

Patents Act, 1981 – 55

of December 21, 1981, as Amended by the Intellectual Property Acts (Amendment) Act, 1984-20
of June 22, 1984*

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Citation

(Short title)

1. This Act may be cited as the *Patents Act, 1981*.

Interpretation

(Definitions)

2. In this Act,

“claim” means, in relation to a description of an invention, a claim within the meaning of paragraph (c) of subsection (2) of section 21;

“Director” means the Registrar of the Supreme Court or such other person appointed in the manner provided by law as Director of the Industrial Property Office;

“Gazette” means the *Official Gazette* or such other publication as is prescribed for the purpose;

“Industrial Property Office” means the office within the Public Service designated as the Industrial Property Office;

“licensee” means the holder of a licence under a licence-contract, the holder of a statutory licence or of a national licence;

“licence-contract” means a licence-contract within the meaning of section 39;

“national licence” means a licence issued under section 57;

“register” means the Register of Patents described in section 88;

“statutory licence” means a licence issued under section 62 or 63;

“transfer” extends to every mode (whether direct or indirect, voluntary or involuntary, absolute or conditional) of disposing of or parting with any right vested under this Act or of any interest in any such right, including the retention of title to the right or interest as security for any obligation.

(Purposes)

3. The purposes of this Act are

(a) to protect certain inventions for which patents or other title of protection have been granted or applied for, so that the laws of Barbados will accord with its obligations under

(i) the Paris Convention for the Protection of Industrial Property dated March 20, 1883, as revised from time to time, in this Act called the “Paris Convention;” and

(ii) the Patent Cooperation Treaty done at Washington on June 19, 1970, as revised from time to time, in this Act called the “Patent Cooperation Treaty;” and

(b) to ensure that the patent laws of Barbados will not discourage the use of new technology in Barbados.

(Inventions)

4.–(1) For the purposes of this Act, an invention is an idea that provides or enables a practical solution to a specific problem in technology.

(2) An invention can be or can relate to a product or a process.

Part I Patents

Protection of Inventions

(Patent rights)

5.–(1) Subject to this Act, a patent granted under this Act for an invention vests in the owner of the patent the exclusive right to prevent any other person from using the invention without the consent of the owner.

(2) Subject to this Act, when an application for a patent for an invention is accorded a filing date under section 29 by the Director, there is thereupon vested in the applicant the exclusive right to prevent any other person from using the invention without the consent of the applicant.

(Invention use)

6. For the purposes of this Act, an invention is used when,

(a) in relation to an invention that is a product,

(i) the product is made, imported, offered for sale, exposed for sale, sold or otherwise dealt with, or

(ii) the product is stocked for sale or other purposes; or

(b) in relation to an invention that is a process,

(i) the process is used, or

(ii) any of the acts described in paragraph (a) are done in connection with a product obtained directly from that process.

(Excepted uses)

7.-(1) The rights vested in the owner of a patent by section 5 in respect of any invention apply only to the use of that invention for industrial or commercial purposes.

(2) The rights vested in the owner of a patent by section 5 in respect of any invention do not apply to the use of the invention

(a) for scientific research only; or

(b) in relation to products that have been marketed in Barbados

(i) by the owner of the patent for that invention or the applicant for a patent for that invention,

(ii) by a licensee under a licence-contract from the owner of, or applicant for, the patent for that invention,

(iii) by the licensee under a statutory licence or national licence related to that invention and issued under this Act,

(iv) by a person who is, pursuant to section 8, using the invention to which the patent or the application for the patent relates, or

(v) by a person who has a right under section 8 to use the invention to which the application for the patent relates.

(3) The rights vested in the owner of a patent by section 5 in respect of an invention do not apply to the use of the invention on

(a) a foreign vessel;

(b) a foreign spacecraft; or

(c) a foreign vehicle of any kind;

that accidentally or temporarily enters the territorial sea, territorial airspace or territory of Barbados, if the invention is used exclusively for the needs of the vessel, spacecraft or vehicle or in its construction or operation.

(4) The rights vested in the owner of a patent by section 5 are limited

(a) to the extent and in the manner provided by section 34; and

(b) to the extent and in the manner provided by Part III.

(Local right)

8.—(1) This section applies to a person who was, on the date accorded under section 29 as the filing date of the application for a patent for an invention or, as the case requires, was on the priority date of the application for such a patent, using the invention in Barbados or had made substantial preparations to use the invention in Barbados, but subject to subsection (3).

(2) A person to whom this section applies has the right to use in Barbados any invention that a patent has been applied for, notwithstanding any rights vested by section 5 in respect of that invention in any other person.

(3) A person may not claim to be a person to whom this section applies, if knowledge of the invention referred to in subsection (2) was,

(a) by reason of or in consequence of an act committed by the owner of the invention or anyone claiming under him, or

(b) as a result of an abuse committed in relation to the owner of the invention or anyone claiming under him,

acquired by the person claiming the right to use the invention in Barbados or anyone through whom he claims that right.

(4) The burden of proof that knowledge of the invention was not acquired

(a) by reason of or in consequence of any act committed by the owner of the invention or anyone claiming under him; or

(b) as a result of any abuse committed in relation to the owner of the invention or any person claiming under him,

lies upon the person who is claiming the right to use the invention in Barbados under this section.

(5) A right to the use of an invention in Barbados that is acquired under this section by a person to whom this section applies may not be transferred otherwise than as part of the business establishment of the person who acquired the right.

Qualification for Patent

(Entitlement)

9. A patent may be granted under this Act for an invention if the invention is new, expresses an inventive advance and is industrially applicable.

(New invention)

10. An invention is new if it is not anticipated by prior art.

(Prior art)

11.—(1) In relation to an invention, prior art consists of

(a) everything disclosed about the invention to the public in any place or at any time

(i) by publication in tangible form, if the disclosure is made outside Barbados, or

(ii) if the disclosure is made in Barbados, by publication in tangible form, by use, by oral disclosure or by any other means,

when the disclosure is made before an application is made outside Barbados for a patent for the invention or, if priority is claimed for the invention, before the priority date properly claimed for the invention; and

(b) the contents of an application for a patent under this Act for the invention made before or, having an earlier priority date than, the application for a patent referred to in paragraph (a), to the extent that those contents are included in the patent granted on the basis of the application made under this Act.

(2) A disclosure to the public of an invention is not to be taken into consideration with respect to an application for a patent that is referred to in paragraph (a) of subsection (1), if the disclosure was made within a period of one year preceding the date on which the application was made and the disclosure was by virtue of or in consequence of an act by, or an abuse of, the rights of the applicant or anyone through whom he claims for a patent.

(Inventive advance)

12. An invention expresses an inventive advance when, having regard to the prior art at the time an application is made for a patent for that invention, the invention is not obvious to a person having ordinary skill in the art.

(Industrial application)

13.—(1) An invention is industrially applicable if it can be made or used in any kind of industry.

(2) For the purposes of this section, “industry” refers to industry of every kind and, without limiting the generality of the foregoing, includes handicraft, agriculture, fishery and services.

(Unpatentable inventions)

14.—(1) Whether or not they constitute an invention within the meaning of this Act, the following are not patentable under this Act, namely:

(a) discoveries, scientific theories and mathematical methods;

(b) plant varieties, animal varieties and essentially biological processes, for the production of plants, other than microbiological processes and the products of those processes;

(c) schemes, rules or methods for

(i) the carrying on of business,

(ii) the performing of acts of a mental nature only, or

(iii) the playing of games;

(d) methods for treatment of human beings or animals by surgery or therapy;

(e) diagnostic methods practised on human beings or animals; or

(f) inventions excluded from the protection of this Act by order of the Minister under section 15.

(2) Paragraphs (d) and (e) of subsection (1) do not extend to products invented for use in the methods referred to in those paragraphs.

(Temporary exclusion)

15.—(1) Notwithstanding section 9, the Minister may, by order, exclude from the protection of this Act, for a period of not more than 10 years, inventions relating to those products or processes that he considers essential for the development of Barbados.

(2) The period referred to in subsection (1) may be extended by the Minister in respect of any invention for one additional period not exceeding 10 years.

(3) No order made under this section applies to

(a) an invention for which a patent is in force at the date of the order;

(b) an invention for which an application for a patent for an invention has been made under this Act before the date of the order; or

(c) an invention for which a patent application has a priority date that is earlier than the date of the order.

(4) The expression “date of the order” refers to the date the order is made or the date the order is stated to have effect, whichever is the earlier date.

(Inventor’s right to invention)

16.—(1) Subject to sections 17 and 18, the right under this Act to a patent for an invention vests in the inventor.

(2) When two or more individuals are joint inventors of an invention, the right to a patent under this Act for that invention vests in them jointly.

(Disqualified inventor)

17. An employee of the Industrial Property Office is, during the period of his employment in that office and for one year thereafter, disqualified

(a) from making any application for a patent of invention under this Act;

(b) from being granted a patent of invention under this Act; and

(c) from holding any rights relating to any patent of invention.

(Employee invention)

18.—(1) Subject to any enactment relating to contracts of employment or to the terms of any specific contract of service or for services, when an invention is invented by an individual

(a) in the course of his employment for the Crown, a body corporate or another individual; or

(b) under a contract for services with, or as a work commissioned by, the Crown, a body corporate or another individual, then, in respect of that invention, the right to a patent of invention for that invention vests in the Crown, body corporate or other individual who employed the inventor or commissioned the invention, as the case requires.

(2) Notwithstanding subsection (1), when an employee under a contract of service who is not required to engage in any creative activity invents an invention by the use of information or means that his employer put at the employee’s disposal, the right to a patent of invention for that invention vests in the employee, but subject to section 19.

(Employer’s rights)

19.—(1) An employee who invents an invention in the circumstances described in subsection (2) of section 18 shall forthwith submit a written report concerning the invention to his employer.

(2) When an employer receives a report concerning an invention of an employee under subsection (1), the employer shall, if he is interested in the invention reported upon, serve on the employee, within a period of 120 days from the date the employer received the report or from the date the invention became known to him, whichever is the later date, a written statement of the employer's interest in the invention.

(3) Upon the service upon his employee of a written statement of the employer's interest in the invention, the right to a patent of invention for that invention vests in the employer.

(4) An employee referred to in subsection (3) is entitled to remuneration calculated after due regard is given to the amount of his salary, the economic importance of his invention and the benefits, if any, accruing to the employer as a result of the invention; but if the employer and employee fail to agree on the amount of the remuneration, it must be fixed by the High Court on the like calculation.

(Effect of employee contracts)

20. Any contract between an employer and an employee in relation to an invention to which section 19 applies that is less beneficial to the employee than the provisions of that section is voidable at the instance of the employee.

Application for Patent

(Patent application)

21.—(1) An application for a patent for an invention must be made to the Director and be accompanied by the prescribed fee.

(2) An application must be in the prescribed form and contain

(a) a petition as described in section 22;

(b) a description of the invention for which the patent is requested

(i) that is sufficiently clear and complete to enable the invention to be evaluated and tested by a person having ordinary skill in the art, and

(ii) that contains an indication of the method best known to the applicant for using the invention;

(c) one or more claims, that is to say, a statement of terms defining the invention for which the application for a patent is being made and setting out the scope of the protection desired under the patent when it is granted; but subject to subsection (3);

(d) such drawings of the invention as are required to assist in the understanding of the invention; and

(e) an abstract providing any necessary technical information relating to the invention for which the patent is requested, but subject to subsection (4).

(3) For the purposes of an application, claims must be clear and precise and be fully supported by the description given pursuant to subsection (2); and in interpreting a claim, reference may be had to the description and any drawings contained in the application.

(4) An abstract contained in an application for a patent may not be used for the purpose of ascertaining the scope of the protection desired under the patent.

(5) An applicant for a patent

(a) who is not a citizen of Barbados or a permanent resident within the meaning of the *Immigration Act*; or

(b) who has his principal place of business outside Barbados,

must be represented by an agent admitted to practice as a patent agent in Barbados.

(6) An application under this Act for a patent for an invention may not be refused nor is any patent granted therefor invalid by reason only that an act performed in connection with the invention to which the patent relates is prohibited by law, unless that act is one that is likely to provoke a breach of the peace.

(Petition)

22.—(1) The petition for a patent of invention must contain a request that a patent be granted for the specific invention and include

(a) the name of the applicant and other prescribed information relating to the applicant;

(b) the name of the inventor of the invention and of the agent, if any, who is representing the applicant; and

(c) the title by which the invention is to be known.

(2) If the applicant for a patent is not the inventor of the invention for which the patent is requested, the petition must be accompanied by a statement justifying the applicant's right to a patent for that invention.

(3) When a petition for a patent contains a statement required under subsection (2), the Director shall send a copy of the statement to the inventor, who

(a) may inspect the application; and

(b) may, at his own expense and exclusively for his own purposes, acquire from the Director a copy of the application.

(Unity of invention)

23. An application for a patent may be made only for one invention or for one unity of invention, that is to say, one group of inventions so linked that they form a single inventive concept.

(Altering application)

24.—(1) An applicant for a patent may

(a) amend his application if the amendment does not alter the disclosure contained in his prior application; or

(b) divide his application into one or more applications, to be known as "divisional applications," if each divisional application does not go beyond the disclosure contained in the prior application.

(2) When a prior application is divided into divisional applications, each divisional application must be assigned a filing date, which, if appropriate, may be the filing date of the prior application that they replace.

(Priority claim)

25.—(1) An applicant for a patent may, pursuant to the Paris Convention, claim the priority of one or more earlier national, regional or international applications that were, in a country that is a

party to that Convention, made for that invention by the applicant or a person through whom he claims.

(2) Where an applicant for a patent claims a priority under subsection (1), the Director may require that the applicant furnish, within the prescribed period, a copy of the earlier application on which his claim is based, which must be certified as correct

(a) by the competent authority of the office in the country in which that earlier application was made; or

(b) by the International Bureau of the World Intellectual Property Organization, if the earlier application was an international application lodged under the Patent Cooperation Treaty.

(3) A claim of priority for an application under subsection (1) has effect as provided in **Article 4** of the Paris Convention.

(Non-compliance)

26.—(1) Where the Director is of the opinion that an applicant who claims priority under an earlier application pursuant to section 25 has not complied with any requirement that ought to have been complied with under that section or the regulations, the Director shall require the applicant to make such corrections as are necessary for the requirement to be complied with.

(2) If the applicant fails to file the necessary corrections to his application with the Director within the time limited therefor under subsection (1), the applicant thereupon abandons his application; and it is deemed never to have been made.

(3) Section 25 and this section come into operation on the date on which Barbados deposits, in accordance with **Article 21** of the Paris Convention, its instrument of accession to that Convention.¹

(Foreign applications)

27.—(1) An applicant for a patent shall, at the request of the Director, furnish the Director with

(a) the date and number of any other application for a patent or other title of protection made in an industrial or intellectual property office of any other country, or within a regional industrial or intellectual property office in this section called a “foreign application,” relating to the same or essentially the same invention as that claimed in the application filed with the Director;

(b) the following documents relating to foreign applications:

(i) a copy of any communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application,

(ii) a copy of the patent or other title of protection granted on the basis of the foreign application, and

(iii) a copy of any final decision rejecting the foreign application or refusing the patent requested in the foreign application;

(c) a copy of any final decision invalidating the patent or other title of protection granted on the basis of the foreign application referred to in paragraph (b);

¹ Barbados deposited its instrument of accession to the Paris Convention on December 12, 1984; the said Convention entered into force, with respect to Barbados, on March 12, 1985 (*Editor's note*).

(d) the following documents relating to a foreign application other than the one referred to in paragraph (b):

(i) a copy of any communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application and in which publications or other documents establishing the prior art are mentioned, and

(ii) a copy of any final decision rejecting the application or refusing the patent requested in the application.

(2) Documents furnished pursuant to subsection (1) may be used only for facilitating the evaluation of the novelty and inventive advance of the invention for which the patent application is being made.

(3) The applicant for a patent may submit comments on any documents furnished by him under subsection (1).

(4) This section applies to the extent only that section 31 is applicable to an application filed with the Director.

(Withdrawal)

28. An applicant for a patent may withdraw his application at any time before the patent is granted.

(Filing date)

29.—(1) The date that an application for a patent is received by the Director is, subject to this section, the filing date of the application, in this Act referred to as the filing date accorded the application by the Director, if

(a) the prescribed application fee is paid at the time of the filing of the application; and

(b) the application contains:

(i) the name of the applicant,

(ii) the name and address of the inventor, and if the applicant is not the inventor, the statement referred to in subsection (2) of section 22, as the case requires,

(iii) a part that on its face appears to be a description as required by subsection (2) of section 21, and

(iv) a part that on its face appears to be a claim as required by subsection (2) of section 21.

(2) If the Director is satisfied that, at the time an application for a patent was received by him, the requirements of subsection (1) had not been complied with, the Director shall require the applicant for the patent to make such corrections as are necessary to bring the application into compliance with those requirements.

(3) When an applicant referred to in subsection (2) complies with a request made under that subsection, the filing date accorded his application is the date on which the correction was made; but, if the applicant does not comply with the request, the applicant abandons his application, and it is deemed never to have been made.

(4) When an application for a patent makes a reference to drawings that are not included in the application, the Director shall request the applicant to furnish him with those drawings.

(5) When an applicant complies with a request made under subsection (4), the filing date accorded his application is the date on which the drawings were furnished to the Director.

(6) When an applicant fails to comply with a request made under subsection (4), the filing date accorded his application is the date the patent application was received by the Director; but the reference in that application to drawings must be disregarded.

(Form examination)

30.—(1) The Director shall examine each application for a patent of invention to determine

(a) whether subsection (5) of section 21, if applicable, has been complied with;

(b) whether the requirements concerning the petition in the application are in compliance with section 22 and the regulations;

(c) whether the requirements of subsection (2) of section 22 have been complied with, if applicable;

(d) whether the description, claims and, if applicable, drawings comply with the prescribed physical requirements for descriptions, claims and drawings; and

(e) whether the application contains an abstract.

(2) If the Director determines that any requirement mentioned in subsection (1) has not been complied with, he shall require the applicant to make such corrections in his application as are necessary to comply with that requirement; and, if an applicant fails to make the required corrections, the Director shall, subject to subsection (3), refuse to grant the patent requested by the application.

(3) If the correction required by the Director is the filing of an abstract, the Director may, upon payment of the prescribed fee, prepare the abstract for the application; but if the prescribed fee for an abstract remains unpaid after the expiration of the time prescribed for its payment, the Director shall refuse the requested patent.

(4) When a patent is refused under this section, notice of the refusal and the reasons therefor shall be communicated to the applicant by the Director as soon as practicable.

(Substance examination)

31.—(1) The Director shall examine each application for a patent of invention to determine

(a) whether the invention is an invention within the meaning of this Act;

(b) whether the invention is patentable within the meaning of sections 9 to 13;

(c) whether the invention is excluded from patentability under section 14 or 15;

(d) whether the description and the claims for the invention are in compliance with the requirements of subsection (2) of section 21, and the regulations;

(e) whether any drawings necessary for the understanding of the invention have been furnished in accordance with subsection (2) of section 21;

(f) whether the application complies with the requirements of this Act and the regulations regarding unity of invention;

(g) whether, if applicable, any amendment or any divisional application goes beyond the disclosure in the prior application as provided in section 25; and

(h) whether the application has complied with any requirement made by the Director under section 26.

(2) If the Director determines that any requirement mentioned in subsection (1) has not been complied with in respect of an application, the Director shall notify the applicant accordingly and invite the applicant to submit any comments the applicant wishes to make regarding his failure to comply with that requirement; and an invitation made to an applicant under this section may include an invitation to amend or divide the application.

(3) Where, notwithstanding any comment, amendment or division of the application submitted to the Director by the applicant, the Director is of the opinion that a requirement mentioned in subsection (1) has not been complied with, the Director may refuse to grant a patent on that application; but any refusal to grant a patent and the reasons therefor must be communicated to the applicant in writing by the Director as soon as practicable.

(4) The Minister may, by order, determine whether or to what extent the provisions of this section operate; and in the order the Minister may provide whether all or some of the provisions of this section are applicable to one or several technical fields covered by inventions; but those technical fields must be classified by reference to the International Patent Classification.

(5) The Minister may, by order, authorise a national, regional, international or foreign institution with which Barbados has an agreement for the purpose to determine whether the provisions of this section have been complied with in the case of any application made in Barbados for a patent, and to advise the Director accordingly concerning that application.

Grant of Patent

(Entitlement to patent)

32. After all the requirements of this Act have been complied with in the case of an application for a patent, the applicant is entitled, on payment of the prescribed fee, to a patent.

(Form requirements)

33.—(1) In granting a patent, the Director shall

- (a) publish a notice of the grant of the patent in the *Gazette*;
- (b) issue a patent in the prescribed form to the applicant therefor;
- (c) if applicable, make a copy of the patent available for any patent information office established by the Government; and
- (d) make copies of the patent available to any member of the public who pays the prescribed fee therefor.

(2) The effective date of a patent granted under this Act is the date that the notice of the grant of the patent is published in the *Gazette* pursuant to subsection (1).

(Duration of patent)

34.—(1) Subject to subsection (2), a patent expires 15 years from the filing date accorded the application for that patent by the Director under section 29.

(2) A patent for an invention shall be extended for a further period of five years by the Director, if the person making the request satisfies the Director

- (a) that the invention is being sufficiently used in Barbados at the date of the request; or
- (b) that there are circumstances that justify the failure to use the invention sufficiently in Barbados;

and for the purposes of paragraph (b), importation into Barbados is not to be regarded as a circumstance.

(3) The failure by the Director to refuse a request referred to in subsection (2) within six months of the receipt by him of the request constitutes an extension of the patent to which the request relates.

(4) The Director shall communicate in writing his refusal of any request for the extension of a patent to the person who made the request for the extension.

(5) When a patent has been extended pursuant to this section, the Director shall record the extension in the register and publish a notice of the extension in the *Gazette*.

(6) Within 30 days after receiving notice of the refusal by the Director of his request for an extension of a patent, the person who made the request may appeal to the High Court against the refusal.

(Surrender of patent)

35.—(1) The owner of a patent may surrender the patent by submitting to the Director a surrender in writing of that patent.

(2) A surrender under subsection (1) may be limited to one or more claims of invention in the patent to which the surrender relates.

(Saving)

36. Where a statutory licence has been issued under this Act in respect of a patent for which a surrender of patent is made under section 35, the patent may only be surrendered under that section if

(a) the owner of the patent submits to the Director a statement in writing signed by the licensee under the statutory licence that he consents to the surrender of the patent; and

(b) the Director is satisfied that circumstances exist that justify the surrender of the patent.

(Recording surrender)

37. The Director shall record a surrender of a patent in the register and publish a notice of the surrender in the *Gazette* as soon as possible, and communicate notice of the surrender to all interested persons.

(Effect of surrender)

38. The surrender of a patent takes effect on the day following the receipt by the Director of the written statement of surrender of the patent.

Part II Contractual Interest

Licence-Contracts

(Licence-contracts)

39.—(1) Subject to this Part, the owner of an application for a patent or the owner of a patent may, by a licence-contract, grant to another person or to an enterprise a licence to use the invention to which the application or patent relates.

(2) A licence-contract must be in writing and signed by the parties to the contract and it is void against persons other than the parties thereto until it is registered.

(3) Subject to this Part, a licence-contract may be registered in the register upon payment of the prescribed fee.

(4) The registration of a licence-contract relating to an invention shall be cancelled by the Director

(a) at the request of the owner of the application or patent; and

(b) on production to the Director of satisfactory evidence by the person making the request that the licence-contract has terminated.

(Further licence)

40.—(1) In the absence of a provision to the contrary in a licence-contract but subject to subsection (2), the grant of a licence to a person to use an invention in industry or commerce does not prevent the grantor of the licence

(a) from granting further licences to other persons to use the invention; or

(b) from using the invention himself.

(2) If the licence-contract provides that the licence granted under it is an exclusive licence, the grantor of the licence may not

(a) grant further licences to other persons to use the invention to which the licence-contract relates; or

(b) in the absence of a provision in the licence-contract to the contrary, use that invention himself.

(Licensee right)

41. In the absence of a provision to the contrary in the licence-contract, the licensee may, while he is a registered licensee under the contract, exercise in Barbados; in relation to the invention to which the licence-contract relates, all the rights vested under this Act in respect of that invention, including the right to apply for an extension of the patent.

(Transfers)

42.—(1) Unless the licence-contract otherwise provides, a licence under a licence-contract is not transferable nor may a licensee thereunder grant a sub-licence.

(2) When a licensee under a licence-contract has authority thereunder to transfer his licence or to grant a sub-licence, sections 39 to 41 and section 43 apply to the transfer or sub-licence.

(Royalties abroad)

43. When, in the economic interests of Barbados, the Minister of Finance so provides by order

(a) licence-contracts requiring payment of royalties abroad, or such classes thereof as are described in the order; and

(b) changes or renewals of the licence-contracts referred to in paragraph (a),
have no effect in Barbados without the approval in writing of the Minister of Finance.

(Special contract)

44. In sections 45 to 56,

(a) “contract” means

(i) a licence-contract,

(ii) a know-how contract, that is to say, an agreement by which one party to the agreement undertakes to communicate technical information, data or knowledge resulting from experience or skills that are practical, particularly to industry, to another party to the agreement for the use of that other party; the first party being the “supplier” and the second party being the “recipient” under the agreement,

(iii) any agreement whereby an application for a patent or a patent is transferred from one person to another,

(iv) any agreement having substantially the same effect as any transaction referred to in subparagraphs (i) to (iii) or modifying any agreement or part of any agreement referred to in any of those sub-paragraphs;

(b) “technology” means an invention claimed in an application for a patent or in a patent, any know-how within the meaning of a know-how contract, or both invention and know-how;

(c) “transferor” includes the supplier of know-how, and “transferee” includes the recipient of know-how.

(Registration)

45. Except as otherwise provided in this Act or the regulations, a contract has no effect unless it is registered in accordance with this Part.

(Director’s duty)

46. The Director shall, without fee, give advice any person seeking to apply or applying for the registration of a contract regarding the acceptability for registration of the contract or any draft of the contract.

(Staff)

47. An employee of the Industrial Property Office is, during the period of his employment in that office and for one year thereafter, disqualified from being a transferor or a transferee under a contract.

(Know-how contracts)

48.—(1) A know-how contract must be in writing, must be signed by the parties thereto and must identify the know-how to be communicated by indicating the objective to be attained by the use of the know-how.

(2) A know-how contract that is not in compliance with subsection (1) is not enforceable.

(Requirements)

49.—(1) No contract may be registered in the register unless

(a) it is in the English language; and

(b) it is submitted to the Director together with an application for its registration in the register.

(2) In submitting an application to have a contract registered, the parties to the contract must jointly submit both the contract and the application.

(3) If any applicant under this section is not a citizen or a permanent resident of Barbados within the meaning of the *Immigration Act*, or has his principal place of business outside Barbados, he must be represented on the application by an agent who permanently resides in Barbados.

(4) An application for the registration of a contract must be accompanied by the prescribed fee and must contain a request to have the contract registered, which must contain the names of the applicants and any other prescribed information relating to the applicants or the contract.

(Form examination)

50.—(1) The Director shall examine each application for registration of a contract and each contract submitted to him for registration to determine whether the requirements of subsections (1) to (3) of section 49 have been complied with.

(2) When, after an examination of an application for registration of a contract, the Director is satisfied that the requirements of the provisions referred to in subsection (1) have not been complied with in respect of the contract, the Director shall refuse to register the contract.

(3) In addition to examining an application for registration of a contract under subsection (1), the Director shall examine the contract submitted with the application to determine if the contract is in writing and signed by the parties to the contract and if subsection (4) of section 49 has been complied with; and if the Director is not satisfied that those requirements have been complied with, the Director shall

(a) request the applicants to furnish such corrections as are necessary to comply with the requirements of those provisions; and

(b) refuse to register the contract if the applicants fail to comply with his request under paragraph (a).

(4) A refusal to register a contract must be in writing and contain a statement of the reasons for the refusal; and the Director shall give notice of his refusal to register to the applicants for registration.

(5) When, after an examination of an application for the registration of a contract and the contract, the Director is satisfied that the requirements of subsections (1) to (3) of section 49 have been complied with, the Director shall issue to the applicants for registration a receipt attesting that the application for registration has been made and indicating the filing date of the application.

(6) For the purposes of subsection (5), the filing date of an application for registration of a contract is the date on which the application was received at the Industrial Property Office.

(Frustration)

51.—(1) If, before the expiration of a licence-contract, any of the following events occur in relation to the application for a patent or to the patent to which the licence-contract relates, namely:

(a) the application for the patent is withdrawn;

(b) the application for the patent is rejected and any appeals have failed;

(c) a grant of patent is refused and any appeals have failed; or

(d) the patent is declared invalid by an order of the High Court and any appeals have failed;

the licensee under the licence-contract is from the date of that event relieved from any obligations to make payments directly relating to the application for the patent or the patent.

(2) When an event described in subsection (1) occurs with respect to an application or patent, the licensee under a licence-contract related to the application or patent is entitled to repayment from the licensor under that contract of all payments made to the licensor if the licensee has not substantially benefitted from the licence-contract.

(Substance examination)

52.—(1) The Director shall examine every contract submitted for registration to the Industrial Property Office to determine whether the contract contains any condition the effect of which would be

(a) to bring about the importing of technology from outside Barbados when equivalent or substantially similar technology is obtainable in Barbados on the same or more favourable conditions without importing it from abroad;

(b) to oblige the transferee to give consideration that is disproportionate to the value of the technology to which the contract relates;

(c) to oblige the transferee to acquire any materials from the transferor or from sources designated or approved by the transferor;

(d) to restrict the freedom of the transferee to acquire materials from any source;

(e) to restrict the freedom of the transferee to use materials that are not supplied by the transferor or by sources designated by or approved by the transferor;

(f) to oblige the transferee, exclusively or principally, to sell the products produced by him to persons designated by the transferor;

(g) to oblige the transferee to make available to the transferor, without appropriate consideration, any improvements made by the transferee with respect to the technology to which the contract relates;

(h) to limit the quantity of the products produced by the transferee;

(i) to restrict the freedom of the transferee himself to export the products produced by him or to restrict his freedom to allow others to export those products;

(j) to oblige the transferee to employ persons designated by the transferor and not needed for the efficient transfer of the technology to which the contract relates;

(k) to impose restrictions on research or technological development that is carried on by the transferee;

(l) to restrict the freedom of the transferee to use technology other than the technology to which the contract relates;

(m) to extend the coverage of the contract to technology not required to achieve the objective of the contract and to oblige the transferee to give consideration for that technology;

(n) to fix prices for the sale or resale of products produced by the transferee;

(o) to exempt the transferor from any liability resulting from any defect inherent in the technology to which the contract relates or unreasonably to restrict any such liability;

(p) to restrict the freedom of the transferee, after the expiration of his contractual obligations, to use the technology acquired as a result of the contract; or

(q) to establish the duration of the contract for a period that is unreasonably long in relation to the economic function of the contract.

(2) If the Director is satisfied that a contract submitted to him for registration contains a condition that would have any of the effects referred to in subsection (1), the Director shall so inform the applicants and request them to remove or appropriately modify that condition or to justify its presence in the contract as not being harmful to the economic interests of Barbados.

(3) The presence in a contract of a condition described in subsection (2) is not harmful to the economic interests of Barbados if the contract, taken as a whole, is not harmful to those interests; and, in particular,

(a) a condition that would produce the effect referred to in paragraph (c) of subsection (1) is not harmful if it would be otherwise impossible, for all practical purposes, to ensure the quality of the products to be produced, and the materials in question, if supplied as required by the contract, are at a reasonable price;

(b) a condition that would produce the effect referred to in paragraph (d) or (e) of subsection (1) is not harmful if it would be otherwise impossible, for all practical purposes, to safeguard the quality of the products produced; and

(c) a condition that would produce the effect referred to in paragraph (i) may be treated as not being harmful if

(i) the transferor owns, in a country to which the restriction applies, a patent that would be infringed by importing the product into that country,

(ii) the transferor has a contractual obligation not to allow other persons to export the products into the other country,

(iii) the transferor already supplies the market in the other country with the same products as those being produced by the transferee.

(4) A restriction of the kind referred to in paragraph (p) of subsection (1) must be considered in relation to the right of the transferor under a patent; and, in the case of paragraph (q) of that subsection, a period that does not exceed the duration of the patent to which the contract relates must not be regarded as unreasonably long.

(5) This section comes into operation on such day as the Minister, by order, determines, and any reference to this section in any other provision of this Act has effect from such day as the Minister, by order, determines.

(Registration)

53.—(1) When, in respect of a contract, the Director is satisfied that the requirements of sections 49 and 50 have been complied with and

(a) that the contract does not contain any of the conditions referred to in subsection (1) of section 52; and

(b) that the presence in the contract of any condition referred to in subsection (1) of section 52 is justified, the Director shall register the contract, issue a certificate of registration to the applicants and publish a notice of the registration in the *Gazette*.

(2) A contract for which an application for registration has been made must be regarded as registered; and the Director shall issue a certificate of registration for the contract, if

(a) after the expiration of three months from the date that the application for registration of the contract was received in the Industrial Property Office, no request had been sent to the applicants under paragraph (a) of subsection (3) of section 50 or section 52; or

(b) within three months from the date of the receipt by the Industrial Property Office of a response from the applicants to a request sent to them under paragraph (a) of subsection (3) of section 50 or section 52, no new request has been sent to the applicants.

(3) A contract is registered when there is recorded in the register

- (a) the names and addresses of the applicants;
- (b) the registration number of the patent, if applicable;
- (c) the technology relating to the contract;
- (d) the date of the application for registration; and
- (e) the date of registration and the registration number.

(4) Both the certificate of registration and the publication required under subsection (1) must contain the information recorded in the register under subsection (3).

(5) If the contract is a licence-contract, the registration must include a record of the information required to be recorded by the regulations.

(Refusal to register)

54.—(1) If, after he has followed the procedure required of him under subsections (1) and (2) of section 52, the Director is satisfied that the contract for which registration is sought still contains a condition described in that section that is not justified, the Director shall refuse to register the contract.

(2) A refusal to register a contract must be in writing and must contain the reasons for the refusal; and the Director shall give notice to the applicants of his refusal to register the contract.

(Appeal)

55. Applicants who are aggrieved by the refusal of the Director to register a contract may, within 30 days from the receipt of notice by them of the refusal, appeal against that decision to the High Court.

(Saving contract)

56. Contracts that are in effect at the commencement of this Part continue in effect for two years from the commencement of this Part unless an application for registration of that contract is made to the Director under this Part within that time and the contract is registered under this Part.

Part III Non-Contractual Licences

Statutory: National

(National licence)

57.—(1) When the use within Barbados of an invention protected by patent is, in the opinion of the Minister, necessary in the interests of national security, national health or national nutrition or the development of an essential sector of the economy of Barbados or for other public interests, the Minister may, without the consent of the owner of the patent for that invention but subject to the payment of a reasonable amount for its use, issue by order a national licence for the use of the invention in Barbados by the Crown, by a government agency or by any person named in the order.

(2) For the purposes of this section, “use” includes, in this section, the importing of the invention into Barbados.

(Procedure)

58.—(1) Before the Minister issues a licence under section 57,

(a) the views of the Director must be obtained regarding the use of the invention;

(b) the owner of the patent for the invention must be notified of the Minister’s intention to issue a national licence regarding the use of that invention in Barbados; and

(c) if a statutory licence has been issued in respect of that invention, the holder of the statutory licence must also be notified.

(2) All persons who have been notified under subsection (1) shall, together with any other persons whose participation the Minister considers desirable, be invited by the Minister to a hearing concerning the issue of a national licence for use in Barbados of the invention referred to in section 57.

(Licence issue)

59.—(1) At the conclusion of the hearing mentioned in section 58, the Minister may make the order issuing a national licence in respect of the invention concerned and, separately, give in writing his reasons for so doing.

(2) When a national licence is issued under subsection (1), the Director shall fix the amount payable to

(a) the owner of the patent for the invention; and

(b) any exclusive licensee under a licence-contract relating to that invention whose rights are affected by the issuing of the national licence or the conditions of payment of the fixed amount, or both; and in fixing the amount of the payment the Director shall have regard to the extent that the invention is used in Barbados and elsewhere.

(3) Upon the issuing of a national licence in respect of an invention, the Director shall

(a) record in the register

(i) the order of the Minister issuing the national licence,

(ii) the amount fixed by the Director to be paid for the invention to the owner of the patent and any exclusive licensee,

(iii) the conditions of payment of the amounts referred to in sub-paragraph (ii);

(b) notify the owner of the patent and other participants in the hearing held by the Minister under section 58 of the issue of the national licence; and

(c) publish a notice of the issue of the national licence for the invention in the *Gazette*.

(Appeal)

60.—(1) No appeal lies against the Minister for issuing a national licence under this Act.

(2) At the instance of the owner of the patent for the invention for which a national licence has been issued or at the instance of an exclusive licensee under a licence-contract relating to the invention, an appeal lies to the High Court

- (a) against any amounts fixed by the Director as the payments to be made to the owner of the patent or to the licensees of the exclusive licence as a result of the issue of the national licence; and
- (b) against the conditions of payment of the amounts so fixed by the Director.

(3) An appeal pursuant to subsection (2) does not affect the use, under the national licence, of the invention in relation to which the appeal is made.

Statutory: General

(Requests for licences)

61.—(1) In this section and sections 62 and 63, “request” refers to a request for a statutory licence under a patent.

(2) A request must be made to the Director and must contain

(a) the name and address of the person making the request together with the prescribed information concerning him;

(b) the registration number of the patent in reference to which the statutory licence is requested; and

(c) a statement of the grounds on which the request is based.

(3) When the request is made under section 63, the request must contain the registration number of the patent owned by the person making the request.

(4) A request must have attached thereto evidence that the person making the request has asked the owner of the patent for a licence to use the invention protected by the patent in Barbados but has been unable to obtain a licence therefor on reasonable terms or within a reasonable time.

(Statutory licences in cases of non-use or insufficient use)

62.—(1) Where an invention for which a patent has been issued is not used in Barbados or is insufficiently used in Barbados, if

(a) a period of four years from the filing date accorded the application for a patent for the invention has expired; or

(b) a period of three years from the grant of a patent for the invention has expired, whichever is the later period, the Director may grant a licence to use the invention in Barbados to any person who requests such a licence to use the invention and satisfies the Director that the applicant can use the invention in Barbados.

(2) The Director may not grant a licence under this section if he is satisfied that circumstances exist that justify the non-use or insufficient use in Barbados of the invention.

(3) For the purposes of subsection (2), importation is not a circumstance that justifies the non-use, or insufficient use, of the invention in Barbados.

(Statutory licences in cases of necessity)

63.—(1) Where

(a) an invention that is claimed by a later patent cannot be used in Barbados without infringing an earlier patent granted on the basis of an application benefitting from an earlier filing or, if appropriate, an earlier priority date; and

(b) the invention claimed in the later patent is an important technical advance in relation to the invention protected by the earlier patent, the Director may, at the request of the owner of the

later patent, the licensee under a licence-contract relating to the later patent or a licensee under a statutory licence under the later patent, grant a statutory licence to the extent necessary to prevent infringement of the earlier patent.

(2) When a statutory licence is granted under subsection (1), the Director may, upon the request of the owner of the earlier patent, a licensee under a licence-contract relating to the earlier patent, or a licensee under a statutory licence under the earlier patent, grant a statutory licence under the later patent.

(Fees)

64. A statutory licence may not be issued unless the prescribed fee accompanies the request for the licence.

(Procedure)

65.—(1) The following procedure applies in the issuing of a statutory licence, namely:

(a) upon receiving a request for a statutory licence, the Director shall examine the request to determine whether the requirements of section 61 and the regulations have been complied with;

(b) if the requirements mentioned in paragraph (a) have not been complied with in connection with a request, the Director shall inform the person making the request of the non-compliance and ask him to make such corrections as are necessary for those requirements to be complied with;

(c) a request shall be rejected if it is not in compliance with the requirements of section 61 or the regulations and the necessary corrections have not been made pursuant to paragraph (b);

(d) if a request is rejected, the Director shall in writing inform the person making the request of the rejection and give him the reasons therefor;

(e) if the requirements of section 61 have been complied with, the Director shall notify the owner of the patent to which the statutory licence relates of the request and of the evidence accompanying the request; and the Director shall invite the owner to make any comments that he wishes to make concerning the matter of the request;

(f) upon being notified under paragraph (e) of a request relating to his patent, the owner of the patent shall notify any licensees of the patent of the request, and the licensees may make any comments to the Director concerning the matter of the request that they wish to make;

(g) the Director shall give, to the licensees under any statutory licences or national licences relating to the invention in respect of which the request has been made, notice of the request and of the evidence accompanying the request; and those licensees may make any comments they wish to the Director concerning the request;

(h) the Director shall notify the person making the request of any comments made under paragraph (e), (f) or (g);

(i) the Director shall, at the instance of an interested person, conduct a hearing to which the person making the request, the owner of the patent for the invention concerned and the persons who made comments under paragraph (f) or (g) must be invited to attend;

(j) the Director

(i) shall issue the statutory licence, if he is of the opinion that the conditions governing the issue of a statutory licence have been complied with, or

(ii) shall refuse to issue a statutory licence if he is of the opinion that the conditions governing the issue of a statutory licence have not been complied with, and the Director shall notify all persons concerned of his determination of the request.

(2) The instrument by which a statutory licence is issued must indicate

(a) the scope of the statutory licence;

(b) the period for which the statutory licence is issued;

(c) the specific uses to which the statutory licence extends, exclusive of importation;

(d) the period within which the licensee under the statutory licence must begin to use the patented invention in Barbados; and

(e) the amount of the payment due by the licensee under the statutory licence to the owner of the patent of invention to which the licence relates and to any person whose rights are affected under paragraph (c) of section 69, and the conditions of payment thereof; the amount of the payment to be determined after having regard to the extent to which the invention is used.

(3) The instrument by which a statutory licence is issued must be in writing and contain the grounds on which its issue is based.

(4) The instrument by which a statutory licence is issued shall be

(a) recorded in the register and published in the *Gazette* by the Director; and

(b) communicated by the Director to the person making the request for the licence, the owner of the patent to which the licence relates and any other persons invited to the hearing referred to in paragraph (i) of subsection (1).

(5) The periods limited for the performance of any acts under this section are those prescribed by the regulations.

(Time for appeal)

66. A person aggrieved by a determination of the Director under section 65 may, within 30 days from receiving notice of the determination of the Director, appeal to the High Court.

(Licence rights)

67.—(1) The licensee under a statutory licence may in Barbados use the invention to which the licence relates.

(2) The right to use an invention under a statutory licence under subsection (1) is subject to the limits imposed on its use by the instrument by which the licence is issued.

(Obligations)

68. The licensee under a statutory licence in respect of an invention

(a) shall begin to use the invention in Barbados within the period fixed therefor in the instrument by which the licence is issued and, if the statutory licence was issued under section 62, shall make sufficient use of the invention in Barbados thereafter;

(b) shall, while using the invention, not exceed the scope of the statutory licence as fixed in the instrument by which the licence is issued; and

(c) shall make the payment, when due, as set out in the instrument by which the licence is issued.

(Effect of licence)

69. The issue of a statutory licence

(a) does not exclude the right of the owner of the invention to which the statutory licence relates to grant a licence-contract in respect of that invention;

(b) does not affect any non-exclusive licence-contract in force respecting the invention to which the statutory licence relates;

(c) does not deprive an exclusive licence-contract of its exclusive nature except only with regard to the statutory licence and to the extent of the statutory licence;

(d) does not affect any other statutory licence in force when it is issued; and

(e) does not exclude the use under a national licence of the invention to which the statutory licence relates.

(Transfers)

70.—(1) The licensee under a statutory licence may not enter into any contract with any other person regarding the invention to which the statutory licence relates.

(2) A statutory licence may only be transferred with the business establishment of the licensee under the statutory licence or with the part of that business establishment within which the invention to which the statutory licence relates is being used; but such a transfer of a statutory licence must first be authorised by the Director.

(3) For the purposes of an authorisation under subsection (2), either the licensee under the statutory licence or the person to whom the licence would be transferred with or as part of the business establishment of the licensee may apply to the Director for his authorisation to the transfer.

(4) Before authorising the transfer of a statutory licence under this section, the Director shall afford the owner of the patent for the invention to which the statutory licence relates and other interested persons an opportunity to be heard and to make any comments they wish to make.

(5) Any decision of the Director under this section must be in writing; and he shall publish the decision in the *Gazette* and communicate it to all the persons referred to in subsections (3) and (4).

(6) A person mentioned in subsection (5), if aggrieved by the decision of the Director, may, within 30 days from the date the decision is communicated to him, appeal to the High Court.

(Effect of transfers)

71. The transfer of a statutory licence under section 70 divests the former licensee under the statutory licence of all his rights and obligations under that licence, and vests those rights in, and imposes those obligations upon, the transferee.

(Amendment and revocation, etc.)

72.—(1) To the extent that any new facts brought to his attention require, the Director may amend any decision earlier made by him regarding the issuing of a statutory licence, if he is requested to do so by

(a) the owner of the patent for the invention that is relevant to the Director's decision;

(b) the licensee under the statutory licence; or

(c) the person whose request for the statutory licence has been refused by the Director under subsection (1) of section 65.

(2) At the request of a person referred to in subsection (1), the Director may revoke a statutory licence, if

(a) the reasons for issuing the statutory licence no longer exist;

(b) the licensee under the statutory licence does not, within the time limited therefor in the statutory licence, use, in Barbados, the invention to which the licence relates or make substantial preparations for its use in Barbados;

(c) in the case of a statutory licence issued under section 62, the licensee under the licence has not, after the expiration of the time limited referred to in paragraph (b), used the invention to which the licence relates;

(d) the licensee under the statutory licence exceeds in the use of the patented invention to which the licence relates the scope of the licence as fixed in the instrument by which the licence is issued; or

(e) the licensee under the statutory licence is in arrears in payment of any amount due under the instrument by which the licence is issued.

(3) Notwithstanding subsection (2), the Director may not revoke a statutory licence if he is satisfied that circumstances exist that would justify continuing the statutory licence; and, in particular, the Director may not revoke a statutory licence under paragraph (a) of subsection (2) if the licensee under the licence is using in Barbados the invention to which the licence relates or has made substantial preparations towards using the invention in Barbados.

(4) Sections 61, 64, 65 and 66 apply, with such modifications as the circumstances require, to the amendment and revocation of a statutory licence.

(5) The licensee under a statutory licence may surrender the licence by making a submission in writing to that effect to the Director.

(6) Upon receipt of a surrender of a statutory licence under subsection (5), the Director shall record the surrender in the register and publish a notice of the surrender in the *Gazette*, and communicate a copy of the notice to the owner of the patent for the invention to which the surrendered licence related.

(7) A surrender of a statutory licence has effect from the date on which the Director receives the written surrender of the licence.

Part IV Legal Remedies

Protective Measures

(Appeals)

73.—(1) An applicant for a patent may appeal to the High Court against any of the following acts of the Director, namely:

(a) the according of a filing date under section 29 for his application;

(b) the treating of his application as though it had never been made;

(c) the taking of a claim of priority as never having been made; and

(d) the rejecting of his application or the refusal to grant him a patent in response to his application.

(2) An appeal to the High Court under this Act may be brought by a notice of motion.

(Civil remedies)

74.—(1) Subject to **section 5** of the *Crown Proceedings Act*, when a right under this Act of any person is infringed, that person may institute legal proceedings in the High Court to recover any damages sustained by him as a result of that infringement, whether or not any person has been prosecuted, successfully or otherwise for that infringement.

(2) A person whose exclusive rights under section 5 are in imminent danger of being infringed or are being infringed may institute proceedings in the High Court

(a) for an injunction to prevent the infringement or to prohibit the continuation of the infringement; or

(b) for damages for the infringement.

(Saving)

75.—(1) An injunction issued pursuant to section 74 does not deprive the person whose rights were affected of any damages that he is entitled to be awarded for any loss sustained by him as a result of an infringement or imminent infringement of his rights under this Act.

(2) A defendant in proceedings instituted under section 74 to protect a patent may, in those proceedings, apply to the court for an order declaring the patent invalid; and subsections (2) to (5) of section 79 and sections 80 and 81 apply to the proceedings as it relates to the application of the defendant.

(Transfer by Court)

76.—(1) Subject to subsection (2), when the essential elements of an invention claimed in an application for a patent under this Act or in a patent of invention granted under this Act are derived from an invention for which the right to a patent of invention is vested in a person other than the applicant or the owner of the patent, that other person may apply to the High Court for an order transferring to him the application or patent, as the case requires.

(2) An application under subsection (1) may not be brought after the expiration of five years from the date of the grant under this Act of a patent for the invention containing essential elements derived from the other invention.

(Licensee's rights)

77.—(1) A licensee may in writing request the owner of a patent for the invention to which the licence relates to institute, within a period of 90 days from the receipt by him of the request, any necessary legal proceedings in respect of any infringement or imminent infringement of the patent.

(2) A request under subsection (1) must contain a statement of the relief desired.

(3) Subject to subsection (5), if the owner of the patent who receives a request under subsection (1) fails to institute legal proceedings within the time limited therefor by that subsection, the licensee who made the request may, unless the instrument that created the licensee relationship otherwise provides, institute those proceedings in his own name after notifying the owner of the patent of his intention to do so.

(4) The owner of a patent may join in any legal proceedings instituted under subsection (3) by a licensee in respect of that patent; but the licensee is liable to the owner of the patent for any damages that the owner sustains as a result of any unwarranted legal proceedings instituted by the licensee.

(5) When a licensee institutes legal proceedings in his own name under this section, he must prove to the court that the owner of the patent to which the proceedings relate failed within the time limited therefor by subsection (1) to institute legal proceedings.

(Judicial aid)

78.—(1) Subject to subsection (2), the High Court may, before the expiration of the period of 90 days referred to in section 77, grant an injunction to a licensee, in respect of the patent for the invention to which the licence relates, to prevent infringement or to prohibit further infringement of the patent.

(2) In making an application to the High Court under subsection (1), the licensee must prove that

(a) immediate action is necessary to prevent substantial damage from the infringement of the patent in respect of which the application is made; and

(b) the owner of the patent of invention had been requested to institute legal proceedings and had failed to do so.

Other Proceedings

(Invalidation)

79.—(1) Any interested person may institute proceedings in the High Court to have a patent declared invalid.

(2) In any proceedings under subsection (1), the court may declare a patent invalid

(a) if any of the requirements mentioned in paragraphs (a) to (e) of subsection (1) of section 31 had not been complied with at the time the patent was granted; or

(b) if,

(i) the right to the patent does not belong to the person to whom the patent was granted, or

(ii) the patent had not been assigned to the person who has the right to the patent.

(3) If in any proceedings under subsection (1), the court is satisfied that only a part of the claim of invention or some of the claims of invention under the patent ought to be invalidated, the court may declare the patent invalid in respect only of that part of the claim of invention or in respect only of those claims of invention.

(4) When a part only of a claim of invention is declared invalid by the court, the declaration acts as a corresponding limitation on the claim set out in the patent to which the declaration relates.

(5) In any proceedings under subsection (1), the court may require the owner of the patent for which the order of invalidity is sought to submit to the court for examination any publication or other document showing the prior art referred to

(a) in connection with the application for the patent under this Act;

(b) in connection with an application for any title of protection lodged for the same or substantially the same invention by the owner of the patent with any other national or regional industrial property office; or

(c) in connection with any proceedings relating to the patent or other title of protection granted as a result of an application referred to in paragraph (a) or (b).

(Notice of invalidation proceedings)

80.—(1) The owner of the patent for an invention for which a declaration of invalidity is sought shall give notice of the proceedings for the declaration of invalidity to all licensees under any licence-contracts relating to the invention; and any of those licensees may join in the proceedings in the absence of any provision to the contrary in their licence-contracts.

(2) The person who institutes proceedings to have a patent for an invention declared invalid shall give notice of the commencement of the proceedings, to all the holders of statutory licences relating to that invention; and any holder of a statutory licence relating to that invention may join in the proceedings.

(3) When the person instituting proceedings to have a patent declared invalid does so on any ground described in paragraph (b) of subsection (2) of section 79, he shall give notice of the commencement of the proceedings to the person with the right to the patent.

(Effect of invalidity)

81. When a patent, a part of a claim of invention in a patent or some of the claims of invention in a patent are declared invalid pursuant to proceedings under section 79, the patent, part or invention, as the case requires, is thereupon invalid with effect from the date of the impugned grant of patent.

(Preventive act)

82.—(1) Where, in respect of any act he is performing or intending to perform with any product or process, a person is threatened with any infringement proceedings of a civil or criminal nature under this Act by any other person, he may institute proceedings in the High Court against that other person for a declaration that the acts performed, being performed or to be performed with that product or process did not, do not or will not constitute infringement of any patent of interest to that other person.

(2) If a person who institutes proceedings under subsection (1) satisfies the court that the acts that he performed, that he is performing or that he intends to perform with any product or process did not, do not or will not infringe any rights in respect of any patent of interest to the person who threatened him with infringement proceedings under this Act, the court may

(a) award him damages for any economic loss he has sustained as a result of the threatened infringement proceedings; and

(b) grant him an injunction restraining the person who threatened the infringement proceedings from further similar threats in relation to the product or process concerned.

(3) For the purpose of this section, notifying a person of the existence of a patent in respect of a product or process and directing his attention to the legal consequences of an infringement of a patent do not constitute a threat of infringement proceedings.

(4) Proceedings may not be instituted under this section by a person threatened by infringement proceedings in respect of a product or process after the expiration of five years from the day on which the last threat to institute infringement proceedings in respect of that product or process was made.

(Validation)

83.—(1) Subject to subsection (5), any interested person may institute proceedings in the High Court against an owner of a patent for an order declaring that the performance of a specific act does not constitute an infringement of that patent.

(2) When proceedings are instituted under subsection (1), the owner of the patent for the invention in respect of which the proceedings have been instituted shall give notice of the

commencement of those proceedings to any licensees under any licence-contracts related to the invention; and a licensee under any such licence-contract may join in those proceedings.

(3) The person who institutes proceedings under subsection (1) in respect of a patent for an invention shall give notice of the commencement of those proceedings to the licensees under any statutory licence or national licence related to the invention; and a licensee under any such licence may join in those proceedings.

(4) Proceedings instituted under subsection (1) may be combined with proceedings to have the patent declared invalid; but a defendant in any infringement proceedings under this Act may not institute proceedings under subsection (1) in respect of the act that is the subject of the infringement proceedings.

(5) Upon being satisfied, after the conclusion of proceedings instituted under subsection (1), that the specific act does not constitute an infringement of the patent to which the proceedings relate, the court may make an order to that effect.

(Other appeals)

84. When any person is aggrieved by any decision or act of the Director, that person may, within the time provided by a provision of this Act therefor or within 30 days from the day he became aware of the decision or act, in any other case, appeal against the decision or act to the High Court.

Communication of Results

(Copy of court decision)

85. The Registrar of the Supreme Court shall, on the determination of any appeal to the High Court under this Act, send a certified copy of the court's decision to the Director; who shall

(a) record the decision in the register in the appropriate place or file;

(b) publish a notice of the decision in the *Gazette*; and

(c) communicate the decision to the interested owner of the patent, applicant for a patent, licensee, transferor, transferee and to any other person to whom the decision is relevant, as the circumstances require.

Criminal Activity

(Offence)

86.—(1) No person shall knowingly infringe any right vested in any other person under this Act.

(2) A person who contravenes subsection (1) is guilty of an offence and liable on summary conviction

(a) to a fine of \$10,000 or to imprisonment for a term of two years, or to both; and

(b) in the case of a continuing offence, to a further fine of \$1,000 a day for each day or part of a day on which the offence continues.

(Limitation)

87. A prosecution for an offence under section 86 may be brought at any time within five years from the date the offence, or the day on which the last of any continuing offence, as the case requires, was committed.

Part V Administration

The Register

(Register)

88.—(1) The Director shall maintain a Register of Patents and record therein

(a) all applications for patents accorded a filing date under section 29;

(b) all patents granted under this Act; and

(c) all transactions required by this Act to be recorded in connection with each application for a patent referred to in paragraph (a) and each patent granted under this Act.

(2) The applications for patents must be recorded in the register in the order in which they are accorded a filing date under section 29.

(3) A contract within the meaning of Part II must be recorded in a separate section of the register reserved for registration of contracts.

(Inspection)

89.—(1) The register is a public record and may be inspected during business hours by any member of the public free of charge.

(2) An inspection of the register includes making copies or extracts therefrom, but, on payment of the prescribed fee therefor, extracts or copies of any records in the register may be obtained from the Director.

(3) Notwithstanding subsections (1) and (2), a file in the register that relates to a contract within the meaning of Part II may only be examined, or an extract made therefrom, on the written permission of one of the parties to the contract and upon payment to the Director of the prescribed fee therefor.

(Secrecy)

90.—(1) No employee of the Industrial Property Office shall, whether during his period of employment or thereafter,

(a) communicate information obtained in his capacity as an employee of that office to a person not entitled to the information;

(b) disclose information referred to in paragraph (a) to the public; or

(c) make use of the information for his personal gain in a manner that is not related to his duties in the office.

(2) A person who contravenes subsection (1) is guilty of an offence and liable on summary conviction to a fine of \$1,000 or to imprisonment for a term of 12 months, or to both.

(Annual fees)

91.—(1) Beginning with the second year after the filing date accorded an application for a patent under section 29, an annual fee must be paid to the Director before the end of each year in order to preserve the application or patent, as the case requires.

(2) The annual fee under subsection (1) is the fee prescribed therefor, but the fee must be so prescribed that it increases proportionately with the number of years in which it is paid.

(3) This section does not prevent several annual fees being paid in advance in one year in respect of any one application or patent.

(4) A six-month period of grace for the payment of an annual fee under this section shall be allowed by the Director upon the payment of a prescribed surcharge for late payment of the annual fee.

(5) When an annual fee for an application for a patent or for a patent is not paid as required by this section, including any surcharge, if applicable,

(a) the application is presumed to have been withdrawn; or

(b) the patent is presumed to have been surrendered,

with effect from the expiration of the period of grace under subsection (4); and the Director shall make such publications and give such notice of the presumed withdrawal or surrender as he would be required to do had the application been withdrawn or the patent surrendered in the ordinary manner.

(Disclosure obligation)

92. An applicant for a patent and the owner of a patent for an invention under this Act shall

(a) disclose the invention in a clear and complete manner and, in particular, indicate the best method for the use of the invention as required by paragraph (b) of subsection (2) of section 21;

(b) give information, if applicable, regarding corresponding foreign applications and patents or other titles of protection relating to the invention as required by section 27;

(c) use the invention in Barbados within the periods mentioned in paragraph (a) or (b) of subsection (1) of section 62; and

(d) pay to the Director such fees in relation to the application or patent as are required or prescribed under this Act.

(Register change)

93.—(1) When a change occurs in the ownership of an application for a patent or in a patent, the change shall, upon payment of the prescribed fee, be recorded in the register by the Director.

(2) A change described in subsection (1) has no effect against any person other than the parties to the change until the change is recorded in the register.

(3) The Director shall publish in the *Gazette* every change described in subsection (1), when it is reported to him in the prescribed manner.

Miscellaneous

(Communications)

94.—Unless otherwise provided by this Act, any communication with an applicant for a patent under this Act, an owner of a patent under this Act, a licensee, or an agent of any of them, may be validly made by sending the communication to his address, or to his address for service, in Barbados, as recorded in the register.

(Reciprocity)

95. The Minister may, by order, provide for reciprocal treatment in relation to applications for patents and for patents to be given to any country that provides, for applications for patents filed in Barbados and patents granted in Barbados, protection similar to the protection given by this Act.

(Fees to Fund)

96. All payments received by the Director pursuant to this Act shall be paid by him into the Consolidated Fund.

(Expenses)

97. All expenses incurred in the administration of this Act are to be defrayed out of the money provided by Parliament for that purpose.

(Regulations)

98. The Minister may make regulations to provide for any matters required to be prescribed or provided for by this Act, and, generally, for the efficient operation of this Act.

(Repeal of Cap. 310 and amendment of Cap. 197)

99.—(1) Subject to subsection (2), the *Patents Act* is repealed.

(2) Notwithstanding its repeal under subsection (1), the *Patents Act* continues in force for

(a) patents granted in Barbados before the commencement of this Act; and

(b) applications for patents under that Act that were filed in Barbados before the commencement of this Act, but patents granted under that Act may only be renewed pursuant to this Act.

(3) **Section 5** of the *Crown Proceedings Act* is amended by deleting the words, “section of *Patents Act*” and substituting therefor the words, “**section 18** of the *Patents Act, 1981*.”

(Binding Crown)

100. This Act is binding on the Crown.

(Commencement)

101. Subject to

(a) subsection (4) of section 31;

(b) subsection (5) of section 52; and

(c) subsection (2) of section 99,

this Act comes into operation on a day to be fixed by proclamation.