

OBJECTS AND REASONS

This Bill would amend the *Patents Act*, Cap. 314, the *Trade Marks Act*, Cap. 319 and *Regulations* and the *Industrial Designs Act*, Cap. 309A and *Regulations* to make better provision for the regulation of intellectual property and to ensure compliance with the World Trade Organisation Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

Arrangement of Sections

Section

1. Short title.
2. Amendment of enactments set out in the Schedule.
3. Validation.
4. Savings and transitional provisions.

SCHEDULE

BARBADOS

A Bill entitled

An Act to amend the *Patents Act*, the *Trade Marks Act* and *Regulations* and the *Industrial Designs Act* and *Regulations* to make better provision for the regulation of intellectual property and to ensure compliance with the World Trade Organisation Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

ENACTED by the Parliament of Barbados as follows:

1. This Act may be cited as the *Intellectual Property* Short title.
(*Miscellaneous Provisions*) Act, 2005.

Amendment of enactments set out in the Schedule.	2. The enactments set out in Column 1 of the <i>Schedule</i> are amended in the respects specified opposite thereto in Column 2 of the <i>Schedule</i> .
Validation. Cap. 319.	3. (1) All functions performed in pursuance of section 8 of the <i>Trade Marks Act</i> by the Registrar during the period 6th August, 2001 to the date of the commencement of this Act, both dates inclusive, and all matters done in relation thereto shall be deemed to have been lawfully and validly performed as if the amendment made to that section by this Act had been effected during that period.
Act 2001-16.	(2) All opposition notices that were filed on the basis of section 8(1)(c) of the <i>Trade Marks Act</i> prior to 6th August 2001, shall be deemed to have been lawfully and validly filed and unaffected by the <i>Trade Marks (Amendment) Act, 2001</i> .
Savings and transitional provisions. Cap. 309A. Schedule. Act 2005-	4. (1) Notwithstanding paragraph 1 of the <i>Schedule</i> in relation to the <i>Industrial Designs Act</i> , where <ul style="list-style-type: none"> (a) an application for the registration of an industrial design was made prior to the commencement of the <i>Intellectual Property (Miscellaneous Provisions) Act, 2005</i>, the duration period that was applicable in respect of the registration and renewal of industrial designs before the commencement of the <i>Intellectual Property (Miscellaneous Provisions) Act, 2005</i> shall apply to that industrial design; or (b) an industrial design was registered prior to the commencement of the <i>Intellectual Property (Miscellaneous Provisions) Act, 2005</i>, the duration period in respect of the registration and renewal of that industrial design that was applicable before the commencement of the <i>Intellectual Property (Miscellaneous Provisions) Act, 2005</i>, shall continue to apply in relation to that design.

(2) Where an industrial design was registered prior to the commencement of the *Intellectual Property (Miscellaneous Provisions) Act, 2005*, the registration of that design may be renewed for the duration periods that were applicable at the time of the registration.

(3) The fees in respect of

- (a) an application for the registration of an industrial design;
- (b) the registration of an industrial design; or
- (c) the renewal of the registration of an industrial design,

where the application, registration or renewal was filed prior to the commencement of the *Intellectual Property (Miscellaneous Provisions) Act, 2005*, shall be those that were in force immediately before the commencement of the *Intellectual Property (Miscellaneous Provisions) Act, 2005*.

SCHEDULE

(Section 2)

*Column 1**Column 2**Enactments**Amendments*

1. *Industrial Designs Act*,
Cap. 309A

In section 26, delete subsection (1) and substitute the following:

"(1) Subject to sections 36, 40 and 41, the registration of an industrial design is valid for a period of 10 years from the date of the application for its registration; and a registration may be renewed for a period of 5 years upon payment of the prescribed fee."

2. *Patents Act*, Cap. 314

Insert the following new section immediately after section 55:

"Burden
of proof
in certain
cases.

55A. (1) Where the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the owner of the patent or a licensee shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

(2) In determining whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so."

*Column 1**Column 2**Enactments**Amendments*

3. *Trade Marks Act*,
Cap. 319

1. In section 2 in the definition of "mark", insert the words "or certification mark" immediately after the words "collective mark".

2. In section 4,

- (a) delete the marginal note and substitute the following:

"Trade, service, collective and certification marks.";

- (b) insert the following new subsection immediately after subsection (3):

"(3A) A certification mark is a visible sign used or to be used in connection with goods or services for the purpose of distinguishing in the course of trade or business, goods or services which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified."; and

- (c) in subsection (4) delete the word "(3)" appearing in the first line and substitute the word "(3A)".

*Column 1**Column 2**Enactments**Amendments*3. *Trade Marks Act,*
Cap. 319 (Cont'd)

3. In section 5, insert the following new subsections immediately after subsection (3):

"(4) In relation to a certification mark, the rights vested in the registered owner of the mark under this section are subject to the conditions governing the use of the mark.

(5) The registered owner of a certification mark may use that mark himself so long as the mark is being used by persons permitted to use it under the conditions governing its use; and use by any of those persons is presumed, for purposes of this Act, to be use by the registered owner."

4. In section 8,

(a) in subsection (1) re-number paragraphs (d) to (g) as paragraphs (e) to (h);

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
3. <i>Trade Marks Act</i> , Cap. 319 (<i>Cont'd</i>)	<p>(b) in subsection (1), insert the following new paragraph immediately after paragraph (c):</p> <p>"(d) Subject to subsection (2), a mark that resembles, in such a way as to be likely to mislead the public, a business name registered under the <i>Registration of Business Names Act</i> and in use in Barbados by another person, if the applicant is aware or could not have reasonably been unaware of the earlier use;" and</p> <p>(c) in subsection (2), delete the words "paragraph (b), (c), (d) or (e)" appearing in the second and third lines and substitute the words " paragraph (b), (c), (d), (e) or (f)".</p> <p>5. In section 10, add the following new subsections:</p> <p>"(6) When the application is for the registration of a certification mark, the application must</p> <p>(a) designate the mark as a certification mark;</p>

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
3. <i>Trade Marks Act,</i> <i>Cap. 319 (Cont'd)</i>	<p>(b) be accompanied by a copy of the rules which must</p> <p>(i) be signed by the applicant;</p> <p>(ii) contain the conditions governing the use of the mark as a certification mark; and</p> <p>(iii) be in compliance with the requirements of subsection (7).</p> <p>(7) The rules providing for the use of a certification mark must specify the</p> <p>(a) categories of persons authorised to use the mark;</p> <p>(b) characteristics to be certified by the mark;</p> <p>(c) conditions governing the use of the mark;</p> <p>(d) procedure by which the certifying body is to test the characteristics to be certified by the mark;</p>

*Column 1**Column 2**Enactments**Amendments*3. *Trade Marks Act,*
Cap. 319 (*Cont'd*)

- (e) manner in which the supervision of the use of the mark will be undertaken;
- (f) fees, if any, that must be paid in connection with the operation of the mark;
- (g) penalties or sanctions that are to be applied if the certification mark is used in contravention of any of the conditions governing its use; and
- (h) procedures for the resolution of disputes."

6. In section 16(3),

- (a) delete the word "and" appearing at the end of paragraph (e);
- (b) delete the full stop appearing at the end of paragraph (f) and substitute the following:

"; and";

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
3. <i>Trade Marks Act,</i> Cap. 319 (<i>Cont'd</i>)	<p>(c) add the following new paragraph immediately after paragraph (f):</p> <p>"(g) if the mark is a certification mark, contain the rules governing the use of the mark as a certification mark that accompanied the application for its registration."</p> <p>7. In section 20, add the following new subsection:</p> <p>"(4) A certification mark must be recorded in a separate section of the register reserved for the registration of certification marks."</p> <p>8. In section 21,</p> <p>(a) delete the word "and" appearing at the end of paragraph (f);</p> <p>(b) delete the full-stop at the end of paragraph (g) and substitute the following:</p> <p>"; and";</p>

*Column 1**Column 2**Enactments**Amendments*

3. *Trade Marks Act*,
Cap. 319 (*Concl'd*)

- (c) add the following new paragraph immediately after paragraph (g):

"(h) if the mark is a certification mark, the rules governing the use of the mark as a certification mark that accompanied the application for its registration.";

- (d) in subsection (3), insert the words "or a certification mark" immediately after the words "collective mark"; and

- (e) in subsection (4), insert the words "or a certification mark" immediately after the words "collective mark".

9. Delete section 29 and substitute the following:

"Transfer of
collective or
certification
marks.

29. (1) The Director may in writing approve the transfer of the registration of a collective or certification mark if the transferee undertakes in writing to exercise effective control of the use of the collective or certification mark in accordance with the conditions governing its use.

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
3. <i>Trade Marks Act,</i> Cap. 319 (<i>Concl'd</i>)	(2) A transfer of the registration of a collective or certification mark is void until it is recorded in the register; and it may not be recorded unless the application to record the transfer is accompanied by the prescribed fee and a copy of the Director's approval of the transfer."
4. <i>Industrial Designs Regulations, 1984</i> (S.I. 1984 No. 83)	<p>In Schedule I, delete all the words appearing under the headings "On application for registration" and "On granting registration of an industrial design" along with the monetary values opposite thereto and substitute the following:</p> <p>"On application for registration:</p> <p>For the first design in the application200.00</p> <p>For each additional design100.00</p> <p>On granting registration of an industrial design:</p> <p>For the first design in the application200.00</p> <p>For each additional design100.00."</p>

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
5. <i>Trade Marks Regulations, 1984</i> (S.I. 1984 No. 85)	1. Insert the following immediately after regulation 31:
	<i>Certification Marks</i>
"Certifi- cation marks.	<p>31A. (1) When an application is made for the registration of a certification mark, the Director shall, in addition to the other examinations of the application that are required to be made by this Act and the regulations, examine the application and accompanying rules governing the use of the mark to ensure that it complies with subsections (6) and (7) of section 10 of the Act.</p>
	<p>(2) The rules accompanying the application must be examined to ensure that</p>
	<p>(a) origin, material, mode of manufacture, quality, accuracy or other common characteristics of the goods or services to which the certification mark is to be applied are set out in sufficient detail to identify the said common characteristics;</p> <p>(b) they contain the conditions and restrictions governing the use of the mark;</p> <p>(c) they state that the owner of the certification mark can</p>

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
5. <i>Trade Marks Regulations, 1984</i> (S.I. 1984 No. 85) (Cont'd)	<p>(i) receive samples of any goods or inspect the delivery of any of the services associated with the certification mark; or</p> <p>(ii) inspect during normal business hours, the place of manufacture of the goods or the place where the services are performed,</p> <p>to ensure that the common characteristics or common quality is being maintained; and</p> <p>(d) they contain some means by which the owner of the certification mark can prevent its use in contravention of the conditions governing its use."</p>

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
<p>5. <i>Trade Marks Regulations, 1984</i> (S.I. 1984 No. 85) (Cont'd)</p>	<p>2. Delete regulation 49 and substitute the following:</p> <p>"Change of conditions.</p> <p>49. (1) When a registered owner of a collective or certification mark wishes to change the conditions governing the use of the collective or certification mark he shall submit an application in Form No. 18 together with the prescribed fee and a copy of the agreement or in the case of a certification mark, the rules, in which the changed conditions are set out.</p> <p>(2) The Director shall examine the agreement or the rules and the changed conditions mentioned in paragraph (1) and if he is satisfied that they comply with the Act and the regulations he shall cause a notice of the application to be published in the <i>Official Gazette</i>.</p> <p>(3) The notice mentioned in paragraph (1) must</p> <p>(a) specify the registration number of the collective or certification mark;</p>

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
5. <i>Trade Marks Regulations, 1984</i> (S.I. 1984 No. 85) (Cont'd)	<p>(b) indicate the goods and services in respect of which the collective or certification mark is registered;</p> <p>(c) set out the change in the conditions governing the use of the collective or certification mark; and</p> <p>(d) set out the name and address of the registered owner, and, if necessary, his address for service.</p> <p>(4) The Director shall, upon recording a change in the conditions governing the use of a collective or certification mark, notify the registered owner of the mark."</p>

*Column 1**Column 2**Enactments**Amendments*

5. *Trade Marks Regulations, 1984*
(S.I. 1984 No. 85)
(Cont'd)

3. Delete regulations 52 and 53 and substitute the following:

"Collec-
tive or
certifica-
tion mark
approval. 52. (1) For the purpose of obtaining the approval of the Director to the transfer of a collective or certification mark under section 29 of the Act, the transferor or transferee of the collective or certification mark must submit to the Director an application in Form No. 21, together with the prescribed fee and evidence satisfactory to the Director that the transfer complies with the requirements of the Act.

(2) If the Director approves the transfer of a collective or certification mark, he shall notify the applicant in Form No. 22.

Record-
ing
transfer
of
collec-
tive or
certifica-
tion
mark. 53. (1) For the purpose of recording a transfer of a collective or certification mark, the transferee must submit to the Director an application in Form No. 23, together with the prescribed fee, the Director's approval of the transfer and evidence satisfactory to the Director that the collective or certification mark has been transferred to the applicant.

*Column 1**Column 2**Enactments**Amendments*

5. *Trade Marks Regulations, 1984*
(S.I. 1984 No. 85)
(*Cont'd*)

(2) If the Director is satisfied that the collective or certification mark has been transferred to the applicant, the Director shall record the transferee as the registered owner of the registration in accordance with the information contained in the application, and advise the applicant in writing of the action taken."

4. In Schedule I,

- (a) delete the words "On application to record a change of conditions governing use of a collective mark" appearing in the fifth and sixth lines thereof and substitute the words "On application to record a change of conditions governing the use of a collective or certification mark";
- (b) delete the words "On application for approval of the transfer of a collective mark" appearing in the penultimate line and substitute the words "On application for approval of the transfer of a collective or certification mark"; and
- (c) delete the words "For recording the transfer of a collective mark" appearing in the last line and substitute the words "For recording the transfer of a collective or certification mark".

*Column 1**Column 2**Enactments**Amendments*

5. *Trade Marks Regulations, 1984*
(S.I. 1984 No. 85)
(Cont'd)

5. In Schedule II,
- (a) in Form No. 1, insert the words ", certification" immediately after the word "service" appearing in the footnote;
 - (b) in Form No. 3, add the following footnote:

"2A. The applicant must indicate whether the application is in respect of a trade mark, service mark, collective mark or certification mark.";
 - (c) in Form No. 4, in the footnote numbered 2, insert the words ", Certification" immediately after the word "Service";
 - (d) in Form No. 12, in the footnote numbered 1, insert the words ", Certification" immediately after the word "Service";
 - (e) in Form No. 17, in the footnote numbered 2, insert the words ", Certification" immediately after the word "Service";
 - (f) in Form No. 18, insert the words "/certification mark" immediately after the words "collective mark" wherever they appear in the form;

<i>Column 1</i>	<i>Column 2</i>
<i>Enactments</i>	<i>Amendments</i>
5. <i>Trade Marks Regulations, 1984</i> (S.I. 1984 No. 85) (Concl'd)	(g) in Form No. 21, insert the words "/certification mark" immediately after the words "collective mark" wherever they appear in the form; (h) in Form No. 22, insert the words "/certification mark" immediately after the words "collective mark" wherever they appear in the form; and (i) in Form No. 23, insert the words "/certification mark" immediately after the words "collective mark" wherever they appear in the form.