



ST CHRISTOPHER AND NEVIS

CHAPTER 18.40

PROTECTION OF LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS ACT

and subsidiary legislation

Revised Edition

showing the law as at 31st December 2009

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Protection of Layout-Designs (Topographies) of Integrated Circuits Act

Act 19 of 2007 in force 5th November, 2007

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CHAPTER 18.40

PROTECTION OF LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS ACT

AN ACT to provide for the protection of Layout-Designs (Topographies) of Integrated Circuits and to provide for connected or related matters.

1. Short title.

This Act may be cited as the Protection of Layout-Designs (Topographies) of Integrated Circuits Act.

2. Interpretation.

In this Act, unless the context otherwise requires,

“Court” means the High Court;

“integrated circuit” means a product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections, are integrally formed in or on any material, and which is intended to perform an electronic function;

“layout-design” is synonymous with “topography” and means the three dimensional disposition, however expressed, of the elements of an integrated circuit as follows:

- (a) where at least one of the elements is active and includes some or all the interconnections of an integrated circuit; or
- (b) such a three dimensional disposition prepared for an integrated circuit intended for manufacture;

“Minister” means the Minister responsible for Intellectual Property;

“Register” means the Register of Layout-Designs referred to in section 12;
and

“Registrar” means the Registrar of the High Court and Intellectual Property;

“right holder” means the person who is regarded as the beneficiary of the protection referred to in section 5 of this Act;

3. Application of Act.

A layout-design which has been commercially exploited anywhere in the world for more than two years before the coming into force of this Act shall not be protected under this Act.

4. Originality.

(1) No layout-design of an integrated circuit shall be protected under this Act unless it is original within the meaning of subsection (2).

(2) A layout-design shall be considered to be original if it is the result of the creator's own intellectual effort and is not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation.

(3) A layout-design consisting of a combination of elements and interconnections which are commonplace shall be protected only if the combinations, taken as a whole, is original within the meaning of subsection (2).

5. Right to protection.

(1) The right to protection of a layout-design shall belong to the creator of the layout-design and may be assigned or transferred by succession.

(2) Where several persons have jointly created a layout-design, the right shall belong to them jointly.

(3) Where the layout-design has been created in execution of a commission or a contract of employment, the right to protection of the layout-design shall belong, in the absence of an agreement to the contrary, to the person who commissioned the work or to the employer, as the case may be.

6. Effect of protection.

(1) Protection under this Act shall not depend upon whether or not the integrated circuit which incorporates the protected layout-design is itself incorporated in an article.

(2) Subject to subsection (3) and to section 17, the effect of the protection of a layout-design under this Act shall be to make the following acts unlawful if performed without the authorisation of the right holder:

- (a) the reproduction, whether by incorporation in an integrated circuit or otherwise, of the protected layout-design in its entirety or any part thereof, except the reproduction of any part that does not comply with the requirement of originality defined in section 4;
- (b) the importation, sale or other distribution, for commercial purposes, of the protected layout-design, an integrated circuit in which the protected layout-design is incorporated, or an article incorporating such an integrated circuit in so far as it continues to contain an unlawfully reproduced layout-design.

(3) The effect of the protection of a layout-design under this Act shall not extend to

- (a) the reproduction of the protected layout-design for private purposes or for the sole purpose of evaluation, analysis, research or teaching;
- (b) the incorporation, in an integrated circuit, of a layout-design created on the basis of such analysis or evaluation, and which is itself original within the meaning of section 4, or the performance of any act referred to in subsections (1) and (2) in respect of that layout-design;

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- (c) the performance of any act referred to in subsection (2)(b) where the act performed in respect of a protected layout-design, or in respect of an integrated circuit in which such a layout-design is incorporated, that has been put on the market by, or with the consent of, the right holder;
- (d) the performance of any act referred to in subsection (2)(b) in respect of
 - (i) an integrated circuit incorporating an unlawfully reproduced layout-design or;
 - (ii) any article incorporating such an integrated circuit
where the person performing or ordering the performance of such an act did not know, and had no reasonable ground for knowing, when acquiring the integrated circuit or the article incorporating such integrated circuit, that it incorporated an unlawfully reproduced layout-design; or
- (e) the performance of any act referred to in subsection (2)(b) where the act is performed in respect of an identical layout-design which is original and has been created independently by a third party.

(4) Where the person referred to in section 3(d) has received sufficient notice that the layout-design was unlawfully reproduced, that person may perform any of the acts referred to in that subsection only with respect to the stock on hand or ordered before he received the notice, and shall be liable to pay, to the right holder, a sum equivalent to such reasonable royalty as would be payable under a freely negotiated licence in respect of such layout-design.

7. Commencement and duration of protection.

(1) The protection of a layout-design under this Act shall commence

- (a) on the date of the first commercial exploitation, anywhere in the world, of the layout-design by, or with the consent of, the right holder, provided that an application for protection is filed by the right holder with the Registrar within the time limit referred to in section 8(3); or
- (b) on the filing date accorded the application for the registration of the layout-design filed by the right holder if the layout-design has not been previously exploited commercially anywhere in the world.

(2) The protection of a layout-design under this Act shall terminate ten calendar years after the date of commencement thereof.

8. Applications.

(1) Any person who wishes to register a layout-design shall file, with the Registrar, an application on the prescribed form.

(2) The applicant shall file a separate application for each layout-design.

(3) A person may apply for the registration of a layout-design only if the layout-design has not yet been commercially exploited, or has been commercially exploited for not more than two years, anywhere in the world.

(4) An application shall

- (a) contain a request that the layout-design be registered, which request shall be accompanied by a brief and precise designation of the layout-design;
- (b) indicate the name, address, nationality and, if different from the address, the habitual residence of the applicant;
- (c) be accompanied by the power of attorney appointing the representative of the applicant, if any, and by a copy or drawing of the layout-design, along with information defining the electronic function which the integrated circuit is intended to perform;
- (d) specify the date of first commercial exploitation of the layout-design anywhere in the world, or indicate that such exploitation has not commenced; and
- (e) provide particulars establishing the right to protection under section 5.

(5) Notwithstanding the provision of subsection (4)(c), the application may omit such parts of the copy or drawing as relate to the manner of manufacture of the integrated circuit, provided that the parts submitted are sufficient to enable the layout-design to be identified.

9. Correction of application.

(1) When an application does not comply with the requirements of section 8(4), the Registrar shall notify the applicant in writing of the defects in the application and invite him to correct them within two months of such notification.

(2) Where the applicant corrects the application within the time specified by the Registrar, the Registrar shall accord, as the filing date of the application, the date of receipt of the application, provided that at the time of such receipt, the application

- (a) contains an express or implied indication that the registration of a layout-design is requested;
- (b) contains information enabling the identity of the applicant to be established; and
- (c) is accompanied by a copy or drawing of the layout-design.

(3) Where the requirements of subsection (2) are not complied with at the date of the receipt of the application but are fulfilled within the time specified by the Registrar, the date of receipt of the required correction shall be deemed to be the filing date of the application, and the Registrar shall confirm the filing date and communicate it to the applicant in writing.

(4) The application shall be deemed not to have been filed if the applicant does not correct any defects in his application within the time specified by the Registrar.

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10. Application fee.

(1) Every application for the protection of a layout-design shall be accompanied by the prescribed application fee.

(2) Where the application fee is not paid, the Registrar shall, in writing, notify the applicant that the application shall be deemed not to have been filed unless payment is made within two months of the date of the notification.

(3) Where the applicant does not pay the application fee within the time notified, the application shall be deemed not to have been filed.

11. Where application is not in English.

Any application filed under this Act shall, if not in English, be accompanied by a translation thereof in English, verified by a translator that the translation is, to the best of his knowledge, complete and faithful.

12. Register.

(1) The Registrar shall maintain a register to be known as the Register of Layout-designs in which he shall record all matters which must be recorded under this Act.

(2) The Register shall contain the number, title, filing date and, where indicated in the application under section 8 (4)(d), the date of the first commercial exploitation, anywhere in the world, of the layout-design, the name and address of the right holder, and such other particulars as may be prescribed.

(3) 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.

(4) 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.

(5) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorised by this Act to make 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.

(6) 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 (3); and
- (b) any document kept in the Registrar's 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 further proof and without production of the original, and such evidence shall be sufficient evidence of the matter stated therein.

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

13. Registration and publication of layout-design.

Where an application complies with the requirements of section 8, the Registrar shall

- (a) register the layout-design in the Register without examining the originality of the layout-design, the applicant's entitlement to protection, or the correctness of the facts stated in the application; and
- (b) publish the registration of the layout-design in the *Gazette*.

14. Right to transfer; rectification of Register.

(1) Where the substantive contents of the application have been taken from the layout-design of another person without his consent, that other person may, in writing, request the Registrar to transfer the application to him.

(2) Where the application has already resulted in a registration, the person may, within three years of the publication of the registration, request the Registrar, in writing, to transfer the registration to him, and to rectify the entry in the Register accordingly.

(3) The Registrar shall forthwith send a copy of the request as to the right holder, and, within the prescribed period and in the prescribed manner, the right holder may file, with the Registrar, a counter-statement of the grounds on which he relies.

(4) Where the right holder files a counter-statement, the Registrar shall furnish a copy thereof to the person requesting the transfer and, after hearing the parties, if they wish to be heard, and considering the merits of the case, shall decide whether the application or registration should be transferred and, where applicable, whether the Register should be rectified.

15. Changes in ownership.

(1) Any change in the ownership of a protected layout-design shall be

- (a) in writing and addressed to the Registrar;
- (b) recorded in the Register by the Registrar; and
- (c) published by the Registrar in the *Gazette*.

(2) A change referred to in subsection (1) shall have no effect against third parties unless it has been recorded.

16. Licence contracts.

(1) The owner of a registered layout-design may grant licences in respect of that layout-design.

(2) A licence contract in respect of a layout-design shall, upon the registration of the layout-design, be filed with the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto in the *Gazette*.

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

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17. Exploitation by Government agency or third person.

(1) Where

- (a) the public interest, in particular, national security, nutrition, health, or the development of any other vital sector of the national economy requires the exploitation of a protected layout-design for public non-commercial use; or
- (b) the Minister has determined that the manner of exploitation, by the owner of the protected layout-design or his licensee, is anti-competitive, and he is satisfied that the exploitation of the layout-design in accordance with this subsection would remedy such practice,

the Minister may decide that, even without the authorisation of the owner of the right holder, a Government agency or a third person designated by the Minister may exploit the layout-design.

(2) The exploitation of the layout-design shall be limited, in scope and duration, to the purpose for which it was authorised and shall be predominantly for the supply of the domestic market.

(3) The exploitation shall be non-exclusive and shall be subject to the payment, to the right owner, of an adequate remuneration therefor, taking into account the economic value of the Minister's authorisation, as determined in his decision and, where applicable, the need to correct anti-competitive practices.

(4) Upon the request of the right holder, or of the beneficiary of the authorisation, the Minister may, after hearing the parties, if they wish to be heard, vary the terms of the decision authorising the exploitation of the layout-design to the extent that changed circumstances justify such variation.

(5) Upon the request of the right holder, the Minister shall terminate the non-voluntary licence if he is satisfied, after hearing the parties if they wish to be heard, that the circumstances which led to his decision have ceased to exist and are unlikely to recur or that the beneficiary of the authorisation has failed to comply with the terms of the authorisation.

(6) Notwithstanding subsection (5), the Minister shall not terminate an authorisation if he is satisfied that the adequate protection of the legitimate interests of the beneficiary of the authorisation justifies the maintenance of the authorisation.

(7) Where a third person has been designated by the Minister, the authorisation may only be transferred with enterprise or business of the beneficiary of the authorisation, or with the part of the enterprise or business within which the layout-design is being exploited.

(8) A request for the Minister's authorisation shall be accompanied by evidence that the right holder has received, from the person seeking the authorisation, a request for a licence, but that the person has been unable to obtain such licence on reasonable commercial terms and conditions, and within a reasonable time.

18. Invalidation.

(1) The Court may, on the application of any interested person, invalidate the registration of a layout-design on the grounds that

- (a) the layout-design is not a layout-design as defined in this Act;
- (b) the layout-design is not original within the meaning of this Act;
- (c) the right holder is not entitled to protection under section 5; or
- (d) where the layout-design has been commercially exploited anywhere in the world before the filing of the application for registration of the layout-design, the said application was not filed within the time limit referred to in section 7(1) and 8(3).

(2) Where the grounds for invalidation are established with respect only to part of the layout-design, the Court shall invalidate only the corresponding part of the registration.

(3) Any invalidation under this section shall be regarded as null and void from the date of the commencement of the protection of the layout-design.

(4) The Registrar of the High Court shall, if he is not the same person, in writing, notify the Registrar of any final decision of the Court relating to invalidation under this section, and the Registrar shall record the decision and publish it in the *Gazette* as soon as possible.

19. Agents.

Where an applicant's ordinary residence or principal place of business is outside of Saint Christopher and Nevis, he shall be represented by a legal practitioner resident and practicing in Saint Christopher and Nevis or otherwise entitled to practise in Saint Christopher and Nevis in accordance with the relevant law.

20. Registrar.

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

21. Exercise of discretionary power.

The Registrar shall give any party to a proceeding before him the opportunity of being heard before exercising any discretionary power vested in him under this Act if the exercise thereof might adversely affect that party.

22. Extension of time for applications.

(1) Where the Registrar is satisfied that the circumstances justify it, he may, upon the written request of any interested person, and upon such terms as he may direct, and upon written notice to the parties concerned, extend the time for doing any act or taking any proceeding under this Act or the Regulations.

(2) The extension may be granted even though the time for doing the act or taking the proceeding has expired, but the time for filing an application referred to in section 8(3) may not be extended.

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23. Jurisdiction of Court.

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

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

24. Infringement.

(1) An infringement shall consist of the performance of any act which is unlawful under section 6.

(2) On the application of the right holder, or of a licensee if he has requested the owner to institute court proceedings for a specific relief and the right holder has refused or failed to do so, the Court may as soon as possible

- (a) grant an injunction to prevent infringement or an imminent infringement;
- (b) award damages;
- (c) order the seizure, forfeiture or destruction of
 - (i) any infringing layout-design, integrated circuit or any product or article of which the infringing layout-design or integrated design forms an integral part; or
 - (ii) any article, instrument or thing by means of which any such infringing circuit or article was product; or
- (d) grant any other remedy provided for in the general law.

(3) An action under this section may be instituted only after an application for the registration of the layout-design has been filed with the Registrar.

25. Offences.

(1) Any person who performs an act which is unlawful under section 6 commits an offence and is liable upon conviction to a fine of not less than fifteen thousand dollars, but not more than forty thousand dollars, or to imprisonment for a term of not less than five years, but not more than ten years, or to both such fine and such imprisonment.

(2) 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 in evidence any such entry or copy thereof,

commits an offence and is liable, upon conviction to a fine of not less than ten thousand dollars, but not more than thirty thousand dollars, or to imprisonment for a term of not less than three years, but not more than ten years, or to both such fine and such imprisonment.

26. Registrar's annual report.

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.

27. Application of international treaties.

The provisions of any international treaty in respect of industrial property to which Saint Christopher and Nevis is a 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.

28. Regulations.

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

29. Act binds Crown.

This Act shall bind the Crown.