

1998

INDUSTRIAL DESIGNS

ACT 2

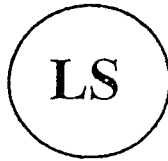
COMMONWEALTH OF DOMINICA

ARRANGEMENT OF SECTIONS

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I assent



C.A. SORHAINDO
President.

22nd April, 1998.

AN ACT TO PROVIDE FOR THE PROTECTION OF INDUS-
TRIAL DESIGNS IN DOMINICA, AND FOR MATTERS
RELATED THERETO.

(Gazetted 30th April, 1998).

BE IT ENACTED by the Parliament of the Commonwealth of
Dominica as follows:

1. This Act may be cited as the –

Short title.

INDUSTRIAL DESIGNS ACT 1998.

Interpretation.

2. In this Act, unless the context otherwise requires –

“Court” means the High Court;

“industrial design” means any composition of lines or colours or any three dimensional form, or any material whether or not associated with lines or colours, which gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft and appeals to, and is judged by the eye, provided that it does not consist of anything which serves to obtain a technical result and leaves no freedom as regards arbitrary features of appearance;

“International Classification” means the classification according to the Locarno Agreement of October 8, 1968, establishing an International Classification for Industrial Designs;

Act No. of 1998.

“Journal” means the journal of patents, marks and designs created under section 5(d) of the Patents Act, 1998;

“Minister” means the Minister responsible for industrial designs;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention; and

“Register” means the register of industrial designs;

Act No. of 1998.

“Registrar” means the Registrar of Companies and Intellectual Property appointed under section 4 of the Patents Act, 1998;

Registrable
industrial designs.

3. (1) An industrial design is registrable if it is new.

(2) An industrial design is new if it has not been disclosed to the public anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Industrial designs the commercial exploitation of which would be contrary to public order or morality shall not be registrable.

(4) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if the disclosure –

- (a) occurred within twelve months preceding the filing date or, where applicable, the priority date of the application; and
- (b) was by reason or in consequence of acts committed by a third party with regard to the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

4. (1) The right to registration of an industrial design shall belong to the creator. Right to
industrial design

(2) Where two or more persons have jointly created an industrial design, the right to registration of the industrial design shall belong to them jointly.

(3) Where two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to the industrial design, as long as the said application is not withdrawn, abandoned or refused.

(4) The right to an industrial design may be assigned or transferred by succession.

(5) Where an industrial design is created in execution of a contract of employment, the right to the industrial design shall belong, in the absence of contractual provisions to the contrary, to the employer.

(6) The creator shall be named as such in the registration of the industrial design unless, in a special written declaration signed by him and addressed to the Registrar, he indicates that he wishes not to be so named.

(7) Any promise or undertaking by the creator made to any person to the effect that he will make a declaration referred to in subsection (6) shall be without legal effect.

Application for
registration of
design.

5. (1) An application for the registration of an industrial design shall be filed with the Registrar in the prescribed form and shall contain the following:

- (a) a request in writing that the design be registered;
- (b) drawings, photographs or other adequate graphic representations of the article embodying the industrial design; and
- (c) an indication of the kind of products for which the industrial design is to be used.

(2) The application shall be accompanied by the prescribed application fee.

(3) The application may be accompanied by a specimen of the article embodying the industrial design where the industrial design is two-dimensional.

(4) Where the applicant is not the creator, the request shall be accompanied by a written statement justifying the applicant's right to the registration of the industrial design.

(5) An application under this section may be in respect of two or more designs provided that the designs relate to the same class of International Classification or to the same set or composition of articles.

(6) The application may, at the time of filing, contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding twelve months from the date of filing or, if priority is claimed, from the date of priority of the application.

(7) The applicant may, at any time before the registration of a design, withdraw his application.

Right of priority.

6. (1) The application may contain a declaration claiming priority, as provided in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his predecessor in title in or for any State party to the Convention.

(2) Where the application contains a declaration referred to in subsection (1), the Registrar may require the applicant to furnish, within the prescribed period, a copy of the earlier application or international application, certified as correct by the office with which it was filed, and the effect of that declaration shall be as provided for in the Paris Convention.

(3) Where the earlier application is not in English, the Registrar may also request the applicant to furnish a translation thereof verified by the translator that the translation is, to the best of his knowledge, complete and faithful.

(4) Where the Registrar is satisfied that the requirements of section 5 and this section and the Regulations pertaining to a declaration have not been fulfilled, the declaration shall be considered not to have been made.

7. (1) The Registrar shall accord as the filing date the date of receipt of the application provided that, at the time of receipt, the application contains information allowing the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design. Filing date of application.

(2) Where the Registrar finds that the application did not, at the time of receipt, satisfy the requirements of subsection (1), he shall invite the applicant to file the required correction and shall accord, as the filing date, the date of receipt of the required correction.

(3) If the applicant does not file the required correction, the application shall be treated as if it had not been filed.

8. After according a filing date, the Registrar shall examine the application to determine whether – Examination of application.

- (a) it complies with the requirements of sections 5 and 6;
- (b) it complies with the definition of a design under this Act;
- (c) the application fee has been paid; and
- (d) the industrial design is contrary to public order or morality.

**Registration of
design.**

9. (1) Where, following the examination referred to in section 8, the Registrar is satisfied that the relevant requirements for registration have been fulfilled, he shall –

- (a) publish a notice of registration of the industrial design in the Journal;
- (b) register the industrial design; and
- (c) issue, to the applicant, a certificate of registration.

(2) Where he is not so satisfied, the Registrar shall refuse the application and notify the applicant in writing of that fact.

(3) Where a request has been made under section 5(6) for deferment of publication, no representation of the design or any file relating to the application shall be open to public inspection and the Registrar shall publish a notice of the deferment which shall contain information identifying the registered owner, the filing date of the application, the length of time for which deferment has been requested and any other prescribed particulars.

(4) During the period of deferment of publication, legal proceedings on the basis of a registered industrial design may not be instituted unless the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

(5) At the expiry of the period of deferment, the Registrar shall publish the registered industrial design.

**Rights conferred by
registration.**

10. (1) The exploitation of a registered industrial design in Dominica by persons other than the registered owner shall require the written authorisation of the latter.

(2) The owner of a registered design shall, subject to the provisions of this Act, and to any rights appearing from the Register to be vested in any other person, have the exclusive right, in Dominica, to make, sell, import or otherwise distribute, for commercial purposes, any article bearing or embodying the design.

(3) For the purposes of this section, “exploitation” of a registered design means the doing of any act specified in subsection (2).

(4) The rights conferred by the registration of a design shall not extend to acts in respect of articles which have been put on the market in Dominica by the registered owner or with his consent.

11. (1) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration but may be renewed for two further consecutive periods of five years upon payment of the prescribed renewal fee. Duration and renewal of registered design.

(2) Where the owner of the registered design is late paying the renewal fee, the Registrar shall, upon payment of the prescribed surcharge, give him a period of grace of six months within which he must pay the renewal fee.

12. (1) The owner of a registered design may surrender it by written declaration to the Registrar who shall record the surrender in the Register and publish it in the Journal. Surrender of registration.

(2) The surrender shall have effect from the date on which it is recorded.

13. (1) Subject to the provisions of section 5(6), the representations, specimens and drawings of a registered design, including all documents lodged in relation thereto shall, upon payment of the prescribed fee, be open to inspection by any person on and after the day on which the certificate of registration is issued. Inspection of registered design.

(2) Any person may, upon payment of the prescribed fee, obtain, from the Registrar, a copy of any such representations, drawings or documents.

(3) The right of inspection under subsection (1) shall not include the right to make a copy of any such representations, drawings or documents by mechanical means.

(4) When an application for the registration of a design has been abandoned or refused, the representations, drawings or other documents shall not, at any time, be open to inspection but shall, after

the expiration of twelve months from the date of application for such registration, be returned to the applicant if he requests that they be returned to him.

Invalidation of
registration of
registered design.

14. (1) The Court may, on the application of any interested party, invalidate the registration of an industrial design either wholly or in part or in respect of any particular article in connection with which the design is registered on any of the following grounds:

- (a) that the design is not new;
- (b) that the applicant for registration is not the owner or his successor in title;
- (c) that the application was made with the intention of defrauding the owner; or
- (d) any other ground on which the Registrar could have refused to register the design.

(3) An application for the invalidation of a design shall be served on the person in whose name the design is registered and lodged with the Court in the manner and within the time prescribed.

(4) An invalidated registration of an industrial design, or part thereof, shall be regarded as null and void from the date of the registration.

(5) The Registrar of the High Court shall notify the Registrar of the decision of the Court to invalidate a design and the Registrar shall publish a reference thereto in the Journal as soon as possible.

Changes in
ownership.

15. (1) Any change in the ownership of a registered design, or in the ownership of the application therefor, shall be in writing and shall, upon the request of any interested party, be recorded and, except in the case of an application, be published in the Journal by the Registrar.

(2) A change under subsection (1) shall have no effect against third parties until it has been recorded.

16. (1) Subject to this section, the owner of a registered design or an application therefor may grant licences in respect of the design. Licence contracts.

(2) A copy of each licence contract relating to a registered design or an application therefor shall be submitted to the Registrar who shall keep its contents confidential, but shall record it and publish a notice thereof.

(3) The licence contract shall have no effect against third parties until it has been recorded.

17. The Registrar shall perform the functions and exercise the powers conferred on him by this Act and any other enactment. Registrar.

18. (1) The Registrar shall maintain a Register in which he shall record all matters required by this Act or the Regulations to be recorded. Register.

(2) Any person may, upon payment of the prescribed fee, and in accordance with any prescribed conditions, consult, inspect or make a copy of, or obtain an extract from, the Register.

(3) The Register shall be *prima facie* evidence of anything required or authorised by this Act to be registered, and shall be admissible and sufficient evidence of any such thing.

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

(5) Each of the following, that is to say a copy of –

- (a) an entry in the Register or an extract from the Register which is supplied under subsection (2); and
- (b) any document kept in the Companies and Intellectual Property Office, or an extract from any such document, or any matter which has been published under this Act, which purports to be a certified copy

or a certified extract shall be admitted in evidence without production of the original, and such evidence shall be sufficient evidence of the matters stated therein.

(6) In this section, “certified copy” and “certified extract” mean a copy and extract certified by the Registrar and sealed with his seal.

Correction of errors.

19. (1) The Registrar may, of his own volition or upon the written request of any interested person, correct any clerical error or error in translation or transcription in any application filed under this Act, or in any document filed in pursuance of such application, and the Registrar may also correct any clerical error in the Register.

(2) Subsection (1) shall not be construed as giving the Registrar any power to correct the Register, any application or document in a material way.

Extension of time.

20. (1) Where the Registrar is satisfied that the circumstances justify it, he may, upon the written request of any interested person, extend the time for doing any act or taking any proceeding under this Act.

(2) The extension may be granted even though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary powers.

21. The Registrar shall, before exercising any discretionary power vested in him by this Act or the Regulations made thereunder, give any party to a proceeding before him the opportunity of being heard if his decision might adversely affect that party.

Agents.

22. Every applicant whose ordinary residence or principal place of business is outside Dominica shall be represented by a legal practitioner who has been enrolled to practice in the courts of Dominica in accordance with the relevant law.

Jurisdiction of Court.

23. (1) The Court shall have jurisdiction in cases of disputes relating to the application of this Act, and in matters which, under this Act, may be brought before it.

(2) Any person who has been aggrieved by a decision of the Registrar under this Act may, within two months of that decision, appeal to the Court.

24. (1) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his authorisation, any of the acts referred to in section 10 (2) or who performs acts which make it likely that infringement will occur.

Proceedings for
infringement.

(2) In any proceedings under this section, the Court may grant relief by way of –

- (a) damages;
- (b) injunction;
- (c) delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part; or
- (d) an account of profits derived from the infringement or otherwise as it may deem fit.

(3) The Court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him from the infringement.

(4) In any proceedings under this section, the Court shall have jurisdiction to order the invalidation of the registration of a design on any of the grounds specified in section 14, and any such grounds may be relied upon by way of defence.

(5) Any person who intentionally performs an act which constitutes an infringement as defined under subsection (1) commits an offence and is liable to a fine of twenty thousand dollars and imprisonment for five years.

(6) A licensee who has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, may also bring an action under this section, and the Court shall grant him any relief specified in subsection (2).

Other offences.

25. (1) Any person who, knowing the same to be false –

- (a) makes or causes to be made a false entry in the Register;
- (b) makes or causes to be made any document falsely purporting to be a copy of an entry in the Register; or
- (c) produces, tenders or causes to be produced as evidence any such entry or copy thereof,

commits an offence and is liable to a fine of thirty thousand dollars and imprisonment for ten years.

(2) Any person who –

- (a) for the purpose of deceiving the Registrar or any other officer in the execution of his duties under this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of any act under this Act;

makes a false statement or representation knowing the same to be false, commits an offence and is liable to a fine of twenty thousand dollars and imprisonment for five years.

Application of treaties.

26. The provisions of any international treaty in respect of industrial property to which Dominica is party shall apply to matters dealt with by this Act and, in case of conflict with the provisions of this Act, shall prevail over the latter.

Registrar's annual report.

27. (1) The Registrar shall, before 1st June every year, make an annual report to the Minister regarding the operation of this Act and the discharge of his functions thereunder.

Regulations.

28. The Minister may make regulations providing for any matter which is to be prescribed under this Act, or for giving effect to the purposes of this Act.

Repeal.
Ch. 78:43.

29. The United Kingdom Designs (Protection) Act (hereinafter referred to as "the former Act") is hereby repealed.

30. (1) Notwithstanding the repeal of the former Act, industrial designs registered thereunder shall remain in force but shall, subject to subsection (2), be deemed to have been registered under this Act. Transitional.

(2) Industrial designs registered under the former Act shall remain in force for the unexpired portion of the period of protection provided for under that Act and may be renewed in accordance with the provisions of this Act.

(3) A person who, on the date of the coming into force of this Act is the owner of an industrial design that has been registered in the United Kingdom or has filed an application for registration of an industrial design in the United Kingdom may, within twelve months the coming into force of this Act, file an application for the registration of the same industrial design under this Act, and such application shall be accorded the same filing date or date of priority accorded to the application for registration in the United Kingdom.

31. (1) This Act shall come into force on such day as the Minister may, by Order published in the *Gazette*, appoint. Commencement.

(2) Different days may be appointed for bringing different provisions into force, or for bringing different purposes of the same provision into force.

Passed in the House of Assembly this 24th day of March, 1998.

ALEX F. PHILLIP (MRS.)
Acting Clerk of the House of Assembly.
