the particulars that may be included in an application, the application shall:

- (a) include six representations of the trade mark; and
- (b) specify, in accordance with the regulations, the goods or

Making of
application

services in respect of which it is sought to register the trade mark.

(4) An application other than an application under section 32 for the registration of two or more trade marks as a series, may be made in respect of goods and services of one or more of the classes prescribed in the Regulations.

Application by
joint owners

14. If the relationship between two or more persons interested in a trade mark is such that none of them is entitled to use the trade mark except

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

they may together apply for its registration under section 13 (1).

Claim for right
priority

15. (1) If:

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

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

(2) Pursuant to subsection (1) the priority claimed shall be for the registration of the trade mark in respect of goods or services

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

Duties of the Registrar with respect to application of Trade Marks

16. (1) The Registrar shall,

- (a) publish a notice, in the prescribed form, of an application to register a trade mark;
- (b) in accordance with the Regulations, examine and report on;
 - (i) whether the application has been made in accordance with this Act;
 - (ii) whether there are grounds under sections 21 to 26 of this Part for rejecting the application.

(2) If a question arises as to the class in which goods or services are comprised:

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

(3) The Registrar shall, after the examination made pursuant to subsection (1), accept the application made pursuant to section 13 unless he is satisfied that:

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

(4) The Registrar shall not reject an application made pursuant to section 13 without giving the applicant an opportunity of being heard.

(5) The Registrar shall;

- (a) notify the applicant in writing of his decision under subsection (3);
- (b) publish notice of the decision in the official journal.

Right to appeal

17. An applicant may appeal to the Court against a decision made by the Registrar:

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

Deferment of acceptance

18. The Registrar may defer the acceptance of an application in the circumstances, and for the period, provided for in the Regulations.

Lapsing of application

19. (1) Subject to subsection (2), an application to register a trade mark shall lapse if it is not accepted within the prescribed period or

within that period as extended in accordance with the Regulations.

(2) If, after the prescribed period or the prescribed period as extended has expired, the Registrar extends under section 185 the period within which the application may be accepted, the application

(a) shall be deemed not to have lapsed when the prescribed period expired; and

(b) shall lapse if it is not accepted within the extended period.

Revocation of acceptance

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

(a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or

(b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;

the Registrar may revoke the acceptance of the application.

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

(a) the application shall be deemed to have never been accepted; and

(b) the Registrar shall examine, and report on the application as necessary under section 16; and

(c) section 16 shall again apply in relation to the application.

Grounds for rejection application

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

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

(a) a sign that is prescribed for the purpose of this subsection; or

(b) a sign so nearly resembling:

(i) a sign referred to in paragraph (a); or

(ii) a sign referred to in subsection (1);

as to be likely to be taken for it.

Trade mark that cannot be represented graphically

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

Trade mark not
distinguishing
applicants
goods or
services

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

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

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

(4) Pursuant to subsection (3), if the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone that the trade mark is capable of distinguishing the designated goods or services, the following shall apply:

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

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

- (b) if the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services the trade mark shall be deemed to be capable of distinguishing the applicant's goods or services from the goods or services of any other person; and
- (c) if the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services, the trade mark shall not be deemed to be capable of distinguishing the applicant's goods or services from the goods or services of any other person.

(5) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services of the applicant

adapted to distinguish the designated goods or services of the applicant from the goods or services of any person, the following provisions shall apply:

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

Trade mark
scandalous or
its use contrary
to law

24. An application for the registration of a trade mark shall be rejected if:

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

Trade mark
likely to deceive
or cause
confusion

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

Identical trade
marks

26. (1) Subject to subsections (3) and (5), an application for the registration of a trade mark in respect of goods shall be rejected if

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

(2) Subject to subsections (3) and (5), an application for the registration of a trade mark in respect of services shall be rejected if:

- (a) it is substantially identical with, or deceptively similar to:
 - (i) a trade mark registered by another person in respect of similar services or closely related goods; or
 - (ii) a trade mark whose registration in respect of similar services or closely related goods is being sought by another person; and
 - (b) the priority date for the registration of the applicant's trade mark in respect of the applicant's services is not earlier than the priority date for the registration of the other trade mark in respect of the similar services or closely related goods.
- (3) If the Registrar in either case is satisfied
- (a) that there has been honest concurrent use of the two trade marks; and
 - (b) that, because of other circumstances, it is proper to do so;
- the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose.
- (4) Pursuant to subsection 3, if the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.
- (5) If the Registrar in either case is satisfied that the applicant, or the applicant and his predecessor in title, have continuously used the applicant's trade mark for a period
- (a) beginning before the priority date for the registration of the other trade mark in respect of:
 - (i) the similar goods or closely related services; or
 - (ii) the similar services or closely related goods; and
 - (b) ending on the priority date for the registration of the applicant's trade mark;
- the Registrar may not reject the application because of the existence of the other trade mark.

PART 4

DIVISIONAL APPLICATIONS

Making a
Divisional
Application

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

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

(2) For the purposes of this Part, the initial application shall be taken to be the application of which particulars have been published by the Registrar under section 16.

(3) For the avoidance of doubt a divisional application is an application made under this Part.

(4) A divisional application for the registration of a trade mark may be made only if the initial application for the registration of the trade mark is pending.

Divisional application for registration of part of trade mark

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

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

(3) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the official journal pursuant to section 16 (5).

Divisional application for registration of trade mark in respect of part of trade mark

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

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

- (a) the goods or services or both specified in the initial application; or

- (b) if the initial application has been amended to exclude some of the goods or services or both specified in that application before its amendment the goods or services or both specified in the initial application as amended.

(3) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the official journal pursuant to section 16.

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

30. (1) This section shall

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

(2) If the initial application is amended:

- (a) before a decision is made about it under section 16; or
- (b) if the initial application is accepted before its acceptance is advertised in the official journal, pursuant to section 16

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

(3) If the initial application has been accepted, the divisional application may not be made after the acceptance is advertised in the official journal, pursuant to section 16.

(4) If the initial application whether it has already been amended or not is amended after its acceptance has been advertised in the official journal, the applicant may, within the prescribed period, make a divisional application for the registration of the trade mark in respect of any or all of the goods or services or both that have been excluded from the application whose acceptance was advertised in the official journal, pursuant to section 16.

Filing date

31. A divisional application shall be taken to have been filed on the day on which the initial application concerned was filed.

PART 5
APPLICATION FOR REGISTRATION OF SERIES OF TRADE MARKS

Application for registration of series of trade marks

32. (1) A person may make a single application under section 13(1) for the registration of two or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters

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

(2) If:

- (a) the application meets all the requirements of this Act; and
- (b) the Registrar is required under section 48 to register the trade marks;

he shall register them as a series in one registration.

PART 6
OPPOSITION TO REGISTRATION

Opposition

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

(2) The notice of opposition shall be in a prescribed form and shall be filed within that period as extended in accordance with the regulations made hereunder.

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

(4) The registration of a trade mark may be opposed only on the grounds specified under Part 7 and no other grounds.

(5) If:

- (a) a person is granted an extension of time in which to file a notice of opposition; and

(b) before the notice of opposition is filed, the right or interest on which the person could have relied to file the notice of opposition become vested in another person; and

(c) the other person notifies the Registrar in writing that the right or interest is vested in him;

then:

(d) the other person is taken to have been granted an extension of time in which to file the notice of opposition; and

(e) that extension ends when the extension stipulated pursuant to paragraph (a) ends.

Circumstances in which opposition may proceed in name of a person other than a person who filed the notice

34. If:

(a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and

(b) the other person:

(i) notifies the Registrar in writing of that right or interest which was vested in him; and

(ii) does not withdraw the opposition;

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

Opposition proceedings

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

(2) Regulations shall prescribe the procedure for hearing opposition proceedings.

Decision of the Registrar

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

(a) to refuse to register the trade mark; or

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

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

Appeal

37. An applicant or opponent may appeal to the Court from a decision of the Registrar under section 36.

PART 7

GROUNDS FOR OPPOSING REGISTRATION

Opposition to registration of trade mark

38. The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Part 3, except the ground that the trade mark cannot be represented graphically.

Application not intending to use trade mark

39. The registration of a trade mark may be opposed on the ground that

- (a) the applicant is not the owner of the trade mark; or
- (b) the applicant does not intend
 - (i) to use, or authorise the use of the trade mark in Saint Vincent and the Grenadines; or
 - (ii) to assign the trade mark to a body corporate for use by the body corporate in Saint Vincent and the Grenadines;

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

Trade mark similar to trade mark that has acquired a reputation in Saint Vincent and the Grenadines

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

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

Trade mark containing or consisting of a false geographical indication

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

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

(2) An opposition on a ground referred to in subsection (1) shall fail if the applicant establishes that

- (a) the relevant goods originated in the country, region or locality identified by the geographical indication;
- (b) the sign has ceased to be used as a geographical indication for the designated goods in the country in which the designated goods originated; or
- (c) the applicant, or a predecessor in title of the applicant, used the sign in good faith in respect of the relevant goods, or applied in good faith for the registration of the trade mark in respect of the relevant goods, before
 - (i) the commencement of this Act;
 - (ii) the day on which the sign was recognized as a geographical indication for the designated goods in their country or origin;
 whichever is the later; or
- (d) if the registration of the trade mark is being sought in respect of wine or spirits the sign is identical with the name that, on the commencement of this Act, was, in the country in which the relevant wine or spirits originated, the customary name of a variety of grapes used in the production of the relevant wine or spirits.

(3) An opposition on a ground referred to in subsection (1) shall also fail if the applicant establishes that:

- (a) although the sign is a geographical indication for the designated goods, it is also a geographical indication for the relevant goods; and
- (b) the applicant has not used, and does not intend to use, the trade mark in relation to the relevant goods in a way that is likely to deceive or confuse members of the public as to the origin of the relevant goods.

(4) For the purpose of this section;

“relevant goods” means the particular goods for which registration is opposed pursuant to subsection (1); and

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

Application
defective

42. The registration of a trade mark may be opposed on any of the following grounds:

- (a) that the application, or a document filed in support of the application, was amended contrary to this Act;

- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

PART 8

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

Amendment of application for registration of trade mark

43. (1) The Registrar may, at the written request of the applicant or his agent, amend an application for the registration of a trade mark in accordance with section 44 or 45.

(2) If:

- (a) an application for the registration of a trade mark may be amended under section 45; and
- (b) the applicant has not asked in writing that the application be amended;

the Registrar may, on his own initiative but in accordance with the regulations, amend the application as necessary to remove any ground on which the application could be rejected so as to ensure that the application is made in accordance with this Act.

Amendment before particulars of application are published

44. If:

- (a) the particulars of the application have not yet been published under section 16 (1); and
- (b) the request for the amendment is made within the prescribed period;

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

Amendment after particulars of application have been published

45. If the particulars of an application have been published under section 16 (1), an amendment may be made:

- (a) to the representation of the trade mark if the amendment does not substantially affect the identity the trade mark as at the time when the particulars of the application were published;
- (b) to correct a mistake of fact or an error in the classification of any goods or services specified in the application;
- (c) to change the type of registration sought in the application;
- (d) to any other particular specified in the application other

than that referred to in part (c) unless the amendment would have the effect of extending the rights that, apart from the amendment, the applicant would have under the registration if it were granted.

Amendment of other documents

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

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

Appeal of decision on amendment

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

PART 9

REGISTRATION OF TRADE MARKS

Duty of Registrar to register

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

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

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

Registration – how effected

49. (1) The trade mark shall be registered

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

(2) The Registrar shall enter in the register the particulars stated in subsection (1) and shall also enter the following

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

entered in the Register.

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

Colours in
registered trade
marks

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

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

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

Notification of
registration

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

(a) advertise the registration in the official journal; and

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

Date and term
of registration

52. (1) The registration of a trade mark in respect of goods or services or both is taken to have had effect from and including the filing date in respect of the application for registration.

(2) Pursuant to subsection (1), if

(a) the application was made in respect of a trade mark whose registration had also been sought in one or more than one Convention country;

(b) the applicant claimed a right of priority under section 15 for the registration of the trade mark in respect of particular goods or services; and

(c) the trade mark is registered under this Act;

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

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

Ceasing of
registration

53. The registration of a trade mark ceases if:

(a) the trade mark is removed from the Register under section

58 or under Part 12; or

(b) the registration of the trade mark is cancelled.

Disclaimers	<p>54. (1) An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the trade mark.</p> <p>(2) A disclaimer under subsection (1) shall affect only the rights given by this Act to the registered owner of the trade mark on registration of the trade mark.</p> <p>(3) The Registrar shall, on registering the trade mark or on receiving notice of the disclaimer whichever is later, enter the particulars of the disclaimer in the Register.</p> <p>(4) A disclaimer properly made shall not be revoked.</p>
Request for renewal of registration	<p>55. (1) Any person may, within the prescribed period before the registration of a trade mark expires, file a request with the Registrar seeking renewal of the registration.</p> <p>(2) The request under subsection (1) shall be filed in the prescribed form.</p>
Notice of renewal due	<p>56. If, within the prescribed period, the Registrar has not received a request for the renewal of the registration of the trade mark, the Registrar shall, in accordance with the regulations, notify the registered owner of the trade mark that the renewal is due.</p>
Renewal before registration expires	<p>57. (1) If a request for the renewal of the registration of a trade mark is made in accordance with section 55, the Registrar shall renew the registration for a period of ten years from the day on which the registration of the trade mark would have expired if it were not renewed.</p> <p>(2) The Registrar shall give notice in the prescribed form, of a renewal to the registered owner of the trade mark in accordance with the regulations.</p>
Failure to renew	<p>58. If the registration of a trade mark is not renewed under section 55, then:</p> <p>(a) subject to sections 59 and 60, the registration shall cease to have effect when it expires; and</p> <p>(b) unless the registration is renewed under section 59, the Registrar <i>shall</i> remove the trade mark from the Register twelve months after the day on which the registration expired.</p>
Renewal within	<p>59. If, within twelve months after the registration of a trade mark has</p>

twelve months after registration expires expired, a person makes a request to the Registrar, in accordance with section 55, to renew the registration of the trade mark, the Registrar shall renew the registration of the trade mark for ten years from the day on which the registration expired.

Status of unrenewed trade mark

60. If:

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

the unrenewed trade mark shall be deemed to be a registered trade mark for the purposes of the application.

PART 10

AMENDMENT AND CANCELLATION OF REGISTRATION – ACTION BY REGISTRAR

Correction of Register

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

Adaptation of classification

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

Amendment of particulars of trade mark entered in Register

63. (1) Subject to Part 14, the Registrar may, at the written request of the registered owner of a registered trade mark:

- (a) amend the representation of the trade mark as entered in the Register if the amendment does not substantially affect the identity of the trade mark as at the time when the particulars of the application for the registration of the trade mark were published under section 16;
- (b) amend any particulars entered in the Register relating to any goods or services in respect of which the trade mark is registered if the amendment does not have the effect of extending the rights that apart from the amendment, the owner has under the registration; or
- (c) amend, or enter in the Register, any other particular in respect of the trade mark if the amendment or entry does not have the effect of extending the rights that apart from

not have the effect of extending the rights that, apart from the amendment of the entry, the owner has under the registration.

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

Cancellation of registration

64. (1) The Registrar shall cancel the registration of a trade mark in accordance with the regulations if the registered owner asks in writing that it be so cancelled.

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

(a) any person recorded under Part 14 as claiming a right in respect of, or an interest in, the trade mark; and

(b) if:

(i) an application has been made to the Registrar for a record of the assignment or transmission of the trade mark to a person to be entered in the Register pursuant to section 89; and

(ii) the assignment or transmission has not yet been recorded,

the person to whom the trade mark has been assigned or transmitted.

PART 11

AMENDMENT AND CANCELLATION OF REGISTRATION - ACTION BY COURT

Amendment to correct error or omission

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

(a) entering in the Register particulars that were wrongly omitted from it; or

(b) correcting any error in an entry in the Register.

Amendment or cancellation on ground of contravention of condition

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

(a) cancelling the registration of a trade mark; or

(b) removing or amending any entry in the Register relating to the trade mark;

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

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

67. (1) If section 10 or 11 applies in relation to a registered trade mark, the court may, on the application of an aggrieved person, but subject to subsection (2) and section 69, order that the Register be rectified by

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

having regard to the effect of section 10 or 11 as the case may be on the right of the registered owner of the trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.

(2) If section 10 or 11 applies in relation to the trade mark because the trade mark contains a sign that

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

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

Amendment or
cancellation:
other specified
grounds

68. (1) Subject to subsection (2) and section 69, the Court may, on the application of an aggrieved person, order that the Register be rectified by

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

(2) An application referred to under subsection (1) may be made only on any of the following grounds;

- (a) any of the grounds on which the registration of the trade mark could have been opposed under Part 7;

- (b) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, or misrepresentation;
- (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which:
 - (i) the application for the registration of the trade mark could have been rejected under section 25 or 26; or
 - (ii) the registration of the trade mark could have been opposed under section 40;
- (d) the application in respect of an entry in the Register has been previously amended as a result of fraud, false suggestion or misrepresentation.

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

69. (1) The Court may not grant an application for rectification made
- (a) under section 67; or
 - (b) on the ground that the trade mark is liable to deceive or confuse; or
 - (c) on the ground referred to in section 68 (2) (c);

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

- (2) In making a decision under subsection (1), the Court
- (a) shall also take into account any matter that is prescribed; and
 - (b) may take into account any other matter that it considers relevant.

Duties and powers of Registrar

70. (1) A person applying to Court under this Part shall give notice of the application to the Registrar.

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

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

Amendment of certificate of registration

71. If the Registrar amends any particular entry *in* the Register in respect of a trade mark, the Registrar may also amend the certificate of registration if he thinks it is appropriate to do so.

PART 12
**REMOVAL OF TRADE MARK FROM REGISTER FOR NON-
 USE**

Application for
removal of trade
mark from
Register

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

(2) An application under subsection (1)

(a) shall be made in a prescribed form; and

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

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

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

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

(i) to use the trade mark in Saint Vincent and the Grenadines;

(ii) to authorise the use of the trade mark in Saint Vincent and the Grenadines;

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

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

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

(i) used the trade mark in Saint Vincent and the Grenadines; or

- (ii) used the trade mark in good faith in Saint Vincent and the Grenadines;

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

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

Time for making application

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

(2) An application on the ground referred to in section 72 (4)(b) not be made before a period of five years has passed from the filing date in respect of the application for the registration of the trade mark.

Referral to court

74. If:

- (a) an application has been made to the Registrar under section 72 (1); and
- (b) the Registrar is of the opinion that the matter should be decided by the Court;

the Registrar may refer the matter to the court and the Court may hear and determine the matter as if an application had been made to it under section 72 (3).

Notification of application

75. (1) If an application has been made to the Registrar under section 72 (1), the Registrar shall give notice of the application in accordance with the Regulations.

(2) If the application is in respect of a trade mark already entered on the Register, the Registrar shall advertise the application in the official journal.

(3) If the application referred to in subsection (1) is in respect of a trade mark whose registration is being sought, the Registrar is to advertise the application in the official journal only if the trade mark is registered.

Notice of opposition

76. (1) Any person may oppose an application under section 72 by filing a notice of opposition with the Registrar or the Court, as the case requires

(2) The notice of opposition

- (a) shall be in a form approved by the Registrar or by the

Court; and

(b) shall be filed in accordance with the regulations or the rules of the Court as the case may be.

Removal of trade mark from the Register if application unopposed

77. (1) If there is no opposition to an application to the Registrar under section 72 (1), the Registrar shall remove the trade mark from the Register in respect of the goods or services or both specified in the application.

(2) If there is no opposition to an application to a court under section 72 (3), the Court shall order the Registrar to remove the trade mark from the Register in respect of the goods or services or both specified in the application.

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

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

78. If

(a) the Registrar has removed a trade mark from the Register under section 77 (1) because no notice of opposition was filed within the period provided under the Regulations; and

(b) the Registrar subsequently extends the period within which the notice may be filed; and

(c) a notice of opposition is filed within the extended period;

the Registrar shall restore the trade mark to the Register and the trade mark shall be deemed not to have been removed from the Register.

Proceedings before Registrar

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

Burden on opponent to establish use of trade mark

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

(a) any allegation made under section 72 (4) (a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:

(i) to use the trade mark in Saint Vincent and the Grenadines; or

(ii) to authorise the use of the trade mark in Saint Vincent and the Grenadines; or

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

in relation to goods or services or both which the opposed application related; or

- (b) any allegation made under section 72 (4) (a) that the trade mark has not, at any time before the period of one month ending on the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both; or
- (c) any allegation made under 72 (4) (b) that the trade mark has not, at any time during the period of three years ending one month before the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both.

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

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

(3) For the purposes of subsection 1 (c), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time

during the period referred to in that subsection been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both if

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

Determination
of opposed
application

81. (1) Subject to subsection (3) and to section 82, if

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

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

(2) Subject to subsection (3) and to section 82, if, at the end of the proceedings relating to an opposed application, the Court is satisfied that the grounds on which the application was made have been established, it may order the Registrar to remove the trade mark from the Register in

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

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

Determination
of opposed
application,
localized use of
trade mark

82. (1) This section shall apply if an application for the removal of a trade mark from the Register is made on the ground referred to in section 72 (4) (b) and

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

(2) If the Registrar or the Court is satisfied

- (a) that the challenged trade mark has remained registered for the period referred to in section 72 (4) (b), and
- (b) that during that period there has been no use, or no use in good faith, of the challenged trade mark in relation to:
 - (i) goods or services dealt with or provided in the particular place referred to in subsection (1); or
 - (ii) goods or services to be exported to the particular market referred to in subsection (1),

the Registrar may decide, or the Court may order, that the challenged trade mark should be removed from the Register but that the registration of the trade mark should be subject to the conditions or limitations that the Registrar or the Court considers necessary to ensure that the registration does not extend to the use of the trade mark in relation to goods or services dealt with or provided in the specified place; or goods or services to be exported to the specified market.

or services to be exported to the specified market.

(3) For the purposes of this section “challenged trade mark” means the trade mark in relation to which an application for removal is made pursuant to subsection (1).

Registrar to
comply with
order of court

83. If the Court makes an order under section 81 or 82, it shall cause copy of the order to be served on the Registrar and the Registrar shall comply with the order.

Appeal

84. An appeal lies to the Court from a decision of the Registrar under section 81 or 82.

Certificate of
use of trade
mark

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

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

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

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

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

PART 13

ASSIGNMENT AND TRANSMISSION OF TRADE MARKS

Assignment of
trade mark

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

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

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

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

87. (1) If a trade mark whose registration is being sought is assigned or transmitted:

- (a) the applicant for the registration of the trade mark; or
 - (b) the person to whom it has been assigned or transmitted;
- shall apply to the Registrar for the assignment or transmission to be recorded.

(2) The application shall

- (a) be on a prescribed form; and
- (b) be filed, together with any prescribed document, in accordance with the regulations.

Recording of assignment of trade mark whose registration is sought

88. (1) If an application pursuant to section 87 complies with this Act, the Registrar shall

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

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

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

89. (1) If a registered trade mark is assigned or transmitted,

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

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

(2) The application shall be filed in a prescribed form together with any prescribed document, in accordance with the regulations.

Recording of assignment of registered trade mark

90. (1) If the application made pursuant to section 89 complies with this Act, the Registrar shall, at, or within, the time provided for in the Regulations

- (a) enter the particulars of the assignment or transmission in

the Register; and

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

(2) The particulars pursuant to subsection (1) (a) are taken to have been entered in the Register on the day on which the application was filed, and the registration of the beneficiary as the owner of the trade mark pursuant to subsection 1 (b) is taken to have had effect from and including that day.

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

91. If an application made under section 87 or 89 in relation to the assignment or transmission of a trade mark complies with this Act, the Registrar shall notify in accordance with the regulations any person recorded under Part 14 as claiming an interest in, or a right in respect of, the trade mark.

PART 14

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

Object of Part

92. This Part makes provision

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

Application to have claims to interest recorded

93. (1) If

- (a) a person other than the registered owner of a trade mark, claims to have an interest in, or a right in respect of, a registered trade mark; and
- (b) this interest or right may not be recorded in the Register under Part 13;

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

(2) The application shall be in a prescribed form and shall be filed in accordance with the Regulations.

Record of claims to interest

94. (1) If an application has been made in accordance with section 93, the Registrar shall enter in the Register the particulars of the claim set out in the application.

(2) If

(a) a trade mark is registered; and

(b) immediately before the registration, particulars of a claim to an interest in, or right in respect of, the trade mark were recorded under section 93 and 95;

the Registrar shall enter those particulars in the Register.

Amendment and
cancellation

95. Regulations may provide for the amendment and cancellation of particulars entered in the Register under this Part;

Record not
proof of
existence of
right

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

Application to
have claims to
interest
recorded

97. (1) If

(a) a person has applied for the registration of a trade mark;
and

(b) another person claims to have an interest in, or a right in respect of, that trade mark;

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

(2) The application shall be in an approved form and shall be filed in accordance with the Regulations.

Record of
claims to
interest

98. If an application has been made in accordance with section 97, the Registrar shall record in the manner that the Registrar thinks fit, but not in the Register, the particulars of the claim set out in the application.

Regulations for
the amendment
and cancellation
of particulars

99. Regulations may provide for the amendment and cancellation of particulars recorded under this Part.

PART 15

INFRINGEMENT OF TRADE MARKS

Infringement

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

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

(a) goods of the same description as that of registered goods;

(b) services that are closely related to registered goods; or

(c) services of the same description as that of registered services; or

(d) goods that are closely related to registered services.

(3) A person shall not be taken to have infringed the trade mark if the person establishes that his using the sign is not likely to deceive or cause confusion.

(4) A person infringes a registered trade mark if

(a) the trade mark is well known in Saint Vincent and the Grenadines; and

(b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to

(i) unrelated goods that are not of the same description as that of the goods in respect of which the trade mark is registered, or are not closely related to services in respect of which the trade mark is registered; or

(ii) unrelated services that are not of the same description as that of the registered goods; and

(c) because the trade mark is well known the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and

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

(5) In deciding, for the purposes of subsection (4) (a), whether a trade mark is well known in Saint Vincent and the Grenadines, the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason, shall be taken into account.

Infringement of
trade mark by
breach of
certain
restrictions

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

(2) Pursuant to subsection (1) the following acts shall be deemed to be prohibited:

(a) applying the trade mark to registered goods, or using the trade mark in physical relation to them, after the state,

condition, or packaging in which they were originally offered to the public has been altered;

- (b) altering, or partially removing or obliterating, any representation of the trade mark applied to registered goods or used in physical relation to them;
- (c) if the trade mark has been applied to registered goods, or use in physical relation to them, together with other matter indicating that the registered owner or authorised user has dealt with the goods, removing or obliterating, totally or in part, any representation of the trade mark without totally removing or obliterating the other matter;
- (d) applying another trade mark to registered goods or using another trade mark in physical relation to them;
- (e) if the trade mark has been applied to registered goods or used in physical relation to them, using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the reputation of the trade mark.

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

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

(4) The trade mark shall not be infringed if the owner of the goods

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

Exceptions to
infringement of
trade mark

102. (1) Notwithstanding section 101, a person shall not infringe a registered trade mark if:

- (a) the person uses in good faith
 - (i) the person's name or the name of the person's place of business; or
 - (ii) the name of a predecessor in business of the person or the name of the predecessor's place of business; or

- (b) the person uses a sign in good faith to indicate
 - (i) the kind, quality, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or
- (c) the person uses the trade mark in good faith to indicate the intended purpose of goods or services; or
- (d) the person uses the trade mark for the purposes of comparative advertising; or
- (e) the person exercises a right to use a trade mark given to the person under this Act; or
- (f) the Court is of the opinion that the person would obtain registration of the trade mark in his name if the person were to apply for it; or
- (g) the person uses a trade mark that is substantially identical with, or deceptively similar to, the first-mentioned trade mark and the court is of the opinion that the person would obtain registration of the substantially identical or deceptively similar trade mark in his name if the person were to apply for it; or
- (h) the person, in using a sign referred to in section 100 subsection (1), (2), or (3) in a manner referred to in that subsection, does not, because of a condition or limitation subject to which the trade mark is registered, infringe the exclusive right of the registered owner to use the trade mark.

(2) Notwithstanding section 100, if a disclaimer has been registered in respect of a part of a registered trade mark, a person does not infringe the trade mark by using that part of the trade mark.

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

103. (1) Notwithstanding section 100 a person who uses a registered trade mark

- (a) in relation to goods that are similar in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied to, or used in relation to, the goods by, or with the consent of the registered owner of the trade mark;
- (b) in relation to services that are similar to registered services in respect of which the trade mark is registered does not infringe the trade mark if the trade mark has been applied

in relation to the services by, or with the consent of, the registered owner of the trade mark.

Prior use of identical trade mark

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

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

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

(2) If the unregistered trade mark has continuously been used only in a particular area in Saint Vincent and the Grenadines subsection (1) shall apply only to the use of the trade mark by the person in that area.

Action for infringement to be brought before Court

105. (1) An action for an infringement of a registered trade mark may be brought in the Court.

(2) The relief that the Court pursuant to subsection (1) may grant in an action for infringement of a registered trade mark includes:

- (a) an injunction, which may be granted subject to any condition that the Court thinks fit; and
- (b) at the option of the plaintiff but subject to section 107, damages or an account of profits

106. *Deleted by Act No.50/2004.*

Special case where claimant not entitled to damages

107. If

- (a) in an action for the infringement of a trade mark registered in respect of particular goods or services, the court finds that the defendant has infringed the trade mark; and
- (b) the defendant has applied under section 72 (3) for an order directing the Registrar to remove the trade mark from the Register in respect of those goods or services; and

- (c) the Court finds that, because the trade mark has not during a particular period been used in good faith by its registered owner in relation to those goods or service, there are grounds under section 72 (4) for so removing the trade mark from the Register;

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

Circumstances
in which action
may not be
brought

108. If the registration of a trade mark is renewed under section 59 within twelve months after it has expired, an action may not be brought in respect of an act that

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

Groundless
threats of legal
proceedings

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

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

any person aggrieved by the threat may bring an action in the Court.

(2) The purpose of the action pursuant to subsection (1) shall be to

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

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

(4) Pursuant to subsection (1) the court may not find in favour of the claimant if the respondent satisfies the court that:

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

(5) An action may not be brought, or if brought may not proceed,

under this section if the registered owner of the trade mark, or an authorised user of the trade mark having power to bring an action for infringement of the trade mark, with due diligence, begins and pursues an action against the threatened person for infringement of the trade mark.

Counterclaim
by defendant in
action on
groundless
threats

110. If the respondent in an action brought under section 109 would be entitled to bring against the claimant an action for infringement of the registered trade mark

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

PART 16

IMPORTATION OF GOODS INFRINGING VINCENTIAN TRADE MARKS

Notice of
objection to
importation

111. (1) The registered owner of a registered trade mark may give to the Comptroller a prescribed notice objecting to the importation after the date of the notice of goods that infringe or appears to infringe, the registered trade mark.

(2) If

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

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

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

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

(4) A notice given by the registered owner of a trade mark shall remain in force for two years from the day on which the notice is given until it is revoked, before the end of that period, by notice in writing

given to the Comptroller of the person who is then the registered owner of the trade mark.

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

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

Comptroller
may seize good
infringing trade
mark

112. (1) This section shall apply to goods manufactured outside Saint Vincent and the Grenadines that:

- (a) are imported into Saint Vincent and the Grenadines; and
- (b) are subject to the control of the customs within the meaning of the Customs (Control and Management) Act.

(2) If the goods to which this section applies

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

the Comptroller shall seize the goods unless he is satisfied that there are reasonable grounds for believing that the notified trade mark is not infringed by the importation of the goods.

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

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

Notice of
seizure

113. The Comptroller shall, as soon as practicable

- (a) give, either personally or by registered post to the designated owner of any seized goods a notice in writing identifying the goods and stating that they have been seized under section 112; and
- (b) give, either personally or by registered post to the objector, or to each objector, a notice in writing:
 - (i) identifying the goods and stating that they have been

seized under section 112; and

- (ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller has and that he believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods; and
- (iii) stating that the goods will be released to the designated owner unless the objector or one of the objectors, as the case requires, brings an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller notice in writing of the action, within the period of ten working days after he has been given the notice or, if the Comptroller extends that period under subsection 116 (1), within the extended period.

Forfeiture of goods

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

(2) If the designated owner gives such a notice, the goods shall be forfeited to the State.

Release of goods to owner where no action for infringement

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

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

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

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

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

designated owner at any time before the end of the action period if

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

(4) For the purpose of this section:

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

- (a) if there is only one objector to the importation of the goods, the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under section 116 (1); or
- (b) if there is more than one objector to the importation of the goods, the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under section 116 (1) and ceasing at the end of the last day on which an objector may bring such an action under section 116 (1).

Action for
infringement of
trade mark

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

(a) if paragraph (b) does not apply within the period of one month from the date of the notice given to the objector in respect of the goods under section 113;

(b) if

(i) the objector has, before the end of the period, applied in writing to the Comptroller for an extension of that period; and

(ii) the Comptroller, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended that period for a number of working days not exceeding ten;

within that period as so extended by the Comptroller.

(2) The Court hearing an action brought pursuant to subsection

(1)

(a) may, on the application of a person, allow the person to be

joined as a defendant to the action; and

(b) shall allow the Comptroller to appear and be heard.

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

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

(b) order that the seized goods be forfeited to the State.

(4) If

(a) the Court decides that the trade mark was not infringed by the importation of the goods; and

(b) the designated owner of the goods, or any other defendant, satisfies the court that he has suffered loss or damage because the goods were seized;

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

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

(6) If either court orders that the goods be released, the Comptroller must, subject to section 119, comply with the order.

Action for
infringement by
authorised user

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

Disposal of
forfeited goods

118. If

(a) goods are forfeited to the State under section 114; or

(b) the Court orders under section 116 that goods be forfeited to the State ;

the goods shall to be disposed of as the Comptroller directs.

Power of
Comptroller to
retain control of
goods

119. Notwithstanding this Part, the Comptroller:

(a) shall not release, or dispose of, any seized goods; or

(b) shall not take any action in relation to the goods to give

effect to any order of either court under section 116;

if the Comptroller is required or allowed to retain control of the goods under any other law of the State.

Insufficient
security

120. If security given under section 112 (3) by the objector or objectors who gave notice under section 111 in respect of a trade mark is not sufficient to meet the expenses incurred by the State as a result of the action taken by the Comptroller under this Part because of the notice, the amount of the difference between those expenses and the amount of security

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

Government not
liable for loss
suffered
because of
seizure

121. The State shall not be liable for any loss or damage suffered by a person:

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

Power to
require
information

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

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

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

**PART 17
OFFENCES**

Falsifying, etc.
a registered
trade mark

123. (1) No person shall, intentionally or recklessly, falsify or unlawfully remove a trade mark that has been applied

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

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

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

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

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

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

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

Falsely applying
a registered
trade mark

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

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

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

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

- (a) the permission of the registered owner, or of an authorised user, of the trade mark; and
- (b) being required or authorised to do so by this Act, a direction of the Registrar or an order of the Court.
- Manufacture and possession of die, etc. for use in commission of offence
125. (1) A person shall not make a die, block, machine or instrument
- (a) knowing that it is likely to be used for, or in the course of, committing an offence against section 123 or 124 or;
- (b) reckless as to whether or not it is likely to be used for, or in the course of, committing an offence against section 123 or 124.
- (2) A person shall not draw, or program a computer or other device to draw, a registered trade mark or part of a registered trade mark
- (a) knowing that the trade mark or part of the trade mark is likely to be used for, or in the course of, committing an offence against section 123 or 124; or
- (b) reckless as to whether or not the trade mark or part of a trade mark is likely to be used for, or in the course of, committing an offence against section 123 or 124.
- (3) A person shall not intentionally have in his possession, or dispose of
- (a) a die, block, machine or instrument; or
- (b) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
- (c) a representation of a registered trade mark or of part of a registered trade mark
- knowing that, or reckless as to whether or not, the die, block, machine, instrument, computer device or representation is likely to be used for, or in the course of, committing an offence against section 123 or 124.
- Selling, etc. goods with false marks
126. A person shall not intentionally
- (a) sell goods; or
- (b) expose goods for sale; or
- (c) have goods in his possession for the purpose of trade or manufacture; or
- (d) imports goods into Saint Vincent and the Grenadines for the purpose of trade or manufacture;
- knowing that, or reckless as to whether or not a falsified registered trade

mark is applied to them or in relation to them or a registered trade mark has been unlawfully removed from them, or a registered trade mark is falsely applied to them or in relation to them.

Penalty for offences

127. A person who contravenes section 123, 124, 125 or 126 commits an offence and shall be liable upon conviction to a fine not exceeding two hundred and fifty thousand dollars.

False representations regarding trade marks

128. (1) A person shall not intentionally or recklessly make representation to the effect that a trade mark is registered *as a* trade mark unless the person knows, or has reasonable grounds to believe, that the trade mark is registered in Saint Vincent and the Grenadines.

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

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

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

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

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

to be exported to that country.

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

False entries in Register

129. (1) A person shall not intentionally
- (a) make a false entry in the Register; or
 - (b) cause a false entry to be made in the Register; or
 - (c) tender in evidence a document that falsely purports to be a copy of, or an extract from, an entry in the Register or a document in the Commerce and Intellectual Property Office.

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

Disobeying summons

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

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

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

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

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

Refusing to give evidence

131. (1) A person appearing before the Registrar as a witness shall not without reasonable excuse
- (a) refuse to be sworn or to make an affirmation; or
 - (b) refuse to answer questions that he is lawfully required to answer; or
 - (c) fail to produce any document or thing that he is lawfully

required to produce.

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

Unauthorised
persons not to
act in the trade
marks matters

132. (1) A person shall not
- (a) apply for, or obtain, on behalf of another person
 - (i) the registration of a trade mark;
 - (ii) the making of an entry in the Register; or
 - (iii) the amendment, cancellation, removal or restoration of an entry in the Register; or
 - (b) prepare, or caused to be filed in accordance with this Act, a document necessary for another person to obtain or oppose
 - (i) the registration of a trade mark;
 - (ii) the making of an entry in the Register;
 - (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
 - (c) give advice to another person about the validity of the registration of a trade mark or the infringement of a trade mark,

unless the person is an attorney-at-law.

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

False
representation
about
Commerce and
Intellectual
Property Office

133. (1) A person
- (a) shall not
 - (i) place, or allow to be placed, on the building in which his office is situated;
 - (ii) use when advertising his office or business; or
 - (iii) place on a document, as a description of his office or business;

the words “Commerce and Intellectual Property Office” or words of similar import whether alone or together with other words; or

- (b) shall not use in any other way, in connection with his business, words that would reasonably lead other persons to believe that his office is, or is officially connected with,

the Commerce and Intellectual Property Office.

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

Employee not to
prepare
documents

134. (1) A public officer employed in the Commerce and Intellectual Property Office shall not prepare, or help to prepare, a document to be filed under this Act unless required or authorised to do so by a written direction of the Registrar or an order of the Court.

(2) A public officer who contravenes subsection (1) shall be liable to disciplinary action by the Public Service Commission.

Conduct of
directors,
servants and
agents

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

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

(a) that the conduct was engaged in by a director, servant or agent of the body corporate within the scope of his actual apparent authority; and

(b) that the director, servant or agent had the state of mind.

(3) Any conduct engaged in on behalf of a body corporate by a director, servant, agent of the body corporate within the scope of his actual or apparent authority is taken to have been engaged in also

by the body corporate unless it proves that it took reasonable precautions and exercised due diligence to avoid the conduct.

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

(a) that the conduct was engaged in by a servant or agent of the individual within the scope of his actual or apparent authority; and

(b) that the servant or agent had the state of mind.

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

(6) For the purposes of this section;

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

members constituting the body;

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

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

(a) the person’s knowledge, intention, opinion, belief or purpose; and

(b) the person’s reasons for the intention, opinion, belief or purpose.

PART 18

COLLECTIVE TRADE MARKS

Application and
definition

136. (1) For the purposes of this Part

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

(2) The provisions of this Act relating to trade mark, other than Part 13 shall apply to collective trade marks and so apply as if

(a) a reference to a trade mark included a reference to a collective trade mark;

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

(c) a reference to a trade mark registered by a person includes a reference to a collective trade mark registered by an association.

(3) For the purposes of this Act

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

(b) the use of a registered collective trade mark by a member of the association that is the registered owner of the collective trade mark is taken to be a use of the collective trade mark by the registered owner.

(4) Section 23 applies in relation to a collective trade mark as if reference to the applicant were a reference to the members of the association that applied for registration of the collective trade mark.

Application for registration

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

Limitation on rights given by registered collective trade mark

138. A member of an association in whose name a collective trade mark is registered shall not have the right to prevent another member of the association from using the collective trade mark in accordance with the rules which may be made by the association.

Assignment etc. of collective trade mark

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

Infringement of collective trade mark

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

PART 19

CERTIFICATION TRADE MARKS

Interpretation

141. (1) For the purposes of this Part, “certification trade mark” means a sign used, or intended to be used to distinguish goods or services:

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

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

(2) Subject to this Part, the provisions of this Act relating to trade marks, other than the following shall apply to certification trade marks and so apply as if a reference to a trade mark included a reference to a certification trade mark:

- (a) under section 2 of the definition of “authorised user of trade marks”;
- (b) section 3 subsection (1), (2) and (3);

- (c) section 4 subsection (5);
- (d) section 13 (1)
- (e) section 16 subsection (3), (4) and (5);
- (f) section 23;
- (g) section 68;
- (h) section 101 and 107;
- (i) Part 12.

Rights given by registration of a trade certification trade mark

142. (1) If a certification trade mark is registered, the registered owner shall have subject to Part 2 and notwithstanding subsection (1) of section 6, the exclusive rights to use, and to allow other persons to use, the certification trade mark, in relation to the goods or services or both in respect of which the certification trade mark is registered.

(2) Pursuant to subsection (1) the registered owner may, use the certification trade mark only in accordance with the rules governing the use of the certification trade mark.

(3) The rights pursuant to subsection (1) and (2) shall be deemed to have accrued to the registered owner as from the date of registration of the certification trade mark.

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

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

Rights of persons allowed to use certification trade mark

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

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

Rules governing the use of certification trade marks

144. (1) A person who has filed an application for the registration of a certification trade mark shall file in accordance with the Regulations, a copy of the rules governing the use of the certification trade mark and any document prescribed under section 12 (2)

any document prescribed under section 13 (2).

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

and any other condition that the Registrar may permit.

(3) For the purposes of this section "acquired certifier" means a person approved for the purpose of certifying goods or services or both pursuant to subsection (2).

Grant of
application to
register

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

- (a) the application has been made in accordance with this Act;
- (b) subject to subsection (2), the rules referred to in section 144
 - (i) would not be detrimental to the public; and
 - (ii) are satisfactory having regard to the criteria prescribed under section 144 (2);
- (c) the applicant or the approved certifiers are competent to certify the goods or services or both in respect of which the certification trade mark is to be registered;
- (d) the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from the goods or services not so certified;
- (e) there are no other grounds for rejecting the application,

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

(2) In deciding, pursuant to subsection (1) (d), whether or not a

certification trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier, the Registrar shall take into account the extent to which

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

(3) The Registrar may require the applicant to make amendments to any of the rules referred to in section 144 as the Registrar considers necessary.

Refusal to Register

146. (1) The Registrar may, subject to subsection (2) reject an application made pursuant to this Part if he is not satisfied as to any of the grounds referred to in section 145 (1).

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

Variation of rules

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

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

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

- (a) would not be detrimental to the public;
- (b) are satisfactory having regard to the criteria prescribed pursuant to section 144 (2) (b).

(4) The Registrar shall:

- (a) notify the registered owner of the certification trade mark in writing, of his decision to approve or not to approved the variation of rules governing the use of a certification and trade mark; and
- (b) cause notice, if applicable, of any variation in the rules, to be published in the official journal.

Rules to be available for inspection

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

Assignment of
registered
certification
trade mark

149. (1) A registered certification trade mark may be assigned only with the consent of the Registrar.

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

(3) In deciding whether or not give her consent, the Registrar may have regard to the matters provided for under the regulations.

(4) A person aggrieved by a decision may be the Registrar pursuant to this section may appeal to the High Court.

Assignment of
registered
certification
trade mark

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

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

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

(4) A person aggrieved by a decision of the Registrar pursuant to this section may appeal to the Court.

Rectification of
Register by
order of Court

151. (1) Subject to subsection (2), the Court may, on the application of an aggrieved person, order that the Register be rectified by:

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

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

- (a) any of the grounds on which the registration of the trade mark should have been opposed under Part 7 or on the grounds that the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from goods or services not so certified;
- (b) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;
- (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason

other than one for which

- (i) the application for the registration of the trade mark could have been rejected under section 25 or 26; or
- (ii) the registration of the trade mark could have been opposed under section 40.

(3) The Court may on the application of a person aggrieved, order that the Register be rectified by cancelling the registration of a certification trade mark, or removing or amending an entry in the Register relating to the certification trade mark, on the ground that

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

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

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

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

Variation of
rules by order of
Court

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

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

Copy of order
and rules

153.(1) A copy of any order made by the Court under this section shall be given to the Registrar.

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

PART 20

DEFENSIVE TRADE MARKS

Defensive trade marks

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

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

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

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

Application of Act

155. Subject to this Part, the provisions of this Act, other than section 6 (1), 13 (1) (b), 23, 39, 101 and 107, Part 12 and Part 19 apply to defensive trade marks and so apply as if a reference to a trade mark included a reference to a defensive trade mark.

Additional grounds for rejecting application for registration or opposing registration

156. In addition to any other ground on which

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

Amendment or cancellation of registration by order of court

157. Section 68 applies in relation to a defensive trade mark as if “or under section 156” were added at the end of subsection (2) (a).

Cancellation of registration by Registrar

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

PART 21

JURISDICTION AND POWERS OF COURTS

Jurisdiction of the High Court

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

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

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

Transfer of proceedings

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

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

(a) all relevant documents of record filed in the transferring court shall be sent to the other court by the Registrar or other appropriate officer of the transferring court; and

(b) the action or proceeding shall continue in the other court as if

(i) it had been started there; and

(ii) all steps taken in the transferring court had been taken in the other court.

Appeals

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

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

(3) With the special leave of the High Court, an appeal lies to the

High Court against a judgement or order referred to in subsection (1).

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

Registrar may appear in appeals

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

Powers of Court

163. On hearing an appeal against a decision or direction of the Registrar, the Court may do any one or more of the following:

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

PART 22

ADMINISTRATION

Registrar of Commerce and Intellectual Property Office

164. The Registrar shall have the powers and functions that are given to him under this Act and any other Act and shall be responsible for the administration of this Act.

Registrar's powers

165. The Registrar may, for the purposes of this Act-

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

Exercise of
power by
Registrar

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

Registrar to act
as soon as
possible

167. If

(a) the Registrar is required under this Act to any act or thing;
and

(b) no time or period is provided within which the act or thing
is to be done;

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

Deputy
Registrar

168. (1) Subject to any direction by the Registrar, a Deputy Registrar has all the powers and functions of the Registrar, except the powers of delegation under section 169.

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

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

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

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

Delegation of
Registrar's
powers and
functions

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

(a) a prescribed person, or persons included in a prescribed class, holding or performing the duties of an office in the Commerce and Intellectual Property Office;

(b) a prescribed public officer, or public officer included in a prescribed class, employed in the Commerce and Intellectual Property Office.

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

(a) the Registrar; or

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

PART 23

THE REGISTER AND OFFICIAL DOCUMENTS

- The Register 170. (1) A Register of Trade Marks is to be kept at the Commerce and Intellectual Property Office.
- (2) The Registrar shall enter in the Register in accordance with this Act
- (a) all particulars of registered trade marks, and all other matters that were on the old register when the Registration of United Kingdom Trade Marks Act was repealed; and
- (b) particulars of trade marks, certification trade marks, collective trade marks and defensive trade marks, and all other matters, that are required to be registered under this Act; and
- (c) other prescribed matters.
- (3) All particulars entered in the Register under subsection (2) (a) shall be taken to have been so entered at the commencement of this Act.
- Register may be kept on computer 171.(1)The Register may be kept in whole or in part by using a computer.
- (2) Any record of a particular or other matter made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.
- Register 172. (1) The Register is prima facie evidence of any particular or other matter entered in it.
- (2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.
- (3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any of the particulars comprised in the Register or in the part of the Register shall be admissible in any proceedings as evidence of those particulars.
- Certified copies of documents 173. (1) A certificate signed by the Registrar and stating that
- (a) anything required or permitted to be done by the Act or the Repealed Acts were done or not done on, or had been done or not been done by, a specified date;

- (b) anything prohibited by the Act or the repealed Act was done or not done on, or had been done or not been done by, a specified date; or
- (c) a document was available for public inspection at the Commerce and Intellectual Property Office on a specified date or during a specified period;

shall be prima facie evidence of the matters so state.

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

PART 24

MISCELLANEOUS

Making and signing applications and filing of documents

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

Withdrawal of application etc.

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

(2) If

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

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

Address for service

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

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

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

- (a) if paragraph (b) does not apply, the address given, or last given, by the registered owner or the person to the Registrar under subsection (1); or
- (b) if, before the Registrar registers the trade mark or records the claim to the interest or right, the registered owner or person

gives in writing to the Registrar another address as his or her address for service, that other address.

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

(4) The address for service of

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

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

(5) An address for service shall be an address in Saint Vincent and the Grenadines.

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

- (a) the document may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document may be served on an agent of the person in Saint Vincent and the Grenadines.

Change of name 177. (1) If there is a change in the name of a person who has filed an application, notice or request, the person shall notify the Registrar in writing of the change.

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

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

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

- Death of applicant etc. 178. (1) If an applicant for the registration of a trade mark dies before registration is granted on the application, his legal representative may proceed with the application.
- (2) If, at any time after a trade mark is registered, the Registrar is satisfied that the person in whose name the trade mark is registered had died, or, in the case of a body corporate, had ceased to exist, before registration was granted, the Registrar may amend the Register by substituting for the name entered in the Register the name of the person who should be the registered owner of the trade mark.
- Description of registered trade mark 179. In an indictment, information, pleading or proceeding relating to a registered trade mark, the trade mark may be identified by its registration number and it shall not *be* necessary to reproduce or describe the trade mark.
- Evidence of usage of trade mark 180. In an action or proceeding relating to a trade mark, evidence is admissible of the usage of the trade concerned and of any relevant trade mark or trade name legitimately used by other persons.
- Death of party to proceeding before Registrar 181. If a person who is party to a proceeding pending before the Registrar dies, the Registrar may
- (a) on being asked, substitute in the proceeding another person in the place of the deceased party if the Registrar is satisfied that the interest of the deceased party has been transmitted to that other person; or
 - (b) allow the proceeding to continue without any substitution if the Registrar is of the opinion that the interest of the deceased party is sufficiently represented by the surviving parties.
- Costs awarded by Registrar 182. (1) The Registrar may award costs in respect of the matters, and in the amounts, provided for in the Regulations against any party to proceedings brought before him.
- (2) A party desiring to obtain costs shall apply to the Registrar in accordance with the Regulations.
- (3) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.
- Security for costs 183. If a person who neither resides nor carries on business in Saint Vincent and the Grenadines
- (a) gives notice of opposition under this Act; or
 - (b) applies to the Registrar under Part 12 for a trade mark to be removed from the Register;

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

Fees

184. (1) The Minister responsible for trade marks may make Regulations prescribing the fees to be paid for the purposes of this Act and may prescribe different fees in respect of the doing of an act according to the time when the act is done.

(2) Prescribed fees shall be payable in accordance with the Regulations.

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

(4) Subject to subsection (5), if

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

(b) a fee is payable in respect of the filing of a document;

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

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

Extension of
time

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

(2) If, because of

(a) an error or omission by the person concerned or by his or her agent; or

(b) circumstances beyond the control of the person concerned;

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

(3) If

(a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and

(b) on application made by that person in accordance with the

Regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time;

the Registrar may extend the time for doing the act.

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

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

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

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

(8) In this section-

“relevant act” means-

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

Publication of documents

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

Use of trade mark for export trade

187. (1) If

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

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

to be exported from Saint Vincent and the Grenadines.

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

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

Passing off
actions

188. (1) Except as provided in subsection (2), this Act does not affect the law relating to passing off.

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

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

Expenses

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

Regulations

190. (1) The Minister may after consultation with the Registrar, make Regulations-

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

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

- (a) provide for appeals against decisions of the Registrar made outside the scope of the Regulations;
- (b) require persons to make statutory declarations in support

- of any application, notice or request filed under this Act;
- (c) provide for the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act;
 - (d) provide for the refund, in specific circumstances, of the whole or part of a fee paid under this Act;
 - (e) provide for the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a Registrar;
 - (f) provide for the expenses and allowances to be paid to witnesses or persons attending at proceedings before the Registrar;
 - (g) give power to the Registrar-
 - (i) to require, in specified circumstances, a person applying under Part 12 for a trade mark to be removed from the Register to give security for any costs that may arise from the proceedings;
 - (ii) not to proceed with the application if security is not given;
 - (iii) to refund to the applicant any amount given as security and not applied in setting costs awarded against the applicant;
 - (h) provide for the destruction of documents relating to a trade mark at least ten years after the registration of the trade mark has ceased;
 - (i) prescribe as penalties for offences against the Regulations fines not exceeding two hundred and fifty dollars;
 - (j) make transitional or consequential provision as necessary or convenient because of the repeal of the repealed Acts and the enactment of this Act.

Repeal

191. The Registration of United Kingdom Trade Marks Act and the Merchandise Marks Act are hereby repealed.

Transitional

192. (1) A trade mark that, immediately before the date of commencement of this Act, was registered under the Registration of United Kingdom Trade Marks Act is a registered trade mark for the purposes of this Act.

(2) The registration of an existing trade mark expires on the day on which it would have expired under the Registration of United

kingdom Trade Marks Act if this Act had not been repealed.

(3) Part 9 sections 55 to 60 shall apply in relation to the renewal of the registration of an existing trade mark.

- (4) (1) Subject to subsection (3), an application or request that:
- (a) was lodged with the Registrar in accordance with the Registration of United Kingdom Trade Marks Act; and
 - (b) was pending immediately before the commencement date of this Act;
- is deemed to have been filed in accordance with this Act and shall be dealt with in accordance with this Act.
- (2) Subject to subsection (3), the filing date in respect of an application referred to in subsection (1) is the day on which the application was lodged with the Trade Marks Office under the Registration of United Kingdom Trade Marks Act.
- (3) If an application for the registration in the old register of the assignment or transmission of an existing registered mark was pending immediately before the commencement date of this Act, this Act shall apply in relation to the application as if:
- (a) it were an application under section 89 for a record of the assignment or transmission to be entered in the Register; and
 - (b) that application was filed after the commencement date of this Act.
- (5) The Registrar shall continue to keep in accordance with this Act all documents that, immediately before the commencement date of this Act, were kept by a registrar under the Registration of United Kingdom Trade Marks Act.
- (6) If, immediately before the commencement date of this Act, the proprietor of an existing registered mark had appointed an agent in Saint Vincent and the Grenadines, the business address of that agent is the address for service of the registered owner of the mark for the purposes of this Act until the registered owner notifies another address to the Registrar under section 176.

If immediately before the commencement date of this Act, the proprietor of an existing registered mark had not appointed an agent in Saint Vincent and the Grenadines, and the address then entered in the old register as the address of the proprietor was not an address in Saint Vincent and the Grenadines; that address is not to be used as the address

for service of the registered owner of the mark, and the registered owner shall give notice in writing to the Registrar of an address of in Saint Vincent and the Grenadines as his address for service..

Passed in the House of Assembly this 16th day of October 2003.

NICOLE HERBERT

Clerk of the House of Assembly (Ag.)