

# CHAPTER 13.30 TRADE MARKS ACT

## Revised Edition

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• Act • Subsidiary Legislation •

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## ACT

### (Act 22 of 2001)

Act 22 of 2001 in force 1 April 2003 (S.I.16/2003)

## ARRANGEMENT OF SECTIONS

### PART 1 PRELIMINARY

1. Short title

### PART 2 INTERPRETATION

2. Interpretation

### PART 3 TRADE MARKS AND TRADE MARK RIGHTS

3. Categories of trade marks
4. Rights given by registration of trade marks
5. Nature of registered trade mark as property
6. Power of registered owner to deal with trade mark
7. Limitation on rights for similar trade marks
8. Trade mark as sign describing article
9. Trade mark relating to article etc. formerly manufactured under patent
10. Powers of authorised user of registered trade mark

### PART 4 APPLICATION FOR REGISTRATION

#### *Division 1 General*

11. Making of application
12. Application by joint owners
13. Claim for priority
14. Notice of application to be published
15. Registrar to examine, and report on, application
16. Registrar to decide on disputed classification of goods etc
17. Application accepted or rejected
18. Notice etc. of decision
19. Appeal
20. Deferment of acceptance
21. Lapsing of application
22. Revocation of acceptance

*Division 2*

*Grounds for rejecting an application*

- 23. Trade mark containing certain signs
- 24. Trade mark that cannot be represented graphically
- 25. Trade mark not distinguishing applicant's goods or services
- 26. Trade mark scandalous or its use contrary to law
- 27. Trade mark likely to deceive or cause confusion
- 28. Identical etc. trade marks

*Division 3*

*Divisional applications*

- 29. Definition of divisional application
- 30. Divisional application possible only if initial application is pending
- 31. Divisional application for registration of part of trade mark
- 32. Divisional application for registration of trade mark in respect of some of goods etc.
- 33. Divisional application for registration of trade mark in respect of goods etc. excluded from the initial application
- 34. Filing date

*Division 4*

*Application for registration of series of trade marks*

- 35. Application—series of trade marks

**PART 5  
OPPOSITION TO REGISTRATION**

*Division 1*

*General*

- 36. Opposition
- 37. Proceedings in name of a person other than the person who filed the notice
- 38. Opposition proceedings
- 39. Decision
- 40. Appeal

*Division 2*

*Grounds for opposing registration*

- 41. Registration may be opposed on same grounds as for rejection
- 42. Applicant not owner of trade mark
- 43. Applicant not intending to use trade mark
- 44. Trade mark similar to trade mark that has acquired a reputation
- 45. Trade mark containing or consisting of a false geographical indication
- 46. Application etc. defective etc.

**PART 6  
AMENDMENT OF APPLICATION FOR REGISTRATION OF A TRADE MARK AND  
OTHER DOCUMENTS**

- 47. Amendment of application for registration of trade mark
- 48. Amendment before notice of application is published
- 49. Amendment after notice of application has been published
- 50. Amendment of other documents
- 51. Appeal

**PART 7  
REGISTRATION OF TRADE MARKS**

*Division 1*

*Initial registration*

- 52. Obligation to register
- 53. Registration—how effected
- 54. Colours in registered trade marks
- 55. Notification of registration
- 56. Date and term of registration

- 57. Ceasing of registration
- 58. Disclaimers

*Division 2*

*Renewal of registration Request for renewal*

- 59. request for renewal
- 60. Notice of renewal date
- 61. Renewal before registration expires
- 62. Failure to renew
- 63. Renewal within 12 months after registration expires
- 64. Status of un-renewed trade mark

**PART 8**

**AMENDMENT AND CANCELLATION OF REGISTRATION**

*Division 1*

*Action by Registrar*

- 65. Correction of register
- 66. Adaptation of classification
- 67. Amendment of particulars of trade mark entered in Register
- 68. Cancellation of registration

*Division 2*

*Action by court*

- 69. Amendment to correct error or omission
- 70. Amendment or cancellation on ground of contravention of condition etc.
- 71. Amendment or cancellation—loss or exclusive rights to use trade mark
- 72. Amendment or cancellation—other specified grounds
- 73. Rectification may not be granted in certain cases if registered owner not at fault etc.
- 74. Duties and powers of Registrar

*Division 3*

*Amendment of certificate of registration*

- 75. Amendment of certificate of registration

**PART 9**

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

- 76. Application for removal of trade mark from Register etc.
- 77. Time for making application
- 78. Referral to court
- 79. Notification of application
- 80. Notice of opposition
- 81. Removal of trade mark from the Register etc. if application unopposed
- 82. Trade mark restored to Register if notice of opposition filed within extended time
- 83. Proceedings before Registrar
- 84. Burden on opponent to establish use of trade mark etc.
- 85. Determination of opposed application-general
- 86. Determination of opposed application-localised use of trade mark
- 87. Registrar to comply with order of court
- 88. Appeal
- 89. Certificate—use of trade mark

**PART 10**

**ASSIGNMENT AND TRANSMISSION OF TRADE MARKS**

- 90. Assignment etc. of trade mark
- 91. Applications for record to be made of assignment etc. of trade mark whose registration is sought
- 92. Recording of assignment etc. of trade mark whose registration is sought
- 93. Application for record of assignment etc. of registered trade mark to be entered in Register
- 94. Recording of assignment etc. of registered trade mark
- 95. Notice of application to be given to person recorded as claiming interest in

trade mark etc

**PART 11**  
**VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN AND RIGHTS IN**  
**RESPECT OF TRADE MARKS**

*Division 1*  
*Preliminary*

96. Object of Part

*Division 2*

*Interests in, and rights in respect of, registered trade marks*

- 97. Application to have claims to interest etc. recorded
- 98. Record of claims to interest etc
- 99. Amendment and cancellation
- 100. Record not proof etc. of existence of right etc

*Division 3*

*Interests in, and rights in respect of unregistered trade marks*

- 101. Application to have claims to interest etc. recorded
- 102. Record of claims to interest etc
- 103. Amendment and cancellation

**PART 12**  
**INFRINGEMENT OF TRADE MARKS**

- 104. Infringement of trade mark
- 105. Infringement of trade mark by breach of certain restrictions
- 106. Goods etc. to which registered trade mark has been applied by or with consent of registered owner
- 107. Prior use of identical trade mark etc
- 108. What courts may hear action for infringement of registered trade mark
- 109. What relief can be obtained from court
- 110. Special case—plaintiff not entitled to damages etc
- 111. Circumstances in which action may not be brought
- 112. Groundless threats of legal proceedings
- 113. Counterclaim by defendant in action on groundless threats

**PART 13**  
**IMPORTATION OF GOODS INFRINGING SAINT LUCIAN TRADE MARKS**

- 114. Object of Part
- 115. Notice of objection to importation
- 116. Comptroller may seize goods infringing trade mark
- 117. Notice of seizure
- 118. Forfeiture of goods
- 119. Release of goods to owner-no action for infringement
- 120. Action for infringement of trade mark
- 121. Action for infringement by authorised user
- 122. Disposal of forfeited goods
- 123. Power of Comptroller to retain control of goods
- 124. Insufficient security
- 125. Government not liable for loss etc. suffered because of seizure
- 126. Power to require information

**PART 14**  
**OFFENCES**

- 127. Falsifying etc. a registered trade mark
- 128. Falsely applying a registered trade mark
- 129. Manufacture and possession of die etc. for use in commission of offence
- 130. Selling etc. goods with false marks
- 131. Penalty for offence under section 127, 128, 129 or 130
- 132. False representations regarding trade marks
- 133. False entries in Register etc
- 134. Disobeying summons etc
- 135. Refusing to give evidence etc

- 136. Unauthorised persons not to act in trade mark matters
- 137. False representation about Registry of Companies and Intellectual Property
- 138. Employee not to prepare documents etc
- 139. Conduct of directors, servants and agents

**PART 15**  
**COLLECTIVE TRADE MARKS**

- 140. Object of Part
- 141. Collective trade mark
- 142. Application of Act
- 143. Application for registration
- 144. Limitation on rights given by registered collective trade mark
- 145. Assignment etc. of collective trade mark
- 146. Infringement of collective trade mark

**PART 16**  
**CERTIFICATION TRADE MARKS**

- 147. Object of Part
- 148. Certification trade mark
- 149. Application of Act
- 150. Rights given by registration of a certification trade mark
- 151. Rights of persons allowed to use certification trade mark
- 152. Rules governing the use of certification trade marks
- 153. Grant of application to register
- 154. Refusal to register
- 155. Variation of rules
- 156. Rules to be available for inspection
- 157. Assignment of registered certification trade mark
- 158. Rectification of the Register by order of court
- 159. Variation of rules by order of court
- 160. Copy of order and rules

**PART 17**  
**DEFENSIVE TRADE MARKS**

- 161. Object of Part
- 162. Defensive trade mark
- 163. Application of Act
- 164. Additional grounds for rejecting application for registration or opposing registration
- 165. Amendment or cancellation of registration by order of court
- 166. Cancellation of registration by Registrar

**PART 18**  
**JURISDICTION AND POWERS OF COURTS**

- 167. Jurisdiction of the High Court
- 168. Transfer of proceedings
- 169. Appeals
- 170. Registrar may appear in appeals
- 171. Powers of High Court

**PART 19**  
**ADMINISTRATION**

- 172. Registrar of Companies and Intellectual Property
- 173. Registrar's powers
- 174. Exercise of power by Registrar
- 175. Registrar to act as soon as practicable
- 176. Deputy Registrar
- 177. Delegation of Registrar's powers and functions

**PART 20**  
**THE REGISTER AND OFFICIAL DOCUMENTS**

- 178. The Register
- 179. Register may be kept on computer
- 180. Inspection of Register

- 181. Register
- 182. Certified copies of documents

**PART 21  
MISCELLANEOUS**

*Division 1*

*Applications and other documents*

- 183. Making and signing applications etc
- 184. Filing of documents
- 185. Withdrawal of application etc
- 186. Address for service
- 187. Change of name
- 188. Death of applicant etc

*Division 2*

*Proceedings before the Registrar or a court*

- 189. Description of registered trade mark
- 190. Evidence of trade usage
- 191. Death of party to proceeding before Registrar
- 192. Costs awarded by Registrar
- 193. Security for costs

*Division 3*

*General*

- 194. Fees
- 195. Extension of time
- 196. Publication of documents
- 197. Use of trade mark for export trade
- 198. Passing off actions
- 199. Expenses
- 200. Regulations
- 201. Transitional

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**CHAPTER 13.30  
TRADE MARKS ACT**

AN ACT to provide for the promotion and protection of trade marks and for related matters.

Commencement [1 April 2003]

**PART 1  
PRELIMINARY**

**1. Short title**

This Act may be cited as the Trade Marks Act.

**PART 2  
INTERPRETATION**

**2. Interpretation**

(1) In this Act—

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

“**applied to**” has the meaning given to it in subsection (11);

**"applied in relation to"** has the meaning given to it in subsection (11);

**"approved form"** means a form approved by the Registrar for the purposes of the provision in which the expression appears;

**"assignment"** in relation to a trade mark, means an assignment by act of the parties concerned;

**"association"** does not include a body corporate;

**"attorney-at-law"** means an attorney-at-law as defined by the Legal Professions Act;

**"authorised user of a trade mark"** has the meaning given to it by subsection (7);

**"authorised user of a trade mark"** has the meaning given to it by subsection (6);

**"certification trade mark"** has the meaning given to it by section 148;

**"collective trade mark"** has the meaning given to it by section 141;

**"Comptroller"** means the Comptroller of Customs appointed under the Customs (Control and Management) Act;

**"Convention country"** means a country which is a party to the Paris Convention for the Protection of Industrial Property 1883;

**"date of registration"**, in relation to the registration of a trade mark in respect of particular goods and services, means the day from which the registration of a trade mark in respect of those goods or services is taken to have had effect under section 56(1) or (2);

**"deceptively similar"** has the meaning given to it by sub-section (13);

**"defensive trade mark"** has the meaning given to it by section 162;

**"Deputy Registrar"** means the Deputy Registrar appointed under the Companies and Intellectual Property (Registry) Act;

**"designated owner"** in relation to goods imported into Saint Lucia means the person identified as the owner of the goods on the entry made under the Customs (Control and Management) Act;

**"divisional application"** has the meaning given to it by section 29;

**"examine"**, in relation to an application for the registration of a trade mark, means to carry out an examination under section 15 in relation to the application;

**"existing registered mark"** means a mark that was registered under the repealed Acts and whose registration was due to expire after the coming into force of this Act;

**"file"** means to file at the Registry of Companies and Intellectual Property;

**"filing date"** means—

- (a) in relation to an application for the registration of a trade mark other than an application referred to in paragraph (b) of this definition, the day on which the application is filed;
- (b) in relation to a divisional application for the registration of a trade mark, the day on which the initial application, within the meaning of Division 3 of Part 4, was filed;

**"geographical indication"**, has the meaning given to it in the Geographical Indications Act;

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

“**limitations**” means limitations of the exclusive right to use a trade mark, including limitations of that right as to—

- (a) mode of use;
- (b) use in Saint Lucia; or
- (c) use in relation to goods or services to be exported;

“**Minister**” means Minister with responsibility for intellectual property;

“**notified trade mark**” means a trade mark in respect of which notice under section 115 is in force;

“**objector**”, in relation to seized goods, means any person who has given a notice under section 115 that is in force;

“**old register**” means the Register of Patents, Trademarks and Designs kept under the repealed Acts;

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

- (a) the person who has filed, under section 36, a notice of opposition to the registration of the trade mark; or
- (b) if section 37 applies, a person in whose name the notice of the opposition is taken to have been filed;

“**originate**” in relation to wine, has the meaning given to it by subsection (19);

“**pending**” in relation to an application for the registration of a trade mark under this Act has the meaning given to it by subsection (14);

“**pending**” in relation to an application for the registration of a trade mark under the repealed Acts has the meaning given to it by subsection (15);

“**person**” includes a body corporate or unincorporated body;

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

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

“**prescribed**” means prescribed in regulations made under this Act;

“**priority date**” has the meaning given to it by subsection (16);

“**Register**” means the Register of Trade Marks kept under section 178;

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

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

“**Registrar**” means the Registrar of Companies and Intellectual Property appointed under the Companies and Intellectual Property (Registry) Act;

“**registration number**”, in relation to a registered trade mark, means the number given to it under section 52(2);



**“Registry of Companies and Intellectual Property”** means the Registry of Companies and Intellectual Property established under the Companies and Intellectual Property (Registry) Act;

**“regulations”** means regulations made under section 200;

**“remove from the Register”**, in relation to a trade mark, has the meaning given to it by subsection (17);

**“repealed Acts”** means the Merchandise Marks Act and Title X of the Commercial Code;

**“represented graphically”** has the meaning given to it in subsection (3);

**“seized goods”** means goods seized under section 116;

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

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

**“similar goods”** has the meaning given to it by subsection (18)(a);

**“similar services”** has the meaning given to it by subsection (18)(b);

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

**“transmission”** means—

- (a) transmission by operation of law;
- (b) devolution on the personal representative of a deceased person; or
- (c) any other kind of transfer except assignment;

**“use of trade mark”** has the meaning effected by subsections (2), (3), and (4);

**“use of trade mark in relation to goods”** has the meaning given to it under subsection (5)(a);

**“use of trade mark in relation to services”** has the meaning given to it under subsection (5)(b);

**“word”** includes an abbreviation of a word.

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

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

(4) An authorised use of a trade mark by a person is taken, for the purposes of this Act, to be a use of the trade mark by the owner of the trade mark.

(5) In this Act—

**“use of a trade mark in relation to goods”** means use of the trade mark upon, or in physical or other relation to, the goods, including second-hand goods;

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

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

(7) The use of a trade mark by an authorised user of the trade mark is an authorised use of the trade mark to the extent only that the user uses the trade mark under the control of the owner of the trade mark.

(8) If the owner of a trade mark exercises quality control over goods or services—

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

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

the other person is taken, for the purposes of subsections (6) and (7), to use the trade mark in relation to the goods or services under the control of the owner.

(9) If—

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

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

the other person is taken, for the purposes of subsection (6) and (7), to use the trade mark in relation to the goods or services under the control of the owner.

(10) Subsections (8) and (9) do not limit the meaning of the expression "under the control of" in subsections (6) and (7).

(11) For the purposes of this Act—

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

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

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

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

(c) in addition to paragraphs (a) and (b), a trade mark is taken to be applied in relation to goods or services if it is used—

(i) on a signboard or in an advertisement, including a televised advertisement, or

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

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

(12) In subsection (11)(b)(i)—

"**covering**" includes packaging, frame, wrapper, container, stopper, lid or cap;

"**label**" includes a band or ticket.

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

(14) An application for the registration of a trade mark under this Act is pending from the time it is filed until—

- (a) it lapses under section 21, is withdrawn under section 185 or is rejected under section 17;
- (b) if the Registrar refuses, under section 39, to register the trade mark and there is no appeal against the decision, the end of the period allowed for the appeal;
- (c) if the Registrar refuses, under section 39, to register the trade mark and—
  - (i) there is an appeal against the decision, and
  - (ii) the decision is confirmed on appeal,
    - the day on which the decision is confirmed on appeal; or
- (d) the trade mark is registered under section 52.

(15) An application for the registration of a trade mark under the repealed Acts was pending immediately before the commencement date of this Act if, before that date—

- (a) the application had not lapsed, been withdrawn, or refused; or
- (b) had been refused but—
  - (i) the period allowed for appealing against the decision to refuse had not yet ended, or
  - (ii) an appeal had been made against the decision but had not been decided,

under the repealed Acts.

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

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

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

(18) For the purposes of this Act—

- (a) goods are similar to other goods if—
  - (i) they are the same as the other goods, or
  - (ii) they are of the same description as that of the other goods; or
- (b) services are similar to other services if—
  - (i) if they are the same as the other services, or
  - (ii) if they are of the same description as that of the other services.

(19) For the purposes of this Act—

- (a) a wine is taken to have originated in a foreign country or Saint Lucia only if the wine is made within the territory of that country or of Saint Lucia, as the case may be; and
- (b) a wine is taken to have originated in a particular region or locality of a foreign country or of Saint Lucia only if the wine is made from grapes grown in that region or locality.

**PART 3**  
**TRADE MARKS AND TRADE MARK RIGHTS**

**3. Categories of trade marks**

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

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

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

**4. Rights given by registration of trade marks**

(1) If a trade mark is registered, the registered owner of the trade mark has, subject to this Act, the exclusive rights—

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

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

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

(4) If a trade mark is registered in the name of 2 or more persons as joint owners of the trade mark, the rights granted to those persons under this section are to be exercised by them as if they were the rights of a single person.

**5. Nature of registered trade mark as property**

(1) A registered trade mark is personal property.

(2) A right in respect of a registered trade mark is enforceable in the same way as rights in respect of any other personal property.

**6. Power of registered owner to deal with trade mark**

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

(2) This section does not protect a person who deals with the registered owner otherwise than—

- (a) as a purchaser in good faith for value; and
- (b) without notice of any fraud on the part of the owner.

**7. Limitation on rights for similar trade marks**

If trade marks that are substantially identical or deceptively similar have been registered by more than one person whether in respect of the same or different goods or services, the registered owner of any one of those trade marks does not have the right to prevent the registered owner of any other of those trade marks from using that trade mark except to the extent that the first mentioned owner is authorised to do so under the registration of his or her trade mark.

## **8. Trade mark as sign describing article**

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

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

- (a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to—
  - (i) the article or substance or other goods of the same description, or
  - (ii) the service or other services of the same description; and
- (b) is taken to have ceased to have those exclusive rights from and including the day determined by the High Court under subsection (4).

(3) If a trade mark contains the sign referred to in subsection (1), the registered owner—

- (a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to—
  - (i) the article or substance or other goods of the same description, or
  - (ii) the service or other services of the same description; and
- (b) is taken to have ceased to have those exclusive rights from the day determined by the High Court under subsection (4).

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

## **9. Trade mark relating to article etc. formerly manufactured under patent**

(1) This section applies if—

- (a) a registered trade mark consists of, or contains, a sign that describes or is the name of—
  - (i) an article or substance that was formerly exploited under a patent, or
  - (ii) a service that was formerly provided as a patented process; and
- (b) it is at least 2 years since the patent has expired or ceased; and
- (c) the sign is the only commonly known way to describe or identify the article, substance or service.

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

- (a) does not have any exclusive rights to use, or authorise other persons to use, the trade mark in relation to—
  - (i) the article or substance or other goods of the same description, or
  - (ii) the service or other services of the same description; and
- (b) is taken to have ceased to have those exclusive rights from the end of the period of 2 years after the patent expired or ceased.

(3) If a trade mark contains the sign referred to in subsection (1), the registered owner—

- (a) does not have any exclusive rights to use, or authorise other persons to use, the sign in relation to—
  - (i) the article or substance or other goods of the same description, or
  - (ii) the service or other services of the same description; and
- (b) is taken to have ceased to have those exclusive rights from the end of the period of 2 years after the patent expired or ceased.

#### **10. Powers of authorised user of registered trade mark**

(1) Subject to any agreement between the registered owner of a registered trade mark and an authorised user of the trade mark, the authorised user may—

- (a) use the trade mark in relation to the goods or services or both, in respect of which the trade mark is registered, subject to any condition or limitation subject to which the trade mark is registered;
- (b) subject to subsection (2), bring an action for infringement of the trade mark if the registered owner refuses or neglects to do so within the prescribed period;
- (c) cause to be displayed on goods in respect of which the trade mark is registered, or on their package, or on the container in which they are offered to the public, a notice prohibiting any act that is under section 105(2) a prohibited act in relation to the goods;
- (d) either—
  - (i) give to the Comptroller a notice under section 115 objecting to the importation of goods that infringe the trade mark, or
  - (ii) revoke a notice given under subparagraph (i);
- (e) give permission to any person—
  - (i) to make any addition to, or
  - (ii) to remove, erase or obliterate, wholly or partly,  
  
a registered trade mark that is applied to any goods, or in relation to any goods or services, in respect of which the trade mark is registered;
- (f) give permission to any person to apply the trade mark to goods, or in relation to goods or services, in respect of which the trade mark is registered.

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

(3) The registered owner is not liable for costs if he or she does not take part in the proceedings for an action brought under subsection (2).

### **PART 4 APPLICATION FOR REGISTRATION**

#### *Division 1 General*

#### **11. Making of application**

(1) A person may apply, in the prescribed form, for the registration of a trade mark in respect of goods or services or both if—

- (a) the person claims to be the owner of the trade mark; and
- (b) one of the following applies—
  - (i) the person is using or intends to use the trade mark in relation to the goods or services or both,
  - (ii) the person has authorised or intends to authorise another person to use the trade mark in relation to the goods or services or both,
  - (iii) the person intends to assign the trade mark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trade mark in relation to the goods or services or both.

(2) Without limiting the particulars that may be included in an application made under subsection (1), the application shall—

- (a) include 6 representations of the trade mark; and
- (b) specify, in accordance with the regulations, the goods or services or both, in respect of which it is sought to register the trade mark.

(3) An application, other than an application under section 35 for the registration of 2 or more trade marks as a series, may be made in respect of goods and services of one or more of the classes prescribed in the regulations.

## **12. Application by joint owners**

If the relations between 2 or more persons interested in a trade mark are such that none of them is entitled to use the trade mark except—

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

the persons may together apply for its registration under section 11(1).

## **13. Claim for priority**

(1) If—

- (a) a person has made an application for the registration of a trade mark in one or more than one Convention country; and
- (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or that person's predecessor in title applies to the Registrar for the registration of the trade mark in respect of some or all of the goods or services or both in respect of which registration was sought in that country or those countries,

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

(2) The priority claimed under subsection (1) is for the registration of the trade mark in respect of the goods or services—

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

#### **14. Notice of application to be published**

The Registrar shall publish notice, in the prescribed form, of an application to register a trade mark.

#### **15. Registrar to examine, and report on, application**

The Registrar shall, in accordance with the regulations, examine and report on—

- (a) whether an application made under section 11 has been made in accordance with this Act; and
- (b) whether there are grounds under Division 2 for rejecting it.

#### **16. Registrar to decide on disputed classification of goods etc.**

If a question arises as to the class in which goods or services are comprised—

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

#### **17. Application accepted or rejected**

(1) The Registrar shall, after the examination made under section 15, accept an application made under section 11 unless he or she is satisfied that—

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

(2) The Registrar may accept an application made under section 11 subject to conditions or limitations.

(3) If the Registrar is satisfied that—

- (a) an application has not been made in accordance with this Act; or
  - (b) there are grounds for rejecting it,
- the Registrar shall, subject to subsection (4), reject an application.

(4) The Registrar may not reject an application made under section 11 without giving the applicant an opportunity of being heard.

#### **18. Notice etc. of decision**

The Registrar shall—

- (a) notify an applicant in writing of his or her decision to accept or reject an application under section 17; and
- (b) publish notice of the decision in the Gazette.

#### **19. Appeal**

An applicant may appeal to the High Court against a decision of the Registrar—

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



## **20. Deferment of acceptance**

The Registrar may defer the acceptance of an application made under section 11 in the circumstances provided for, and for the period prescribed in the regulations.

## **21. Lapsing of application**

(1) Subject to subsection (2), an application lapses if—

- (a) it is not accepted; or
- (b) no further action is taken on the application by the applicant;
- (c) the applicant fails to submit information requested by the Registrar, within the prescribed period or within the period as extended by the Registrar in accordance with section 195.

(2) If, after the prescribed period or the prescribed period as extended has expired, the Registrar extends under section 195 the period within which an application may be accepted, the application—

- (a) is taken not to have lapsed when the prescribed period expired; and
- (b) lapses if it is not accepted within the extended period.

## **22. Revocation of acceptance**

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

- (a) that an application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations,

the Registrar may revoke the acceptance of the application—

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

- (a) the application is taken to have never been accepted; and
- (b) the Registrar shall examine, and report on, the application as necessary under section 15; and
- (c) sections 17 and 18 again apply in relation to the application.

### *Division 2 Grounds for rejecting an application*

## **23. Trade mark containing certain signs**

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

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

- (a) a sign that is prescribed for the purposes of subsection (1); or
- (b) a sign so nearly resembling—
  - (i) a sign referred to in paragraph (a), or
  - (ii) a sign referred to in subsection (1); as to be likely to be taken for it.

## **24. Trade mark that cannot be represented graphically**

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

## **25. Trade mark not distinguishing applicant's goods or services**

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

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

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

(4) If the Registrar finds that the trade mark is to some extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons but is unable to decide, on that basis alone, that the trade mark is capable of so distinguishing the designated goods or services—

- (a) the Registrar is to consider whether, because of the combined effect of the following—
  - (i) the extent to which the trade mark is inherently adapted to distinguish the designated goods or services,
  - (ii) the use, or intended use, of the trade mark by the applicant, and
  - (iii) any other circumstances,the trade mark does or will distinguish the designated goods or services as being those of the applicant; and
- (b) If—
  - (i) the Registrar is then satisfied that the trade mark does or will so distinguish the designated goods or services the trade mark is taken to be capable of distinguishing the applicant's goods or services from the goods or services of other persons; or
  - (ii) the Registrar is not satisfied that the trade mark does or will so distinguish the designated goods or services, the trade mark is taken not to be capable of distinguishing the applicant's goods or services from the goods or services of other persons.

(5) If the Registrar finds that the trade mark is not inherently adapted to distinguish the designated goods or services from the goods or services of other persons, the following provisions apply—

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

## **26. Trade mark scandalous or its use contrary to law**

An application for the registration of a trade mark shall be rejected if—

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

## **27. Trade mark likely to deceive or cause confusion**

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

## **28. Identical etc. trade marks**

(1) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of goods shall be rejected if—

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

(2) Subject to subsections (3) and (4), an application for the registration of a trade mark in respect of services shall be rejected if—

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

(3) If the Registrar, in either case mentioned in subsection (1) or (2), is satisfied—

- (a) that there has been honest concurrent use of the 2 trade marks; or
- (b) that, because of other circumstances, it is proper to do so,

the Registrar may accept the application for the registration of the applicant's trade mark subject to any conditions or limitations that the Registrar thinks fit to impose and if the applicant's trade mark has been used only in a particular area, the limitations may include that the use of the trade mark is to be restricted to that particular area.

(4) If the Registrar in either case mentioned in subsection (1) or (2) is satisfied that the applicant, or the applicant and the predecessor in title of the applicant, have continuously used the applicant's trade mark for a period—

- (a) beginning before the priority date for the registration of the other trade mark in respect of—
  - (i) the similar goods or closely related services, or
  - (ii) the similar services or closely related goods, and
- (b) ending on the priority date for the registration of the applicant's trade mark,  
the Registrar may not reject the application because of the existence of the other trade mark.

*Division 3*  
*Divisional applications*

**29. Definition of divisional application**

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

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

(2) For the purposes of this Division—

- (a) the initial application is taken to be the application for which notice has been published by the Registrar under section 14; and
- (b) a divisional application is an application made under this Division.

**30. Divisional application possible only if initial application is pending**

A divisional application for the registration of a trade mark or a part of a trade mark may be made only if the initial application for the registration of the trade mark is pending.

**31. Divisional application for registration of part of trade mark**

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

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

(3) If the initial application has been accepted, notice of the divisional application shall not be made after the acceptance is published in the Gazette under section 18.

**32. Divisional application for registration of trade mark in respect of some of goods etc.**

(1) This section provides for the making of a divisional application for the registration of a trade mark in respect of some of the goods or services or both in

respect of which registration of the trade mark is being sought by the initial application.

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

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

(3) If the initial application has been accepted, the divisional application may not be made after the notice of acceptance is published in the Gazette under section 18.

### **33. Divisional application for registration of trade mark in respect of goods etc. excluded from the initial application**

(1) This section—

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

(2) If the initial application is amended—

- (a) before a decision is made about it under section 17; or
- (b) if the initial application is accepted, before notice of its acceptance is published in the Gazette under section 18,

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

(3) If the initial application has been accepted, the divisional application may not be made after the notice of the acceptance is published in the Gazette under section 18.

(4) If the initial application, whether it has already been amended or not, is amended after notice of its acceptance has been in the Gazette under section 18, the applicant may, within the prescribed period, make a divisional application for the registration of the trade mark in respect of any or all of the goods or services or both that have been excluded from the application whose notice of acceptance was so published.

### **34. Filing date**

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

## *Division 4* *Application for registration of series of trade marks*

### **35. Application—series of trade marks**

(1) A person may make a single application under section 11(1) for the registration of 2 or more trade marks in respect of similar goods or similar services within a single class if the trade marks resemble each other in material particulars and differ only in respect of one or more of the following matters—

- (a) statements or representations as to the goods or services in relation to which the trade marks are used or are intended to be used;
  - (b) statements or representations as to number, price, quality or names of places;
  - (c) the colour of any part of the trade mark;
  - (d) any matter that is not inherently adapted to distinguish the goods or services and does not substantially affect the identity of the trade marks.
- (2) If—
- (a) the application meets all the requirements of this Act; and
  - (b) the Registrar is required, under section 52, to register the trade marks, he or she shall register them as a series in one registration.

## **PART 5 OPPOSITION TO REGISTRATION**

### *Division 1 General*

#### **36. Opposition**

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

(2) A notice of opposition filed under subsection (1) shall be in an approved form and shall be filed within the prescribed period or within that period as extended in accordance with the regulations.

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

(4) The registration of a trade mark may be opposed on any of the grounds specified in Division 2 and on no other grounds.

#### **37. Proceedings in name of a person other than the person who filed the notice**

If—

- (a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and
- (b) the other person—
  - (i) notifies the Registrar in writing that the right or interest is vested in him or her, and
  - (ii) does not withdraw the opposition,

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

#### **38. Opposition proceedings**

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

(2) Subject to subsection (1), the proceedings for dealing with the opposition shall be in accordance with the regulations.

### **39. Decision**

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

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

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

### **40. Appeal**

An applicant or opponent may appeal to the High Court against a decision of the Registrar under section 39.

#### *Division 2 Grounds for opposing registration*

### **41. Registration may be opposed on same grounds as for rejection**

The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under Division 2 of Part 4, except the ground that the trade mark cannot be represented graphically.

### **42. Applicant not owner of trade mark**

The registration of a trade mark may be opposed on the ground that the applicant is not the owner of the trade mark.

### **43. Applicant not intending to use trade mark**

The registration of a trade mark may be opposed on the ground that the applicant does not intend—

- (a) to use, or authorise the use of, the trade mark in Saint Lucia; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia,

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

### **44. Trade mark similar to trade mark that has acquired a reputation**

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

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

### **45. Trade mark containing or consisting of a false geographical indication**

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

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

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

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

(3) In addition to subsection (2), an opposition on a ground referred to in subsection (1) fails if the applicant establishes that—

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

(4) In this section—

“**relevant goods**” means the particular goods for which registration is opposed under subsection (1);

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

#### **46. Application etc. defective etc.**

The registration of a trade mark may be opposed on any of the following grounds—

- (a) that the application, or a document filed in support of the application, was amended contrary to this Act;
- (b) that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.



**PART 6**  
**AMENDMENT OF APPLICATION FOR REGISTRATION OF A TRADE MARK AND**  
**OTHER DOCUMENTS**

**47. Amendment of application for registration of trade mark**

(1) The Registrar may, at the written request of the applicant or of his or her agent, amend an application for the registration of a trade mark in accordance with section 48 or 49.

(2) If—

- (a) an application for the registration of a trade mark may be amended under section 49; and
- (b) the applicant has not asked in writing that the application be amended, the Registrar may, on his or her own initiative but in accordance with the regulations, amend the application as necessary to remove any ground on which the application could be rejected.

**48. Amendment before notice of application is published**

If—

- (a) the notice of an application has not yet been published under section 14; and
- (b) the request for the amendment is made within the prescribed period, an amendment may be made to correct a clerical error or an obvious mistake.

**49. Amendment after notice of application has been published**

(1) If the notice of an application has been published under section 14, the application may be amended as provided in this section.

(2) An amendment may be made to the representation of the trade mark if the amendment does not substantially affect the identity of the trade mark as at the time when the notice of the application was published.

(3) An amendment may be made to correct a mistake of fact or an error in the classification of any goods or services specified in the application.

(4) An amendment may be made to change the type of registration sought in the application.

(5) An amendment may be made to any particular specified in the application other than that referred to in subsection (4), unless the amendment would have the effect of extending the rights that, apart from the amendment, the applicant would have under the registration if it were granted.

**50. Amendment of other documents**

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

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

## **51. Appeal**

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

## **PART 7 REGISTRATION OF TRADE MARKS**

### *Division 1 Initial registration*

## **52. Obligation to register**

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

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

(2) On registering a trade mark under subsection (1), the Registrar shall give it a number by which it may be identified.

## **53. Registration—how effected**

(1) The trade mark shall be registered—

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

(2) The Registrar shall, in addition to subsection (1), enter in the Register—

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

(3) If 2 or more persons applied together for the registration of the trade mark, the applicants shall be registered as joint owners of the trade mark.

## **54. Colours in registered trade marks**

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

(2) The limitations under subsection (1) may be in respect of the whole, or a part, of the trade mark.

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

## **55. Notification of registration**

When a trade mark has been registered, the Registrar shall—

- (a) publish notice of the registration in the Gazette; and

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

## **56. Date and term of registration**

(1) Subject to subsection (2), the registration of a trade mark in respect of the goods or services or both in respect of which the trade mark is registered is taken to have had effect from and including the filing date in respect of the application for registration.

(2) If—

- (a) an application for registration was in respect of a trade mark whose registration had also been sought in one or more than one Convention country;
- (b) the applicant claimed a right of priority under section 13 for the registration of the trade mark in respect of particular goods or services; and
- (c) the trade mark is registered under this Act,

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

(3) Unless it is earlier cancelled, or the trade mark is earlier removed from the Register, the registration of a trade mark expires 10 years after the filing date in respect of the application for its registration.

## **57. Ceasing of registration**

The registration of a trade mark ceases if—

- (a) the trade mark is removed from the Register under section 62 or Part 9; or
- (b) the registration of the trade mark is cancelled.

## **58. Disclaimers**

(1) An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice in writing given to the Registrar, disclaim any exclusive right to use, or authorise the use of, a specified part of the trade mark.

(2) A disclaimer under subsection (1) affects only the rights given by this Act to the registered owner of the trade mark on registration of the trade mark.

(3) The Registrar shall, on registering the trade mark or on receiving notice of the disclaimer whichever is later, enter the particulars of the disclaimer in the Register.

(4) A disclaimer made in accordance with subsection (1) shall not be revoked.

### *Division 2 Renewal of registration Request for renewal*

## **59. Request for renewal**

Any person may, within the prescribed period before the registration of a trade mark expires, make a request in the prescribed form to the Registrar for the renewal of the registration.

## **60. Notice of renewal date**

If, at the beginning of the prescribed period, the Registrar has not received a request for the renewal of the registration of the trade mark, the Registrar shall, in accordance with the regulations, notify the registered owner of the trade mark that the renewal is due.

## **61. Renewal before registration expires**

(1) If a request for the renewal of the registration of a trade mark is made in accordance with section 59, the Registrar shall renew the registration for a period of 10 years from the day on which the registration of the trade mark would expire if it were not renewed.

(2) The Registrar shall give notice, in the prescribed form, of a renewal granted under subsection (1) to the registered owner of the trade mark.

## **62. Failure to renew**

If the registration of a trade mark is not renewed, then—

- (a) subject to sections 63 and 64, the registration ceases to have effect when it expires; and
- (b) unless the registration is renewed under section 63, the Registrar shall remove the trade mark from the Register 12 months after the day on which the registration expired.

## **63. Renewal within 12 months after registration expires**

If, within 12 months after the registration of a trade mark has expired, a person makes a request to the Registrar, in accordance with section 59, for the renewal of the registration of the trade mark, the Registrar shall renew the registration of the trade mark for 10 years from the day on which the registration expired.

## **64. Status of un-renewed trade mark**

If—

- (a) the registration of a trade mark has not been renewed; and
- (b) within 12 months after the registration expired, an application for the registration of a trade mark is made by a person other than the person who was registered as the owner of the un-renewed trade mark,

the un-renewed trade mark is taken to be a registered trade mark for the purposes of the application.

# **PART 8 AMENDMENT AND CANCELLATION OF REGISTRATION**

## *Division 1 Action by Registrar*

## **65. Correction of register**

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

## **66. Adaptation of classification**

The Registrar may, in accordance with the regulations, amend the Register, whether by making, removing or altering entries, for the purpose of adapting the

designation of the goods or services in respect of which trade marks are registered to reflect any change that has occurred in the classification of goods or services for the purposes of this Act.

#### **67. Amendment of particulars of trade mark entered in Register**

(1) Subject to Division 2, the Registrar may, at the written request of the registered owner of a registered trade mark—

- (a) amend the representation of the trade mark as entered in the Register if the amendment does not substantially affect the identity of the trade mark as at the time when the notice of the acceptance of the application for the registration of the trade mark was published under section 18;
- (b) amend any particulars entered in the Register relating to any goods or services in respect of which the trade mark is registered if the amendment does not have the effect of extending the rights that apart from the amendment the owner has under the registration; or
- (c) amend, or enter in the Register, any other particular in respect of the trademark if the amendment or entry does not have the effect of extending the rights that, apart from the amendment or entry, the owner has under the registration.

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

#### **68. Cancellation of registration**

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

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

- (a) any person recorded under Part 11 as claiming a right in respect of, or an interest in, the trade mark; and
- (b) if—
  - (i) an application has been made to the Registrar for a record of the assignment or transmission of the trade mark to a person to be entered in the Register under section 93, and
  - (ii) the assignment has not yet been recorded,  
the person to whom the trade mark has been assigned or transmitted.

#### *Division 2 Action by court*

#### **69. Amendment to correct error or omission**

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

- (a) entering in the Register particulars that were wrongly omitted from it; or
- (b) correcting any error in an entry in the Register.

#### **70. Amendment or cancellation on ground of contravention of condition etc.**

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

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

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

#### **71. Amendment or cancellation—loss or exclusive rights to use trade mark**

(1) If section 8 or 9 applies in relation to a registered trade mark, the High Court may, on the application of an aggrieved person, but subject to subsection (2) and section 73, order that the Register be rectified by—

- (a) cancelling the registration of the trade mark; or
- (b) removing or amending any entry in the Register relating to the trademark, having regard to the effect of section 8 or 9, on the right of the registered owner of the trade mark to use the trade mark, or any sign that is part of the trade mark, in relation to particular goods or services.

(2) If section 8 or 9 applies in relation to a trade mark because the trade mark contains a sign that—

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

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

#### **72. Amendment or cancellation—other specified grounds**

(1) Subject to subsection (2) and section 73, the High Court may, on the application of an aggrieved person, order that the Register be rectified by—

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

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

- (a) any of the grounds on which the registration of the trade mark could have been opposed under Division 2 of Part 5;
- (b) an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation;
- (c) because of the circumstances applying at the time when the application for rectification is filed, the use of the trade mark is likely to deceive or cause confusion for a reason other than one for which—
  - (i) the application for the registration of the trade mark could have been rejected under section 27 or 28, or

- (ii) the registration of the trade mark could have been opposed under section 44;
- (d) the following circumstances apply—
  - (i) the Registrar accepted the application for the registration of the trade mark because he or she was satisfied, having regard to the extent to which the trade mark was inherently adapted to distinguish the goods or services of the applicant for registration from the goods or services of any other person and the intended use of the trade mark, that the trade mark would distinguish those goods or services as being those of the applicant,
  - (ii) the application for rectification is made at least 10 years after the filing date, or
  - (iii) in the intervening period, the trade mark has not been used to an extent sufficient for it to distinguish, in fact, the goods or services of the registered owner from the goods or services of any other person;
- (e) the application is in respect of an entry in the Register and the entry was made, or has been previously amended, as a result of fraud, false suggestion or misrepresentation.

**73. Rectification may not be granted in certain cases if registered owner not at fault etc.**

- (1) The High Court may decide not to grant an application for rectification made—
  - (a) under section 71;
  - (b) on the ground that the trade mark is liable to deceive or confuse; or
  - (c) on the ground referred to in section 72(2)(c),if the registered owner of the trade mark satisfies the High Court that the ground relied on by the applicant has not arisen through any act or fault of the registered owner.
- (2) In making a decision under subsection (1), the High Court—
  - (a) shall also take into account any matter that is prescribed; and
  - (b) may take into account any other matter that it considers relevant.

**74. Duties and powers of Registrar**

- (1) A person applying to the High Court under this Division shall give notice of the application to the Registrar.
- (2) Except for cases where the High Court directs the Registrar to appear, the Registrar may appear before the High Court and be heard at his or her discretion.
- (3) A person applying under this division shall give to the Registrar a copy of any order made by the High Court under this Division and the Registrar shall comply with the order.

*Division 3  
Amendment of certificate of registration*

**75. Amendment of certificate of registration**

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

**PART 9**  
**REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE**

**76. Application for removal of trade mark from Register etc.**

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

(2) An application under subsection (1)—

- (a) shall be as prescribed in the regulations; and
- (b) may be made in respect of any or all of the goods or services or both in respect of which the trade mark may be, or is, registered.

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

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

- (a) on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith—
  - (i) to use the trade mark in Saint Lucia,
  - (ii) to authorise the use of the trade mark in Saint Lucia, or
  - (iii) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia,

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

- (b) the trade mark has remained registered for a continuous period of 3 years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner—
  - (i) used the trade mark in Saint Lucia, or
  - (ii) used the trade mark in good faith in Saint Lucia,

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

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

**77. Time for making application**

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

(2) An application on the ground referred to in section 76(4)(b) may not be made before a period of 5 years has passed from the filing date in respect of the application for the registration of the trade mark.



## **78. Referral to court**

If—

- (a) an application has been made to the Registrar under section 76(1); and
- (b) the Registrar is of the opinion that the matter should be decided by High Court,

the Registrar may refer the matter to the High Court and the High Court may hear and determine the matter as if an application had been made to it under section 76(3).

## **79. Notification of application**

(1) If an application has been made to the Registrar under section 76, the Registrar shall give notice of the application in accordance with the regulations.

(2) If the application, referred to in subsection (1), is in respect of a trade mark already entered on the Register, the Registrar shall publish a notice of the application in the Gazette.

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

## **80. Notice of opposition**

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

(2) The notice of opposition—

- (a) shall be in a form approved by the Registrar or by the High Court; and
- (b) shall be filed in accordance with the regulations or the rules of court as the case may be.

## **81. Removal of trade mark from the Register etc. if application unopposed**

(1) If there is no opposition to an application to the Registrar under section 76(1), the Registrar shall remove the trade mark from the Register in respect of the goods or services or both specified in the application.

(2) If there is no opposition to an application to the High Court under section 76(3), the High Court shall order the Registrar to remove the trade mark from the Register in respect of the goods or services or both specified in the application.

(3) The High Court shall cause a copy of the order made under subsection (2) to be served on the Registrar and the Registrar shall comply with the order.

## **82. Trade mark restored to Register if notice of opposition filed within extended time**

If—

- (a) the Registrar has removed a trade mark from the Register under section 81(1) because no notice of opposition was filed within the period provided under the regulations; and
- (b) the Registrar subsequently extends the period within which the notice may be filed;
- (c) a notice of opposition is filed within the extended period,

the Registrar shall restore the trade mark to the Register and the trade mark is taken not to have been removed from the Register.

### **83. Proceedings before Registrar**

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

### **84. Burden on opponent to establish use of trade mark etc.**

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

- (a) any allegation made under section 76(4)(a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith—
  - (i) to use the trade mark in Saint Lucia,
  - (ii) to authorise the use of the trade mark in Saint Lucia, or
  - (iii) to assign the trade mark to a body corporate for use by the body corporate in Saint Lucia,
    - in relation to the goods or services or both to which the opposed application relates (in this section referred to as “relevant goods or services or both”); or
- (b) any allegation made under section 76(4)(a) that the trade mark has not, at any time before the period of one month ending on the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both; or
- (c) any allegation made under section 76(4)(b) that the trade mark has not, at any time during the period of 3 years ending one month before the day on which the opposed application was filed, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both.

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

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

(3) For the purposes of subsection (1)(c), the opponent is taken to have rebutted the allegation that the trade mark has not, at any time during the period referred to in that subsection, been used, or been used in good faith, by its registered owner in relation to the relevant goods or services or both if—

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

#### **85. Determination of opposed application-general**

(1) Subject to subsection (3) and to section 86, if—

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

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

(2) Subject to subsection (3) and to section 86, if, at the end of the proceedings relating to an opposed application, the High Court is satisfied that the grounds on which the application was made have been established, the High Court may order the Registrar to remove the trade mark from the Register in respect of any or all of the goods or services or both to which the application relates.

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

#### **86. Determination of opposed application-localised use of trade mark**

(1) This section applies if an application for the removal of a trade mark from the Register is made on the ground referred to in section 76(4)(b) and—

- (a) the applicant is the registered owner of a trade mark that is substantially identical with, or deceptively similar to, the challenged trade mark and is registered in respect of the goods or services or both specified in the application subject to the condition or limitation that the use of the trade mark is to be restricted to—
  - (i) goods or services or both to be dealt with or provided in a particular place in Saint Lucia, otherwise than for export from Saint Lucia, or
  - (ii) goods or services or both to be exported to a particular market; or

- (b) the Registrar or the High Court is of the opinion that such a trade mark may properly be registered in the name of the applicant with that condition or limitation.

(2) If the Registrar or the High Court is satisfied—

- (a) that the challenged trade mark has remained registered for the period referred to in section 76(4)(b); and
- (b) that during that period there has been no use, or no use in good faith, of the challenged trade mark in relation to—
  - (i) goods or services dealt with or provided in the particular place referred to in subsection (1), or
  - (ii) goods or services to be exported to the particular market referred to in subsection (1),

the Registrar may decide, or the High Court may order, that the challenged trade mark should not be removed from the Register but that the registration of the trade mark should be subject to the conditions or limitations that the Registrar or the High Court considers necessary to ensure that the registration does not extend to the use of the trade mark in relation to—

- (c) goods or services dealt with or provided in the specified place; or
- (d) goods or services to be exported to the specified market.

(3) In this section “**challenged trade mark**” means the trade mark in relation to which an application for removal is made under subsection (1).

### **87. Registrar to comply with order of court**

If the High Court makes an order under section 85 or 86 the High Court shall cause a copy of the order to be served on the Registrar and the Registrar shall comply with the order.

### **88. Appeal**

An appeal lies to the High Court from a decision of the Registrar under section 85 or 86.

### **89. Certificate—use of trade mark**

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

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

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

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

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

**PART 10**  
**ASSIGNMENT AND TRANSMISSION OF TRADE MARKS**

**90. Assignment etc. of trade mark**

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

(2) An assignment or transmission under subsection (1) may be partial, that is, it may apply to some only of the goods or services or both in respect of which registration is sought or the trade mark is registered, but it may not be partial in relation to the use of a trade mark in a particular area.

(3) An assignment or transmission under subsection (1) may be with or without the goodwill of the business concerned in the relevant goods or services or both.

**91. Applications for record to be made of assignment etc. of trade mark whose registration is sought**

If a trade mark whose registration is being sought is assigned or transmitted—

- (a) the applicant for the registration of the trade mark; or
- (b) the person to whom it has been assigned or transmitted,

shall apply, in the prescribed form, to the Registrar for the assignment or transmission to be recorded.

**92. Recording of assignment etc. of trade mark whose registration is sought**

(1) If an application made under section 91 complies with this Act the Registrar shall—

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

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

**93. Application for record of assignment etc. of registered trade mark to be entered in Register**

If a registered trade mark is assigned or transmitted—

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

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

**94. Recording of assignment etc. of registered trade mark**

(1) If an application made under section 93 complies with this Act, the Registrar shall, at, or within, the time provided for in the regulations—

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

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

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

(3) The Registrar shall publish notice of—

- (a) the recording of the assignment or transmission; and
- (b) the registration of the beneficiary as the owner of the trade mark in the Gazette.

(4) In this section “**beneficiary**” means the person to whom a trade mark has been assigned or transmitted.

### **95. Notice of application to be given to person recorded as claiming interest in trade mark etc.**

If an application made under section 91 or 93 in relation to the assignment or transmission of a trade mark complies with this Act, the Registrar shall notify in accordance with the regulations any person recorded under Part 11 as claiming an interest in, or a right in respect of, the trade mark.

## **PART 11 VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN AND RIGHTS IN RESPECT OF TRADE MARKS**

### *Division 1 Preliminary*

### **96. Object of Part**

This Part makes provision—

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

### *Division 2 Interests in, and rights in respect of, registered trade marks*

### **97. Application to have claims to interest etc. recorded**

If—

- (a) a person, other than the registered owner of the trade mark, claims to have an interest in, or a right in respect of, a registered trade mark; and
- (b) this interest or right may not be recorded in the Register under Part 10,

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

### **98. Record of claims to interest etc.**

(1) If an application has been made in accordance with section 97, the Registrar shall enter in the Register the particulars of the claim set out in the application.

(2) If—

- (a) a trade mark is registered; and
  - (b) immediately before the registration, particulars of a claim to an interest in, or right in respect of, the trade mark were recorded under Division 3,
- the Registrar shall enter those particulars in the Register.

### **99. Amendment and cancellation**

The regulations may provide for the amendment and cancellation of particulars entered in the Register under this Division.

### **100. Record not proof etc. of existence of right etc.**

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

#### *Division 3*

#### *Interests in, and rights in respect of unregistered trade marks*

### **101. Application to have claims to interest etc. recorded**

If—

- (a) a person has applied for the registration of a trade mark; and
- (b) another person claims to have an interest in, or a right in respect of, the trade mark,

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

### **102. Record of claims to interest etc.**

If an application has been made in accordance with section 101, the Registrar shall record in the manner that the Registrar thinks fit, but not in the Register, the particulars of the claim set out in the application.

### **103. Amendment and cancellation**

The regulations may provide for the amendment and cancellation of particulars recorded under this Division.

## **PART 12 INFRINGEMENT OF TRADE MARKS**

### **104. Infringement of trade mark**

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

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

- (a) goods of the same description as that of registered goods;
- (b) services that are closely related to registered goods; or
- (c) services of the same description as that of registered services; or
- (d) goods that are closely related to registered services.

(3) A person is not taken to have infringed the trade mark if the person establishes that his or her use of the sign as in subsection (2)(a), (2)(b), (2)(c) or (2)(d) of is not likely to deceive or cause confusion.

(4) A person infringes a registered trade mark if—

- (a) the trade mark is well known in Saint Lucia; and
- (b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to—
  - (i) unrelated goods,
  - (ii) unrelated services; and
- (c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and
- (d) for that reason, the interests of the registered owner are likely to be adversely affected.

(4) In deciding, for the purposes of subsection (3)(a), whether a trade mark is well known in Saint Lucia, one shall take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason.

(5) In this section—

“**registered goods**” means goods in respect of which a trade mark is registered;

“**registered services**” means services in respect of which a trade mark is registered;

“**unrelated goods**” means goods that are not of the same description as that of the registered goods or that are not so closely related to the registered services;

“**unrelated services**” means services that are not of the same description as that of the registered service or that are not so closely related to the registered goods.

## **105. Infringement of trade mark by breach of certain restrictions**

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

(2) Each of the following is a prohibited act—

- (a) applying the trade mark to registered goods, or using the trade mark in physical relation to them after the state condition get-up or packaging in which they were originally offered to the public has been altered;
- (b) altering or partially removing or obliterating, any representation of the mark applied to registered goods or used in physical relation to them;
- (c) if the trade mark has been applied to registered goods, or used in physical relation to them, together with other matter indicating that the registered



owner or authorised user has dealt with the goods, removing or obliterating, totally or in part, any representation of the trade mark without totally removing or obliterating the other matter;

- (d) applying another trade mark to registered goods or using another trade mark in physical relation to them;
- (e) if the trade mark has been applied to registered goods or used in physical relation to them, using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the reputation of the trade mark.

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

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

(4) The trade mark is not infringed if the owner of the goods—

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

(5) Despite section 104, a person does not infringe a registered trade mark when—

- (a) the person uses in good faith—
  - (i) the person's name or the name of the person's place of business, or
  - (ii) the name of a predecessor in business of the person or the name of the predecessor's place of business; or
- (b) the person uses a sign in good faith to indicate—
  - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services, or
  - (ii) the time of production of goods or of the rendering of services; or
- (c) the person uses the trade mark in good faith to indicate the intended purpose of goods or services; or
- (d) the person uses the trade mark for the purposes of comparative advertising; or
- (e) the person exercises a right to use a trade mark given to the person under this Act; or
- (f) the court is of the opinion that the person would obtain registration of the trade mark in his or her name if the person were to apply for it; or
- (g) the person, in using a sign referred to in section 104(1), (2) or (3) in a manner referred to in that section, does not, because of a condition or limitation subject to which the trade mark is registered, infringe the exclusive right of the registered owner to use the trade mark.

(6) Despite section 104, if a disclaimer has been registered in respect of a part of a registered trade mark, a person does not infringe the trade mark by using that part of the trade mark.

#### **106. Goods etc. to which registered trade mark has been applied by or with consent of registered owner**

(1) Despite section 104, a person who uses a registered trade mark in relation to goods that are similar to registered goods does not infringe the trade mark if the trade mark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trade mark.

(2) Despite section 104, a person who uses a registered trade mark in relation to services that are similar to registered services does not infringe the trade mark if the trade mark has been applied in relation to the services by, or with the consent of, the registered owner of the trade mark.

#### **107. Prior use of identical trade mark etc.**

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

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

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

(2) If the unregistered trade mark has continuously been used only in a particular area of Saint Lucia, subsection (1) applies only to the use of the trade mark by the person in that area.

#### **108. What courts may hear action for infringement of registered trade mark**

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

(2) Subsection (1) does not prevent an action for infringement of a registered trade mark from being brought in any other court that has jurisdiction to hear the action.

#### **109. What relief can be obtained from court**

The relief that a court may grant in an action for an infringement of a registered trademark includes—

- (a) an injunction, which may be granted subject to any condition that the court thinks fit; and
- (b) at the option of the plaintiff but subject to section 110, damages or an account of profits.

#### **110. Special case—plaintiff not entitled to damages etc.**

If—

- (a) in an action for the infringement of a trade mark registered in respect of particular goods or services, the court finds that the defendant has infringed the trade mark;

- (b) the defendant has applied under section 76(3) for an order directing the Registrar to remove the trade mark from the Register in respect of those goods or services; and
- (c) the court finds that, because the trade mark has not during a particular period been used in good faith by its registered owner in relation to those goods or services, there are grounds under section 76(4) for so removing the trade mark from the Register,

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

#### **111. Circumstances in which action may not be brought**

If the registration of a trade mark is renewed, under section 63, within 12 months after it has expired, an action may not be brought in respect of an act that—

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

#### **112. Groundless threats of legal proceedings**

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

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

any person aggrieved by the threat may bring an action, either in the High Court or in any other court having jurisdiction, against the person making the threat.

(2) The purpose of an action under subsection (1) is to—

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

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

(4) The court may not find in favour of the plaintiff if the defendant satisfies the court that—

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

(5) An action may not be brought, or if brought may not proceed, under this section if the registered owner of the trade mark, or an authorised user of the trade mark having power to bring an action for infringement of the trade mark, with due diligence, begins and pursues an action against the threatened person for infringement of the trade mark.

(6) In this Part—

“**plaintiff**” means the person bringing an action under subsection (1);

“**defendant**” means the person making a threat and against whom the action is brought under subsection (1);

“**threatened person**” means the person against whom an action has been threatened under subsection (1).

### **113. Counterclaim by defendant in action on groundless threats**

If the defendant in an action brought under section 112 would be entitled to bring against the plaintiff an action for infringement of the registered trade mark—

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

## **PART 13 IMPORTATION OF GOODS INFRINGING SAINT LUCIAN TRADE MARKS**

### **114. Object of Part**

The object of this Part is to protect registered trade marks by making provision allowing the Comptroller to seize and deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered trade mark.

### **115. Notice of objection to importation**

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

(2) If—

- (a) the registered owner of the registered trade mark has not given a notice under subsection (1); or
- (b) any notice given under subsection (1) is no longer in force,  
an authorised user of the trade mark having power to give a notice under subsection (1) may ask the registered owner to give such a notice in respect of the trade mark.

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

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

(4) A notice given by the registered owner of a trade mark remains in force for 2 years from the day on which the notice is given unless it is revoked, before the end of that period, by notice in writing given to the Comptroller by the person who is then the registered owner of the trade mark.

(5) A notice given by an authorised user of the trade mark remains in force for 2 years unless it is revoked, before the end of that period, by notice in writing given to the Comptroller—

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

### **116. Comptroller may seize goods infringing trade mark**

- (1) This section applies to goods manufactured outside Saint Lucia that—
  - (a) are imported into Saint Lucia; and
  - (b) are subject to the control of Customs under the Customs (Control and Management) Act.
- (2) If goods to which this section applies—
  - (a) have applied to them or in relation to them a sign that, in the opinion of the Comptroller, is substantially identical with, or deceptively similar to, a notified trade mark; and
  - (b) are goods in respect of which the notified trade mark is registered,  
  
the Comptroller shall seize the goods unless he or she is satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.
- (3) The Comptroller may decide not to seize the goods if he or she has not been given by the objector, or by one or more of the objectors, security in an amount that he or she considers sufficient to repay to the Government the expense that may be incurred by the Government if the goods were seized.
- (4) Goods seized under this section shall be kept in a secure place as directed by the Comptroller.

### **117. Notice of seizure**

The Comptroller shall, as soon as practicable—

- (a) give, either personally or by post, to the designated owner of any seized goods a notice in writing identifying the goods and stating that they have been seized under section 116; and
- (b) give, either personally or by post, to the objector, or to each objector, a notice in writing—
  - (i) identifying the goods and stating that they have been seized under section 116,
  - (ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller has and that he or she believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods, and
  - (iii) stating that the goods will be released to the designated owner unless the objector or one of the objectors, as the case requires, intends to bring an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller notice in writing of the intended action, within the period of 10 working days after he or she has been given the notice or, if the Comptroller extends that period under section 120(1), within the extended period.

### **118. Forfeiture of goods**

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

(2) If the designated owner gives such a notice, the goods are forfeited to the Government.

### **119. Release of goods to owner-no action for infringement**

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

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

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

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

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

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

(4) In this section "**action period**", in relation to seized goods, means—

- (a) if there is only one objector to the importation of the goods, the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under section 120(1); or
- (b) if there is more than one objector to the importation of the goods—the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under section 120(1) and ending at the end of the last day on which an objector may bring such an action under section 120(1).

### **120. Action for infringement of trade mark**

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

- (a) if paragraph (b) does not apply within the period of one month from the date of the notice given to the objector in respect of the goods under section 117; or
- (b) if—
  - (i) the objector has, before the end of the period specified in paragraph (a), applied in writing to the Comptroller for an extension of that period, and
  - (ii) the Comptroller, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended that period for a number of working days not exceeding 10 days;

within the period as so extended by the Comptroller.

(2) The court hearing an action brought under subsection (1)—

- (a) may, on the application of a person, allow the person to be joined as a defendant to the action; and
- (b) shall allow the Comptroller to appear and be heard.

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

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

(4) If—

- (a) the court decides that the trade mark was not infringed by the importation of the goods; and
- (b) the designated owner of the goods, or any other defendant, satisfies the court that he or she has suffered loss or damage because the goods were seized,

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

(5) If, after 3 months from the day on which the action was brought, there is not in force at any time an order of the court preventing the goods from being released, the Comptroller shall release the goods to their designated owner.

(6) If the court orders that the goods be released, the Comptroller shall, subject to section 123, comply with the order.

### **121. Action for infringement by authorised user**

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

### **122. Disposal of forfeited goods**

If—

- (a) goods are forfeited to the Government under section 118; or
- (b) the court orders under section 120 that goods be forfeited to the Government,

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

### **123. Power of Comptroller to retain control of goods**

Despite this Part, the Comptroller—

- (a) shall not release, or dispose of, any seized goods; or
- (b) shall not take any action in relation to the goods to give effect to any order of a court under section 120,

if the Comptroller is required or allowed to retain control of the goods under any other law in force in Saint Lucia.

#### **124. Insufficient security**

If security given under section 116(3) by the objector or objectors who gave notice under section 115 in respect of a trade mark is not sufficient to meet the expenses incurred by the Government as a result of the action taken by the Comptroller under this Part because of the notice, the amount of the difference between those expenses and the amount of security—

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

#### **125. Government not liable for loss etc. suffered because of seizure**

The Government is not liable for any loss or damage suffered by a person—

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

#### **126. Power to require information**

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

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

(2) If the importer or his or her agent intentionally or recklessly fails to comply with the request within the prescribed period, the importer or agent commits an offence and is liable on conviction to a fine of \$10,000.

### **PART 14 OFFENCES**

#### **127. Falsifying etc. a registered trade mark**

(1) A person shall not, intentionally or recklessly, falsify or unlawfully remove a trade mark that has been applied—

- (a) to any goods that are being, or are to be, dealt with or provided in the course of trade; or
- (b) in relation to any goods or services that are being, or are to be, dealt with or provided in the course of trade,  
  
knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

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

- (a) alters or defaces it;
- (b) makes any addition to it; or



- (c) partly removes, erases or obliterates it,  
without the permission of the registered owner, or an authorised user, of the trade mark and without being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

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

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

#### **128. Falsely applying a registered trade mark**

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

- (a) to goods that are being, or are to be, dealt with or provided in the course of trade; or
- (b) in relation to goods or services that are being, or are to be, dealt with or provided in the course of trade,  
knowing that the trade mark is registered or reckless of whether or not the trade mark is registered.

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

- (a) the permission of the registered owner, or of an authorised user, of the trade mark; and
- (b) being required or authorised to do so by this Act, a direction of the Registrar or an order of a court.

#### **129. Manufacture and possession of die etc. for use in commission of offence**

(1) A person shall not make a die, block, machine or instrument—

- (a) knowing that it is likely to be used for, or in the course of, committing an offence against section 127 or 128; or
- (b) reckless of whether or not it is likely to be used for, or in the course of, committing an offence against section 127 or 128.

(2) A person shall not draw, or program a computer or other device to draw, a registered trade mark or part of a registered trade mark—

- (a) knowing that the trade mark or part of the trade mark is likely to be used for, or in the course of, committing an offence against section 127 or 128; or
- (b) reckless of whether or not the trade mark or part of a trade mark is likely to be used for, or in the course of, committing an offence against section 127 or 128.

(3) A person shall not intentionally have in his or her possession, or dispose of—

- (a) a die, block, machine or instrument;
- (b) a computer, or other device, programmed to draw a registered trade mark or part of a registered trade mark; or
- (c) a representation of a registered trade mark or of part of a registered trade mark,

knowing that, or reckless of whether or not, the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, committing an offence against section 127 or 128.

### **130. Selling etc. goods with false marks**

A person shall not intentionally—

- (a) sell goods; or
- (b) expose goods for sale; or
- (c) have goods in his or her possession for the purpose of trade or manufacture; or
- (d) import goods into Saint Lucia for the purpose of trade or manufacture,

knowing that, or reckless of whether or not a falsified registered trade mark is applied to them or in relation to them, or a registered trade mark has been unlawfully removed from them, or a registered trade mark is falsely applied to them or in relation to them.

### **131. Penalty for offence under section 127, 128, 129 or 130**

A person who contravenes section 127, 128, 129 or 130 commits an offence and is liable upon conviction to a fine not exceeding \$250,000.

### **132. False representations regarding trade marks**

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

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

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

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

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

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

(6) A person who contravenes a provision of this section commits an offence and upon conviction is liable to a fine of \$10,000.

**133. False entries in Register etc.**

(1) A person shall not intentionally—

- (a) make a false entry in the Register;
- (b) cause a false entry to be made in the Register; or
- (c) tender in evidence a document that falsely purports to be a copy of, or an extract from, an entry in the Register or a document in the Registry of Companies and Intellectual Property.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of \$1,000.

**134. Disobeying summons etc.**

(1) A person—

- (a) who has been summoned to appear as a witness before the Registrar; and
- (b) to whom a reasonable sum has been tendered in payment for expenses, shall not, without reasonable excuse, fail to appear in answer to the summons.

(2) A person—

- (a) who has been required by the Registrar to produce a document or any other thing; and
- (b) to whom a reasonable sum has been tendered in payment for expenses, shall not, without reasonable excuse, fail to produce the document or thing.

(3) A person who contravenes subsection (1) or (2) commits an offence and upon summary conviction is liable to a fine of \$250.

**135. Refusing to give evidence etc.**

(1) A person appearing before the Registrar as a witness shall not, without reasonable excuse—

- (a) refuse to be sworn or to make an affirmation; or
- (b) refuse to answer questions that he or she is lawfully required to answer; or
- (c) fail to produce any document or thing that he or she is lawfully required to produce.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of \$250.

**136. Unauthorised persons not to act in trade mark matters**

(1) A person shall not—

- (a) apply for, or obtain, on behalf of another person—
  - (i) the registration of a trade mark,
  - (ii) the making of any entry in the Register, or

- (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (b) prepare, or cause to be filed in accordance with this Act, a document necessary for another person to obtain or oppose—
  - (i) the registration of a trade mark,
  - (ii) the making of an entry in the Register,
  - (iii) the amendment, cancellation, removal or restoration of any entry in the Register; or
- (c) give advice to another person about the validity of the registration of a trade mark or the infringement of a trade mark,  
unless the person is an attorney-at-law.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of \$10,000.

### **137. False representation about Registry of Companies and Intellectual Property**

- (1) A person—
  - (a) shall not—
    - (i) place, or allow to be placed, on the building in which his or her office is situated,
    - (ii) use when advertising his or her office or business, or
    - (ii) place on a document, as a description of his or her office or business,  
the words “Registry of Companies and Intellectual Property” or words of similar import, whether alone or together with other words; or
  - (b) shall not use in any other way, in connection with his or her business, words that would reasonably lead other persons to believe that his or her office is, or is officially connected with, the Registry of Companies and Intellectual Property.

(2) A person who contravenes subsection (1) commits an offence and upon summary conviction is liable to a fine of \$10,000.

### **138. Employee not to prepare documents etc.**

(1) A public officer employed in an office of the Registry of Companies and Intellectual Property shall not prepare, or help prepare, a document to be filed under this Act unless required or authorised to do so by this Act, or any other Act, including the regulations under that Act, a written direction of the Registrar or an order of a court.

(2) A public officer who contravenes subsection (1) is liable to disciplinary action by service commission which appointed him or her.

### **139. Conduct of directors, servants and agents**

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

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

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

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

(3) Any conduct engaged in on behalf of a body corporate by a director, servant or agent of the body corporate within the scope of his or her actual or apparent authority is taken to have been engaged in also by the body corporate, unless it proves that it took reasonable precautions and exercised due diligence to avoid the conduct.

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

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

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

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

(6) In this section—

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

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

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

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

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

## **PART 15 COLLECTIVE TRADE MARKS**

### **140. Object of Part**

This Part—

(a) defines a collective trade mark; and

(b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to collective trade marks.

### **141. Collective trade mark**

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

### **142. Application of Act**

(1) Subject to this Part, the provisions of this Act relating to trade marks, other than Part 10, apply to collective trade marks and so apply as if—

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

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

(2) For the purposes of this Act—

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

(3) Section 25, applies in relation to a collective trade mark as if a reference to the applicant were a reference to the members of the association that applied for registration of the collective trade mark.

### **143. Application for registration**

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

### **144. Limitation on rights given by registered collective trade mark**

A member of an association in whose name a collective trade mark is registered does not have the right to prevent another member of the association from using the collective trade mark in accordance with the rules of the association, if any.

### **145. Assignment etc. of collective trade mark**

A collective trade mark may not be assigned or transmitted.

### **146. Infringement of collective trade mark**

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

## **PART 16 CERTIFICATION TRADE MARKS**

### **147. Object of Part**

This Part—

- (a) defines a certification trade mark;
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to certification trade marks; and
- (c) outlines the role of the Registrar in the regulation of certification trade marks.

### **148. Certification trade mark**

A certification trade mark is a sign used, or intended to be used, to distinguish goods or services—

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

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

#### **149. Application of Act**

Subject to this Part, the provisions of this Act relating to trade marks, other than section 2(6), 2(7), 2(8), 2(9), 2(10), 10, 11(1)(b), 17, 18, 25, 72(2)(d), 105 and 110, and Part 9 and Part 17 apply to certification trade marks and so apply as if a reference to a trade mark included a reference to a certification trade mark.

#### **150. Rights given by registration of a certification trade mark**

Section 4 applies in relation to a certification trade mark as if subsection (1) were omitted and the following subsection were substituted—

- “(1) If a certification trade mark is registered, the registered owner has, subject to this Part, the exclusive rights to use, and to allow other persons to use, the certification trade mark, in relation to the goods or services or both in respect of which the certification trade mark is registered. The registered owner may, however, use the certification trade mark only in accordance with the rules governing the use of the certification trade mark.”

#### **151. Rights of persons allowed to use certification trade mark**

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

(2) In this Part “**approved user**” means the person allowed to use a registered certification trade mark under subsection (1).

#### **152. Rules governing the use of certification trade marks**

(1) A person who has filed an application for the registration of a certification trade mark shall file, in accordance with the regulations, a copy of the rules governing the use of the certification trade mark, and any document prescribed under section 11(2).

(2) The rules shall include provisions regarding—

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

and any other provision that the Registrar requires or permits to be inserted.

(3) In this Part “**approved certifier**” means a person approved for the purpose of certifying goods or services or both under subsection (2).

### **153. Grant of application to register**

(1) If after examining an application made under this Part, the Registrar is satisfied that—

- (a) the application has been made in accordance with this Act;
- (b) subject to subsection (2), the rules referred to in section 152—
  - (i) would not be detrimental to the public, and
  - (ii) are satisfactory having regard to the criteria prescribed under section 152(2);
- (c) the applicant or the approved certifiers are competent to certify the goods or services or both in respect of which the certification trade mark is to be registered;
- (d) the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from the goods or services not so certified;
- (e) there are no other grounds for rejecting the application,  
the Registrar shall register the certification trade mark and issue a certificate to that effect to the applicant and shall publish notice of the registration in the prescribed form in the Gazette.

(2) In deciding, under subsection (1)(d), whether or not a certification trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier, the Registrar shall take into account the extent to which—

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

(3) The Registrar may require the applicant to make amendments to any of the rules referred to in section 152 as the Registrar considers necessary.

### **154. Refusal to register**

(1) The Registrar may, subject to subsection (2), reject an application made under this Part if he or she is not satisfied as to any of the grounds referred to in section 153(1).

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

### **155. Variation of rules**

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

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

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

- (a) would not be detrimental to the public;



- (b) are satisfactory having regard to the criteria prescribed under section 152 (2)(b).
- (4) The Registrar shall—
  - (a) notify the registered owner of the certification trade mark in, writing, of his or her decision to approve or not to approve the variation of the rules governing the use of a certification and trade mark; and
  - (b) cause notice, if applicable, of any variation in the rules, to be published in the Gazette.

#### **156. Rules to be available for inspection**

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

#### **157. Assignment of registered certification trade mark**

- (1) A registered certification trade mark shall not be assigned unless with the consent of the Registrar.
- (2) An application to the Registrar for his or her consent to the assignment of a registered certification trade mark shall be in the prescribed form.
- (3) The Registrar may, having regard to the matters provided for under the regulations, grant or refuse consent.
- (4) Appeal against a decision of the Registrar under this section lies to the High Court.

#### **158. Rectification of the Register by order of court**

- (1) Section 72 applies in relation to a certification trade mark as if the words “or on the ground that the trade mark is capable of distinguishing goods or services certified by the applicant or an approved certifier from goods or services not so certified” was added at the end of subsection (2)(a).
- (2) In addition to its powers under Division 2 of Part 8 as affected by subsection (1) in relation to certification trade marks, High Court may, on the application of a person aggrieved, order that the Register be rectified by cancelling the registration of a certification trade mark, or removing or amending an entry in the Register relating to the certification trade mark, on the ground that—
  - (a) the registered owner or an approved certifier is no longer competent to certify any of the goods or services or both in respect of which the mark is registered;
  - (b) the rules governing the use of the certification trade mark are detrimental to the public; or
  - (c) the registered owner or an approved user has failed to comply with a provision of the rules governing the use of the certification trade mark.
- (3) Notice of an application to the High Court under subsection (1), shall be given to the Registrar.
- (4) Except for cases in which the High Court directs the Registrar to appear, the Registrar may appear before the High Court and be heard at his or her discretion.
- (5) A copy of any order made by the High Court under this section shall be given to the Registrar and the Registrar shall comply with the order.

### **159. Variation of rules by order of court**

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

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

### **160. Copy of order and rules**

(1) A copy of an order made by the High Court under section 159 shall be given to the Registrar.

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

## **PART 17 DEFENSIVE TRADE MARKS**

### **161. Object of Part**

This Part—

- (a) provides for the registration of certain trade marks as defensive trade marks; and
- (b) provides to what extent, and subject to what modifications or additions, the provisions of this Act relating to trade marks apply to defensive trade marks.

### **162. Defensive trade mark**

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

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

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

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

### **163. Application of Act**

Subject to this Part, the provisions of this Act, other than sections 4(1), 11(1)(b), 25, 43, 72(2)(d), 105 and 110, Part 9 and Part 16 apply to defensive trade marks and so apply as if a reference to a trade mark included a reference to a defensive trade mark.

#### **164. Additional grounds for rejecting application for registration or opposing registration**

In addition to any other ground on which—

- (a) an application for the registration of a trade mark as a defensive trade mark may be rejected; or
- (b) the registration of a trade mark as a defensive trade mark may be opposed,

the application shall be rejected or the registration may be opposed—

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

#### **165. Amendment or cancellation of registration by order of court**

Section 72 applies in relation to a defensive trade mark as if “or under section 164” were added at the end of subsection (2)(a).

#### **166. Cancellation of registration by Registrar**

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

### **PART 18 JURISDICTION AND POWERS OF COURTS**

#### **167. Jurisdiction of the High Court**

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

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

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

#### **168. Transfer of proceedings**

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

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

- (a) all relevant documents of record filed in the transferring court shall be sent to the other court by the Registrar or other appropriate officer of the transferring court; and
- (b) the action or proceeding shall continue in the other court as if—
  - (i) it had been started there, and
  - (ii) all steps taken in the transferring court had been taken in the other court.

### **169. Appeals**

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

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

(3) With the special leave of the High Court, an appeal lies to the High Court against a judgment or order referred to in subsection (1).

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

### **170. Registrar may appear in appeals**

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

### **171. Powers of High Court**

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

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

## **PART 19 ADMINISTRATION**

### **172. Registrar of Companies and Intellectual Property**

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

### **173. Registrar's powers**

The Registrar may, for the purposes of this Act—

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

#### **174. Exercise of power by Registrar**

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

#### **175. Registrar to act as soon as practicable**

If—

- (a) the Registrar is required under this Act to do any act or thing; and
  - (b) no time or period is provided within which the act or thing is to be done,
- the Registrar is to do the act or thing as soon as practicable.

#### **176. Deputy Registrar**

(1) Subject to any direction by the Registrar, a Deputy Registrar has all the powers and functions of the Registrar, except the powers of delegation under section 177.

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

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

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

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

#### **177. Delegation of Registrar's powers and functions**

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

- (a) a prescribed person, or persons included in a prescribed class, holding or performing the duties of an office in the Registry of Companies and Intellectual Property; or
- (b) a prescribed public officer, or public officer included in a prescribed class, employed in the Registry of Companies and Intellectual Property.

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

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

### **PART 20 THE REGISTER AND OFFICIAL DOCUMENTS**

#### **178. The Register**

(1) A Register of Trade Marks is to be kept at the Registry of Companies and Intellectual Property.

(2) The Registrar shall enter in the Register in accordance with this Act—

- (a) all particulars of registered trade marks, and all other matters that were on the old register when the repealed Acts were repealed; and
- (b) particulars of trade marks, certification trade marks, collective trade marks and defensive trade marks, and all other matters, that are required to be registered under this Act; and
- (c) other prescribed matters.

(3) If 2 or more trade marks were entered as associated trade marks in the old register, no equivalent entry designating them as associated trade marks is to be made in the Register.

(4) All particulars entered in the Register under subsection (2)(a) are taken to have been so entered at the commencement of this Act.

### **179. Register may be kept on computer**

(1) The Register may be kept in whole or in part by using a computer.

(2) Any record of a particular or other matter made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.

### **180. Inspection of Register**

(1) The Register shall be available at the Registry of Companies and Intellectual Property for inspection by any person during the hours when the office is open for business.

(2) If the Register, or any part of the Register, is kept by using a computer, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

### **181. Register**

(1) The Register is *prima facie* evidence of any particular or other matter entered in it.

(2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

(3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any of the particulars comprised in the Register or in that part of the Register is admissible in any proceedings as evidence of those particulars.

### **182. Certified copies of documents**

(1) A certificate signed by the Registrar and stating that—

- (a) anything required or permitted to be done by the Act or the Repealed Act was done or not done on, or had been done or not been done by, a specified date;
- (b) anything prohibited by the Act or the repealed Act was done or not done on, or had been done or not been done by, a specified date; or
- (c) a document was available for public inspection at the Registry of Companies and Intellectual Property on a specified date or during a specified period,

is *prima facie* evidence of the matters so stated.

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

## **PART 21**

### **Miscellaneous**

#### *Division 1*

#### *Applications and other documents*

### **183. Making and signing applications etc.**

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

### **184. Filing of documents**

(1) A document is taken to be filed at the Registry of Companies and Intellectual Property if it is filed at a sub-office of the Registry of Companies and Intellectual Property.

(2) A document may be filed at the Registry of Companies and Intellectual Property or any of its sub-offices by being delivered there—

- (a) personally;
- (b) by post; or
- (c) by any prescribed means.

### **185. Withdrawal of application etc.**

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

(2) If—

- (a) the right or interest on which the person relied to file the application, notice or request has become vested in another person; and
  - (b) the other person notifies the Registrar in writing that the right or interest is vested in him or her,
- the other person may withdraw the application, notice or request as provided in subsection (1).

### **186. Address for service**

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

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

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

- (a) if paragraph (b) does not apply, the address given, or last given, by the registered owner or the person to the Registrar under subsection (1); or

- (b) if, before the Registrar registers the trade mark or records the claim to the interest or right, the registered owner or person gives in writing to the Registrar another address as his or her address for service, that other address.

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

(4) The address for service of—

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

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

(5) An address for service shall be an address in Saint Lucia.

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

- (a) the document may be left at, or sent by post to, the address for service of the person; or
- (b) if the person does not have an address for service, the document may be served on an agent of the person in Saint Lucia or may be sent by post to any address of the person in Saint Lucia that is known to the Registrar.

(7) Subsection (6) does not affect the operation of section 23 of the Interpretation Act.

### **187. Change of name**

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

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

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

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

### **188. Death of applicant etc.**

(1) If an applicant for the registration of a trade mark dies before registration is granted on the application, his or her legal representative may proceed with the application.

(2) If, at any time after a trade mark is registered, the Registrar is satisfied that the person in whose name the trade mark is registered had died, or, in the case of a body corporate, had ceased to exist, before registration was granted, the Registrar may amend the Register by substituting for the name entered in the Register the name of the person who should be the registered owner of the trade mark.



### **189. Description of registered trade mark**

In an indictment, information, pleading or proceeding relating to a registered trade mark, the trade mark may be identified by its registration number and it is not necessary to reproduce or describe the trade mark.

### **190. Evidence of trade usage**

In an action or proceeding relating to a trade mark, evidence is admissible of the usage of the trade concerned and of any relevant trade mark, trade name or get-up legitimately used by other persons.

### **191. Death of party to proceeding before Registrar**

If a person who is party to a proceeding pending before the Registrar dies, the Registrar may—

- (a) on being so asked, substitute in the proceeding another person in the place of the deceased party if the Registrar is satisfied that the interest of the deceased party has been transmitted to that other person; or
- (b) allow the proceeding to continue without any substitution if the Registrar is of the opinion that the interest of the deceased party is sufficiently represented by the surviving parties.

### **192. Costs awarded by Registrar**

(1) The Registrar may award costs in respect of the matters, and in the amounts, provided for in the regulations against any party to proceedings brought before him or her.

(2) A party desiring to obtain costs shall apply to the Registrar in accordance with the regulations.

(3) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

### **193. Security for costs**

If a person who neither resides nor carries on business in Saint Lucia—

- (a) gives notice of opposition under this Act; or
- (b) applies to the Registrar under Part 9 for a trade mark to be removed from the Register,

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

## *Division 3 General*

### **194. Fees**

(1) The regulations may prescribe the fees to be paid for the purposes of this Act and may prescribe different fees in respect of the doing of an act according to the time when the act is done.

(2) Prescribed fees are payable in accordance with the regulations.

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

(4) Subject to subsection (5), if—

- (a) a fee is payable in respect of the doing of an act by a person other than the Registrar or the Comptroller; or
- (b) a fee is payable in respect of the filing of a document,  
the act is taken to have been done, or the document is taken to have been filed, in spite of the failure to pay the fee.

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

### **195. Extension of time**

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

(2) If, because of—

- (a) an error or omission by the person concerned or by his or her agent; or
- (b) circumstances beyond the control of the person concerned,

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

(3) If—

- (a) a relevant act that a person is required by this Act to do within a certain time is not, or cannot be, done within that time; and
- (b) on application made by that person in accordance with the regulations, the Registrar is of the opinion that special circumstances exist that justify an extension of that time,

the Registrar may extend the time for doing the act.

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

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

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

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

(8) In this section "**relevant act**" means—

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

### **196. Publication of documents**

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

### **197. Use of trade mark for export trade**

(1) If—

(a) a trade mark is applied in Saint Lucia—

- (i) to, or in relation to goods that are to be exported from Saint Lucia,
- (ii) in relation to services that are to be exported from Saint Lucia; or

(b) any other act is done in Saint Lucia to goods to be exported from Saint Lucia or services to be exported from Saint Lucia which, if done in relation to goods or services to be dealt with or provided in the course of trade in Saint Lucia, would constitute a use of the trade mark in Saint Lucia,

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

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

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

### **198. Passing off actions**

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

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

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

### **199. Expenses**

Any expenses incurred under this Act shall be a charge on the Consolidated Fund.

### **200. Regulations**

(1) The Minister may after consultation with the Registrar, make regulations—

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

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

- (a) provide for appeals against decisions of the Registrar made under the regulations;
- (b) require persons to make statutory declarations in support of any application, notice or request filed under this Act;
- (c) provide for the making of a declaration, or the doing of an act, under this Act on behalf of a person who, because of infancy or physical or mental disability, is unable to make the declaration or do the act;
- (d) provide for the refund, in specific circumstances, of the whole or part of a fee paid under this Act;
- (e) provide for the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee;
- (f) provide for the expenses and allowances to be paid to witnesses or persons attending at proceedings before the Registrar;
- (g) give power to the Registrar—
  - (i) to require, in specified circumstances, a person applying under Part 9 for a trade mark to be removed from the Register to give security for any costs that may arise from the proceedings,
  - (ii) not to proceed with the application if security is not given,
  - (iii) to refund to the applicant any amount given as security and not applied in settling costs awarded against the applicant;
- (h) provide for the destruction of documents relating to a trade mark at least 10 years after the registration of the trade mark has ceased;
- (i) prescribe as penalties for offences against the regulations fines not exceeding \$250;
- (j) make transitional or consequential provision as necessary or convenient because of the repeal of the repealed Acts and the enactment of this Act.

## **201. Transitional**

(1) A trade mark that, immediately before the date of commencement of this Act, was registered under the repealed Acts is a registered trade mark for the purposes of this Act.

(2) The registration of an existing trade mark expires on the day on which it would have expired under the repealed Act if these Acts had not been repealed.

(3) Division 2 of Part 7 applies in relation to the renewal of the registration of an existing trade mark.

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

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### **CHAPTER 13.30 TRADE MARKS ACT**

#### **SUBSIDIARY LEGISLATION**

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*List of Subsidiary Legislation*

1. Trade Marks Regulations – Section 200

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## **Trade Marks Regulations – Section 200**

### **(Statutory Instrument 17/2003)**

Statutory Instrument 17/2003 in force 1 April 2003

#### ARRANGEMENT OF REGULATIONS

##### **PART 1 PRELIMINARY**

1. Citation
2. Commencement
3. Interpretation

##### **PART 2 TRADE MARKS AND TRADE MARK RIGHTS**

4. Classification of goods and services
5. Period in which action for infringement may be brought

##### **PART 3 APPLICATION FOR REGISTRATION**

6. Applications: approved form
7. Applications: requirements for filing
8. Representation of trade marks
9. Specification of goods or services or both
10. Period for claiming priority for an application
11. How to claim priority
12. Publication of particulars of application
13. Examination of application: report to applicant
14. Examination: applicant's response to report
15. Examination: further report to applicant
16. Examination: additional requirements
17. Periods after which applications lapse
18. Deferment of acceptance
19. Period for which acceptance is deferred
20. Trade marks containing etc. certain signs
21. Divisional applications
22. Applications under Part 4
23. Request for expedited examination of application
24. Expedited examinations

##### **PART 4 OPPOSITION TO REGISTRATION**

25. Time for filing notice of opposition
26. Extension of time for filing; grounds
27. Extension of time for filing: applications
28. Extension of time for filing: grant of extension
29. Copy of earlier application to be available to opponent
30. Opposition proceedings
31. Evidence in support
32. Notice that opponent will not rely on evidence in support
33. Failure to file
34. Evidence in answer
35. Period for service of a copy of the evidence in answer
36. Notice that applicant will not rely on evidence in answer
37. Failure to file
38. Evidence in reply to evidence in answer

- 39. Notice that opponents will not rely on evidence in reply to evidence in answer and failure to file
- 40. Hearing of opposition
- 41. Extension of period to serve evidence and service of further evidence
- 42. Conduct of opposition proceedings generally
- 43. Registrar to give notice of dismissal of proceedings

#### **PART 5**

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

- 44. Amendment of applications by Registrar
- 45. Request to amend before publication of details
- 46. Filing of declarations
- 47. Notification of amendments

#### **PART 6**

#### **REGISTRATION OF TRADE MARKS**

- 48. Period in which a trade mark can be registered
- 49. Particulars to be entered in the Register
- 50. Period for request for renewal
- 51. Notice of renewal due: when and how given
- 52. Notice of renewal

#### **PART 7**

#### **AMENDMENT AND CANCELLATION OF REGISTRATION**

- 53. Notice of cancellation
- 54. Amendment or cancellation-matters for the court

#### **PART 8**

#### **REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE**

- 55. Applications for removal etc
- 56. Notification of applications
- 57. Notice of opposition to removal
- 58. Opposition proceedings before the Registrar

#### **PART 9**

#### **ASSIGNMENT AND TRANSMISSION OF TRADE MARKS**

- 59. Applications for assignment etc. to be recorded or entered
- 60. Recording of assignment etc,; trade marks not registered
- 61. Particulars of recorded assignment or transmission to be published
- 62. Recording of assignment etc. of registered trade marks
- 63. Notice to persons recorded as claiming right or interest in trade marks

#### **PART 10**

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

- 64. Amendment of particulars: claimed interests or rights
- 65. Amendment of name, address and address for service: claims not in the Register
- 66. Cancellation of particulars; claimed interests or rights

#### **PART 11**

#### **IMPORTATION OF GOODS INFRINGING SAINT LUCIAN TRADE MARKS**

- 67. Notice of objection to importation: accompanying documents
- 68. Notice of objection to importation: authorised users
- 69. Period for compliance with Comptroller's request for information etc.

#### **PART 12**

#### **CERTIFICATION TRADE MARKS**

- 70. Copy of rules to be filed
- 71. Applications to vary rules
- 72. Assignment of registered certification trade marks

**PART 13**  
**DEFENSIVE TRADE MARKS**

73. Evidence in support of applications

**PART 14**  
**ADMINISTRATION**

74. Registry and sub-offices business hours  
75. Delegates of the Registrar

**PART 15**  
**MISCELLANEOUS**

*Division 1*

*Applications and other documents*

76. Compliance with instructions on approved forms  
77. Filing of documents: requirements as to form  
78. Filing of documents: common requirements  
79. Filing of documents: treatment of non-complying documents  
80. Filing of documents: date of receipt to be marked  
81. Declarations  
82. Declarations: additional material  
83. Notification of service  
84. Notice of withdrawal of applications etc.  
85. Withdrawal of application etc.: Registrar's notice to applicants  
86. Change of address for service: notice to interested persons

*Division 2*

*Proceedings before the Registrar*

87. Applications for costs  
88. Determination of costs  
89. Conduct of proceedings generally  
90. Hearings by Registrar  
91. Registrar not required to hold hearings  
92. Evidence in proceedings  
93. Documents not in English  
94. Registrar may use information available  
95. Statements of reason for decision

*Division 3*

*General*

96. What fees are payable  
97. How fees are to be paid  
98. Notice of non-payment of fee  
99. Refunds etc, of fees  
100. Extension of time: application  
101. Extension of time: notice of opposition  
102. Extension of time: opposition proceedings  
103. Extension of time-prescribed acts and documents  
104. Incapacity of certain persons  
105. Destruction of documents  
106. Direction not otherwise prescribed  
107. Requirements cannot be complied with for reasonable cause  
108. Forms generally  
109. Form of documents  
110. General

**PART 16**  
**TRANSITIONAL PROVISIONS**

111. Application of the Act  
112. Certain extensions of time continue

- Schedule 1  
Schedule 2  
Schedule 3  
Schedule 4

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**TRADE MARKS REGULATIONS – SECTION 200**

Commencement [1 April 2003]

**PART 1  
PRELIMINARY**

**1. Citation**

These Regulations may be cited as the Trade Marks Regulations.

**2. Commencement**

*(Editorial Deletion)*

**3. Interpretation**

In these Regulations—

“**Act**” means the Trade Marks Act;

“**certificate of verification**” means a statement—

(a) that a document to which the statement relates—

(i) has been translated by a person who is proficient in both the language from which the document has been translated into English, and English, and

(ii) is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and

(b) that is dated and signed;

“**earlier application**”, in relation to an application for the registration of a trade mark for which a right of priority is claimed, means an application for the registration of that trade mark in a Convention country—

(a) that was filed, at the trade marks office, or its equivalent, of that Convention country before the application for which the right of priority is claimed; and

(b) on which the claim for the right of priority is based;

“**National Archives Authority of St. Lucia**” means the National Archives Authority of St. Lucia established under the National Archives Authority of Saint Lucia Act;

“**trade marks officer**” means any officer so designated by the Registrar;

“**working day**” means a day other than a Saturday, a Sunday or a public holiday.



**PART 2**  
**TRADE MARKS AND TRADE MARK RIGHTS**

**4. Classification of goods and services**

For the purposes of section 11(2)(6), and section 11(3) of the Act (which deals with the classification of goods and services) an application for registration of a trade mark must specify the goods or services and the class or classes in respect of which the trade mark is sought to be registered in accordance with the Nice Classification.

**5. Period in which action for infringement may be brought**

For the purposes of section 10(1)(b) of the Act (which deals with powers of the authorised user of a trade mark), the prescribed period is 2 months from the day on which the authorised user of a trade mark asks the registered owner of the trade mark to bring an action for infringement of the trade mark.

**PART 3**  
**APPLICATION FOR REGISTRATION**

**6. Applications: approved form**

(1) For the purposes of section 11(1) of the Act (which deals with applications for registration) and Parts 15, 16 and 17 of the Act (which deal with collective trade marks, certification trade marks and defensive trade marks respectively), an application for the registration of a trade mark shall be in the form prescribed in Form 1 of Schedule 6.

(2) Any material that is intended by the applicant to form part of the application for registration of a trade mark—

- (a) must be attached to the application; and
- (b) is taken to be part of the application.

**7. Applications: requirements for filing**

(1) In order for an application for registration of a trade mark to be taken to be filed, the applicant must—

- (a) state that the application is for registration of the trade mark, or contain a clear indication to that effect;
- (b) include a representation of the trade mark that is sufficient to identify the trade mark;
- (c) specify the goods or services or both in relation to which the application is made;
- (d) specify the name of the applicant;
- (e) contain sufficient information to enable the Registrar to contact the applicant; and
- (f) be accompanied by an authorisation of agent.

(2) If the application does not meet a requirement referred to in subregulation (1)(a), (1)(b), (1)(c) or (1)(d), the Registrar must give to the applicant written notices of the requirement.

(3) If the applicant meets the requirement referred to in subregulation (2) within a period of 3 months from the date of the notice, the application is taken to be filed on the day on which the requirements is met.

(4) If the applicant does not meet the requirement referred to in subregulation (2) within the period referred to in subregulation (3), the application is taken not to have been filed.

## **8. Representation of trade marks**

(1) If practicable, the representation of a trade mark included in an application for registration of the trade mark must not exceed 8 centimetres by 8 centimetres (3 inches by 3 inches).

(2) In an application for the registration of 2 or more trade marks as a series, the representation of each trade mark in the series must, if practicable, not exceed 8 centimetres by 8 centimetres (3 inches by 3 inches).

(3) In an application for the registration of a trade mark that contains, or consists of, a 3 dimensional shape—

- (a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; and
- (b) otherwise, the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.

(4) If the Registrar reasonably believes that the views of a trade mark to which subregulation (3)(a) or (3)(b) applies are not sufficient to allow all features of the trade mark to be properly examined, the Registrar may, by notice in writing, require the applicant to give to the Registrar up to 6 additional views of the trade mark that show the features sufficiently to permit proper examination of the trade mark.

(5) If the representation of a trade mark in an application for registration of the trade mark includes words of a language other than English, the applicant must file in support of the application a translation of the words into English.

(6) If the representation of a trade mark in an application for registration of the trade mark includes characters constituting words, being characters that are not roman letters, the applicant must file in support of the application—

- (a) a transliteration of the characters into roman letters, using the recognised system of Romanisation of the characters, if any; and
- (b) a translation of the words into English.

(7) If a trade mark for which registration is sought contains or consists of a sign that is a colour, shape, or an aspect of packaging, or any combination of those features, the application for registration of the trade mark must include a concise and accurate description of the trade mark.

(8) If the Registrar reasonably believes that the description or representation of a trade mark in an application for registration of the trade mark does not—

- (a) demonstrate the nature of the trade mark sufficiently; or
  - (b) show each feature of the trade mark sufficiently,
- to permit proper examination of the trade mark, the Registrar may require the applicant to give to the Registrar a description, or further description, of the trade mark and a specimen of the trade mark.

(9) If representation of a single trade mark exceeds, or the representations of the trade marks in a series of trade marks together exceed 8 centimetres by 8 centimetres (3 inches by 3 inches), the representation or representations—

- (a) must be attached to the application for registration of the trade mark or trade marks; and
- (b) shall be taken to be part of the application.

(10) The representation of a trade mark in an application for registration of the trade mark must be of a kind and quality that—

- (a) ensures that the features of the trade mark will be preserved in the course of time; and
- (b) is suitable for reproduction.

## **9. Specification of goods or services or both**

(1) For the purposes of section 11(3) of the Act, the following subregulations set out the manner of specifying, in an application for the registration of a trade mark, the goods or services or both in respect of which registration is sought.

(2) The expression “all goods”, “all services”, “all other goods”, or “all other services” must not be used in an application for registration of a trade mark to specify the goods or services or both in respect of which registration is sought.

(3) The goods or services or both must be grouped according to the appropriate classes as detailed in the Nice Classification.

(4) The applicant must nominate the class number that is appropriate to the goods or services in each group.

(5) The groups must be listed in the order of their class numbers.

(6) The goods or services or both must, as far as practicable, be specified in terms appearing in any listing of goods and services that is—

- (a) published by the World Intellectual Property Organisation in the Nice Classification; and
- (b) made available for inspection by the public at the Registry of Companies and Intellectual Property and its sub-offices.

(7) If any of the goods or services or both cannot be specified using terms referred to in subregulation (6), the applicant must provide sufficient information to enable the Registrar to decide the classification of the goods or services or both.

## **10. Period for claiming priority for an application**

For the purposes of section 13(1) of the Act (which deals with claims for priority), the prescribed period in relation to a claim for a right of priority for an application is 6 months after filing the application.

## **11. How to claim priority**

(1) For the purposes of section 13(1) of the Act (which deals with claims for priority), an applicant must claim a right of priority for an application by filing notice of the claim.

(2) Any notice under subregulation (1) must specify, in respect of the earlier application or, if there is more than one earlier application, in respect of each earlier application—

- (a) the Convention country in which the earlier application was filed at the trade marks office, or its equivalent, of that Convention country; and
- (b) the date on which the earlier application was filed; and
- (c) if a number is allocated to the earlier application in the trade marks office, or its equivalent, of that Convention country, that number.

(3) If, as a result of a claim for a right of priority, more than one priority date applies in relation to an application, a person who claims a right of priority under section 13(1) of the Act must specify the goods or services or both to which each priority date relates.

## **12. Publication of particulars of application**

(1) For the purposes of section 14 of the Act (which deals with publishing particulars of applications), the Registrar must publish the following particulars of the application—

- (a) if a number has been allocated to the application in the Registry of Companies and Intellectual Property – the number;
- (b) the applicant's name;
- (c) the date of filing the application;
- (d) if the application is a divisional application – particulars of the initial application;
- (e) particulars of any claim for a right of priority for the application;
- (f) the class number or numbers for the goods or services or both in respect of which registration of the trade mark is sought.

(2) The particulars must be published in one, or more than one, of the following ways—

- (a) publication in the Gazette;
- (b) listing in a computer database maintained by the Registry of Companies and Intellectual Property;
- (c) making a record of the application available, in electronic or other form, in each of the sub-offices of the Registry of Companies and Intellectual Property.

## **13. Examination of application: report to applicant**

(1) For the purposes of section 15 of the Act (which deals with examination and reporting), if in the course of an examination of an application the Registrar reasonably believes that—

- (a) the application has not been made in accordance with the Act or these Regulations; or
- (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it,  
the Registrar must report that belief in writing to the applicant.

(2) A report under subregulation (1) must include notice of the date on which the application will lapse if it is not accepted earlier.

(3) If the Registrar reasonably suspects that the provisions of section 11(1)(b) of the Act do not apply in relation to all of the goods or services or both specified in an application for registration of a trade mark, the Registrar may require the applicant to make a declaration to the Registrar that those provisions apply to all of those goods or services or both.

## **14. Examination: applicant's response to report**

(1) An applicant may respond in writing to the Registrar's report under regulation 13.

(2) The response may—

- (a) contest a belief of the Registrar that is expressed in the report; and
- (b) contest another matter that is mentioned in the report; and
- (c) provide further documents or evidence in support of the application; and
- (d) request that the application be amended in accordance with the Act.

## **15. Examination: further report to applicant**

(1) On receipt of a response under regulation 14, the Registrar must consider the response.

(2) If the Registrar continues to believe that—

- (a) the application has not been made in accordance with the Act or these Regulations; or
- (b) there are grounds under Division 2 of Part 4 of the Act for rejecting it, the Registrar must report that belief in writing to the applicant.

(3) Unless acceptance of an application is deferred, a report under subregulation (2) in relation to that application must include notice of the date on which the application will lapse if it is not accepted earlier.

(4) Regulation 14 and this regulation apply to a report under subregulation (2) as if it were a report under regulation 13.

## **16. Examination: additional requirements**

(1) In the course of an examination of an application for which a right of priority is claimed, the Registrar may, in writing, require the applicant to file—

- (a) a copy of any earlier application certified in the trade marks office, or its equivalent, of the Convention country in which it was filed; and
- (b) if the earlier application is not in English—
  - (i) a translation of the earlier application into English, and
  - (ii) a certificate of verification relating to the translation.

(2) If the applicant is the successor in title to the person who made the earlier application, the Registrar may, in writing, require the applicant to file documentary evidence that is sufficient to establish the passing of title to the applicant.

## **17. Periods after which applications lapse**

(1) For the purposes of section 21(1) of the Act (which deals with lapsing), the prescribed period, for an application in respect of which a report is made under regulation 13 is—

- (a) except as provided by paragraph (b), 12 months from the date of that report whether or not a further report is made under regulation 15; or
- (b) if a further report raises grounds under Division 2 of Part 4 of the Act for rejecting the application that were not raised in the report made under regulation 13, 12 months from the date of the further report.

(2) In determining the period of 12 months for the purposes of subregulation (1)(a) or (1)(b) in relation to an application, no account is to be taken of a period in which acceptance of the application is deferred under regulation 18.

(3) An applicant may, before the end of a period prescribed in subregulation (1), or that period as extended under section 195 of the Act or as a result of a previous application of subregulation (4), request the Registrar in writing to extend the period.

(4) The Registrar must, in accordance with a request made under subregulation (3), extend a period, unless—

- (a) the period; or
- (b) that period as extended under section 195 of the Act or as a result of a previous application of this subregulation,

would be extended for more than 6 months after the end of the relevant period prescribed in subregulation (1).

## **18. Deferment of acceptance**

(1) The Registrar may, at the request of the applicant in writing, defer acceptance of an application for registration of a trade mark, if—

- (a) the request is made within a period prescribed in subregulation 17(1); and
- (b) the Registrar reasonably believes that there are grounds for rejecting the application under section 28(1) or 28(2) of the Act because of another trade mark—
  - (i) that is registered by another person, or
  - (ii) in respect of which an application for registration has been made by another person; and
- (c) the applicant—
  - (i) is awaiting the finalisation of proceedings in respect of the application for registration of the other trade mark, or
  - (ii) is seeking to satisfy the Registrar as to a matter mentioned in section 28(3)(a) or 28(3)(b) of the Act or as to the matters mentioned in section 28(4) of the Act in relation to the applicant's trade mark and the other trade mark, or
  - (iii) has filed an application under section 76 of the Act (which deals with the removal of trade marks), in respect of the other trade mark, and is awaiting the finalisation of proceedings in respect of that application, or
  - (iv) has begun proceedings to have the Register rectified in respect of the other trade mark and the proceedings have not been determined or otherwise disposed of, or
  - (v) is awaiting renewal of the registration of the other trade mark in the period of 12 months after registration of the other trade mark has expired, or removal of the other trade mark from the Register.

(2) The Registrar may, on his or her own initiative, defer acceptance of the application within a period that is prescribed in regulation 17(1) or that is extended under section 195 of the Act or regulation 17(4), if—

- (a) the time within which proceedings mentioned in paragraph (b) may be begun, or an application mentioned in paragraph (c) may be made, has not ended; or
- (b) appeal proceedings under a provision of the Act have begun in a prescribed court in relation to the application; or
- (c) the Registrar is informed in writing that the applicant has died.

(3) The Registrar must notify an applicant in writing—

- (a) if the applicant requests the Registrar to defer acceptance of an application of the Registrar's decision to defer, or not to defer, acceptance of the application; and
- (b) if the Registrar otherwise defers acceptance of an application of the provision under which acceptance of the application is deferred.

## 19. Period for which acceptance is deferred

(1) The period for which acceptance of an application is deferred (in this regulation called “**the deferment period**”) begins immediately after the date of the notice of deferment issued under regulation 18(3).

(2) The deferment period ends—

- (a) when the application is withdrawn; or
- (b) if paragraph (a) does not apply when the Registrar is reasonably satisfied that there are no longer grounds for rejecting the application under section 28(1) or (2) of the Act; or
- (c) if paragraphs (a) and (b) do not apply in accordance with subregulation (3).

(3) For the purposes of subregulation (2)(c), the deferment period ends—

- (a) if acceptance is deferred because of regulation 18(1)(c)(i), when proceedings relating to the registration of the other trade mark are finalised; and
- (b) if acceptance is deferred because of regulation 18(1)(c)(ii), at the end of 6 months from the date of the notice of deferment; and
- (c) if acceptance is deferred because of regulation 18(1)(c)(iii), when proceedings under Part 9 of the Act in respect of the other trade mark are finalised; and
- (d) if acceptance is deferred because of regulation 18(1)(c)(iv), when the proceedings to have the Register rectified in respect of the other trade mark are determined or otherwise disposed of; and
- (e) if acceptance is deferred because of regulation 18(1)(c)(v), when the registration of the other trade mark is renewed or the other trade mark is removed from the Register; and
- (f) if acceptance is deferred because of regulation 18(2)(a), at the end of 2 months after the beginning of the period in which—
  - (i) proceedings mentioned in regulation 18(2)(a) may be begun, or
  - (ii) an application mentioned in regulation 18(2)(a) may be made; and
- (g) if acceptance is deferred because of regulation 18(2)(b), at the end of—
  - (i) 3 months after the determination, or other disposal, of the proceedings or review, or
  - (ii) such time as the court to which any appeal is brought allows;
- (h) if acceptance is deferred because of regulation 18(2)(c), at the end of a period after the death of the applicant that the Registrar reasonably regards as sufficient in the circumstances.

(4) If acceptance of an application is deferred as a result of the operation of more than one of the provisions of regulation 18(1)(c) and regulation 18(2), the deferment period ends in accordance with the relevant provision of subregulation (3) under which the deferment period ends later or last, as the case requires.

(5) The Registrar must notify the applicant in writing of—

- (a) the end of a period of deferment; and
- (b) if acceptance is deferred under regulation 18(1), the last day of the relevant period prescribed by regulation 17(1) (a) or (b).

## **20. Trade marks containing etc. certain signs**

(1) For the purposes of section 23(2)(a) of the Act (which deals with signs), the signs in Schedule I are prescribed.

(2) A list of the marks mentioned in Schedule 1 must be available at the Registry of Companies and Intellectual Property and sub-offices.

## **21. Divisional applications**

(a) For the purposes of section 31(2) of the Act (which deals with divisional applications), the period in relation to a divisional application for the registration of part of a trade mark is 6 months after filing the initial application for the registration of the trade mark.

(b) For the purposes of sections 33(2) and 33(4) of the Act (which deal with divisional applications), the period in relation to a divisional application for the registration of the trade mark in respect of goods or services or both excluded from the initial application is one month from the date of the notice of the amendment of the initial application for the registration of the trade mark given under regulation 45.

## **22. Applications under Part 4**

An Application under Part 4 Division 3 of the Act shall be in the form prescribed in Form 3 of Schedule 6.

## **23. Request for expedited examination of application**

(1) A person who applies, or has applied, for the registration of a trade mark—

- (a) may request in writing expedited examination of the application; and
- (b) must include with the request a declaration stating the reasons for the request.

(2) As soon as practicable after making a decision in relation to a request, the Registrar must give written notice of the decision to the person who made the request.

## **24. Expedited examinations**

(1) The Registrar must, to the extent that is practicable, examine applications for the registration of trade marks in relation to which requests under regulation 23 are granted—

- (a) in the order in which the requests are filed; and
- (b) before examination of an application for registration of a trade mark in relation to which—
  - (i) a request under regulation 23 is not made, or
  - (ii) a request made under that regulation is not granted.

(2) In the absence of a request for expedited examination of an application for registration of a trade mark, the Registrar may expedite examination of the application if he or she reasonably believes that expedited examination is warranted.

(3) The relationship of an application mentioned in subregulation (2) to another application for registration of a trade mark is a relevant circumstance for the purposes of that subregulation.



**PART 4**  
**OPPOSITION TO REGISTRATION**

**25. Time for filing notice of opposition**

(1) For the purposes of section 36(2) of the Act (which deals with notice of opposition), the period for filing a notice of opposition is 3 months from the day on which the acceptance of the application is advertised in the Gazette.

(2) For the purposes of section 36(2) of the Act, a notice of opposition shall be in the form as prescribed in Form 4 of Schedule 6.

(3) The opponent shall within 2 days after the service of the copy of the notice of opposition on the applicant file a statement setting out the date, place and manner of service on the applicant.

**26. Extension of time for filing; grounds**

(1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.

(2) An application for an extension of time may be made within the period for filing a notice of opposition referred to in regulation 25 on one, or more than one, of the following grounds and on no other ground—

- (a) an error or omission by a member of staff of the Registry of Companies and Intellectual Property;
- (b) an error or omission by the person applying for the extension of time, or by the person's agent;
- (c) circumstances beyond the control of the person applying for the extension of time;
- (d) the conduct of genuine negotiations between that person and the applicant for registration;
- (e) the undertaking of genuine research to decide—
  - (i) whether opposition is justified, or
  - (ii) on the grounds of opposition.

(3) If the period for filing a notice of opposition has ended, an application for extension of time may be made at any time before the trade mark is registered on one, or more than one, of the grounds set out in subregulation (2)(a), (2)(b) or (2)(c) and on no other ground.

**27. Extension of time for filing: applications**

An application for an extension of time in which to file a notice of opposition must—

- (a) be in writing; and
- (b) be accompanied by a declaration stating—
  - (i) the facts on which the grounds specified in the application are based, and
  - (ii) if the period for filing a notice of opposition has ended the reason why the application was not made before the end of that period.

**28. Extension of time for filing: grant of extension**

(1) Subject to subregulations (2) and (4), if the Registrar is reasonably satisfied as to the grounds set out in an application for an extension of time to file a notice of opposition, the Registrar must grant the extension of time.

(2) The Registrar must not grant the extension of time, unless the Registrar—

- (a) is reasonably satisfied that the person applying for the extension of time has served a copy of the application, and the accompanying declaration, on the applicant for registration of the trade mark; and
- (b) has given to both the person applying for the extension of time and the applicant for registration of the trade mark a reasonable opportunity to make representations concerning the application for extension of time.

(3) For the purposes of subregulation (2)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(4) If an application for extension of time is made after the period for filing a notice of opposition has ended, the Registrar must not grant the extension unless the Registrar is reasonably satisfied that there is sufficient reason for the application not being made before the end of that period.

(5) An extension of time must be for such period—

- (a) in the case of an extension of time that is granted on a ground set out in regulation 26(2)(a), 26(2)(b) and 26(2) (c), as the Registrar believes is reasonable; or
- (b) in the case of an extension of time that is granted on a ground set out in regulation 26(2)(d) and 26(2)(e), not exceeding 3 months as the Registrar believes is reasonable.

## **29. Copy of earlier application to be available to opponent**

(1) In opposition proceedings relating to an application in respect of which the applicant claims a right of priority, an opponent may in writing ask the Registrar for a copy of an earlier application to be made available.

(2) On receipt of a request under subregulation (1), the Registrar must require in writing the applicant to file—

- (a) a copy of the earlier application certified in the trade marks office, or its equivalent, of the Convention country in which it was filed; and
- (b) if the earlier application is not in English—
  - (i) a translation of the earlier application into English, and
  - (ii) a certificate of verification relating to the translation.

(3) If the applicant is the successor in title to the person who made the earlier application, the Registrar may require in writing the applicant to provide documentary evidence that is sufficient to establish the passing of title to the applicant.

(4) Subregulation (2) does not apply if the applicant has already filed the documents mentioned in that subregulation.

(5) The Registrar must send a copy of the documents mentioned in subregulation (2) to the opponent.

## **30. Opposition proceedings**

For the purposes of section 38(2) of the Act (which deals with opposition proceedings), regulations 31 to 41 set out the procedure to be followed in dealing with an opposition after a notice of opposition is filed.

## **31. Evidence in support**

(1) If the opponent intends to rely on evidence in support of the opposition, the opponent must serve a copy of the evidence in support on the applicant within 3 months from the day on which the notice of opposition is filed.

(2) Within 2 days after the opponent serves a copy of the evidence in support on the applicant, the opponent must file with the Registrar—

- (a) the original evidence; and
- (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.

### **32. Notice that opponent will not rely on evidence in support**

(1) If the opponent does not intend to rely on evidence in support of the opposition, the opponent must, within 3 months from the day on which the notice of opposition is filed, serve on the applicant a copy of a notice stating that the opponent does not intend to rely on evidence in support of the opposition.

(2) As soon as practicable after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar—

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

### **33. Failure to file**

If the opponent does not file evidence in support under regulation 31 or the notice under regulation 32 or apply for extension so to do, the opponent shall be deemed to have abandoned his or her opposition.

### **34. Evidence in answer**

(1) If the applicant intends to rely on evidence in answer to the opposition, the applicant must serve a copy of the evidence in answer on the opponent within the period for service of a copy of that evidence under regulation 35.

(2) Within 2 days after the applicant serves a copy of the evidence in answer on the opponent, the applicant must file with the Registrar—

- (a) the original evidence; and
- (b) a statement setting out the date, place and manner of service of the copy of the evidence on the opponent,

### **35. Period for service of a copy of the evidence in answer**

If the opponent complies with regulation 31 or 32, the period for service of a copy of the evidence in answer to the opposition is 3 months from the day on which the opponent serves on the applicant—

- (a) the copy of the evidence in support referred to in regulation 31(1); or
- (b) the copy of the notice referred to in regulation 32(1).

### **36. Notice that applicant will not rely on evidence in answer**

(1) If an applicant does not intend to rely on evidence in answer to the opposition, the applicant must serve on the opponent, within the period for service of a copy of the evidence in answer, a copy of a notice stating that the applicant does not intend to rely on evidence in answer to the opposition.

(2) Within 2 days after the applicant serves a copy of the notice on the opponent, the applicant must file with the Registrar—

- (a) the original notice; and

- (b) a statement setting out the date, place and manner of service of the copy of the notice on the opponent.

### **37. Failure to file**

If the applicant does not file evidence in answer under regulation 34 or the notice under regulation 36 or apply for extension of time so to do, he or she shall be deemed to have abandoned his or her application.

### **38. Evidence in reply to evidence in answer**

(1) If an opponent intends to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve a copy of the evidence in reply on the applicant within 3 months after the service on the opponent of a copy of the evidence in answer.

(2) Within 2 days after the opponent serves a copy of the evidence in reply on the applicant, the opponent must file with the Registrar—

- (a) the original evidence; and
  - (b) a statement setting out the date, place and manner of service of the copy of the evidence on the applicant.
- (3) This evidence must be confined to matters strictly in reply.

### **39. Notice that opponents will not rely on evidence in reply to evidence in answer and failure to file**

(1) If an opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition, the opponent must serve on the applicant, within 3 months after the service on the opponent of a copy of the evidence in answer, a copy of a notice stating that the opponent does not intend to rely on evidence in reply to the evidence in answer to the opposition.

(2) Within 2 days after the opponent serves a copy of the notice on the applicant, the opponent must file with the Registrar—

- (a) the original notice; and
- (b) a statement setting out the date, place and manner of service of the copy of the notice on the applicant.

(3) If the opponent does not file evidence in reply to evidence in answer under regulation 34 or the notice under regulation 36 or apply for extension so to do, the evidence shall be deemed closed and opposition proceedings follow the normal course.

### **40. Hearing of opposition**

(1) Upon completion of the evidence, the applicant or opponent may ask the Registrar to hear the parties to the opposition proceedings.

(2) The Registrar must comply with a request made in accordance with subregulation (1).

(3) If an applicant or opponent in opposition proceedings may make a request to the Registrar under subregulation (1) and the request is not made, the Registrar may, on his or her own initiative, give an opportunity to the parties to the opposition proceedings to be heard in relation to those proceedings.

(4) The Registrar must give notice to the parties of a date when he or she will hear arguments in the opposition proceedings.

(5) The date under subregulation (4) must be a date at least 14 days after the date of the notice unless the parties consent to a shorter notice.

(6) Within 7 days from the receipt of the notice any party who intends to appear must so notify the Registrar in the form prescribed in Form 5 of Schedule 6.

(7) A party who receives notice as mentioned above and who does not, within 7 days from receipt thereof, notify the Registrar in accordance with subregulation (6) may be treated as not desiring to be heard and the Registrar may act accordingly.

#### **41. Extension of period to serve evidence and service of further evidence**

(1) A party to the opposition proceedings may apply to the Registrar—

- (a) for an extension of the period for serving a copy of the evidence under regulation 31, 35 or 38; or
- (b) for permission to serve a copy of further evidence on the other party.

(2) The Registrar may grant an application on reasonable terms specified by the Registrar.

(3) The Registrar must not grant an application unless the Registrar—

- (a) is reasonably satisfied that the applicant has served a copy of the application, and of any documents accompanying the application, on the other party; and
- (b) has given the parties a reasonable opportunity to make representations concerning the application; and
- (c) is reasonably satisfied that—
  - (i) in the case of an application to which subregulation (1)(a) applies, the extension of the period for serving a copy of the evidence, and
  - (ii) in the case of an application to which subregulation (1)(b) applies—permission to serve a copy of further evidence,is appropriate.

(4) For the purposes of subregulation (3)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(5) If the Registrar grants an application under subregulation (1)(b) on terms that include service of a copy of the further evidence within a specified period, a party to the opposition proceedings may apply to the Registrar for an extension of that period.

(6) Subregulations (2), (3) and (4) apply to an application under subregulation (5).

#### **42. Conduct of opposition proceedings generally**

(1) The Registrar may, at the request of a party to the opposition proceedings or on the initiative of the Registrar, give a direction in relation to the procedure in the proceedings.

(2) A direction given under subregulation (1) must not be inconsistent with these Regulations.

(3) The Registrar must not give a direction unless the Registrar—

- (a) is reasonably satisfied that parties to the proceedings have been notified of the proposed direction; and
- (b) has given the parties a reasonable opportunity to make representations concerning the proposed direction; and
- (c) is reasonably satisfied that the proposed direction is appropriate.

(4) For the purposes of subregulation (3)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

### **43. Registrar to give notice of dismissal of proceedings**

If opposition proceedings are dismissed under section 193 of the Act, which deals with security for costs, or discontinued, the Registrar must notify the parties in writing that the opposition proceedings have been dismissed or discontinued.

## **PART 5 AMENDMENT OF APPLICATION FOR REGISTRATION OF A TRADE MARK AND OTHER DOCUMENTS**

### **44. Amendment of applications by Registrar**

(1) For the purposes of section 47(2) of the Act (which deals with amendment), if the Registrar proposes to amend an application for the registration of a trade mark, the Registrar must give notice in writing to the applicant—

- (a) setting out the proposed amendment and the reason for making the amendment; and
- (b) stating that the proposed amendment will be made at the end of a reasonable period stated in the notice, unless the applicant objects in writing to the amendment within that period, stating grounds for the objection.

(2) If an applicant objects to an amendment proposed by the Registrar within the period mentioned in subregulation (1)(b), the Registrar must not make the amendment unless the objection is withdrawn.

### **45. Request to amend before publication of details**

For the purposes of section 48(b) of the Act (which deals with amendments before publication), the period for requesting an amendment is 14 days after filing the application for the registration of the trade mark.

### **46. Filing of declarations**

If a person requests an amendment under section 48 of the Act, (which deals with amendments before publication), or section 50(a) of the Act, (which deals with amendment of other documents), the Registrar may require the applicant to file a declaration stating—

- (a) that a clerical error or obvious mistake was made in the application; and
- (b) the circumstances in which the error or mistake was made.

### **47. Notification of amendments**

If the Registrar amends an application, notice or document under Part 6 of the Act, the Registrar must give notice in writing of the amendment to—

- (a) the person who requested the amendment; and
- (b) any other person that the Registrar thinks appropriate.

## **PART 6 REGISTRATION OF TRADE MARKS**

### **48. Period in which a trade mark can be registered**

(1) For the purposes of section 52(1) of the Act (which deals with registration), the period for the registration of a trade mark that has been accepted for registration is—

- (a) except if paragraph (b) applies, the period from the beginning of the day on which the acceptance is advertised in the Gazette to the end of—
    - (i) the day that is 4 months after that day, or
    - (ii) if a later day is specified under subregulation (2) or (3) the day specified in that subregulation; and
  - (b) in the case of the death of an applicant for registration of the trade mark, within 6 months of the date of death or within such further period as the Registrar reasonably allows.
- (2) If—
- (a) proceedings in relation to the registration of the trade mark before the High Court are not determined or otherwise disposed of; and
  - (b) the High Court is satisfied that the registration of the trade mark cannot take place on or before the first-mentioned day in subregulation (1)(a) (i), the High Court may specify for the purposes of subregulation (1)(a)(ii) a day that is later than the first-mentioned day in subregulation (1)(a)(i).
- (3) If—
- (a) proceedings in relation to the registration of the trade mark are before the Registrar; and
  - (b) the Registrar is reasonably satisfied that—
    - (i) the registration of the trade mark cannot take place on or before the first-mentioned day in subregulation (1)(a)(i), and
    - (ii) it is appropriate to do so,
 the Registrar may specify, for the purposes of subregulation (1)(a)(ii), a day that is later than the first-mentioned day in subregulation (1)(a)(i).

#### **49. Particulars to be entered in the Register**

For the purposes of section 53(2)(c) of the Act (which deals with particulars), the following other particulars of a trade mark must be entered in the Register—

- (a) if the trade mark is registered as a certification trade mark, a collective trade mark or a defensive trade mark—an indication to that effect;
- (b) the date of the registration;
- (c) the date on which the particulars of the registration are entered in the Register under section 53(1) of the Act;
- (d) the particulars of any right of priority claimed under section 13 of the Act;
- (e) the filing date of the initial application on which any divisional application is based;
- (f) any number allocated to the initial application for registration of the trade mark;
- (g) the class numbers of the goods or services or both in respect of which the trade mark is registered;
- (h) the address of the owner of the trade mark;
- (i) the name and address of the authorised agent;
- (j) any other particulars relating to the trade mark that the Registrar reasonably believes to be appropriate.

## **50. Period for request for renewal**

(1) For the purposes of section 59 of the Act (which deals with requests for renewal), the period within which a person may request the Registrar to renew the registration of a trade mark is 6 months ending on the day on which the registration of the trade mark expires.

(2) A request for renewal under section 59 shall be as prescribed in Form 7 of Schedule 6.

## **51. Notice of renewal due: when and how given**

(1) For the purposes of section 60 of the Act (which deals with notice of renewal date), the period in relation to notifying a registered owner that renewal of the registration of a trade mark is due is within 3 months ending on the day on which the registration of the trade mark expires.

(2) A notice that the renewal is due must include—

- (a) a statement of the date on which the registration of the trade mark will expire; and
- (b) a statement of any fee payable.

## **52. Notice of renewal**

For the purposes of section 61(2) of the Act (which deals with renewal), a notice of the renewal of the registration of a trade mark must include—

- (a) a statement that the registration is renewed; and
- (b) the period for which it is renewed.

## **PART 7 AMENDMENT AND CANCELLATION OF REGISTRATION**

## **53. Notice of cancellation**

(1) The Registrar must, after receiving a request from the owner of a registered trade mark under section 68(1) of the Act (which deals with cancellation of registration), cancel registration of the trade mark if the Registrar is not obliged under section 68(2) of the Act to notify a person.

(2) If the Registrar must notify a person under that subsection, the notice must state that unless—

- (a) the request from the owner is sooner withdrawn; or
- (b) a prescribed court determines that the Registrar must not cancel registration of the trade mark,  
  
the Registrar will cancel the trade mark at the end of a period of 2 months from the date of the notice.

(3) If—

- (a) before the end of the period of 2 months, each person who is notified advises the Registrar in writing that the person does not object to cancellation of registration of the trade mark—the Registrar must cancel registration of the trade mark; or
- (b) paragraph (a) does not apply—the Registrar must cancel registration of the trade mark after the end of that period;  
  
unless the request from the owner is withdrawn or a prescribed court determines otherwise.



#### **54. Amendment or cancellation-matters for the court**

For the purposes of section 73(2)(a) of the Act (which deals with amendment or cancellation by the High Court), the High Court, in making a decision under section 73(1) of the Act on an application for rectification of the Register, must take into account the following matters, so far as they are relevant—

- (a) the extent to which the public interest will be affected if registration of the trademark is not cancelled;
- (b) whether any circumstances that gave rise to the application have ceased to exist;
- (c) the extent to which the trade mark distinguished the relevant goods or services or both before the circumstances giving rise to the application arose;
- (d) whether there is any order or other remedy, other than an order for rectification, that would be adequate in the circumstances.

### **PART 8 REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE**

#### **55. Applications for removal etc.**

For the purposes of section 76(2)(a) of the Act (which deals with applications for removal of trade marks), an application for the removal of a trade mark from the Register—

- (a) shall be in the form prescribed in Form 9 of Schedule 6; and
- (b) must be accompanied by a declaration made by, or on behalf of, the applicant—
  - (i) stating that an inquiry into the use of the trade mark has been conducted by, or on behalf of, the applicant, and
  - (ii) setting out the findings of that inquiry that support either or both of the grounds for the application referred to in section 76(4) of the Act.

#### **56. Notification of applications**

(1) For the purposes of section 79(1) of the Act (which deals with notification), the Registrar must give notice of an application under section 76 of the Act within one month after the application is filed in accordance with these Regulations.

(2) The notice must be given by sending a copy of the application, and the accompanying declaration, to each person who, in the opinion of the Registrar, needs to know that the application has been filed.

#### **57. Notice of opposition to removal**

(1) For the purposes of section 80(2) of the Act (which deals with notice of opposition), a notice of opposition to an application under section 76 of the Act shall be in the form prescribed in Form 4 of Schedule 6 and must be filed with the Registrar within 3 months from the day on which the application is advertised in the *Gazette*.

(2) The opponent must serve a copy of the notice of opposition on the applicant as soon as practicable after the notice is filed.

#### **58. Opposition proceedings before the Registrar**

(1) For the purposes of section 83 of the Act (which deals with opposition proceedings), regulations 31 to 41 inclusive apply, subject to subregulations (2) and (3), to an opposition to an application under section 76 of the Act

(2) The Registrar must, if asked to do so by the opponent within the period for serving—

- (a) a copy of the evidence in support under regulation 31(1); or
- (b) a copy of the notice under regulation 32(1),  
hear the parties to the opposition proceedings.

(3) If the opponent—

- (a) does not serve a copy of the evidence in support in accordance with regulation 31(1); or
- (b) serves a copy of a notice under regulation 32(1); or
- (c) does not serve a copy of that notice within the time allowed in regulation 31(1) or 32(1) as the case may be,

and the opponent does not request a hearing under subregulation (2), the opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed.

(4) If—

- (a) under subregulation (3) opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed; and
- (b) the Registrar is satisfied that the grounds on which the opposed application was made have been established,  
the Registrar must determine the application in accordance with section 85 of the Act.

## **PART 9 ASSIGNMENT AND TRANSMISSION OF TRADE MARKS**

### **59. Applications for assignment etc. to be recorded or entered**

For the purposes of sections 91 and 93 of the Act (which deal with assignment and transmission), the following documents are prescribed—

- (a) a document that establishes the title to a trade mark of the assignee, or of the person to whom the trade mark has been transmitted; or
- (b) evidence of the assignment or transmission of a registered certification trade mark; and
- (c) Form 10 of Schedule 6.

### **60. Recording of assignment etc.: trade marks not registered**

(1) For the purposes of section 92(1)(a) of the Act (which deals with assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation unless—

- (a) the application to assign or transmit the trade mark is withdrawn; or
- (b) a prescribed court determines otherwise.

(2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars after ascertaining that a claim has not been recorded.

(3) If—

- (a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and

- (b) the Registrar has notified that person, or each of those persons, under regulation 63(1); and
  - (c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written notice to the Registrar consenting to the assignment or transmission,  
  
the Registrar must record the particulars after the Registrar has received the last notice consenting to the assignment or transmission.
- (4) If—
- (a) paragraphs (3)(a) and (b) apply; and
  - (b) the person, or any of the persons, notified by the Registrar under regulation 63(1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the date of the notice,  
  
the Registrar must record the particulars as soon as practicable after the end of that period.

### **61. Particulars of recorded assignment or transmission to be published**

For the purposes of section 92(1)(b) of the Act (which deals with assignment and transmission)—

- (a) the following particulars of an assignment or transmission of a trade mark for which registration is sought must be published—
  - (i) if a number has been allocated in the Registry of Companies and Intellectual Property to the application for registration of the trade mark—the number,
  - (ii) the name of the person to whom the trade mark is recorded as having been assigned or transmitted,
  - (iii) the day on which the particulars of the assignment or transmission were recorded; and
- (b) if details of an application for registration of the trade mark have been published in a way described in regulation 12(2), the particulars of the assignment or transmission mentioned in paragraph (a) must be published in the same way.

### **62. Recording of assignment etc. of registered trade marks**

(1) For the purposes of section 94(1)(a) of the Act (which deals with recording of assignment and transmission), the Registrar must record particulars of the assignment or transmission of a trade mark in accordance with this regulation, unless—

- (a) the application to assign or transmit the trade mark is withdrawn; or
- (b) a prescribed court determines otherwise.

(2) If there is no record made under Part 11 of the Act of a person claiming an interest in, or a right in respect of, the trade mark, the Registrar must record the particulars in the Register after ascertaining that a claim has not been recorded.

- (3) If—
- (a) there is a record made under Part 11 of the Act of a person, or persons, claiming an interest in, or a right in respect of, the trade mark; and
  - (b) the Registrar has notified that person, or each of those persons, under regulation 63(1); and

- (c) that person or each of those persons has, within the period of 2 months from the date of the notice mentioned in paragraph (b), given written notice to the Registrar consenting to the assignment or transmission,

the Registrar must record the particulars in the Register after the Registrar has received the last notice consenting to the assignment or transmission.

(4) If—

- (a) paragraphs (3)(a) and (3)(b) apply; and
- (b) the person, or any of the persons, notified by the Registrar under subregulation 63(1) has not consented in writing to the assignment or transmission of the trade mark within the period of 2 months from the date of the notice,

the Registrar must record the particulars in the Register as soon as practicable after the end of that period.

### **63. Notice to persons recorded as claiming right or interest in trade marks**

(1) For the purposes of section 95 of the Act, the Registrar must give notice in writing to a person recorded under Part 11 of the Act as claiming an interest in, or a right in respect of, a trade mark stating that the Registrar will record the assignment or transmission of the trade mark at the end of a period of 2 months from the date of the notice, unless—

- (a) the application to assign or transmit the trade mark is withdrawn; or
- (b) a prescribed court determines otherwise; or
- (c) each person to whom the Registrar must give notice under this subregulation has already notified the Registrar in writing that the person consents to the assignment or transmission.

(2) Each notice under subregulation (1) in respect of a particular trade mark must be given on the same day.

## **PART 10 VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN AND RIGHTS IN RESPECT OF TRADE MARKS**

### **64. Amendment of particulars: claimed interests or rights**

(1) For the purposes of sections 99 and 103 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in, or to a right in respect of, a trade mark other than the name, address or address for service of a person whose claim is recorded or entered in the Register or recorded under Division 3 of Part 11 of the Act may be amended in accordance with this regulation.

(2) A request to amend particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing—

- (a) together by the person whose claim is recorded and the owner of the trade mark; or
- (b) if the request has with it the written consent to the amendment of one of the persons mentioned in paragraph(a), by the other person mentioned in that paragraph.

(3) If a request is made in accordance with subregulation (2), the Registrar must amend the particulars in accordance with the request.

## **65. Amendment of name, address and address for service: claims not in the Register**

If a person—

- (a) whose claim to an interest in, or to a right in respect of, a trade mark for which registration is sought is recorded; and
- (b) whose name, address or address for service has changed since the claim was recorded,

gives notice in writing of the new name or address to the Registrar, the Registrar must amend the record accordingly.

## **66. Cancellation of particulars; claimed interests or rights**

(1) For the purposes of sections 99 and 103 of the Act (which deal with amendment and cancellation of particulars), particulars of a claim to an interest in or to a right in respect of, a trade mark, entered in the Register or recorded under Division 3 of Part 11 of the Act may be cancelled in accordance with this regulation.

(2) A request to cancel particulars of a claim to an interest in, or to a right in respect of, a trade mark must be made in writing—

- (a) by the person whose claim is recorded; or
- (b) by the owner of the trade mark; or
- (c) together by the person whose claim is recorded and the owner of the trade mark; or
- (d) if the request has with it the written consent to the cancellation of one of the persons mentioned in paragraph (c) by the other person mentioned in that paragraph.

(3) If a request is made under subregulation (2)(a), (2)(c) or (2)(d), the Registrar must cancel the particulars in accordance with the request.

(4) If a request is made under subregulation (2)(b), the Registrar must notify in writing the person whose claim is recorded that—

- (a) the request has been made; and
- (b) unless the request is withdrawn or a prescribed court orders otherwise, the Registrar will cancel particulars of the claim in accordance with the request as soon as practicable after the end of a period of 2 months from the date of the notice.

(5) Unless a request made under subregulation (2)(b) is withdrawn or a prescribed court determines otherwise, the Registrar must, as soon as practicable—

- (a) if, before the end of the period mentioned in subregulation (4)(b), a person the particulars of whose claim are recorded informs the Registrar in writing that the person does not object to cancellation of the particulars-cancel the particulars in accordance with the request; or
- (b) if paragraph (a) does not apply-cancel the particulars after the end of that period in accordance with the request.

## **PART 11 IMPORTATION OF GOODS INFRINGING SAINT LUCIAN TRADE MARKS**

### **67. Notice of objection to importation: accompanying documents**

For the purposes of section 115(1) of the Act (which deals with notice of objection), the document prescribed in relation to a notice given under that subsection, is Form 12.

## **68. Notice of objection to importation: authorised users**

(1) For the purposes of section 115(3) of the Act (which deals with notice of objection), the period in relation to a request by an authorised user under section 115(2) of the Act is 2 months from the date on which the request is made.

(2) For the purposes of section 115(3) of the Act, the following documents are prescribed—

- (a) a copy of the certificate of registration of the trade mark certified by the Registrar as being a true copy and issued no more than 2 months before the date of the notice given under section 115(1) of the Act; and
- (b) documents that establish that—
  - (i) the authorised user has the power to give a notice of objection under section 115(1) of the Act,
  - (ii) the registered owner was asked to give the notice,
  - (iii) since the request mentioned in section 115(2) was made, the period prescribed by subregulation (1) in relation to the request has ended.

## **69. Period for compliance with Comptroller's request for information etc.**

For the purposes of section 126 of the Act (which deals with giving information to the Comptroller), the period for complying with a request under section 126(1) of the Act is 10 working days from the date on which the request is made.

## **PART 12 CERTIFICATION TRADE MARKS**

### **70. Copy of rules to be filed**

For the purposes of section 152(1) of the Act (which deals with rules governing use), an applicant for registration of a certification trade mark must file a copy of the rules governing the use of the certification trade mark at, or as soon as practicable after, the time of filing of the application.

### **71. Applications to vary rules**

(1) For the purposes of section 155(1) of the Act (which deals with the variation of rules), the registered owner of a certification trade mark may apply to the Registrar to approve a variation of the rules governing the use of the certification trade mark.

(2) An application to approve the variation of the rules governing the use of a registered certification trade mark must—

- (a) be in writing; and
- (b) have with it a copy of the rules governing the use of the registered certification trade mark that incorporates the proposed variation, highlighting the variations.

### **72. Assignment of registered certification trade marks**

(1) An application to the Registrar for his or her consent to the assignment of a registered certification trade mark must—

- (a) be made by the registered owner of the certification trade mark; and
- (b) state the name, address, and address for service of the prospective assignee; and

- (c) state whether the prospective assignee proposes to continue after assignment to apply the same rules governing use of the registered certification trade mark that the registered owner of the trade mark applies; and
- (d) if the prospective assignee does not propose to continue to apply those rules—
  - (i) state any variation of the rules that the prospective assignee proposes to apply after assignment, and
  - (ii) have with it a copy of the rules incorporating the proposed variation that the prospective assignee proposes to apply after assignment.

(2) In considering an application, the Registrar must have regard to the following matters—

- (a) whether the prospective assignee, or any prospective approved certifier within the meaning of section 152(2)(a) of the Act, is competent to certify the goods or services or both in respect of which the certification trade mark is registered;
- (b) if the prospective assignee does not propose after the assignment to continue to apply the same rules governing use of the registered certification trade mark as the registered owner of the trade mark applies—whether, if the application were an application to approve the variation of those rules that the prospective assignee proposes to vary after the assignment, the application would be approved by the Registrar.

## **PART 13 DEFENSIVE TRADE MARKS**

### **73. Evidence in support of applications**

An applicant for registration of a defensive trade mark must file evidence in support of the application at, or as soon as practicable after, the time of filing of the application.

## **PART 14 ADMINISTRATION**

### **74. Registry and sub-offices business hours**

The hours of business of the Registry of Companies and Intellectual Property and each sub-office of the Registry of Companies and Intellectual Property are from 9:00 a.m. to 2:00 p.m. Monday to Thursday and 9:00 a.m. to 3:00 p.m. on Friday, other than a public holiday, or such other hours as the Companies and Intellectual Property (Registry) Act may provide.

### **75. Delegates of the Registrar**

For the purposes of section 177(1) of the Act, persons employed in, holding or performing the duties of offices in the Registry of Companies and Intellectual Property that are set out in Schedule 2 are prescribed persons or prescribed public officers.

## **PART 15 MISCELLANEOUS**

### *Division 1 Applications and other documents*

## **76. Compliance with instructions on approved forms**

If—

- (a) an application, notice or request under the Act or these Regulations is required to be in an approved form; and
- (b) a blank form that may be used in making an application or request or giving notice—
  - (i) is supplied by the Registrar, and
  - (ii) contains directions about completing that form,  
the person who completes the form must comply with those directions;
- (c) where a blank form is not obtained from the Registrar, the form used must conform as closely as possible to the prescribed or approved form.

## **77. Filing of documents: requirements as to form**

(1) A document to be filed at the Registry of Companies and Intellectual Property must comply with the requirements set out in Schedule 3.

(2) If the document does not comply with the requirements in Schedule 3, the Registrar may return the document to the person from whom it was received with a statement setting out the requirements that have not been complied with and stating a period within which the requirements must be complied with.

(3) A document may be filed by facsimile transmission—

- (a) if no fee is payable on filing the document; or
- (b) if a fee is payable on filing the document—if the document is accompanied by—
  - (i) documentary evidence that the fee has been paid, or
  - (ii) written authorisation of the payment.

(4) If a document is filed by a person by facsimile transmission, the Registrar shall require the person to file the original document from which the facsimile was transmitted.

## **78. Filing of documents: common requirements**

(1) A person who files an application, notice or request must include in the application, notice or request the business or residential address of—

- (a) the attorney-at-law making the application or request or giving the notice; and
- (b) the person on whose behalf the application, notice or request is made.

(2) If an address recorded in the Register or included in an application, notice or request that is filed changes, the person whose address changes, or a person acting on behalf of that person, must notify the Registrar of the new address as provided for in regulation 86.

(3) If the Registrar is notified of a new address, the Registrar must amend the Register, application, notice or request accordingly.

(4) An application, notice or request that is to be filed must be signed by an attorney-at-law on behalf of the person making the application or request, or giving the notice, and dated by the signatory.



## **79. Filing of documents: treatment of non-complying documents**

If a document received for filing at the Registry of Companies and Intellectual Property fails to comply with the Act or these Regulations, the Registrar may—

- (a) treat the document as not having been filed at the Registry of Companies and Intellectual Property; or
- (b) treat the document as having been filed, but require the person who filed the document to make, or cause to be made, any alterations to the document that are necessary to enable the document to so comply.

## **80. Filing of documents: date of receipt to be marked**

(1) A document that is received for filing must be marked by the Registrar with the date on which it is received.

(2) If the Registry of Companies and Intellectual Property or a sub-office provides a facility for the receipt of documents (other than documents filed electronically or by facsimile transmission), when the Registry of Companies and Intellectual Property or sub-office is not open to the public for business, a document received by means of that facility is taken to have been received on the day on which the Registry of Companies and Intellectual Property or sub-office was last open to the public for business before the document was received.

(3) Except as otherwise provided by the Act or these Regulations, a document is taken to be filed at the Registry of Companies and Intellectual Property on the date on which it is received by the Registry of Companies and Intellectual Property.

## **81. Declarations**

(1) In this regulation “**diplomatic or consular officer**” means a person who holds any of the following offices of the State in a country other than Saint Lucia—

- (a) ambassador;
- (b) high commissioner;
- (c) minister;
- (d) charge d’affaires;
- (e) counsellor or second or third secretary at an embassy, high commission or other post;
- (f) consul-general;
- (g) consul;
- (h) vice-consul;
- (i) Secretary of State.

(2) A declaration required by the Act or these Regulations must—

- (a) be headed with the title of the matter in respect of which the declaration is made; and
- (b) be expressed in the first person; and
- (c) state—
  - (i) the name and address of the declarant, and
  - (ii) if the declaration is made on behalf of another person the name and address of the other person; and
- (d) if the declaration is made for the purposes of a business the details of which are set out in the declaration—state—

- (i) the office or position held by the person by whom the declaration is made, and
  - (ii) the address of the place where the business is conducted or principally conducted; and
- (e) be divided into paragraphs, each of which must be numbered consecutively and, as far as practicable, be confined to one subject.

(3) A declaration may be made before—

- (a) a magistrate; or
- (b) a justice of the peace; or
- (c) a commissioner of affidavits; or
- (d) a commissioner for declarations; or
- (e) a notary royal; or
- (f) a notary public; or
- (g) a patent attorney; or
- (h) a person before whom a statutory declaration may be made under the Statutory Declarations Act or the law of the State, Territory or foreign country where the declaration is made; or
- (i) a diplomatic or consular officer.

(4) The name and title of the person before whom the declaration is made and the date when, and the place where, it was made must be stated in the declaration.

## **82. Declarations: additional material**

(1) If—

- (a) a person is required by the Act or these Regulations to file a declaration or serve a copy of the declaration; and
- (b) it is not practicable to include in, or attach to, the declaration or copy any material to which the declaration refers,

the person must file or serve the material to which the declaration refers, or a copy of the material, at the same time as the declaration or as soon as practicable after that time.

(2) A declaration is not taken to have been filed or served until any material to which the declaration refers, or any copy of the material, is filed or served.

## **83. Notification of service**

A person who is required by the Act or these Regulations to serve a document on another person must, as soon as practicable after the document is served, notify the Registrar in writing of the date, place and manner of service.

## **84. Notice of withdrawal of applications etc.**

(1) For the purposes of section 185 of the Act (which deals with withdrawal of applications, notices and requests)—

- (a) a person who has filed an application, notice or request; or
- (b) another person in whom the right or interest in reliance on which the application, notice or request was filed has become vested,

may withdraw the application, notice or request by giving notice in writing of the withdrawal to the Registrar.

(2) If—

- (a) the application, notice or request was filed by, or on behalf of, more than one person; or
- (b) the right or interest mentioned in subregulation (1)(b) has become vested in more than one person,

the notice of withdrawal must be signed by an agent on behalf of each of those persons.

(3) If a person mentioned in subregulation (1)(b) withdraws an application, notice or request, the Registrar may require, in writing, that person to file documentary evidence that is sufficient to establish that the right or interest mentioned in that paragraph is vested in the person.

### **85. Withdrawal of application etc.: Registrar's notice to applicants**

If an application, notice or request is withdrawn in accordance with regulation 84, the Registrar must notify in writing the person or his or her attorney-at-law of the withdrawal and record the fact of the withdrawal in a manner deemed appropriate.

### **86. Change of address for service: notice to interested persons**

(1) A person—

- (a) who has filed an application, notice or request stating an address; and
- (b) who notifies the Registrar of another address for the purposes of section 186(1)(b) of the Act (which deals with address for service) or any other purpose,

must give a copy of the notification to any party to proceedings relating to the application, notice or request and to any other person as directed by the Registrar.

(2) For the purposes of section 186 a request for a change of address of service shall be in the form prescribed in Form 21 of Schedule 6.

#### *Division 2*

#### *Proceedings before the Registrar*

### **87. Applications for costs**

(1) For the purposes of section 192 of the Act (which deals with costs), a party to proceedings before the Registrar may apply to the Registrar in the form prescribed in Form 25 of Schedule 6 for an award of costs in relation to the proceedings.

(2) An application must be made—

- (a) during the proceedings; or
- (b) within 3 months from—
  - (i) the date on which the Registrar makes a decision in the proceedings that ends those proceedings, or
  - (ii) the date of the Registrar's notice to the party that the proceedings have been discontinued or dismissed,

as the case requires.

(3) Before awarding costs in respect of the proceedings, the Registrar must give each party to the proceedings a reasonable opportunity to be heard in relation to the award of costs.

(4) If a bill of costs is filed in relation to the proceedings, the bill of costs must be filed within 3 months from the date on which the costs are awarded.

#### **88. Determination of costs**

(1) In this regulation, “**costs**” does not include the costs referred to in section 89(2)(b) of the Act.

(2) For the purposes of section 192 of the Act (which deals with costs), costs may only be awarded in respect of a matter set out in Schedule 4.

(3) The amount of costs must be taxed, allowed and certified by a trade marks officer appointed by the Registrar for that purpose, in accordance with—

- (a) in the case of an item in Part 1 of Schedule 4, the amount specified in that item; or
- (b) in the case of a matter set out in a clause in Part 2 of Schedule 4 that clause.

(4) The Registrar may review the taxation of costs by a trade marks officer.

#### **89. Conduct of proceedings generally**

(1) The Registrar may, at the request of a party to proceedings before the Registrar, other than opposition proceedings, give directions in relation to the procedure in the proceedings.

(2) Directions given under subregulation (1) must not be inconsistent with these Regulations.

(3) The Registrar must not give directions under subregulation (1) unless the Registrar—

- (a) is reasonably satisfied that any person affected by the proposed directions has been notified of the proposed directions;
- (b) has given any person affected a reasonable opportunity to make representations concerning the proposed directions; and
- (c) is reasonably satisfied that the proposed directions are appropriate.

(4) For the purposes of subregulation (3)(b), representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

(5) Subject to these Regulations, the Registrar may determine the procedure to be followed in proceedings before the Registrar.

#### **90. Hearings by Registrar**

(1) This regulation applies if the Act or these Regulations provide for a person to be heard by the Registrar.

(2) A request for a hearing by the Registrar must be in the form prescribed in Form 26 of Schedule 6.

(3) On request, or on his or her own initiative, the Registrar may—

- (a) fix a time, date and place for the hearing; and
- (b) give the parties to the hearing at least 10 days’ notice in writing of the hearing and of the time, date and place fixed for the hearing.

(4) A party must, as soon as practicable after being notified of the hearing, inform the Registrar in writing as to whether the party wants to be heard.

(5) A party may attend a hearing in person or by such means as the Registrar reasonably allows.

(6) A party may make representations in writing before or during a hearing.

(7) A hearing must be conducted with as little formality and technicality, and with as much expedition, as the requirements of the Act and these Regulations and a proper consideration of the matters before the Registrar, allow.

(8) The Registrar is not bound by the rules of evidence but may inform himself or herself on any matter that is before him or her in any way that the Registrar reasonably believes to be appropriate.

(9) The Registrar may adjourn a hearing by notifying each party to the hearing accordingly.

(10) Subject to these Regulations, the Registrar may give a direction that is reasonably necessary for the conduct of the hearing.

### **91. Registrar not required to hold hearings**

(1) The Registrar is not required to proceed to hear a matter if—

- (a) the Registrar reasonably believes that no party wishes to be heard in the matter; or
- (b) at least one of the following circumstances applies in relation to each party notified of the hearing under regulation 90(3):
  - (i) the party has not indicated to the Registrar that the party wishes to be heard,
  - (ii) the party has informed the Registrar that the party does not wish to be heard, or
  - (iii) the party does not attend the hearing.

(2) The Registrar may decide a matter to which subregulation (1) refers—

- (a) without a hearing; and
- (b) by reference to relevant information about the matter that is held in the Registry of Companies and Intellectual Property.

### **92. Evidence in proceedings**

(1) Evidence that is given in writing in any proceedings before the Registrar must be in the form of a declaration.

(2) The Registrar may require a person who has made a declaration that is filed in the proceedings to attend before the Registrar to give evidence orally on oath or affirmation instead of, or in addition to, the evidence contained in the declaration.

(3) The Registrar may permit a party to cross-examine a person who attends under subregulation (2).

### **93. Documents not in English**

If a document that is filed as evidence in proceedings before the Registrar is not in English, the party who files the document must file with it—

- (a) a translation of the document into English; and
- (b) a certificate of verification in relation to the translation.

#### **94. Registrar may use information available**

- (1) If—
  - (a) information that is available to the Registrar is relevant to proceedings before the Registrar; and
  - (b) the Registrar has reason to believe that the information is not known to a party to the proceedings; and
  - (c) the Registrar proposes to take the information into account in making a decision in the proceedings; before making the decision the Registrar must—
    - (i) provide the information to the party, and
    - (ii) give the party a reasonable opportunity to make representations about the information.

(2) For the purposes of subregulation (1)(c)(ii), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

#### **95. Statements of reason for decision**

- (1) If—
  - (a) the Registrar notifies a party to proceedings before the Registrar of a decision of the Registrar in the proceedings; and
  - (b) the party requests the Registrar in writing for the reasons for the decision, the Registrar must comply with the request.

(2) A request for reasons under subregulation (1) shall be in the form prescribed in Form 24 of Schedule 6.

#### *Division 3 General*

#### **96. What fees are payable**

For the purposes of section 194(1) of the Act (which deals with fees), the fees specified in column 3 of an item in Schedule 5 are payable in respect of a matter specified in column 2 of that item.

#### **97. How fees are to be paid**

(1) For the purposes of section 194(2) of the Act (which deals with payment of fees), a fee, other than a fee payable under Part 13 of the Act, must be paid to the Registrar at the Registry of Companies and Intellectual Property or at a sub-office of the Registry of Companies and Intellectual Property.

(2) A fee payable under Part 13 of the Act must be paid to the Comptroller.

(3) A fee must be paid in accordance with a direction given—

- (a) in the case of a fee that is paid to the Registrar by the Registrar; and
- (b) in the case of a fee that is paid to the Comptroller by the Comptroller, as to the way in which it is to be paid.

#### **98. Notice of non-payment of fee**

For the purposes of section 194(5) of the Act (which deals with non-payment of fees), the Registrar or the Comptroller must notify in writing the person concerned, or

his or her agent, that the fee has not been paid, within 14 days after the doing of the act, or the filing of the document, for which the fee is payable.

#### **99. Refunds etc, of fees**

(1) If, because of an error or omission by a trade marks officer, a person becomes liable to pay a fee for which the person would not otherwise have been liable, the Registrar may—

- (a) remit the whole or part of the fee; or
- (b) if the fee has been paid-refund the whole or part of the fee to that person, after obtaining approval or the consent of the Accountant General.

#### **100. Extension of time: application**

For the purposes of section 195(2) and 195(3) of the Act (which deal with extensions of time), an application for an extension of time for doing a relevant act—

- (a) must be in the form prescribed in Form 23 of Schedule 6; and
- (b) must be accompanied by a declaration stating—
  - (i) the facts on which the grounds specified in the application are based, and
  - (ii) if the period for doing the relevant act has ended-the reason why the application was not made before the period ended.

#### **101. Extension of time: notice of opposition**

(1) For the purposes of section 195(6) of the Act (which deals with opposition to an extension), a person may oppose an application for an extension of time for more than 3 months by filing a notice of opposition with the Registrar.

(2) A notice of opposition—

- (a) must be in writing; and
- (b) must be filed within one month after notice of the application for an extension of time is published in the Gazette.

(3) The opponent must serve a copy of the notice on the applicant.

#### **102. Extension of time: opposition proceedings**

For the purposes of section 195(6) of the Act (which deal with opposition to an extension), regulations 31 to 39 inclusive apply to an opposition to an application for an extension of time.

#### **103. Extension of time-prescribed acts and documents**

(1) For the purposes of paragraph (a) of the definition of "relevant act" in section 195(8) of the Act, the following acts are prescribed—

- (a) complying with the requirements of regulation 7(1);
- (b) claiming a right of priority for an application for the registration of a trade mark under section 13(1) of the Act;
- (c) making a divisional application for the registration of a part of a trade mark under section 31(2) of the Act;
- (d) making a divisional application for the registration of a trade mark under section 33(2) of the Act;

- (e) making a divisional application for the registration of a trade mark under section 33(4) of the Act;
- (f) serving a copy of the evidence under regulations 31, 34 or 38;
- (g) serving a copy of a notice under regulations 32, 36 or 39;
- (h) responding to a notice to which regulation 53(2) applies;
- (i) requesting that an application for the registration of a trade mark be amended under section 48(b) of the Act;
- (j) requesting renewal of the registration of a trade mark under section 59 of the Act;
- (k) responding to a notice to which regulation 63(1) applies;
- (l) responding to a notification of the Registrar under regulation 66(4);
- (m) complying with the authorised user's request referred to in regulation 68;
- (n) complying with a request for information referred to in regulation 69.

(2) For the purposes of paragraph (b) of the definition of "relevant act" in section 195(8) of the Act, the following documents are prescribed—

- (a) a notice of opposition to the registration of a trade mark under section 36 of the Act;
- (b) a notice of opposition to which regulation 101(1) applies.

#### **104. Incapacity of certain persons**

(1) If a person is incapable of doing anything required or permitted by the Act or these Regulations to be done because of infancy or physical or mental disability, a court may, on the application of a person acting on behalf of the incapable person or of another person interested in the thing being done—

- (a) do the thing; or
- (b) appoint a person to do the thing,  
in the name, and on behalf, of the incapable person.

(2) A thing done in the name of, and on behalf of, an incapable person is taken to have been done by that person as if the person had not been incapable when the thing was done.

#### **105. Destruction of documents**

(1) The Registrar may order the destruction of documents relating to trade marks the registration of which ceased not less than 10 years before the date of the order.

(2) Subregulation (1) does not authorise the destruction of—

- (a) the Register; or
- (b) documents that are considered by the Registrar or the National Archives Authority of St. Lucia to be of legal or historical interest.

#### **106. Direction not otherwise prescribed**

If the Registrar reasonably believes that it is necessary for the proper conduct of proceedings for a person to perform an act, file a document or produce evidence that the person is not required by the Act or these Regulations to perform, file or produce, the Registrar may give notice in writing to the person requiring him or her—

- (a) to perform the act; or



- (b) file the document; or
  - (c) to produce the evidence,
- that is specified in the notice.

#### **107. Requirements cannot be complied with for reasonable cause**

If—

- (a) under these Regulations, a person is required to do an act or thing, sign a document, make a declaration or file or give to the Registrar a document or evidence; and
- (b) the Registrar is reasonably satisfied that the person cannot comply with the requirement,

subject to any condition that the Registrar may reasonably impose, the Registrar may dispense with the requirement.

#### **108. Forms generally**

(1) An authorisation of an attorney-at-law as an agent under section 183 of the Act shall be in the form prescribed in Form 2 of Schedule 6.

(2) A request for correction of a clerical error, or amendment of application of registration of trade mark and other documents under sections 47–50 of the Act shall be in the form prescribed in Form 6 of Schedule 6.

(3) An application for cancellation or amendment of registration of a trade mark on the Register under sections 65–68 of the Act shall be in the form prescribed in Form 8 of Schedule 6.

(4) An application to record claims to interests in and rights in respect of a trade mark under section 97 of the Act shall be in the form prescribed in Form 11 of Schedule 6.

(5) A notice of objection to importation under section 115(1) of the Act shall be in the form prescribed in Form 12 of Schedule 6.

(6) A revocation of the notice of objection to importation under section 115(5) of the Act shall be in the form prescribed in Form 13 of Schedule 6.

(7) An application for extension of time in which to bring an action under section 120(1)(b) of the Act shall be in the form prescribed in Form 14 of Schedule 6.

(8) A notice of seizure of infringing goods under section 117(a) of the Act shall be in the form prescribed in Form 15 of Schedule 6.

(9) A notice of seizure of infringing goods under section 117(b) of the Act shall be in the form prescribed in Form 16 of Schedule 6.

(10) A notice of consent to goods being forfeited to the State under section 118 of the Act shall be in the form prescribed in Form 17 of Schedule 6.

(11) A notice of consent to goods being released to designated owner under section 119(2) of the Act shall be in the form prescribed in Form 18 of Schedule 6.

(12) A notice of infringement of notified trade mark under section 120(1) of the Act shall be in the form prescribed in Form 19 of Schedule 6.

(13) An application for consent to assignment of certification trade mark under section 157 of the Act shall be in the form prescribed in Form 20 of Schedule 6.

(14) A request to enter a change of name of registered owner or authorised user of a trade mark in the register under section 187 of the Act shall be in the form prescribed in Form 22 of Schedule 6.

(15) A Certificate of Registration under the Act shall be in the form prescribed in Form 27 of Schedule 6.

(16) A notification of amendment under Part 8 Division 2 of the Act shall be in the form prescribed in Form 28 of Schedule 6.

(17) A notice of renewal of registration of trade mark under section 61(2) of the Act shall be in the form prescribed in Form 29 of Schedule 6.

(18) The Registrar may give a certificate, other than a certificate prescribed by the Act or these Regulations regarding any entry, matter or thing that he or she is authorised or required by the Act or these Regulations to make or do.

(19) A person who can show an interest in an entry, matter or thing for which a certificate is required may, by an application in Form 30, request the certificate from the Registrar.

#### **109. Form of documents**

A document to be filed under the Act shall be in the form prescribed in Schedules 3 and 6.

#### **110. General**

The Registrar may acknowledge inquiries made to the office, but the Registrar need not furnish any applicant or other person with information that would require a search of the public records of the office or provide advice on matters concerning the interpretation of the Act or Regulations or concerning other questions of law.

### **PART 16 TRANSITIONAL PROVISIONS**

#### **111. Application of the Act**

(1) If—

- (a) the Registrar has issued a report on an application lodged under Title X of the Commercial Code; and
  - (b) immediately before the commencement of these Regulations, the application is pending and has not been completed,
- the report is taken to have been issued by the Registrar under the Act on the date on which it was issued under Title X of the Commercial Code.

(2) If—

- (a) an application under Title X of the Commercial Code Cap 244 for the registration of a trade mark is amended under Title X of the Commercial Code; and
  - (b) immediately before the commencement of these Regulations, the application is pending and has not been accepted,
- the amendment is taken to have been made under the Act on the date on which it was made under Title X of the Commercial Code.

#### **112. Certain extensions of time continue**

If—

- (a) the Registrar has extended a period of time under the Trade Marks and Service Marks Rules 1986 of the United Kingdom; and
- (b) the extended period of time had not ended before the commencement of these Regulations,

the period ends when it would have ended if that section had continued to be in force.

### **Schedule 1**

(Regulation 20)

#### **SIGNS THAT SHALL NOT BE REGISTERED AS TRADE MARKS**

The following shall not be registered as trade marks—

- (a) the words "Patent", "Patented", "By Royal Letters Patent", "Registered", "Registered Design", "Copyright" "Plant Breeder's Rights", or words or symbols to the same effect, including the symbols;
- (b) the words "To counterfeit this is a forgery", or words to the same effect;
- (c) a representation of the Coat of Arms, or of the flag or seal, of Saint Lucia;
- (d) a representation of the logo or emblem of a public authority or public institution in Saint Lucia except where registered by the public authority or public institution to which it relates;
- (e) a representation of a mark notified by the International Union for the Protection of Industrial Property as not entitled to registration under international arrangements;
- (f) words, letters or devices likely to lead persons to think that the applicant has or recently has had Royal patronage or authorisation;
- (g) a representation of the Royal Crown.

### **Schedule 2**

(Regulation 75)

#### **PRESCRIBED OFFICES**

1. Deputy Registrar
2. Assistant Registrar
3. Clerk III
4. Clerk/typist
5. Secretary
6. Vault Attendant
7. Office Assistant
8. Accounts Clerk

### **Schedule 3**

(Regulation 107)

#### **FORM OF DOCUMENTS**

1. Documents, except documents mentioned in regulations 15, 28 and 92 must be written in English.

2. Documents (excluding documents that are to be filed by facsimile transmission) must be written on tough white paper of good quality, preferably international A4 size (297 millimeters by 210 millimeters) or 8 1/2 x 11 size (216 millimeters by 279 millimeters).
3. The contents of a document must be written on one side only of the paper in a carbonaceous or other permanent ink on which bleaching agents do not have any effect.
4. The contents of a document must be legible and if the document is printed, the type setting must not be less than size 12 font point.
5. The signature of the person signing a document and the date of signature must be placed on the last sheet of the document.
6. The name of a person signing a document must be legibly written under or beside the signature of that person.
7. An alteration made in a document before it is filed at the Registry of Companies and Intellectual Property must be initialled in the margin of the document opposite to the alteration by the person who signs the document.
8. The use of correction fluid on documents is prohibited and such documents will not be accepted for filing.
9. Documents must be filed in duplicate.
10. Documents which pertain to applications under the Act must be accompanied by an authorisation of agent form as prescribed in Form 2 of Schedule 6.

#### **Schedule 4**

(Regulation 88)

#### COSTS, EXPENSES AND ALLOWANCE

##### **PART 1 COSTS**

Column 1 Item	Column 2 Matter	Column 3 Amount
1	Notice of opposition	\$180
2	Evidence in support	\$480
3	Receiving and perusing notice of opposition	\$100
4	Receiving and perusing evidence in support	\$100
5	Evidence in answer	\$300
6	Receiving and perusing evidence in answer	\$150
7	Evidence in reply	\$150
8	Receiving and perusing evidence in reply	\$100
9	Preparation of cases for hearing	\$300
10	Attendance at hearing by attorney-at-law	\$200 per hour

##### **PART 2 EXPENSES AND ALLOWANCES**

###### *Division 1 Expenses*

1. A person who has paid a fee prescribed in these Regulations in relation to proceedings before the Registrar may be paid the amount of the fee.

2. A person attending proceedings before the Registrar must be paid—
  - (a) a reasonable amount for allowances for transport between the usual place of residence of the person and the place that he or she attends for that purpose; and
  - (b) if the person is required to be absent overnight from his or her usual place of residence—a reasonable amount for allowances up to a daily maximum of \$400 for meals and accommodation.

*Division 2  
Allowances*

3. A person who, because of his or her professional, scientific or other special skill or knowledge, is summoned to appear as a witness before the Registrar must be paid—
  - (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
  - (b) in any other case—an amount of not less than \$100, or more than \$500, for each day on which he or she so attends.
4. A person summoned to appear as a witness, other than a witness referred to in clause 3, before the Registrar must be paid—
  - (a) if the person is remunerated in his or her occupation by wages, salary or fees—an amount equal to the amount of wages, salary or fees not paid to the person because of his or her attendance for that purpose; and
  - (b) in any other case—an amount of not less than \$60, or more than \$100, for each day on which he or she so attends.

**Schedule 5**

(Regulation 96)

FEES

ITEM	MATTER	FEES
1	Filing an application to register a trade mark/certification/defensive or collective trade mark	
	(a) In respect of goods or services in a single prescribed class	\$100
	(b) In respect of goods or services in more than 1 prescribed class	\$100 plus \$50 for each additional class
2	Filing of divisional application	\$100 for each class
3	Filing of an application to register 2 or more trade marks as a series under section 35	\$200 in respect of 2 trade marks plus \$50 for each additional mark in the series
4	Additional fee for filing application under item 1,2, or 3 if a representation of the mark exceeds 8cm x 8 cm or 3 in x 3 in	\$65 per application
5	Request for deferment of acceptance of an application	\$50
6	Request for expedited examination of application for registration of a trade mark	\$40
7	Filing of any notice of opposition	\$200
8	Filing of application for extension of period or time under regulations—	
	(a) for each month or part of a month for which the extension is sought	\$50

	(b) additional fee if application or request is filed after the end of the period or time to extend	\$100
9	Filing of notice or evidence in opposition proceedings	\$60
10	Certificate of registration of trade mark in respect of 1 - 4 Classes 5 - 10 Classes 11 - 15 Classes 16 - 20 Classes 21 Classes and up	\$100 \$200 \$300 \$350 \$400
11	Publication/Gazette fee (a) word mark  (b) combined mark  (c) logos	\$100 for single class and \$100 for each additional class \$125 for single class and \$100 for each additional class \$150 for single class and \$100 for each additional class
12	Renewal of registration of trade mark (a) in respect of goods or services in a single prescribed class (b) in respect of goods or services in more than one prescribed class (c) as a result of a request made within 12 months after the expiry date  Certificate of Renewal	\$100 \$100 plus \$20 for each additional class in addition to fees in (a) and (b) \$25 for each class and for each month or part of a month after the expiry date \$50
13	Application for amendment of trade mark application before or after publication of notice of application	\$50
14	Application for amendment of Register	\$80 per mark
15	Application for amendment of documents other than application for registration of trade mark	\$40
16	Filing authorisation of agent - 1st time -if already filed	\$5 \$2
17	Application for cancellation of a mark	\$50
18	Filing an application for recording of assignment or transmission of trade mark	\$100 per mark
19	Application to record a claim to an interest in or a right in respect of a trade mark	\$100
20	Request for an amendment or cancellation of recorded particulars of a claim to an interest in, or a right in respect of a trade mark	\$80
21	Filing a copy of rules governing use of a certification trade mark	\$80
22	Filing evidence supporting an application for registration of a defensive trade mark	\$80
23	Request for hearing	\$200
24	Attendance at hearing	\$50
25	Withdrawal of an application, notice or request	\$20
26	Request for change of address of registered owner	\$30 per mark
27	Request for change of name of registered owner	\$40 per mark
28	Filing of application for costs	\$25
29	Taxation of costs	\$60
30	Certified copy of a certificate of registration	\$20

31	Certified copy of a document other than a certificate of registration	\$10
32	Uncertified photographic copy of document	\$1 per page
33	Filing of any document for which a fee is not provided	\$20
34	Search	\$5 for up to three files, and \$1 for each additional file
35	Request for Certificate in relation to an entry, matter or thing under regulation 107(18), (19)	\$30

**Schedule 6**

(Regulation 6)

FORMS

Form 1

**APPLICATION FOR REGISTRATION OF A TRADE MARK**

**(Reproduction of mark should not exceed 8 cm x 8 cm or 3 in X 3 in)**

Please refer to the notes for completion of this form  
Trade Marks Act: Section 11 parts 15, 16 & 17

1.	Indicate if this application is for				
	(i) a trade mark	<input type="checkbox"/>			
	(ii) a collective trade mark	<input type="checkbox"/>			
	(iii) a certification trade mark	<input type="checkbox"/>			
	(iv) a defensive trade mark	<input type="checkbox"/>			
2.	The applicant claims to be the owner of the trade mark and				
	(i) is using or intends to use the trade mark	<input type="checkbox"/>			
	(ii) has authorised or intends to authorise another person to use the trade mark	<input type="checkbox"/>			
	(iii) intends to assign the trade mark to body corporate	<input type="checkbox"/>			
3.	Representation of trade mark	<div style="border: 1px solid black; width: 150px; height: 60px; margin: 0 auto;"></div>			
4.	State "Yes" here if the trade mark is a word or words without any particular form of presentation				
5.	If mark contains or consists of a sign that is a colour, shape or an aspect of packaging, or any combination of those, give concise and accurate description of the trade mark				
6.	If the application is a series of marks indicate how many in the series				
7.	If this application claims priority indicate the priority date(s) claimed, the country and the number.	<table style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 35%; border-bottom: 1px solid black;">Date of filing</td> <td style="width: 20%; border-bottom: 1px solid black;">Country</td> <td style="width: 45%; border-bottom: 1px solid black;">Number</td> </tr> </table>	Date of filing	Country	Number
Date of filing	Country	Number			
8.	Certified copy of application of which priority is claimed				
	Is attached	<input type="checkbox"/>			
	Will be furnished within six months	<input type="checkbox"/>			

9.	Translation of certified copy		
	Is attached	<input type="checkbox"/>	
	Will be furnished within one month of the filing date	<input type="checkbox"/>	
10.	Specification of goods or services	Class number	List of goods
11.	if colour claimed, indicate and state colours claimed		
12.	Indicate any limitation or disclaimers		
13.	Full name and address of applicant		
14.	Full name and address of agent		
15.	Authorisation of Agent is attached	Yes <input type="checkbox"/>	No <input type="checkbox"/>
16.	The mark is 3 dimensional	<input type="checkbox"/>	
	Reproduction of the mark In black and white is attached	<input type="checkbox"/>	
	Reproduction of the mark In colour is attached	<input type="checkbox"/>	
17.	State the number of sheets attached to this application		

Dated this ..... day of ..... , 20

\_\_\_\_\_  
**Signature of Agent**

**Notes**

1. If there is not enough space for your answer to any section of this form, use separate sheets and number each one and write on the form how many extra sheets you have used.
2. All applications must be accompanied by 6 additional representations.

**FOR OFFICIAL USE ONLY:**

Mark Type:	<input type="checkbox"/>	Wordmark
	<input type="checkbox"/>	Word & device
	<input type="checkbox"/>	Device only

FORM 2

(Regulation 108(1))

**AUTHORISATION OF AGENT  
(Trade Marks Act: Section 183)**

I/We1 ..... have appointed2  
..... of3 ..... to act as my/our Agent in relation to4

- 1. Application and registration of and post registration matters relating to the following trade mark(s):
- 2. The following application(s) or registration(s) in relation to the following registered mark(s):
- 3. Registration of and other proceedings in relation to all trade marks in which we

1 The full name of the Company or person  
 2 Insert full name of Agent(s)  
 3 Insert full address of Agent and Chambers (if applicable)  
 4 Tick appropriate box(es)



may now or hereafter have any right or interest.

I/We request that all monies, requisitions and communications relating thereto be sent to the agent at the above address.

I/We hereby revoke all previous authorisations, if any, in respect of the same matter or proceeding.

I/We hereby declare that I am/We are<sup>5</sup> .....

Dated this ..... day of ..... 2 .....

Signature<sup>6</sup>: .....

Address: .....

*N.B.: The Authorisation of Agent must bear the Seal or Stamp of the Company.*

FORM 3

(Regulation 22)

**Request to divide an application  
(Trade Marks Act: Part 4 Division 3)**

1.	Give details of application to be divided
2.	Is this request to divide the specification of goods or services?
3.	If this request is to divide an application into more than two parts, indicate how many parts you want it divided into and give details.
4.	Full name and address of applicant
5.	Full name and address of agent
6.	Signature Date ...../...../..... Day Month Year
7.	State number of sheets attached to this form

**NB:** *List on a separate sheet (a) the goods or services by class number to be removed to a divisional application (b) representation of the marks which will form part of a divisional application.*

**You cannot divide a registered trade mark.**

FORM 4

(Regulation 25(2), 57)

**NOTICE OF OPPOSITION TO REGISTRATION/  
REMOVAL OF TRADEMARK**

**(Trade Marks Act: Sections 36(2) & 80)**

**Notice of opposition to registration/removal of a Trade Mark**

1. Number of the application against which opposition is lodged.  
Class(es)
2. Please give details of the Gazette in which the application was advertised. Gazette Details

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
day month year

\_\_\_\_\_  
Gazette No. & Vol. No.

3. Full name and address of opposant

\_\_\_\_\_  
(Name)  
\_\_\_\_\_

<sup>5</sup> State nationality of Applicant

<sup>6</sup> To be signed by person appointing Agent or authorised officer of the Company

(Address)

- 4. Grounds of Opposition to Registration/Removal:
- 5. Agents details

\_\_\_\_\_  
(Name)

\_\_\_\_\_  
(Address)

\_\_\_\_\_  
(Contact No)

\_\_\_\_\_  
Signature of agent

Dated this ..... day of ....., 20....

NB: (1) All forms must be filed in duplicate at the Registry of Companies and Intellectual Property Office.

\_\_\_\_\_  
FORM 5

(Regulation 40(6))

**NOTICE OF ATTENDANCE  
(Trade Marks Act: Section 38)**

OPPOSITION HEARING

TO: Registrar of Companies & Intellectual Property

Take notice that .....1 ..... acting by his or her agent .....2  
.....

intends to appear in opposition proceedings relating to Trademark Application 20.../....

Dated this ..... day of ....., 20....

\_\_\_\_\_  
*Signature of Agent*

FORM 6

(Regulation 108(2))

**Request for Correction of Clerical Error, Or Amendment of Application of Registration  
of Trademark and Other Documents**

(Trade Marks Act: Section 47-50)

- 1. Application Number or Registration Number (if applicable)
- 2. Is the application in relation to 1  
A trademark application  
Other document
- 3. Full name and address of applicant for registration or registered proprietor  
Name: \_\_\_\_\_  
Address: \_\_\_\_\_  
\_\_\_\_\_

- 4. Details to be amended or corrected:
- 5. Agents details  
Name: \_\_\_\_\_  
Address: \_\_\_\_\_  
\_\_\_\_\_

- 6. Signature \_\_\_\_\_ Date \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_

\_\_\_\_\_  
1 Insert name of opposant or applicant as applicable  
2 Insert name of agent and address  
1 Tick appropriate box

Agent

Day Month Year

FORM 7

(Regulation 50(2))

**Request for the Renewal of a Trade Mark**

(Trade Marks Act: Section 59)

1. **Indication that a Renewal is Sought**

The renewal of the registration identified in the present request is hereby requested.

2. **Registration Concerned**

Registration Number

3. **Proprietor**

Name: \_\_\_\_\_

Address: \_\_\_\_\_

4. Agent:

Date \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_

day

month

year

Signature \_\_\_\_\_

Agent

FORM 8

(Regulation 108(3))

**Application for the Cancellation or Amendment of  
Registration of a Trade Mark on the Register**

(Trade Marks Act: Section 65 – 68)

1. Registration Number (s) and Class number (s) of the trade marks for which cancellation or amendment is sought

2. Full name of registered proprietor

3. Is this application for amendment or cancellation of a trade mark? 2

4. Details to be amended

5. Agents details

Name: \_\_\_\_\_

Address: \_\_\_\_\_

(vi) Signature

Date

\_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_

day

month

year

FORM 9

(Regulation 55)

**Application for the Removal of a Trade Mark from the Register**

(Trade Marks Act: Section 76)

1. Registration Number (s) and Class Number (s) of the trade marks for which removal is sought

2. Full name of registered proprietor

3. Is this application for removal of a mark in respect of? 3

All goods / services

4Some goods / services

in respect of which the trade mark is registered

4. Grounds for the removal applied for

5. Agent details

Name: \_\_\_\_\_

Address: \_\_\_\_\_

2 Tick the appropriate box

3 Tick the appropriate box

4 List goods/services for which removal of trade mark is sought

6. Signature \_\_\_\_\_ Date \_\_\_\_\_  
 \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_  
 Agent Day Month Year

FORM 10

(Regulation 59)

**Application for Recording of Assignment or Transmission of Trade Mark**

(Trade Marks Act: Sections 91-93)

Registration number (s), Application number (s) and class number (s) of the trade marks concerned and the goods and services for which the trade mark (s) has been used.

5 Registration No/Application No  Class No.

Goods or services for which the trade mark has been used and is assigned.

1. Full name of current Registered Owner (Assignor)
2. Full name and address of assignee

\_\_\_\_\_  
 (Name)

\_\_\_\_\_  
 (Address)

3. Date of Assignment \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_

4. Is the applicant the  
 Current registered proprietor (Assignor)   
 Or Assignee

5. Certified copy of evidence of assignment or transmission of trade is attached  
 Yes  No

6. Agent's Details \_\_\_\_\_  
 (Name)

\_\_\_\_\_  
 (Address)

7. Signature \_\_\_\_\_ Date \_\_\_\_\_  
 \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_  
 Agent Day Month Year

FORM 11

(Regulation 108(4))

**Application to Record Claims to Interest in and Rights in Respect of a Trade Mark**

(Trade Marks Act: Section 97)

1. Trade Mark Concerned  Class No.  Trademark No.

2. Applicant's Details \_\_\_\_\_  
 (Name)

\_\_\_\_\_  
 (Address)

\_\_\_\_\_  
 (Agent)

3. Registered Owner \_\_\_\_\_  
 (Name)

5 If more space is needed please insert  
 6 Tick the appropriate box

\_\_\_\_\_

(Agent)

4. Particulars of claims to interest in, or to right on respect of trade mark

5. Signature

Date

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
Day Month Year

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
Day Month Year

FORM 12

(Regulations 67; 108(5))

**Notice of Objection to Importation**

(Trade Marks Act: Section 115(1))

To: Comptroller of Customs & Excise

I/We7 \_\_\_\_\_

of8 \_\_\_\_\_

being the registered owner/authorised user of the trade mark(s) mentioned in the Schedule to this Notice under the Trade Marks Act object to the importation into Saint Lucia of any goods made outside of Saint Lucia being goods to which section 116 of the Trade Marks Act applies and which infringe the trade mark.

I/We hereby give the Comptroller of Customs and Excise, and his or her agents, for the purposes of section 116(3) of the Trade Marks Act security in the amount of9 ..... in respect of any liability or expenses that may be incurred by the Comptroller and his or her agents as a result of seizure under section 116 of the Trade Marks Act of any goods to which this notice relates.

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

Contact No: \_\_\_\_\_

FORM 13

(Regulation 108(6))

**Revocation of Notice of Objection to Importation**

(Trade Marks Act: Section 115(5))

To: Comptroller of Customs & Excise

RE: Notified Trade Mark(s)10 \_\_\_\_\_

Under notice dated: \_\_\_\_/\_\_\_\_/\_\_\_\_\_  
Day Month Year

I/We11 \_\_\_\_\_

of \_\_\_\_\_

being the registered owner/authorised user named in the above notice hereby revokes the said notice in relation to the above mentioned trade mark(s)

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

- 7 Delete the appropriate one
- 8 Insert address
- 9 Insert amount of security given
- 10 State registration number(s) and names of trade mark(s)
- 11 Delete the appropriate one

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

Contact No: \_\_\_\_\_

FORM 14

(Regulation 108(7))

**Application for Extension of Time in which to bring Action**

(Trade Marks Act: Section 120(1)(b))

To: Comptroller of Customs & Excise

RE: Notified Trade Mark \_\_\_\_\_

Under notice of objection to importation dated: \_\_\_\_/\_\_\_\_/\_\_\_\_  
DD MM YY

I/We12 \_\_\_\_\_

of13 \_\_\_\_\_

being the objector(s) in relation to goods seized under notice of the Comptroller of Customs and Excise dated \_\_\_\_/\_\_\_\_/\_\_\_\_  
DD MM YY

hereby request an extension of time for a period of \_\_\_\_ days in which to bring the action with respect to the infringement of the notified trade mark(s). The reason for this request is stated hereunder: 14

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

Contact No: \_\_\_\_\_

FORM 15

(Regulation 108(8))

**Notice of Seizure of Infringing Goods**

(Trade Marks Act: Section 117(a))

To: \_\_\_\_\_

of \_\_\_\_\_

(Designated owner)

Notice is hereby given that the under mentioned goods have been seized under Section 116 of the Trade Marks Act:

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Comptroller of Customs & Excise

***The Comptroller of Customs and Excise***

FORM 16

(Regulation 108(9))

**Notice of Seizure of Infringing Goods**

(Trade Marks Act: Section 117(b))

To: \_\_\_\_\_

(Objector)

Notice is hereby given that the undermentioned goods have been seized under section 116 of the Trade Marks Act.

- \_\_\_\_\_  
12 Delete the appropriate one  
13 Insert full name and address  
14 Give full details

The designated owner(s) of the goods is/are \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_ of

Take notice that the said goods will be released to the designated owner unless you or one of the objectors bring an action for infringement of the notified trade mark and give notice under section 120(1)(a) of the Trade Marks Act within one month from the date of this notice or if the period of notice has been extended under section 120(1)(b) the extended period.

Dated: \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_  
Comptroller of Customs and Excise

**The Comptroller of Customs and Excise**

FORM 17

(Regulation 108(10))

**Notice of Consent to Goods Being Forfeited to the State**

(Trade Marks: Section 118)

To: The Comptroller of Customs and Excise

I/We15 \_\_\_\_\_

of16 \_\_\_\_\_

the designated owner(s) of goods seized under notice of the Comptroller of Customs and Excise dated \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
DD MM YY

hereby consent to the goods mentioned in the above notice being forfeited to the State

Dated: \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

Contact No: \_\_\_\_\_

FORM 18

(Regulation 108(11))

**Notice of Consent to the Goods being released to the Designated Owner**

(Trade Marks Act: Section 119(2))

To: The Comptroller of Customs and Excise

I/We17 \_\_\_\_\_

of18 \_\_\_\_\_

being the objector(s) in relation to goods seized under notice of the Comptroller of Customs and Excise dated \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
DD MM YY

hereby consent to the goods mentioned in the above notice/the goods listed hereunder19 to be released to the designated owner.

Dated: \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

15 Delete the appropriate one

16 State full name and address

17 Delete the appropriate one

18 State full name and address

19 If the notice of consent relates to only some of the goods seized and listed in the Notice of the Comptroller list those goods to which this notice of consent applies

Contact No: \_\_\_\_\_

FORM 19

(Regulation 108(12))

**Notice of Action for Infringement of Notified Trade Mark**

(Trade Marks Act: Section 120(1))

To: The Comptroller of Customs and Excise

RE: Notified trade mark(s)<sup>20</sup> \_\_\_\_\_

Under notice dated: \_\_\_\_/\_\_\_\_/\_\_\_\_  
DD MM YY

I/We<sup>21</sup> \_\_\_\_\_

of<sup>22</sup> \_\_\_\_\_

being the objector(s) in relation to goods seized under notice of the Comptroller of Customs and Excise dated \_\_\_\_/\_\_\_\_/\_\_\_\_  
DD MM YY

hereby give notice that action No. \_\_\_\_\_ has been commenced on \_\_\_\_\_  
in<sup>23</sup> \_\_\_\_\_ with respect to the infringement of the notified trade mark.

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_  
Day Month Year

Signature: \_\_\_\_\_

Name of Agent: \_\_\_\_\_

Address: \_\_\_\_\_

Contact No: \_\_\_\_\_

FORM 20

(Regulation 108(13))

**Application for Consent to Assignment of Certification Trade Mark**

(Trade Marks Act: Section 157)

To: Registrar of Companies and Intellectual Property

1. Registration No \_\_\_\_\_ Class \_\_\_\_\_

2. Registered owner: \_\_\_\_\_

(Name)

\_\_\_\_\_

(Address)

3. Agent

\_\_\_\_\_

(Name)

4. Assignee

\_\_\_\_\_

(Name)

\_\_\_\_\_

(Address)

5. The assignee proposes to continue after assignment to apply the same rules governing use of the registered certification trade mark that the registered owner applies  
Yes  No

6. The assignee proposes to apply the following variation of the rules after the assignment

7. A copy of the rules incorporating the proposed variation is attached

20 Insert registration number(s) and names

21 Delete the appropriate one

22 State full name and address

23 Insert the full name and jurisdiction in which the action has been commenced



Dated: \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_  
Day Month Year

Yes  No

Signature: \_\_\_\_\_  
Agent

FORM 21

(Regulation 86)

**Request for Change of Address for Service in the Register of Trade Marks**

(Trade Marks Act: Section 186)

1. Registration number

Trade mark number	Class
2. Full name of Registered Owner or Authorised User currently on Register  
Name: \_\_\_\_\_  
Address: \_\_\_\_\_
3. New Address to be entered on register  
New Address: \_\_\_\_\_
4. Agent Name: \_\_\_\_\_  
Address: \_\_\_\_\_
5. Signature \_\_\_\_\_ Date \_\_\_\_\_  
Agent Day Month Year

FORM 22

(Regulation 108(4))

**Request to enter Change of Name of Registered Owner or Authorised User of a Trade Mark in the Register**

(Trade Marks Act: Section 187)

1. Registration Number (s) and Class of the trade marks affected<sup>24</sup>

Registration number		Class	
Registration number		Class	
2. Is the name to be changed that of the registered proprietor or registered user of the mark(s) above<sup>25</sup>  
Registered owner  
Authorised user
3. Give full name(s) of registered proprietor or registered user at present on the Register \_\_\_\_\_
4. New name to be entered on the Register.
5. Certified copy of evidence of change of name is attached  
Yes  No
6. Agents details  
Name: \_\_\_\_\_  
Address: \_\_\_\_\_  
Signature \_\_\_\_\_ Date \_\_\_\_\_  
Agent Day Month Year

<sup>24</sup> Insert more if needed  
<sup>25</sup> Tick appropriate box

**Request for Extension of Time**

(Trade Marks Act: Section 195)

To: Registrar of Companies and Intellectual Property

Application number:

Date:

Class(es):

Dear Sir/Madam

An extension of time is requested for ..... months from .... to ..... in respect of the above application in order to deal with outstanding matters. The reason(s) for the request is/are as follows:

Yours faithfully

**For official use only**

To: \_\_\_\_\_

Application number:

Class(es):

Applicants name:

Dear Sirs

Your request for an extension of time has been granted from \_\_\_\_\_ to \_\_\_\_\_

Yours faithfully

REGISTRY OF COMPANIES & INTELLECTUAL PROPERTY

.....

REGISTRAR

FORM 24

(Regulation 95)

**Request to the Registrar for a statement of grounds of decision**

(Trade Marks Act)

- 1. Details of the application or registration Number(s)      Class
- 2. Date of Registrar's decision
- 3. Agents Details \_\_\_\_\_

(Name)

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
DD                  MM                  YY

Signature

FORM 25

(Regulation 87(1))

**Application for an award of costs**

(Trade Marks Act: Section 192)

- 1. Applicant \_\_\_\_\_  
(Name)

(Address)

- 2. Application being made for costs in relation to the following proceedings:
- 3. Registration number(s) of trade marks to which proceedings relate:

(Registration number)

4. Signature

Dated: \_\_\_\_/\_\_\_\_/\_\_\_\_\_  
Day                  Month                  Year

Signature: \_\_\_\_\_





**NOTIFICATION OF AMENDMENT**

(Trade Marks Act: Part 8 Division 2)

To:

TAKE NOTICE that the following amendment has been made to Application No. Trademark No.

Details of Amendment Made

Dated this ..... day of ..... 20

\_\_\_\_\_  
*Registrar*

*Companies & Intellectual Property*

FORM 29

(Regulation 108(17))



**CERTIFICATE OF RENEWAL OF REGISTRATION OF TRADEMARK**

(Trade Marks Act: Section 61(2))

To:

I, ..... Registrar of Companies & Intellectual Property of Saint Lucia, do hereby certify that by virtue of an application filed the .....day of ..... 20.... Registered Trademark No. .... has been renewed for a period of 10 years from ..... day of ..... 20

Next renewal date:

WITNESS my hand this ..... day of  
20

\_\_\_\_\_  
*Registrar*

*Companies and Intellectual Property*

FORM 30

(Regulation 108(19))

**(Trade Marks Act)**

**REQUEST FOR CERTIFICATE OF THE REGISTRAR IN RELATION TO AN ENTRY, MATTER OR THING**

IN THE MATTER OF28 (e.g. an application for change of name)

I/We \_\_\_\_\_ hereby

(insert name and address)

request the Registrar to furnish me (us) with \_\_\_\_\_ 29

Dated this .....day of ..... 20

\_\_\_\_\_ 30

Signature

\_\_\_\_\_ 31

Address

To:

The Registrar

Registry of Companies and Intellectual Property

Saint Lucia

28 Address

29 Here set out the particulars that the Director is required to certify

30 Signature(s) with full names typed below

31 Address

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