

## **REVIEW OF LEGISLATION**

### **SAINT LUCIA<sup>1</sup>**

The present document reproduces the introductory statement made by the delegation of Saint Lucia, the questions put to it and the responses given in connection with the review of legislation undertaken at the Council's meeting of 2-5 April 2001.<sup>2</sup>

#### **I. INTRODUCTORY STATEMENT**

Saint Lucia signed the Uruguay Round Agreements in 1995 and thus became party to the TRIPS Agreement. The TRIPS Agreement introduced the issue of protection of intellectual property rights and made that protection an integral part of the international trading system. This the Agreement sought to do by placing obligations on Members to ensure that domestic legislation made adequate provision for the enforcement and protection of intellectual property rights.

When Saint Lucia signed the TRIPS Agreement, the laws pertaining to intellectual property administration and enforcement did not meet the obligations contained in the said Agreement. This therefore necessitated the updating, and in some cases the introduction, of new legislation to meet the obligations of the TRIPS Agreement.

On 1st January, 1995, the laws in existence which dealt with intellectual property were:

- (1) Title X, Patents, Designs, and Trade Marks, Commercial Code, Chapter 244, Revised Laws of Saint Lucia 1957. This legislation is for the most part based on 1938 United Kingdom laws. The procedure relating to trademarks is based on the 1986 Trademark Rules. This piece of legislation was amended by No. 14 of 1989 to provide for the registration of service marks.
- (2) The Copyright (St. Lucia) Order, 1965 and the Copyright Act 1956 of the United Kingdom.

Having signed the Uruguay Round Agreements, and therefore the TRIPS Agreement, it became necessary to review existing legislation and in most cases adopt new legislation. In keeping with its obligations, the following pieces of legislation were passed between 1995 and 2001:

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<sup>1</sup> As regards laws and regulations notified by Saint Lucia under Article 63.2 of the Agreement, reference is made to documents IP/N/1/LCA/1; IP/N/1/LCA/C/1 to 3; IP/N/1/LCA/D/1; IP/N/1/LCA/G/1; IP/N/1/LCA/L/1; IP/N/1/LCA/U/1 and IP/N/6/NAM/1.

<sup>2</sup> The minutes of this meeting have been circulated as document IP/C/M/30.

- (1) The Copyright Act, 1995 (Act No. 10 of 1995)  
Copyright (Amendment ) Act, 2000 (Act No. 7 of 2000)  
Copyright (International Organisations) Order, 2000 (Statutory Instrument No. 112 of 2000)  
Copyright (Importation Restriction) Regulation, 2000 (Statutory Instrument No. 113 of 2000)
- (2) Geographical Indications Act, 2000 (Act No. 4 of 2000)
- (3) Layout-Designs (Topographies) of Integrated Circuits Act, 2000 (Act No. 3 of 2000)
- (4) Protection Against Unfair Competition Act, 2001 (Act No. 1 of 2001)
- (5) Industrial Designs Act, 2001 (Act No. 2 of 2001)
- (6) Trademarks Act, 2001
- (7) Patents Act, 2001

It should be noted that for the purposes of this review of TRIPS implementing legislation, Saint Lucia received two questions from Canada, one question from Japan, five questions from Switzerland and 55 questions from the United States. Written responses to these questions were submitted through the embassies of the Eastern Caribbean States and Missions to the WTO.

#### A. ADMINISTRATION

Prior to April 2000, the administration of intellectual property in Saint Lucia was the responsibility of the Registry of the Supreme Court. This Registry was also responsible for the administration of the High Court, Civil Status and Deeds and Mortgages. It was recognized that with the advent of international obligations under the TRIPS and other international agreements, it was necessary to separate the functions relating to intellectual property. This saw the creation of the Registry of Companies and Intellectual Property by the Companies and Intellectual Property (Registry) Act 2000 (Act No. 12 of 2000). This new Registry is solely responsible for the administration and enforcement of intellectual property rights. The Registry is headed by a Registrar of Companies and Intellectual Property and has a staff component of eight.

#### B. COPYRIGHT ACT 1995 (ACT NO. 10 OF 1995)

This Act repealed the Copyright (St. Lucia) Order, 1965 and the Copyright Act 1956 of the United Kingdom as well as all Orders-in-Council made under the Copyright Act 1956. The Act introduced a new system of copyright protection and sought to bring Saint Lucia's law in line with international conventions to which Saint Lucia is a party. This was necessary especially in light of the rapidly developing technology today and the need to provide adequate protection to copyright owners.

The 1995 Act provides protection for computer programmers and compilations of data and also makes provision for moral rights in addition to economic rights. The term of protection provided under the Act is fifty years for most categories of works.

In order to ensure compliance with the obligations of the TRIPS Agreement and two new WIPO treaties relating to copyright and related rights, the Copyright Act was amended in 2000. The Copyright (Amendment) Act 2000 expanded the nature of economic rights to which a copyright owner is entitled by making provision for "communication to the public" and "rental or public

lending of the work", among others. The amendment also made provision for protection of producers of phonograms as well as performers. The civil remedies available were also extended by this amendment to include "order for the impounding of copies of works" and "order for the forfeiture and seizure of the instruments or equipment used to make the infringing copies.

The Copyright (Importation Restriction) Regulations 2000 make provision for the enforcement of rights by the right holder as stipulated in Articles 51-59 of the TRIPS Agreement and therefore allow for the seizure of infringing goods by Customs at the request of the right holder.

C. GEOGRAPHICAL INDICATIONS ACT 2000 (ACT NO. 4 OF 2000)

There was no law existing with respect to the protection of geographical indications in Saint Lucia. In order to comply with TRIPS obligations, the Geographical Indications Act, 2000 was passed. This piece of legislation therefore incorporates Articles 22 to 24 of the TRIPS Agreement. The Act is divided into five parts:-

1. Preliminary matters
2. Registration of Geographical Indications
3. Protection of Geographical Indications
4. Special provisions concerning marks and exceptions
5. Regulations

The Act makes provision in section 12 for civil proceedings in cases of the unlawful use of geographical indications. Section 13 deals with availability of protection regardless of registration and establishes that protection is available irrespective of registration in Saint Lucia. Section 14 deals with homonymous geographical indications for wines.

The Act also makes provision for criminal sanctions for the deliberate and wrongful use of geographical indications.

D. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS ACT (ACT NO. 3 OF 2000)

The area of layout-designs is another area where Saint Lucia had no existing legislation and therefore had to introduce new legislation. The Layout-Designs (Topographies) of Integrated Circuits Act 2000 incorporates Articles 36 to 38 of the TRIPS Agreement.

The Act makes protection for layout-designs contingent on commercial exploitation for not more than two years and provides protection if the layout-design has not been exploited at all. The term of protection provided under the Act is ten years. The Act places the responsibility for the administration of the Act on the Registrar of Companies and Intellectual Property. The functions of the Registrar relate to registration and do not require a substantive examination of the layout-design application for registration.

Section 12 of the Act makes provision for cancellation by an interested person on application to the Court. The effect of cancellation is that the layout-design is regarded as null and void from the date of the commencement of protection.

The Act also makes provision for civil and criminal remedies in respect of infringement of layout-designs.

E. PROTECTION AGAINST UNFAIR COMPETITION ACT (ACT NO. 1 OF 2001)

This is another area in which there was no legislation in Saint Lucia. This therefore saw the passing of the Protection of Unfair Competition Act 2001. This Act incorporates Article 39 of the TRIPS Agreement. This Act unlike most of the other intellectual property legislation does not require administration by the Registrar of Companies and Intellectual Property. The rights provided by this piece of legislation are individual rights and so must be enforced by the right holder. There is no system of registration under this Act.

F. INDUSTRIAL DESIGNS ACT (ACT NO. 2 OF 2001)

As far as industrial designs are concerned, the legislation which existed was Part II of Title X of the Commercial Code, Ch. 244 Revised Laws of Saint Lucia which was largely based on old United Kingdom Designs legislation. The provisions of this legislation did not meet international standards. The Act made provision for the automatic registration of United Kingdom registered designs and provided copyright protection of five years to the right holder. These provisions were certainly not in keeping with the TRIPS Agreement and therefore, a new Industrial Designs Act 2001 was passed to incorporate Articles 25 to 26 of the TRIPS Agreement. The Act therefore repealed Part II of Title X of the Commercial Code.

The Industrial Designs Act has removed the automatic registration of United Kingdom registered designs and makes protection available to the creator of an industrial design which falls within the definition of industrial design under the Act. The Act does not extend to anything in an industrial design which serves solely to obtain a technical result. The industrial design to be registrable must be new i.e. not been disclosed to the public, anywhere in the world, by publication in tangible form or in any other way.

The Act places the responsibility for all functions relating to the procedure for the registration of industrial designs and for the administration of registered industrial designs with the Registrar of Companies and Intellectual Property.

The term of protection provided by the Act is ten years renewable for two further consecutive periods of five years. Remedies for infringement of a registered industrial design, both civil and criminal are provided by the Act.

G. TRADEMARKS ACT 2001

The legislation relating to trademarks is Part III, Title X of the Commercial Code, Chapter 244, Revised Laws of Saint Lucia. This piece of legislation provides for the registration of trade and service marks. It also makes provision for the registration of United Kingdom registered trademarks. The term of protection under this piece of legislation is fourteen years. It was recognized that although the legislation relating to trademarks was in some respects compliant with the TRIPS Agreement, provisions such as the automatic registration of United Kingdom Trademarks were certainly not in keeping with international obligations.

In light of this, the Trademarks Act was passed in Parliament in Saint Lucia last month (March) and is to come into force on a date to be proclaimed by the Governor General. This new Act will have the effect of repealing the existing trademarks legislation and its provisions take into account Articles 15 to 21 of the TRIPS Agreement.

The Trademarks Act widens the definition of trademark presently contained in existing legislation under the Commercial Code to include "aspect of packaging and shape".

It abandons the distinction between Part A and Part B of the Register, which was based on English law and practice. The new Act will only make provision for one register and the test will be that a trademark will be registered if it is capable of distinguishing. Of major significance is the fact that the Act also abandons reference to United Kingdom registered trademarks. All applications for registration of marks will be treated in the same manner.

The Trademarks Act provides for certification trademarks, well-known trademarks and collective trademarks whereas the existing legislation only provides for defensive trademarks. Multi-class filing is allowed under the new Trademarks Act and the concept of associated trademarks is not retained by the Act. The term of protection is changed by the new Act to 10 years.

In accordance with Articles 51 to 59 of the TRIPS Agreement, the Trademarks Act makes provision for the Comptroller of Customs to seize counterfeit goods at the instance of the trademark owner.

#### H. PATENTS ACT 2001

The legislation relating to patents is Part I, Title X of the Commercial Code, Chapter 244, Revised Laws of Saint Lucia. This piece of legislation provides for the granting of patents. It also makes provision for the registration of United Kingdom registered patents. The existing legislation also provides for compulsory licences, however, there is no record of any use of this provision.

In order to comply with its obligations under the TRIPS Agreement, i.e. Articles 27 to 34 relating to patents, a new Patents Act was passed in the Parliament of Saint Lucia last month (March) and is to come into force on a date to be proclaimed by the Governor General. This new Act repeals the existing legislation relating to patents.

The Patents Act provides the protection for all inventions except micro-organisms and sets out detailed conditions for granting compulsory licences. The new Act takes away all references to registration of United Kingdom Patents and treats all applications for the grant of a patent in the same manner. The Act has provisions dealing with patentable subject matter, procedure for the grant of patents, term of protection, the exclusive rights conferred on the right holder, compulsory licences, use of patented inventions for services of government, revocation of patents and offences.

Saint Lucia became a party to the Patent Co-operation Treaty on 30 August, 1996 and acts as a designated office with its receiving office functions being delegated to the International Bureau of the World Intellectual Property Organisation. The Patents Act provides for registration of applications filed in accordance with the Patent Co-operation Treaty and provides generally for the administration of patents. The responsibility for the granting and administration of patents lies with the Registrar of Companies and Intellectual Property.

#### I. DRAFT PLANT VARIETIES ACT

It is the intention of Saint Lucia to introduce legislation dealing with plant varieties and a draft Plant Varieties Act has already been drafted and will be laid before the Senate at its next sitting.

#### J. INTERNATIONAL CONVENTIONS AND TREATIES

The International Conventions and Treaties concerning intellectual property to which Saint Lucia is a party or has deposited instruments of accession are:

1. Paris Convention for the Protection of Industrial Property (1883) – 9 June, 1995

2. Berne Convention for the Protection of Literary and Artistic Works (1886) – 24 August, 1993
  3. Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957) – 18 March, 2001
  4. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations (Rome Convention (1961) – 17 August, 1996
  5. Patent Co-operation Treaty (PCT) (1970) – 30 August, 1996
  6. WIPO Copyright Treaty (1996) (Accession)
  7. WIPO Performers and Phonograms Treaty (1996) (Accession)
  8. Documents of accession to the Geneva Convention for the Protection of Phonograms against Unauthorised Duplication of their Phonograms (1971) and the Washington Treaty on Integrated Circuits were deposited with the appropriate authorities during the latter part of 2000.
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The representative of Barbados congratulated Saint Lucia for the extensive work that had been carried out. She emphasized that it was a notable achievement for a small developing country like Saint Lucia which, like others in the region, was facing great capacity constraints in order to fulfil existing WTO commitments.

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## **II. RESPONSES TO QUESTIONS POSED BY CANADA**

### **1. Please describe how the enforcement obligations (Articles 41-61 of the TRIPS Agreement) have been implemented.**

#### Article 41: General Obligations

The Industrial Property legislation makes provision for the appeal against a decision of the Registrar. Such appeal is to be made to the High Court and must be made within a specified period stipulated under the relevant piece of legislation.

Section 21 of the Industrial Designs Act 2001 allows for appeal from any decision of the Registrar within three months from the date of the Registrar's decision.

Section 18 of the Layout-Designs (Topographies) of Integrated Circuits Act 2000 and Section 11 of the Geographical Indications Act 2000 allow for appeal from the Registrar's decision within two months from the date of the decision.

The Trademarks Bill allows for appeal from decisions of the Registrar at various stages of the registration process and like the other legislation the appeal must be brought within the time specified in the legislation.

Generally in civil proceedings before the Court in Saint Lucia, decisions rendered by the Court are normally written and made available to the party's solicitor as soon as it is available.

#### Article 42: Fair and Equitable Procedures

The Civil procedure adopted during a civil case is provided for in the Rules of the Supreme Court 1970 and as such makes provision for the manner in which a civil case will be dealt with.

#### Article 43: Evidence

The Courts have the authority to order the production of documents in court by virtue of the Rules of the Supreme Court 1970. A party to litigation has an obligation to (either automatically or by order of the Court to give "discovery" of such documents which it may have in its possession, custody or control which relate to the particular court proceeding. The Court can also make orders (by way of an Anton Pillar injunction) at the beginning of the proceedings for the protection of evidence and to prevent any possibility of evidence not being available if there is a fear that the defendant may destroy the evidence.

#### Article 44: Injunctions

Under the general jurisdiction of the court and under the various Intellectual Property Laws the courts may grant relief for infringement in the form of an interlocutory or perpetual injunction.

The courts apply the rule that they may grant an interlocutory injunction if the court is satisfied that there is a serious issue to be tried, if the risk of damage to the plaintiff if the injunction is not granted will not be compensated by an order for damages provided that the plaintiff gives an undertaking to compensate the defendant if the injunction is later found by the court to be unjustified.

#### Article 45: Damages, including recovery of profits and expenses; including attorney's fees

Under the general jurisdiction of the court and under the provision of IP laws the courts have powers to award damages for infringement or if the plaintiff desires an account for profit. Under the Copyright Act 1995 the plaintiff cannot be awarded damages in the case of innocent infringement but is entitled to an account of profit. Damages usually include the recovery of commercial losses associated with the infringement and flagrancy of the infringement shall be taken into account in deciding whether additional damages should be awarded. An award of damages would normally be accompanied by an order for payment of legal cost incurred by the successful party. With respect to legal costs the court may order that costs be taxed if not otherwise agreed.

Under such order for costs the successful party will normally recover a sum corresponding to the reasonable sums which were expended in the litigation. If these costs cannot be agreed between the parties such costs are assessed by the Registrar of the Supreme Court.

As an alternative to an award of damages, the right holder may seek an account of profits instead of damages. This requires the court to assess the profits which the infringer has made as a result of his infringing act and to pay this over to the right holder.

#### Article 46: Other Remedies - destruction or other disposal of infringing goods and material/implements for their production;

The courts have jurisdiction to order defendants to deliver infringing goods and copies as well as materials or implements used in their production. Provision of the Copyright Act 1995 and the drafts Trademarks Act allow for the seizure of infringing goods or copies and in the case of the

Copyright Act the equipment used for making them. There is also a provision for disposal or destruction of forfeited goods or copies by the Comptroller of Customs.

The draft Trademarks Act provides for the Comptroller of Customs to direct the disposal of counterfeit goods which have been seized by the customs authorities. Under the Copyright Act where goods have been seized in accordance with the Copyright (Importation Restriction) Regulations, 2000 its disposal is determined by powers granted under the Customs (Control and Management) Act, 1990

For patent infringement the court has the power to make an order for the infringer:

"to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised."

#### Article 47: Right of Information

The Supreme Court has the inherent power to make such orders. The courts may order an infringer to provide information which identifies those who have supplied to him infringing articles and also those who have supplied the means by which these articles have been made provided that the supplier had the knowledge or reasonable belief that the particular instrument would be used to make infringing copies.

#### Article 48: Indemnification of the Defendant

Where the court order an interlocutory injunction it is necessary that the plaintiff give to the court an undertaking that if the injunction was wrongly granted against the defendant the plaintiff will pay damages to the defendant. The court may also require security for such an undertaking to be given by way of deposit of money into the courts funds or by providing a guarantee. This will normally be the case where the plaintiff is residing outside of Saint Lucia.

#### Article 50: Provisional Measures

Under the common law system, the Court can exercise the following powers:

- (i) The High Court has power to adjudicate on the enforcement of IPRs and can take provisional measures before the full trial including the grant of interlocutory injunctions;
- (ii) The Court may also grant relief of the type known as an Anton Pillar order after the case has started. Under this order, the defendant is required to admit onto his premises a person named in the order to search for and take into custody any document and any things specified in the order to preserve the evidence for the trial;
- (iii) An application can also be made to the Court for an interim award of damages. The plaintiff must show that it is likely that at full trial a substantial award of damages will be made by the court and that pending the assessment of the issues at trial, there should be an interim payment.

In cases of exceptional urgency, the High Court will order an injunction on an *ex parte* basis, that is *inaudita altera parte*. However, this will only be done when the court is of the opinion that an immediate injunction is necessary because otherwise the plaintiff is likely to suffer extreme and irreparable damage. Ex parte injunctions are granted to the plaintiff for a matter of days only and must return to the court at the time when the defendant is also present and then seek a renewal of the injunction. Some of the other types of provisional relief such as Anton Pillar Order and Mareva



Injunctions are normally made on an *ex parte* basis in order to surprise the defendant and thereby prevent it from taking steps to evade the relief ultimately to be awarded by the court.

Usually the plaintiff is required to institute the action by filing a writ of summons before applying for provisional measures. In cases of extreme urgency, an *ex parte* injunction may be granted, upon an undertaking by an intended plaintiff to file the writ of summons at the earliest possible opportunity. An *ex parte* injunction may issue, upon the mere production to the Judge of the infringing item, upon Counsel's undertaking to put the supporting evidence of infringement on oath, at the earliest possible opportunity.

Strict guidelines will be given by the Judge granting *ex parte* injunction for the "return hearing" when the defendant will be afforded an opportunity to be heard. On the return hearing the general principles governing interlocutory injunctions will be applied and also key measures in affording protection to the defendant against damages that he may incur in the event that the provisional measure is proved to be unjustified. These could include undertakings by the plaintiff supported by bond to secure the payment of damages or less commonly by a payment of money into court.

#### Articles 51- 60: Special Requirements Related To Border Measures

Under section 115 of the draft Trademarks Act and section 51 of the Copyright Act 1995, the competent authority to suspend the release of goods is the Comptroller of Customs.

To initiate the seizure of copies of counterfeited goods the copyright owner, exclusive licensee or the trademark owner or authorised user must provide written notice of objection to importation to the Comptroller of Customs together with any prescribed documents. A notice remains in force for a specified period not exceeding five years from the day of which the notice is given. The Comptroller may not seize copies of goods unless the copyright owner exclusive licensee or trademark owner or authorised user provides a security in respect of any liability or expense which the Comptroller may incur in consequence of the notice by reason of the detention of an article or anything done to an article detained.

The draft Trademarks Act provides that the Comptroller may seize goods which are manufactured outside of Saint Lucia and imported in to Saint Lucia and which are subject to the control of the Comptroller of Customs under the Customs (Control and Management) Act 1990. If goods have a trademark that, in the opinion of the Comptroller, is identical with, or deceptively similar to, a notified trademark and are goods in a class for which the trademark is registered the Comptroller must seize the goods unless satisfied that there are no reasonable grounds for believing that infringement has occurred.

Once goods or copies have been seized the Comptroller must give notice of a seizure to the objector and the importer or owner which notice identifies the copies or goods.

Under section 120 of the Draft Trademarks Act the notice must also state that the goods or copies will be released to the designated owner or importer unless the objector brings an action for infringement, and gives to the Comptroller notice in writing of the action within one month from the date of the notice or within the period as extended by the Comptroller

Under section 126 of the draft Act if goods are seized and the Comptroller is satisfied that the use of a trademark is fraudulent the Comptroller may ask the importer of the goods or an agent of the importer to produce any document relating to the good and give information about the name and address of the person by whom the goods were consigned to Saint Lucia and the name and address of

the person in Saint Lucia to whom the goods were consigned. Failure to comply with this request is an offence and renders the defaulter liable on conviction to a fine of ten thousand dollars.

If an infringement action has not been started within the stipulated time the Comptroller must release the seized copies of goods to the importer or designated owner.

Once a person who has given notice to the Comptroller has received the notice of suspension of release of goods, he must bring an action for infringement in relation to the seized copies or goods, and give notice of it to the Comptroller within one month from the date of the notice unless an extension of time has been obtained. The extension cannot exceed ten working days. The copyright owner must bring an action for infringement with the time specified in the notice or the time limited for bringing an action for infringement whichever is earlier.

Under the Trademarks Act if, three weeks after the action was brought, there is no order of the court preventing the release of the seized goods, then they must be released by the Comptroller. If an infringement action is commenced the Court may order the release of the seized copies or goods at any time it seems fit.

There is no provision requiring ex officio action by Customs officials. All actions must be initiated by the Copyright owner or exclusive licensee or by the owner (or authorised user) of the industrial property right. Under the Copyright Act 1995, the Comptroller may only seize copies if the copyright owner or licensee gives notice of objection to the importation of the copies. This is the same situation under the draft Trademarks Act where the goods can only be seized by the Comptroller if the goods bear a mark identical or similar to a trademark in relation to which a notice of objection has been given.

The Customs authority is not empowered to order remedies for infringement. They can seize infringing copies of counterfeit goods and dispose of those copies or goods if they are forfeited by the importer. All remedies are decided by the courts.

#### Article 61: Criminal procedures

With respect to criminal offences the following has been or is intended to be implemented:

- an offence of infringement of copyright is committed under the provisions of section 52 of the Copyright Act 1995. Under this provision, an infringement of any right protected under the Act is committed by a defendant who knows or has reason to believe that he is infringing copyright;
- under section 16 of the Geographical Indications Act the doing of any of the acts in section 12 knowingly and with intent to deceive constitutes an offence;
- under section 22 of the Industrial Designs Act the performance intentionally of an act under section 9 (2) including making, selling, for commercial purposes constitutes an offence;
- under section 15 of the Layout-Designs (Topographies) of Integrated Circuits Act the performance, knowingly of any act under section 6, making, selling or otherwise distributing for commercial purposes constitutes an offence; and
- the Plant Varieties Act will make provision for criminal proceedings for wilful non-compliance or misuse of variety denomination.

## **2. What protection does your Copyright legislation afford to "foreign works"?**

Section 8 of the Copyright Act 1995 as amended by the Copyright (Amendment) Act 2000 in subsection (9) provides that the provisions of the Act apply also to works that are eligible for protection in Saint Lucia by virtue of and in accordance with any international convention or other international agreement to which Saint Lucia is a party.

Section 110A of the Copyright (Amendment) Act 2000 provides similar protection for performers who are eligible for protection by virtue of and in accordance with any international convention or other international agreement to which Saint Lucia is a party.

These sections therefore make provision for national treatment as required by the TRIPS Agreement. Section 110A also provides that the provisions relating to performers apply to performers who are not nationals of Saint Lucia but whose performances take place in Saint Lucia, are incorporated in sound recordings that are protected under the Act or have been fixed in sound recordings but are included in broadcasts which qualify for protection under the Act. Also section 8(1)(b) of the Copyright Act 1995 provides that a published work qualifies for protection if the first publication took place in a country other than Saint Lucia, and therefore makes no distinction with regard to nationality of the right holder.

In addition, by virtue of sections 8 and 110A the provisions of Article 5 of the Berne Convention, which speaks to protection for works outside their country of origin, also apply.

## **III. RESPONSES TO QUESTIONS POSED BY THE EUROPEAN COMMUNITIES AND THEIR MEMBER STATES**

### **A. GENERAL PROVISIONS**

**1. Please describe if your legislation includes measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to your socio-economic and technological development as mentioned under Article 8 of the TRIPS Agreement. If yes, please explain how such measures are consistent with the provisions of the TRIPS Agreement.**

Section 16 of the Layout-Designs (Topographies) of Integrated Circuits Act 2000 (Act No. 3 of 2000) incorporates Article 8 of the TRIPS Agreement and allows the Minister responsible for intellectual property to decide without the authorization of the right holder, that a Government agency or a third person designated by the Minister may exploit the layout-design. This can be done where the public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy requires the exploitation of a protected layout-design for public non-commercial use.

### **B. COPYRIGHT AND RELATED RIGHTS**

**2. Please state how your legislation provides for the protection of the exclusive rights of authors in relation to their literary and artistic works, as specified in Article 9 of the TRIPS Agreement which requires Members to comply with Articles 1-21 of the Berne Convention and the Appendix to the Berne Convention (1971)).**

In relation to literary and artistic works, the following protection is granted to the author of such a work. He/she has the right to do, authorize or prohibit the following acts granted by section 9

as amended by section 4 of the Copyright (Amendment) Act:

- reproduction of the work;
- translation of the work;
- adaptation, arrangement or other transformation of the work;
- the first public distribution of the original and each copy of the work by sale, rental or otherwise;
- rental or public lending of the original or a copy of an audiovisual work, a work embodied in the form of notation, irrespective of the ownership of the original or copy concerned;
- importation of copies of the work;
- public display of the work;
- public performance of the work;
- communication to the public of the work.

These rights can be enforced through the invoking of various civil and criminal remedies provided for in the Copyright Act 1995.

**3. Please describe the protection accorded to authors of computer programs, databases or compilations of data.**

Section 7(10) of the Copyright Act 1995 provides categories of works in which copyright under the Act can subsist and one of these categories is literary works. Section 3 defines literary work as any work other than a dramatic or musical work, which is written, spoken or sung, and includes:

- a written table or compilation; and
- a computer programme.

Section 9 as amended goes on to describe the nature of the economic rights granted to the owner of the copyright in a work for which protection is granted. By virtue of this section the owner of copyright has the exclusive right to do, authorise or prohibit the following acts granted by Section 9, i.e.

- reproduction of the work;
- translation of the work;
- adaptation, arrangement or other transformation of the work;
- importation of copies of the work;
- public display of the work;

- communication to the public of the work.

The term of protection granted to the above works is fifty years, in the case of computer generated programmes from the end of the year in which the work is made and in other cases of literary works, fifty years from the end of the year in which the author dies.

**4. Please state whether your legislation provides for a rental right and, if so, the works to which it applies.**

Section 9 of the Copyright Act 1995 as amended by the Copyright (Amendment) Act 2000 makes provision for the exclusive rights which the owner of copyright has. In subsection (e) of section 9 as amended it provides the exclusive right of "rental or public lending of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer programme, a data base or a musical work in the form of notation".

Section 9 subsection 2 goes on to provide that the rights of rental and lending do not apply to rental or lending of computer programmes where the programme itself is not the essential object of the rental or lending; or to cinematographic works, unless such commercial rental has led to widespread copying of such works materially impairing the exclusive right of protection.

**5. Please describe the rights granted to performers, producers of phonograms (sound recordings) and broadcasting organisations under your legislation.**

A performer enjoys the right to consent to the exploitation of his performance and to be paid royalties for use of the performance. Performers also have rights conferred by section 9 as amended of the 1995 Act, i.e.:

- making a recording of the whole or any substantial part of the performance;
- broadcasting live the whole of any substantial part of a performance;
- showing or playing in public the whole or any substantial part of a performance;
- using an original recording of a performance for the purpose of making an adaptation of the recording;

In addition, performers and broadcasters enjoy the following rights to do, authorize or prohibit the following acts granted by section 9 as amended by section 4 of the Copyright (Amendment) Act:

- reproduction of the work; translation of the work;
- adaptation, arrangement or other transformation of the work;
- the first public distribution of the original and each copy of the work by sale, rental or otherwise;
- rental or public lending of the original or a copy of an audiovisual work, a work embodied in the form of notation, irrespective of the ownership of the original or copy concerned;
- importation of copies of the work;

- public display of the work;
- public performance of the work;
- communication to the public of the work.

Producers of phonograms have the right to be identified as the performer of a performance and to object to any distortion, mutilation or other modification of his or her performance that would be prejudicial to his or her reputation.

**6. Please state whether your legislation provides for any limitation or exception in relation to each of the rights described above in accordance with the relevant provisions of the Berne and Rome Conventions and in light of Articles 13 and 14.6 of the TRIPS Agreement.**

Limitations and exceptions to copyrights under the Copyright Act 1995:

- for the purpose of research and private study (section 56);
- for the purpose of criticism, review and reporting (section 57);
- if accompanied by a sufficient acknowledgement where there is incidental inclusion of a protected work (section 59);
- where it is not possible to ascertain the identity of the author and it is reasonable to assume that the copyright has expired or the author died 50 years or more before (section 60);
- use of notes for recording of spoken words for the purpose of reporting current events (section 61);
- acts done for the purposes of instruction or examination (section 62);
- the inclusion of a short passage from a published literary or dramatic work, in a collection for use in educational institutions (anthologies) (section 63);
- performing, playing or showing works in the course of educational activities (section 64);
- recording by or on behalf of an educational establishment for the purposes of that establishment (section 65);
- reprographic copies of passages from published literary, dramatic or musical works made by or on behalf of an educational establishment for the purpose of instruction provided that not more than 1% of any work may not be copied in any quarter (section 66);
- supply by libraries of copies of published works (section 69);
- recording of works for archival purposes (section 73);

- for the purposes of parliamentary or judicial proceedings and for the purpose of reporting such proceedings (section 74);
- making or supplying copies of public records (section 75);
- transfer of works in electronic form subject to any express terms prohibiting such transfer or otherwise (section 78);
- reading and recitation in public (section 80);
- representations of artistic works on public display (section 81);
- anything done for the purposes of reconstructing a building (section 82);
- recording for the purpose of time shifting (section 85).

The Act speaks to fair dealing with a work. Sections 57 and 58 state what factors would be taken into account to determine whether an act constitutes fair dealing. One such factor is the effect of the act upon the potential market for or the commercial value of the work. Provision is also made for the overriding of some exceptions where there are express contractual terms to the contrary.

**7. Please state the terms of protection of each right described above and the work or subject matter to which it applies.**

The length of protection granted under the Copyright Act 1995 is generally 50 years. The following is a detailed synopsis of the categories of works and term of protection.

- In relation to literary, dramatic, musical or artistic work - 50 years from the end of the year in which the author dies (section 10 (1));
- In relation to computer generated work – 50 years from the end of the year in which the work is made;
- In relation to a sound recording or film – 50 years from the end of the year in which it was made;
- In relation to a broadcast or cable programme – 50 years from the end of the year in which the broadcast was made or the programme included in a cable programme service;
- In relation to typographical arrangements of a published edition – 25 years from the end of the year in which the edition was first published.

**8. Please state how your legislation grants the retroactive protection provided pursuant to Article 18 of the Berne Convention (the obligation of which derives from Article 9 of the TRIPS Agreement) and Article 14.6 of the TRIPS Agreement.**

Section 8 as amended by the Copyright (Amendment) Act 2000 provides in subsection (9) provides that the Act applies to works which are eligible for protection in Saint Lucia by virtue and in accordance with any international convention or other international agreement to which Saint Lucia is a party. Saint Lucia is a party to the Berne Convention and so by virtue of Section 8 of the Act, Article 18 applies.

C. TRADEMARKS

**9. Please give the definition of a sign under your national legislation and explain under what conditions it is protectable.**

"Sign" is described in section 2 of the Trademarks Act 2001 as including "letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, and combination of the above".

The conditions under which a trademark would be protected are as follows:

"the person applying for registration claims to be the owner of the trademark and is using or intends to use the trademark in relation to the goods and services or both; or is authorised or intends to authorise another person to use the trademark; or intends to assign the trademark the trademark to a body corporate that is about to be constituted with a view to the use by the body corporate of the trademark in relation to the goods and services or both."

The trademark which is sought to be registered must not contain certain signs which are prescribed in the Regulations (regulations still being drafted) or must not be scandalous or its use contrary to law. It must be capable of being represented graphically and must not be likely to deceive or cause confusion or be identical to a trademark already registered by another person.

A trademark is protected for a term of 10 years.

**10. Please confirm whether or not services are a protectable subject matter in your trademark law. Please confirm if signs, such as trade names, are protectable. Please describe if elements such as sound, perfumes and containers are protectable.**

Under the Trademarks Act 2001, services are protectable subject-matter. The Act does not provide for the protection of trade names as these are protected under the Registration of Business Names Ordinance in Saint Lucia. The Trademarks Act does not provision for the protection of smell and sound as trademarks but provides for the protection of shape and aspect of packaging as trademarks containers are therefore protectable under the Act.

**11. Please explain what the requirements of use are, if any, as a condition for a trademark registration. Please explain the definition of use and the conditions of maintenance of a registration in that respect.**

In order for a person to apply for registration of a trademark, the applicant must claim to be the owner of the trademark and that he is using or intends to use the trademark in relation to the goods and services or both.

Section 2 subsection 5 of the Trademarks Act 2001 defines use in relation to goods as "use of the trademark upon, or in physical or other relation to, the goods, including second-hand goods". Use in relation to services is defined as "use of the trademark in physical or other relation to the services".

A trademark may be removed from the register if its use is not maintained and there has been no use of the trademark in Saint Lucia or use in good faith of the trademark in Saint Lucia for a continuous period of three years ending one month before the day on which the application for removal is made.



**12. Please confirm whether or not your legislation permits that the registration of trademarks be indefinitely renewable.**

Yes, the Trademarks Act 2001 does make provision for the renewal of trademarks indefinitely. The initial term of protection is ten years and upon expiration of that period application can be made for renewal.

**13. Please describe the special requirements, if any, prescribed by your legislation concerning the use of a trademark.**

There are no special requirements prescribed by the Trademarks Act concerning use of a trademark.

**D. GEOGRAPHICAL INDICATIONS**

**14. Please explain whether or not your trademark registration authority refuses a trademark application if it contains a geographical indication.**

Under the provisions of Section 17 of the Geographical Indications Act 2000 (Act No. 4 of 2000) the Registrar of Companies and Intellectual property shall on his or her own motion or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in Saint Lucia is of a nature as to mislead the public as to the true place of origin. Under Section 18 the Registrar is also authorised to refuse or invalidate the registration of a trademark for wines which contains or consists of a geographical indication identifying wines or a trademark for spirits which consists or contains a geographical indication identifying spirits with respect to wines or spirits not having this origin.

**15. Please give the definition of a geographical indication in your legislation.**

Geographical indication is defined as "an indication which identifies a good as originating in the territory of a country, or a region or locality in this territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin".

**16. Please describe and explain the provisions of your legislation establishing a link, if any, between the characteristics of an indication and its geographical origin.**

There are no such provisions establishing such a link.

**17. Please describe how additional protection is granted by your legislation to wines and spirits. Please mention other types of products, if any, covered by this additional protection.**

Section 12 of the Geographical Indications Act 2000 (Act No. 4 of 2000) provides a means whereby an interested person or group of producers or consumers can institute proceedings in Court to prevent "the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like".

Sections 17 and 18 of the Act allow the Registrar of Companies and Intellectual Property to refuse or invalidate the registration of a trademark where the mark consists of a geographical

indication and is misleading as to the true place of origin or the trademark conflicts with a geographical indication for wines and spirits.

Section 14 of the Act makes provision for protection of each indication in the case of homonymous geographical indications.

**18. Please explain how exceptions under Article 24 of the TRIPS Agreement are used in your jurisdiction. Please provide examples of the use of the exceptions by courts or lists of names considered as generic in your jurisdiction.**

Section 19 of the Geographical Indications Act 2000 (Act No. 4 of 2000) makes provision for the exceptions contained in Article 24 of the TRIPS Agreement.

With respect to the use of these exceptions, it must be pointed out that the Geographical Indications Act is relatively new and therefore there has been little use of these provisions and examples are not available at this time.

#### E. INDUSTRIAL DESIGNS

**19. Please explain whether or not your legislation extends to the protection of designs dictated essentially by technical or functional considerations. Please explain how textile designs are protected.**

The Industrial Designs Act 2001 (Act No. 2 of 2001) does not extend protection to designs where its sole purpose is to obtain a technical result. (Section 3(1))

Section 3 of the Act defines industrial designs as any composition of lines or colours or any three dimensional form, or any material or not associated with lines or colours where such composition, form or material gives a special appearance to a product of industry or handicraft, can serve as a pattern for a product of industry or handicraft, or appeals to and is judged by the eye.

Although the Act does not explicitly mention textile designs, the above definition is wide enough to encompass textile designs.

The protection afforded is that the industrial design cannot be exploited by anyone without the agreement of the registered owner and the registered owner has the right to institute court proceedings against any person who infringes the registration of the industrial design by doing making, selling, importing or otherwise distributing for commercial purposes, articles bearing or embodying a design which is a copy, or substantially a copy, of the industrial design without his prior consent.

**20. Please explain how your legislation protects right holders of a design against importing of articles bearing embodied or copied design.**

In Section 9 as indicated above, the right holder has the option to institute proceedings against the importing among other things of articles bearing or embodying a design which is a copy or substantially a copy of the industrial design.

**21. Please state whether or not your legislation provides for the right to issue a compulsory licence for industrial designs.**

The Industrial Designs Act 2001 in section 14 makes provision for the owner of a registered industrial design to grant licences in respect of the design.

**22. Please indicate for what period of time your legislation grants protection for industrial designs.**

The registration of an industrial design is granted for a period of five years from the filing date of the application for registration with the option to renew for two consecutive periods of five years.

F. PATENTS

**23. Please describe how your legislation defines the notions of: novelty, inventiveness and industrial application.**

Under the Patents Act 2001:

- "novelty" relates to an invention which does not form part of the state of the art. The Act provides that "the state of the art" comprises all matter, whether a product, a process, information about a product or process, or anything else, which has at any time before the priority date of the invention been made available to the public whether in Saint Lucia or elsewhere, by written or oral description, by use, or any other way.
- "inventiveness" is defined as involving something which is not obvious to a person skilled in the art.
- "industrial application" is an invention which can be made or used in any kind of industry, including agriculture, fishery and handicraft.

**24. Please explain whether or not in your legislation, patent or otherwise, patent rights are enjoyed without any exclusions. If exclusions are provided for, please describe in detail how these exclusions are applied in legal as well as practical terms.**

The legislation does provide for exceptions with regard to the rights enjoyed by patent holders. One such case would be the use of a patent without the authorisation or consent of the right holder which is provided for in section 57 of the Patents Act 2001. The Act is new and has not entered into force yet and so there has been no practical application of this particular section.

**25. Please explain whether your legislation provides for the exclusion of inventions from patentability based on *ordre public* or morality. If so, please explain the relevant section of your legislation and explain its formulation. Please also explain if it has been applied in practice.**

Apart from the exceptions mentioned in section 9 of the Patents Act 2001 there is no specific exclusion from patentability based on *ordre public* or morality. The only provision made is in section 29 with respect to applications which may be refused because they contain information which is prejudicial to defence of Saint Lucia or safety of the public.

**26. Please explain whether or not diagnostic, therapeutic and surgical methods are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.**

Yes, Section 9 (2) of the Patents Act 2001 excludes anything which consists of diagnostic, therapeutic and surgical methods for the treatment of humans or animals.

**27. Please explain whether or not plants, animals and essentially biological processes are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.**

The Patents Act does not address the protection of plants as this will be addressed in the new Plant Varieties Act which is soon to be passed. The Act does not however specifically exclude animals and biological processes from patentability.

**28. Please describe how micro-organisms, non-essentially biological processes, microbiological processes and plant varieties are protected in your legislation. Please explain, in this respect, the relevant sections of your legislation.**

See response to Question 27.

**29. Please explain how your legislation protects patent right holders against the importing and against the offering for sale of a patented invention.**

Section 62 of the Patents Act 2001 provides that a patent is infringed if it is used, offered for use, imported into Saint Lucia, without the consent of the proprietor. Where such acts have been committed without the consent of the proprietor the proprietor has the right to institute civil proceedings against the infringer. The proprietor can make a claim in such proceedings for (a) an injunction restraining the defendant from any appended act of infringement; (b) an order that the defendant deliver up or destroy any patented product in relation to which the patent is infringed; (c) damages in respect of the infringement; (d) an account of the profits derived by the defendant from the infringement; and (e) a declaration that the patent is valid and has been infringed by the defendant.

**30. Please state if your legislation provides for patent product protection of pharmaceutical and agricultural chemical products. In the affirmative, please indicate the legal reference.**

Section 9 which deals with things which are excluded from patentability does not exclude pharmaceutical and agricultural chemical products from being protected by being patented.

**31. Please clarify if the patent protection of a process, as provided for in your legislation, covers the product obtained directly by that process.**

The Patents Act 2001 in its definition section defines patented product and by virtue of this definition includes a product obtained directly by a process: "patented product" means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied.

**32. Please explain the additional conditions, if any, in your legislation other than the sufficient disclosure of the invention in Article 29 of the TRIPS Agreement (e.g. submission of justification for access to genetic material or prior informed consent to its use). If such additional conditions exist, please point out the relevant legislations and describe the additional conditions in detail.**

There are no additional conditions detailed in the Patents Act 2001.

**33. Please describe if your legislation provides for limited exceptions to the exclusive rights conferred by a patent. If affirmative, please make a reference to relevant legislation.**

The Patents Act 2001 provides limited exceptions by making provision for the use of patented inventions for services of Government without the consent of the proprietor. This is provided for in Section 57 *et seq.*

**34. Please explain whether or not your legislation provides for compulsory licensing. If so, please explain in detail the conditions under which a compulsory licence may be granted. In particular, please explain how your national legislation considers individual merits in the authorization of such use.**

Yes, the legislation does make provision for compulsory licences in Section 51 of the Act. The conditions or grounds which need to be present in order for such a licence to be granted are stated in Section 51 subsection 2 of the Act. These conditions include:

- (a) that there is no production of the patented product or application of the patented process in Saint Lucia without any legitimate reason;
- (b) that there is no product produced in Saint Lucia under the patent for sale in Saint Lucia or there are some but they are sold at unreasonably high prices or do not meet the public demand without legitimate reason;
- (c) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms-
  - (i) a market for the export of any patented product made in Saint Lucia is not being supplied;
  - (ii) the working or efficient working in Saint Lucia of any other patented invention which makes a substantial contribution to the art is prevented or hindered; or
  - (iii) the establishment or development of commercial or industrial activities in Saint Lucia is unfairly prejudiced; or
- (d) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in Saint Lucia, is unfairly prejudiced.

Section 54 of the Act states that in making a determination as to whether a compulsory licence should be granted, the Registrar should take account of "the ability of any person to whom a licence would be granted under the order to work the invention to the public advantage". This allows for the taking into account of individual merits.

**35. Please explain how your legislation explicitly ensures that a proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. In this context, how do you define "reasonable period of time". Please also explain how your legislation ensures that the use of a compulsory licence shall be authorised predominantly for the supply to the domestic market of the member authorizing such use.**

The Patents Act ensures that a proposed user has made efforts to obtain authorisation from a right holder by making the doing of certain acts an infringement if done without the consent of the proprietor of the patent. What is deemed as "reasonable period of time" will be defined by the circumstances of the particular case.

The Patents Act ensures that the use of a compulsory licence shall be authorised predominantly for the supply to the domestic market of the Member authorising such use by stipulating grounds which must be satisfied in order for a compulsory licence to be granted (Section 51). The grounds specified all deal in some way with the non-production of the patented product at the domestic level; no sale of the patented product or unreasonably high prices at the domestic level; the establishment or development of commercial or industrial activities in Saint Lucia; the disposal or use of the patented product or on the use of a patented product; the manufacture, use or disposal of materials not protected by the patent which is unfairly prejudiced due to conditions imposed by the proprietor of the patent.

**36. Please state if your legislation grants additional protection for innovations after the 20 years of patent protection has lapsed.**

Yes, the Patents Act in section 32 provides additional protection after 20 years of patent protection has lapsed as it provides for application for renewal of a patent once the 20 year period has expired.

**37. Please explain how your legislation provides for the enhanced patent protection of patents or patent applications pending on 1<sup>st</sup> January 1995.**

The Patents Act 2001 in its transitional provisions makes provision for applications which were pending under the repealed enactment and applications made pursuant to the Patent Cooperation Treaty before the commencement of the Act. Although there is no stipulation of a date i.e. 1 January, 1995, such applications are to be dealt with in accordance with the Act and accordingly afforded the protection under the Act.

**38. Please explain how your legislation provides for the reversal of the burden of proof in relation to process patents.**

Section 64 of the Patents Act 2001 provides for the reversal of the burden of proof in relation to process patents.

The section that "in any proceedings for the infringement of a patent, where the subject-matter of the patent is a process for obtaining a new product, the burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used".

G. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

**39. Please describe how your legislation protects Topographies.**

The Layout-Designs (Topographies ) of Integrated Circuits Act 2000 (Act No. 3 of 2000) provides protection for layout-designs if and to the extent that they are original i.e. it is a result of its creator's own intellectual effort and is not common place among creators of layout-designs and manufacturers of integrated circuits at the time of its creation. Protection under the Act is not dependant on whether or not the integrated circuit which incorporates the protected layout-design is itself incorporated in an article.

The protection afforded by the Act makes the following acts unlawful if performed without the authorization of the right holder, i.e.:

- reproducing, whether by incorporation in an integrated circuit or otherwise, the protected layout-design in its entirety or any part thereof, except the act of reproducing any part that does not comply with the requirement of originality;
- importing, selling or otherwise distributing for commercial purposes the protected layout-design, an integrated circuit in which the protected layout-design is incorporated or an article incorporating such an integrated circuit in so far as it continues to contain an unlawfully reproduced layout-design.

**40. Please explain what protection your national legislation grants to right holders against the unlawful importation, sale or distribution for commercial purposes of topographies including integrated circuits or other articles in which a topography is incorporated in accordance with Article 36 of the TRIPS Agreement.**

Section 6 of the Layout-Designs (Topographies) of Integrated Circuits Act 2000 makes the above acts unlawful if done without the authorization of the right holder. Section 14 of the Act makes provision for the right holder to institute proceedings in Court where the Court may grant an injunction to prevent infringement or an imminent infringement, award damages or grant any other remedy provided for in the general law.

Section 15 provides criminal sanctions for such infringement described above and renders the guilty person liable on summary conviction to a fine of five thousand dollars or to imprisonment for two years. The Court may also order the seizure, forfeiture and destruction of the layout-designs, integrated circuits or articles concerned and of any materials or implements, the predominant use of which has been in the commission of the offence.

**41. Please explain how your legislation provides for the derogation from Article 36 as specified in Article 37 of the TRIPS Agreement where a person has no knowledge or reasonable grounds to know when acquiring an integrated circuit or an article incorporating such an integrated circuit that it contains an unlawful topography.**

Section 6 incorporates Article 37 of the TRIPS Agreement.

Section 6 (3) of the Act provides that the protection afforded under the Act does not extend to

- the reproduction of the protected layout-design for private purposes or for the sole purpose of evaluation, analysis, research or teaching;

- the incorporation in an integrated circuit of a layout-design created on the basis of such analysis or evaluation and which is itself original or the performance of any acts deemed unlawful in respect of that layout-design;
- the importation, selling or otherwise distributing for commercial purposes where it is done in respect of an integrated circuit in which such a layout-design is incorporated, that has been put on the market by or with the consent of the right holder;
- the performance of the acts referred to above where the act is performed in respect of an identical layout-design which is original and has been created independently by a third party; or
- the performance of any of the above acts in respect of an integrated circuit incorporating an unlawfully reproduced layout-design or any article incorporating such an integrated circuit where the person performing or ordering such an act did not know and had no reasonable ground to know, when acquiring the integrated circuit or the article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout-design.

**42. Please state the term of protection granted by your legislation to topographies.**

The term of protection granted to topographies is ten years. (Section 7 (2))

**H. PROTECTION OF UNDISCLOSED INFORMATION**

**43. Please explain whether or not your legislation grants a defined period of time for the protection of undisclosed information. If so, please give the time span.**

Please see the reply to question 45.

**44. Please explain how your legislation defines "undisclosed information".**

Please see the reply to question 45.

**45. Please explain how your legislation defines data submitted to governments or governmental agencies.**

In relation to the above questions there are no provisions on the above subject area as yet.

**I. ENFORCEMENT**

**46. Please describe how your legislation provides for effective action against infringement of intellectual property rights.**

The Intellectual Property legislation makes provision for effective action against infringement of intellectual property rights by making available to the right holder various remedies. These include:

- injunctions;
- damages, including recovery of profits and expenses; including attorney's fees;



- destruction or other disposal of infringing goods and material/implements for their production;
- any other remedies.

### Injunctions

Under the general jurisdiction of the court and under the various Intellectual Property Laws the courts may grant relief for infringement in the form of an interlocutory or perpetual injunction.

The courts apply the rule that they may grant an interlocutory injunction if the court is satisfied that there is a serious issue to be tried, if the risk of damage to the plaintiff if the injunction is not granted will not be compensated by an order for damages provided that the plaintiff gives an undertaking to compensate the defendant if the injunction is later found by the court to be unjustified.

### Damages, including recovery of profits and expenses; including attorney's fees

Under the general jurisdiction of the court and under the provision of IP laws the courts have powers to award damages for infringement or if the plaintiff desires an account for profit. Under the Copyright Act 1995 the plaintiff cannot be awarded damages in the case of innocent infringement but is entitled to an account of profit. Damages usually include the recovery of commercial losses associated with the infringement and flagrancy of the infringement shall be taken into account in deciding whether additional damages should be awarded. An award of damages would normally be accompanied by an order for payment of legal costs incurred by the successful party. With respect to legal costs the court may order that costs be taxed if not otherwise agreed.

Under such order for costs the successful party will normally recover a sum corresponding to the reasonable sums which were expended in the litigation. If these costs cannot be agreed between the parties such costs are assessed by the Registrar of the Supreme Court.

### Destruction or other disposal of infringing goods and material/implements for their production

The courts have jurisdiction to order defendants to deliver infringing goods and copies as well as materials or implements used in their production. Provisions of the Copyright Act 1995 and the Trademarks Act 2001 allow for the seizure of infringing goods or copies and in the case of the Copyright Act the equipment used for making them. There is also a provision for disposal or destruction of forfeited goods or copies by the Comptroller of Customs.

The Trademarks Act 2001 provides for the Comptroller of Customs to direct the disposal of counterfeit goods which have been seized by the customs authorities. Under the Copyright Act where goods have been seized in accordance with the Copyright (Importation Restriction) Regulations, 2000 their disposal is determined by powers granted under the Customs (Control and Management) Act, 1990

For Patent infringement the court has the power to make an order for the infringer:

"to deliver up or destroy any patented product In relation to which the patent is infringed or any article in which that product is inextricably comprises."

Any other remedies

As alternative to an award of damages the right holder may seek an account of profits instead of damages. This requires the court to assess the profits which the infringer has made as a result of his infringing act and to pay this over to the right holder.

**47. Please explain whether or not your legislation provides for a mechanism to appeal to judicial bodies of final administrative decisions.**

Yes, the legislation provides for appeal to the High Court from decisions of the Registrar of Companies and Intellectual Property within prescribed time periods.

**48. Please describe how your legislation authorizes judges to order production of evidence by the opposing party. Please give precise information on what measures are taken to ensure the protection of confidential information.**

The Courts have the authority to order the production of documents in court by virtue of the Rules of the Supreme Court 1970. A party to litigation has an obligation either automatically or upon order of the Court to give discovery of any documents which it may have in its custody, possession or control which relates to the issues in the proceedings before the Court.

The Court also has the power to make orders at the commencement of proceedings for the protection of evidence in those proceedings if there is a legitimate fear of such evidence being destroyed by granting an Anton Pillar Order.

There are no statutory requirements or directives regarding confidentiality and it is entirely in the court's discretion as to how they will deal with confidential information brought forward as evidence. The onus lies on the party claiming confidentiality of information to apply to the court for the direction as to confidentiality. If the court determines that there is need for the confidentiality of information to be protected it will so order.

Normally, court proceedings in civil matters are opened to members of the public. However, some of the preliminary proceedings may be held "in chambers" i.e. closed to the public. The court also has the power to sit *in camera* i.e. in closed session where it considers it necessary to protect information.

**49. Please quote provisions of your legislation that authorize judges to order a defendant to desist from an infringement.**

All of the existing intellectual property legislation in Saint Lucia make provision for the granting of injunctions for infringement of intellectual property rights. An injunction can be granted to compel the defendant to do something or to refrain from doing an act. Therefore where there has been an infringement, the judge may order that the defendant refrain from doing the infringing act and any other matters which is deemed necessary in the circumstances.

**50. Please quote what provisions of your legislation authorize judges to order the payment to the right holder of adequate damages to compensate the injury he suffered.**

Under the general jurisdiction of the Court, the judge can award damages for infringement of IPRs. Damages usually include recovery of commercial losses associated with the infringement and flagrancy of the infringement shall be taken into account in deciding whether additional damages should be awarded.

In addition, the Court can order an account of profits if requested by the plaintiff. This requires that the court assess the profits which the infringer has made as a result of his infringing act and to pay this over to the right holder.

**51. Please quote what provisions of your legislation authorize judges to order the payment of the right holder's expenses by the infringer.**

Under the general jurisdiction of the Court and under Section 171 Trademarks Act 2001, Section 88 of the Patents Act 2001, Section 14 of the Layout-Designs (Topographies) of Integrated Circuits Act 2000, Section 9 of the Protection Against Unfair Competition Act 2001, Section 22 of the Industrial Designs Act 2001, Section 12 of the Geographical Indications Act 2000, the Court has power to award damages for infringement of intellectual property rights. An award of damages will normally be accompanied by an order for payment of legal costs incurred by the successful party. With respect to legal costs the court may order that costs be taxed if not otherwise agreed.

Under such order for costs the successful party will normally recover a sum corresponding to the reasonable sums which were expended in the litigation. If these costs cannot be agreed between the parties such costs are assessed by the Registrar of the Supreme Court.

**52. Please explain if and how judges have the authority to order that infringing goods are placed outside channels of commerce or destroyed.**

The Supreme Court has the inherent power to make such orders on application by the plaintiff. In fact, the Trademarks Act 2001 provides that the High Court may make any order, that in the circumstances it thinks fit.

**53. Please quote what provisions of your legislation authorize judges to indemnify a defendant in the event of abuse by the plaintiff.**

Where the court orders an interlocutory injunction it is necessary that the plaintiff give the court an undertaking that if the injunction was wrongly granted against the defendant, the plaintiff will pay damages to the defendant. The Court may also require security for such an undertaking to be given by way of deposit of money into the court's funds or by providing a guarantee. This will normally be the case where the plaintiff is residing outside of Saint Lucia.

**54. Please explain how your legislation implements Article 50 the TRIPS Agreement.**

Under the common law system, the Court can exercise the following powers:

- (i) The High Court has power to adjudicate on the enforcement of IPRs and can take provisional measures before the full trial including the grant of interlocutory injunctions.
- (ii) The Court may also grant relief of the type known as an Anton Pillar order after the case has started. Under this order, the defendant is required to admit onto his premises a person named in the order to search for and take into custody any document and any things specified in the order to preserve the evidence for the trial.
- (iii) An application can also be made to the Court for an interim award of damages. The plaintiff must show that it is likely that at full trial a substantial award of damages will be made by the court and that pending the assessment of the issues at trial, there should be an interim payment.

In cases of exceptional urgency, the High Court will order an injunction on an *ex parte* basis. However, this will only be done when the court is of the opinion that an immediate injunction is necessary because otherwise the plaintiff is likely to suffer extreme and irreparable damage. *Ex parte* injunctions are granted to the plaintiff for a matter of days only and must return to the court at the time when the defendant is also present and then seek a renewal of the injunction. Some of the other types of provisional relief such as Anton Pillar Orders and Mareva Injunctions are normally made on an *ex parte* basis in order to surprise the defendant and thereby prevent it from taking steps to evade the relief ultimately to be awarded by the court.

Usually the plaintiff is required to institute the action by filing a writ of summons before applying for provisional measures. In cases of extreme urgency, an *ex parte* injunction may be granted, upon an undertaking by an intended plaintiff to file the writ of summons at the earliest possible opportunity. An *ex parte* injunction may issue, upon the mere production to the Judge of the infringing item, upon Counsel's undertaking to put the supporting evidence of infringement on oath, at the earliest possible opportunity.

Strict guidelines will be given by the Judge granting an *ex parte* injunction for the "return hearing" when the defendant will be afforded an opportunity to be heard. On the return hearing the general principles governing interlocutory injunctions will be applied and also key measures in affording protection to the defendant against damages that he may incur in the event that the provisional measure is proved to be unjustified. These could include undertakings by the plaintiff supported by bond to secure the payment of damages or less commonly by a payment of money into court.

In addition, most of the intellectual property legislation provide for the granting of injunctions by the Court where there has been an infringement of intellectual property rights.

**55. Please identify the competent authorities in your jurisdiction who receive requests from right holders for an application to suspend the release of counterfeit goods by the customs authorities.**

The competent authority is the Comptroller of Customs in Saint Lucia.

**56. Please indicate whether or not procedures are available to suspend the exporting of counterfeit goods.**

No there are no procedures available to suspend the exporting of counterfeit goods under the present legislation.

**57. Please quote what provisions of your legislation authorize the competent authorities to order the destruction or disposal of infringing goods.**

Where goods have been seized in accordance with section 51 of the Copyright Act 1995 and the Copyright (Importation Restriction) Regulations Statutory Instrument 113 of 2000, their disposal is determined by powers granted under the Customs (Control and Management) Act, 1990. Section 139A of the Copyright Act 1995 provides that the court may order the seizure of the equipment used for making the infringing goods.

The Trademarks Act 2001 in Section 122 provides for the Comptroller of Customs to direct the disposal or destruction of counterfeit goods which have been seized by the Customs authorities.

Under the Patents Act 2001, the court has the power to make an order for the infringer to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which the product is inextricably comprised.

**58. Please indicate whether or not your legislation provides for a *de minimis* imports exception.**

No provision is made in the Saint Lucian legislation for a *de minimis* imports exception.

**59. Please explain how your legislation implements Article 61 of the TRIPS Agreement.**

An offence of infringement of copyright is committed under the provisions of section 52 of the Copyright Act 1995. Under this provision, an infringement of any right protected under the Act is committed by a defendant who knows or has reason to believe that he is infringing copyright.

Under section 16 of the Geographical Indications Act the doing of any of the acts in section 12 knowingly and with intent to deceive constitutes an offence.

Under section 22 of the Industrial Designs Act the performance intentionally of an act under section 9 (2) including making, selling, for commercial purposes constitutes an offence.

Under section 15 of the Layout-Designs (Topographies) of Integrated Circuits Act the performance, knowingly of any act under section 6, making, selling or otherwise distributing for commercial purposes constitutes an offence.

The Plant Varieties Act will make provision for criminal proceedings for wilful non-compliance or misuse of variety denomination.

**IV. RESPONSE TO THE QUESTION POSED BY JAPAN**

**A. COPYRIGHT AND RELATED RIGHTS**

**1. Please explain exceptions or exemptions of the national treatment and most-favoured-nation treatment under the Copyright and Neighbouring Rights Law, if any, as permitted in Articles 3 and 4 of the TRIPS Agreement.**

There are no exceptions or exemptions of the national and most-favoured-nation treatment under the Copyright Act of Saint Lucia No. 10 of 1995.

**V. RESPONSES TO QUESTIONS POSED BY SWITZERLAND**

**A. PATENTS**

**1. In your law, are patents available for all categories of products? In particular, are all pharmaceutical products patentable? Are there any exceptions? If so please explain in detail what these exceptions are and how they comply with Article 27 of the TRIPS Agreement.**

No, under the Patents Act 2001, patents are not available for all categories of products. Yes, pharmaceutical products are patentable.

The Act in Section 9 subsection 2 excludes the following things from patentability:

- (a) anything which consists of-
  - (i) a discovery, scientific theory or mathematical method;
  - (ii) a literary dramatic musical or artistic work or any other aesthetic creation whatsoever;
  - (iii) a scheme, rule or method for performing a mental act, playing a game or doing business, or a program for a computer;
  - (iv) the presentation of information; or
- (b) anything which consists of diagnostic, therapeutic and surgical methods for the treatment of humans or animals.

In addition, the Minister responsible for intellectual property may by order published in the Gazette, vary the things excluded from patentability for the purposes of maintaining them in conformity with developments in science and technology.<sup>3</sup>

**2. Does your law, in accordance with Article 27.1 in combination with Article 31 of the TRIPS Agreement, consider importation as "working a patent" (and therefore preclude compulsory licensing, if a product is being imported)?**

Please see the reply to question 4.

**3. Does your law make compulsory licenses subject to all the conditions enumerated in Article 31 of the TRIPS Agreement? Please cite the relevant provisions of law.**

Please see the reply to question 4.

**4. Does your legislation provide for the principle of the reversal of burden of proof in a process patent litigation? Please cite the relevant provisions of law.**

With respect to the above questions, please note that a new Patents Act is currently in the draft stage and consequently information to provide answers to the above questions is unavailable. However, as soon as the new Act has been passed it will be notified to the WTO.

**Follow-up question to responses to questions 2, 3 and 4:**

**You mention that the new Patent Act is currently in the draft stage. Please explain what the draft Act provides in relation to our questions 2, 3 and 4 and when the new regulation is supposed to be adopted.**

**2. Does your law, in accordance with Article 27.1 in combination with Article 31 of the TRIPS Agreement, consider importation as "working a patent" (and therefore preclude compulsory licensing, if a product is being imported)?**

Section 52 of the Patents Act 2001 relates to inventions relating to food or medicine or surgical or curative devices and provides in its subsection 4 that a compulsory licence granted in relation to this area may permit the licensee to import the patented product.

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<sup>3</sup> This replaces the reply circulated in document IP/C/W/237/Add.1.

This only refers to inventions relating to food or medicine or surgical or curative devices and does not appear to apply to other inventions.

**3. Does your law make compulsory licenses subject to all the conditions enumerated in Article 31 of the TRIPS Agreement? Please cite the relevant provisions of law.**

Yes, the legislation does make provision for compulsory licences in Section 51 of the Act. The conditions or grounds which need to be present in order for such a licence to be granted are stated in Section 51 subsection 2 of the Act. These conditions include:

- (a) that there is no production of the patented product or application of the patented process in Saint Lucia without any legitimate reason;
- (b) that there is no product produced in Saint Lucia under the patent for sale in Saint Lucia or there are some but they are sold at unreasonably high prices or do not meet the public demand without legitimate reason;
- (c) that by reason of the refusal of the proprietor of the patent to grant a licence or licences on reasonable terms-
  - (i) a market for the export of any patented product made in Saint Lucia is not being supplied;
  - (ii) the working or efficient working in Saint Lucia of any other patented invention which makes a substantial contribution to the art is prevented or hindered; or
  - (iii) the establishment or development of commercial or industrial activities in Saint Lucia is unfairly prejudiced; or
- (d) that by reason of conditions imposed by the proprietor of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in Saint Lucia, is unfairly prejudiced.

**4. Does your legislation provide for the principle of the reversal of burden of proof in a process patent litigation? Please cite the relevant provisions of law.**

Yes the legislation does provide in section 64 of the Patents Act 2001 for the principle of the reversal of the burden of proof in a process patent litigation.

B. PROTECTION OF UNDISCLOSED INFORMATION

**5. Please explain in detail if your legislation ensures that undisclosed and confidential test data or other data submitted by an applicant to the responsible State agency in the procedure for market authorisation of a pharmaceutical or of an agricultural chemical product is protected against disclosure and against unfair commercial use by a competitor, for example by prohibiting a second applicant from relying on, or from referring to the original data of the first applicant, when applying subsequently for market authorisation for his own product. Does your legislation provide for exceptions to this? If yes, under what conditions would such exceptions apply? Does your legislation provide for a defined period of protection for undisclosed information / for such test data of the first applicant?**

Section 8 (4) of the Protection Against Unfair Competition Act No. 1 of 2001 provides that an act or practice, in the course of industrial or commercial activities, shall be considered an act of unfair competition if it consists or results in:

- (a) an unfair commercial use of secret test or other data, the origination of which involves considerable effort and which have been submitted to a competent authority for the purposes of obtaining approval of the marketing of pharmaceutical or agricultural chemical products which utilize new chemical entities; or
- (b) the disclosure of such data

The exceptions provided are where disclosure is necessary to protect the public and where steps are taken to ensure that data are protected against unfair commercial use.

There is no defined period of protection for undisclosed information.

**VI. RESPONSES TO QUESTIONS POSED BY THE UNITED STATES<sup>4</sup>**

A. GENERAL

**1. (Question 1, IP/C/W/215/Add.1; Question 1, IP/C/W/240) With respect to each form of intellectual property covered by Part II of the TRIPS Agreement, including plant variety protection, please explain the manner in which the laws of Saint Lucia ensure that nationals of other WTO Members receive national treatment and most-favoured-nation treatment as required by Articles 3 and 4 of the TRIPS Agreement. Please cite to the relevant provisions of law.**

Copyright and Related Rights

Section 8 of the Copyright Act 1995 as amended by Section 3 of the Copyright (Amendment) Act 2000 provides that the provisions of the Copyright Act also apply to works that are eligible for protection in Saint Lucia by virtue and in accordance with any international convention or other international agreement to which Saint Lucia is a party. This section makes copyright protection available to any person once the relevant is eligible for protection.

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<sup>4</sup> The United States posed two sets of questions to Saint Lucia in documents IP/C/W/215/Add.1 and IP/C/W/240. Saint Lucia's submitted responses numbered as shown.



### Trademarks

The draft Trademarks Act which is due to be laid before Parliament at its next sitting defines "applicant" as the person in whose name the application is proceeding and makes no exception to who can be an applicant. The Act requires a local attorney-at-law for all applicants whether Saint Lucian or not.

### Geographical Indications

Section 2 of the Geographical Indications Act 2000 defines "applicant" as a person applying under Section 3. Section 3 which deals with applications for registration and contents of the application makes no distinction between nationals of Saint Lucia and nationals of other countries with respect to the requirements.

### Industrial Designs

The Industrial Designs Act 2001 makes no exceptions to the protection granted to nationals of other WTO member states. The Act in Section 20 states that where an applicant's ordinary residence or principal place of business is outside of Saint Lucia, he shall be represented by an attorney-at-law resident and practising in Saint Lucia. This section also supports the fact that application for protection of industrial designs is open to nationals of other countries. Section 23 of the Industrial Designs Act provides that the provisions of any international treaties in respect of industrial property to which Saint Lucia is a party shall apply to all matters dealt with by the Act. In light of this provision, Articles 3 and 4 of the TRIPS Agreement must be adhered to.

### Patents

The draft Patents Act will do away with the automatic registration of United Kingdom patents and will allow for registration and the affording of protection to nationals of other countries same as that afforded to nationals of Saint Lucia.

### Layout-Designs (Topographies) of Integrated Circuits

Section 2 of the Layout-Designs (Topographies) of Integrated Circuit Act 2000 (No. 3 of 2000) defines "right holder; as the person who is to be registered as the beneficiary of the protection referred to in Section 6 of the Act". Section 5 provides that "the right to layout-design protection shall belong to the creator of the layout-design..." These sections make the protection available under the Act open to all creators of layout-designs whether they are nationals or not of Saint Lucia.

### Protection of Undisclosed Information

Protection under the Protection Against Unfair Competition Act (No. 1 of 2001) makes no distinction between national of Saint Lucia and nationals of other countries and offers the same protection to both groups of persons and industrial or commercial enterprise.

B. COPYRIGHT

**2. (Question 2, IP/C/W/215/Add.1; Question 2, IP/C/W/240) Please explain how Saint Lucia's copyright law protects computer programs as literary works and compilations of data as required by Article 10 of the TRIPS Agreement and cite to the relevant provisions.**

Section 7 of the Copyright Act 1995 provides categories of works in which copyright under the Act can subsist and one of these categories is original literary works.

Section 3 defines literary work as any work other than a dramatic or musical work, which is written, spoken or sung, and includes-

- a written table or compilation; and
- a computer programme.

Section 9 goes on to provide the nature of the rights granted to the owner of the copyright in a work for which protection is granted.

**3. (Question 3, IP/C/W/215/Add.1, Question 3, IP/C/W/240) Article 11 of the TRIPS Agreement requires that rental rights be provided for computer programs and cinematographic works in most instances and Article 14.4 requires that rental rights be provided to the producers of phonograms. Please describe how Saint Lucia's law on copyright and neighbouring rights ensures that the required rental rights are provided and cite to the relevant provisions of law.**

Section 9 of the Copyright Act 1995 as amended by the Copyright (Amendment) Act 2000 makes provision for the exclusive rights which the owner of copyright has. In its subsection (e) of section 9 as amended it provides the exclusive right of:

"rental or public lending of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer programme, a data base or a musical work in the form of notation."

Section 9 subsection 2 goes on to provide that the rights of rental and lending do not apply to rental or lending of computer programmes where the programme itself is not the essential object of the rental or lending; or to cinematographic works, unless such commercial rental has led to widespread copying of such works materially impairing the exclusive right of protection.

**4. (Question 4, IP/C/W/215/Add.1) Please identify the term of protection available with respect to works and with respect to each form of neighbouring rights under Saint Lucia's law on copyright and neighbouring rights and cite to the relevant provisions of law.**

The length of protection granted under the Copyright Act 1995 is generally 50 years. The following is a detailed synopsis of the categories of works and term of protection:

- in relation to literary, dramatic, musical or artistic work- 50 years from the end of the year in which the author dies (section 10(1));
- in relation to computer generated work – 50 years from the end of the year in which the work is made;

- in relation to a sound recording or film – 50 years from the end of the year in which it was made;
- in relation to a broadcast or cable programme – 50 years from the end of the year in which the broadcast was made or the programme included in a cable programme service;
- in relation to typographical arrangements of a published edition – 25 years from the end of the year in which the edition was first published.

**5. (Question 5, IP/C/W/215/Add.1) Article 13 of the TRIPS Agreement obliges WTO Members to confine any limitations or exceptions to copyrights to certain special cases that do not conflict with the normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder. Please describe any and all limitations and exceptions to copyrights provided under Saint Lucia's law on copyrights and neighbouring rights and cite to the relevant provision of law. Please indicate how Saint Lucia ensures that those limitations and exceptions do not conflict with the normal exploitation of works and do not unreasonably prejudice the legitimate interests of the right holder.**

Limitations and exceptions to copyrights under the Copyright Act 1995:

- for the purpose of research and private study (section 56)
- for the purpose of criticism, review and reporting (section 57) if accompanied by a sufficient acknowledgement
- where there is incidental inclusion of a protected work (section 59)
- where it is not possible to ascertain the identity of the author and it is reasonable to assume that the copyright has expired or the author died 50 years or more before (section 60)
- use of notes for recording of spoken words for the purpose of reporting current events (section 61)
- acts done for the purposes of instruction or examination (section 62)
- the inclusion of a short passage from a published literary or dramatic work, in a collection for use in educational institutions (anthologies) (section 63)
- performing, playing or showing works in the course of educational activities (section 64)
- recording by or on behalf of an educational establishment for the purposes of that establishment (section 65)
- reprographic copies of passages from published literary, dramatic or musical works made by or on behalf of an educational establishment for the purpose of instruction provided that not more than 1 % of any work may not be copied in any quarter (section 66)
- supply by libraries of copies of published works (section 69)

- recording of works for archival purposes (section 73 )
- for the purposes of parliamentary or judicial proceedings and for the purpose of reporting such proceedings (section 74)
- making or supplying copies of public records (section 75)
- transfer of works in electronic form subject to any express terms prohibiting such transfer or otherwise (section 78)
- reading and recitation in public (section 80)
- representations of artistic works on public display (section 81)
- anything done for the purposes of reconstructing a building (section 82)
- recording for the purpose of time shifting (section 85)

The Act speaks to fair dealing with a work. Sections 57 and 58 state what factors would be taken into account to determine whether an act constitutes fair dealing. One such factor is the effect of the act upon the potential market for or the commercial value of the work. Provision is also made for the overriding of some exceptions where there are express contractual terms to the contrary.

**6. (Question 5, IP/C/W/240) Please describe the protection the copyright law of Saint Lucia provides for performers, and the term of the protection. (Question 6, IP/C/W/215/Add.1) Please describe in detail the rights provided under Saint Lucia's law on copyright and neighbouring rights to performers, broadcasters and producers of phonograms and cite to the relevant provisions of law.**

A performer enjoys the right to consent to the exploitation of his performance and to be paid royalties for use of the performance. Performers also have rights conferred by section 9 as amended of the 1995 Act, i.e. making a recording of the whole or any substantial part of the performance, broadcasting live the whole of any substantial part of a performance, showing or playing in public the whole or any substantial part of a performance, using an original recording of a performance for the purpose of making an adaptation of the recording.

In addition, performers and broadcasters enjoy the following rights to do, authorize or prohibit the following acts granted by section 9 as amended by section 4 of the Copyright (Amendment) Act:

- reproduction of the work;
- translation of the work;
- adaptation, arrangement or other transformation of the work;
- the first public distribution of the original and each copy of the work by sale, rental or otherwise;
- rental or public lending of the original or a copy of an audiovisual work, a work embodied in the form of notation, irrespective of the ownership of the original or copy concerned;
- importation of copies of the work;

- public display of the work;
- public performance of the work;
- communication to the public of the work.

Producers of phonograms have the right to be identified as the performer of a performance and to object to any distortion, mutilation or other modification of his or her performance that would be prejudicial to his or her reputation.

**7. (Question 6, IP/C/W/240) Article 14.2 of the TRIPS Agreement provides that producers of phonograms are to enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms. Article 14.2 requires that producers of phonograms are to have the right to authorize or prohibit the commercial rental to the public of originals or copies of their phonograms. Please describe how the copyright law of Saint Lucia implements these obligations and indicate the term of protection.**

Section 9 of the Copyright Act as amended by the Copyright (Amendment) Act provides that owners of copyright have the exclusive right to do, authorize or prohibit in subsection (a) reproduction of the work and in subsection (e) rental or public lending of the original or a copy of an audiovisual work, a work embodied in a sound recording, a computer programme, a data base or a musical work in the form of notation, irrespective of the ownership of the original or copy concerned.

Term of protection: 50 years from the end of the year in which it was made.

**8. (Question 7, IP/C/W/215/Add.1) Article 18 of the Berne Convention, as incorporated into the TRIPS Agreement by Article 9.1 of the TRIPS Agreement requires that copyright be restored for works that are still are protected under copyright in their country of origin and have not had a full term or protection in Saint Lucia. Please describe in detail how Saint Lucia has implemented this obligation and cite to the relevant provisions of law.**

Section 8 as amended by the Copyright (Amendment) Act 2000 provides in subsection (9) provides that the Act applies to works which are eligible for protection in Saint Lucia by virtue and in accordance with any international convention or other international agreement to which saint Lucia is a party. Saint Lucia is a party to the Berne Convention and so by virtue of Section 8 of the Act, Article 18 applies.

**9. (Question 8, IP/C/W/215/Add.1) Article 14.6 of the TRIPS Agreement requires that protection be restored for phonograms that are still under protection of copyright or neighbouring rights law in their country of origin and that have not had a full term of protection in Saint Lucia. Please describe in detail how Saint Lucia has implemented this obligation and cite to the relevant provisions of law.**

Section 8 as amended by the Copyright (Amendment) Act 2000 provides in subsection (9) provides that the Act applies to works which are eligible for protection in Saint Lucia by virtue and in accordance with any international convention or other international agreement to which saint Lucia is a party. Saint Lucia is a party to the TRIPS Agreement and so by virtue of Section 8 of the Act, Article 14.6 applies.

C. TRADEMARKS

**10. (Question 9, IP/C/W/215/Add.1; Question 7, IP/C/W/240) Please describe in detail the subject-matter that can comprise a trademark under Saint Lucia's trademark law and cite to the relevant provisions of law.**

The draft Trademarks Act provides in Section 2 for the following subject matter to comprise a trademark: letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, and any combination thereof.

**11. (Question 10, IP/C/W/215/Add.1; Question 8, IP/C/W/240) Please describe in detail the procedure that must be followed to register a trademark in Saint Lucia, citing the relevant provisions of the trademark law and describe the rights that the owner of a registered mark acquires with registration.**

Procedure for registration of trademark

Section 11 of the draft Act deals with making of the application for registration of a trademark.

- Application may be made in respect of goods or services or both in the prescribed form (to be contained in the Trademark Regulations) if the person applying claims to be owner of the trademark, and uses or intends to use, or has authorized or intends to authorize another person to use or intends to assign the trademark in relation to the goods or services or both.
- All applications must be accompanied by six additional representations of the mark section 11(2)(a).
- The classification and the respective goods and services for which registration of the mark is being sought must be listed in the application (classification is according to the Nice Classification).
- Application to be accompanied by an authorization of agent appointing an attorney-at-law to file an application for registration.
- Application fee to be paid at the time of filing of the application.
- Notice that application has been made to be published in the Official Gazette by the Registrar.
- The application will then be examined by the Registrar (section 15) before acceptance or refusal. The applicant may be invited to amend the application. The decision to accept or refuse an application is to be published in the Official Gazette (section 18) and where the mark has been accepted, a period of 3 months will be allowed for oppositions (section 36). If there are no oppositions after the 3-month period, a certificate of registration will be issued.

The rights which a trademark owner acquires with registration are provided for in Section 4 of the draft Act. That section provides that the registered owner of a trademark has the exclusive rights (1) to use the trademark; (2) to authorize other persons to use the trademark in relation to goods or services or both in respect of which the trademark is registered; and (3) to obtain relief under the Act

if the trademark has been infringed.

**12. (Question 9, IP/C/W/240) Please provide the length and terms of protection that the trademark law of Saint Lucia provides for a trademark.**

The term of protection provided by the draft Trademarks Act for trademarks is 10 years from the filing date.

**13. (Question 11, IP/C/W/215/Add.1) Please explain in detail how Saint Lucia's trademark and other laws provide for the protection of well-known trademarks and service marks, citing the relevant provisions of law.**

The draft Trademarks Act in Division 2 (Grounds for opposing registration) section 44 speaks to marks that have acquired a reputation. Registration of a mark can be opposed on the ground that it is substantially identical with or deceptively similar to a trademark that has acquired a reputation in Saint Lucia and because of that reputation, registration of the mark would be likely to deceive or cause confusion.

**14. (Question 12, IP/C/W/215/Add.1) Please describe in detail any limitations or special requirements that apply to trademark rights under Saint Lucia's laws and indicate how those limitations take account of the legitimate interests of the owner of the trademark and of third parties.**

Limitations or special requirements that apply to trademark rights

The only limitations specified relate to limitations of the exclusive right to use a trademark including limitation of that right as to:

- colour
- mode of use
- use in Saint Lucia
- use in relation to goods or services to be exported

Section 7 of the draft Act refers to limitations on rights for similar trademarks and provides that if trademarks which are identical 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 trademarks cannot prevent the registered owner of the other trademark from using that trademark except to the extent that the first mentioned owner is authorized to do so under the registration of his or her mark.

These limitations do not interfere with the legitimate interests of the owner of the trademark nor with the interests of third parties as the Act makes provision for appeal against a decision by the Registrar to accept an application for the registration of a trademark subject to limitations.

**15. (Question 13, IP/C/W/215/Add.1) Please indicate the length of the initial term of protection for a registered trademark under Saint Lucia's trademark law and describe the conditions for renewing the registration and the period of the renewal. Please cite to the relevant provisions of Saint Lucia's law.**

Length of the initial term of protection for a registered trademark is 10 years (section 56(3), draft Act).

The registration of a trademark may be renewed within the prescribed period i.e. one month before the registration of the trademark expires and is renewable for a period of ten years from the day on which the registration of the trademark would expire if it were not renewed. (Sections 59 and 61(1), draft Act).

If renewal does not take place within the time specified above, application for renewal may be made within one year after registration of the mark expires (section 63, draft Act).

**16. (Question 10, IP/C/W/240) Please explain whether the laws of Saint Lucia protect pre-existing trademarks against usurpation by geographical indications, as required by Article 24 of the TRIPS Agreement.**

Section 45 of the draft Trademarks Act makes provision for opposition to the registration of a mark if the trademark contains or consists of a sign that is a geographical indication for other goods.

However, subsection (2) of section 45 in sub-paragraph (c) of the draft Act provides that an opposition on the ground referred to above will fail if 'the applicant, or a predecessor in title of the applicant, used the sign in good faith in respect to goods or applied in good faith for registration of the mark before (a) the commencement of the Act; or (b) the day on which the sign was recognized as a geographical indication for goods in their country of origin; whichever is later.

**17. (Question 11, IP/C/W/240) Please describe in detail how the laws of Saint Lucia provide for the recognition and protection of geographical indications required by Article 22.2 of the TRIPS Agreement, citing to the relevant provisions of law or regulation, and provide examples of geographical indications so protected.**

Section 45(1) of the draft Act provides for the protection of geographical indications by making provision for a trademark application to be opposed on the ground that it contains or consists of a sign that is a geographical indication for other goods.

There are at present no geographical indications protected under the Geographical Indications Act of Saint Lucia. It should also be noted that Section 17 of the Geographical Indications Act (No. 4 of 2000) provides that the Registrar shall on his own or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in Saint Lucia is of such a nature as to mislead the public as to the true place of origin.

**18. (Question 12, IP/C/W/240) Please describe in detail the manner in which the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement is implemented, citing to the relevant provisions of law or regulation, and provide examples of geographical indications for such products.**

Section 45(2)(d) of the draft Trademarks Act provides that an application on the ground that the trademark contains or consists of a geographical indication for other goods fails if it is established that if the registration of the trademark is being sought in respect of wines and spirits and the sign is identical with the name that, on the date of commencement of the Act, was, in the country in which the wines and spirits originated, the customary name of a variety of grapes used in the production of the other wine or spirit.

There are at present no geographical indications registered for such products. Section 18 of the Geographical Indications Act should be noted since it provides that the registration of a trademark for wines and spirits which contains or consists of a geographical indication identifying wines or a



trademark for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Registrar with respect to such wines and spirits not having this origin.

D. GEOGRAPHICAL INDICATIONS

**19. (Question 14, IP/C/W/215/Add.1) Please describe in detail how and under what laws geographical indications are protected in Saint Lucia and cite to the relevant provisions of law.**

Geographical Indications are protected under the Geographical Indications Act No. 4 of 2000. The Act in Part III makes provision for the protection of geographical indications by way of civil proceedings. In Section 12 of the Act, provision is made by way of Court proceedings for the prevention in relation to geographical indications of

- the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good;
- any use which constitutes an act of unfair competition;
- the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indications in question.

Protection of geographical indications under the Geographical Indications Act is available regardless of whether the geographical indication has been registered. But registration under the Act raises a presumption that such indication is a geographical indication.

**20. (Question 15, IP/C/W/215/Add.1) Does the law of Saint Lucia regarding geographical indications provide for any of the exceptions to protection of geographical indications contained in Article 24 of the TRIPS Agreement, and, if so, please describe the way in which the exception is applied and cite to the relevant provisions of law.**

The Geographical Indications Act in section 15(c) makes provision for the exception to protection of geographical indications contained in Article 24.9 by stating that geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country shall be excluded from protection under the Act.

Section 19 of this Act embodies the exceptions as stated in paragraphs 4, 5, 6, 7 and 8 of Article 24 of the TRIPS Agreement.

This Act came into force in May 2000 and application of its provisions is very limited.

E. INDUSTRIAL DESIGNS

**21. (Question 16, IP/C/W/215/Add.1) Please describe in detail the way in which industrial designs, including textile designs, are protected under Saint Lucia's laws and cite to the relevant provisions of law.**

Industrial designs are protected under the Industrial Designs Act which confers on the registered owner of a registered industrial design. The protection offered is as follows: (section 9)

- against exploitation of a registered industrial design in Saint Lucia by another person other than the registered owner without the agreement of the registered owner. Exploitation in this context means making, selling, importing or otherwise distributing, for commercial purposes, articles embodying a design which is a copy or substantially a copy of the industrial design.
- the right to institute court proceedings against any person who infringes the registration of the industrial design by making, selling, importing or otherwise distributing, for commercial purposes, articles embodying a design without the agreement of the registered owner or who performs acts which make it likely that infringement will occur.

Protection is granted for a period of 5 years from the filing date of the application for registration of an industrial design and may be renewed for two further consecutive periods of 5 years.

**22. (Question 13, IP/C/W/240) Please describe the procedure that must be followed to obtain protection for industrial designs, citing to the provisions of the law of Saint Lucia, and describe the nature of the protection provided.**

Procedure to obtain protection for industrial designs as follows. Application is to be made to the Registrar of Companies and Intellectual Property and must contain:

- a request
- drawings
- photographs or other adequate graphic representations of the article embodying the industrial design
- indication of the kind of products for which industrial design is to be used
- a specimen of the article embodying the industrial design where the industrial design is two dimensional.

The prescribed fee is to be paid on filing. The date of receipt of the application is the filing date. The application is then examined by the Registrar for compliance with the above requirements and to ascertain that the industrial design represented is a registrable one pursuant to sections 3 and 4 of the Act. (section 7)

Once the conditions are fulfilled, the Registrar shall register the industrial design and publish a reference to the registration and issue a certificate of registration of the industrial design. (section 8)

The nature of the protection afforded by the Act in respect of industrial designs is as was detailed in the response to question 21 above.

**23. (Question 14, IP/C/W/240) Please describe the procedure that must be followed to obtain protection for textile designs and cite to the relevant provisions of law or regulation.**

The Industrial Designs Act does not make a distinction between industrial and textile designs and the same procedure described in the answer to Question 22 would apply.

F. PATENTS

**24. (Question 17, IP/C/W/215/Add.1) Please explain whether or not inventions within the categories specified below are eligible to be patented under Saint Lucia's law if they are otherwise novel, involve an inventive step, and are industrially applicable:**

- (a) process inventions which, in whole or in part, consist of steps that are performed by a computer and are directed by a computer program;**
- (b) product inventions consisting of elements of a computer-implemented invention including:**
  - (i) machine-readable computer program code stored on a tangible medium such as a floppy disk, computer hard drive or computer memory; or**
  - (ii) a general purpose computer whose novelty over the prior art arises primarily due to its combination with a specific computer program;**
- (c) process inventions that facilitate the conduct of business;**
- (d) a micro-organisms.**

Section 9 (2) of the Patents Act 2001 lists the things which are not inventions for the purpose of the Act and so cannot be patented. These are:

- anything which consists of a discovery, scientific theory or mathematical method;
- a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- a scheme, rule or method for performing a mental act, playing a game or doing business, or a programme for a computer;
- the presentation of information;

**25. (Question 18, IP/C/W/215/Add.1) Please identify any exceptions to the rights conferred by a patent in Saint Lucia and indicate the manner in which the law of Saint Lucia ensures that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.**

The Act in section 57 identifies exceptions to the rights conferred by a patent by providing for use of patented inventions for services of Government i.e. the doing of certain acts in Saint Lucia without the consent of the proprietor of the patent, e.g. where the invention is a product, make, use, import, obtain or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing, obtaining or keeping it.

Section 57 (1) further provides that anything done by virtue of this section shall not amount to an infringement of the product. The Act goes on to define in Section 58 what "services of the Government" referred to in section 57 relate to and states that it includes:

- the supply of anything for foreign defence purposes

- the production or supply of drugs and medicines required for the provision of pharmaceutical, medical or dental services in any prescribed dispensary, hospital or other medicinal institution maintained by or on behalf of the Government and any dispensary, hospital or medical institution which the Minister may specify by notification in the Gazette.

Section 59 of the Act deals with the rights of third parties in respect of Government use.

**26. (Question 19, IP/C/W/215/Add.1) Please describe any provisions for compulsory licensing of patents in Saint Lucia's law and explain how Saint Lucia ensures that each of the conditions in Article 31 of the TRIPS Agreement is met in relation to any compulsory licences. Please cite to the relevant provisions of law.**

Section 51 of the Patents Act 2001 makes provision for compulsory licences and lists in subsection (2) the conditions/grounds which must be met before a compulsory licence can be granted.

**27. (Question 20, IP/C/W/215/Add.1) Please indicate the number of compulsory licences issued under Saint Lucia's patent law in each of the last five years.**

The Patents Act 2001 is a new piece of legislation which has been passed and is not yet in force. Therefore there has been no administering of the legislation and consequently no compulsory licences have been issued.

Whereas there existed a provision for compulsory licences under the Commercial Code, there is no record of such licences being issued.

**28. (Question 21, IP/C/W/215/Add.1) Article 33 of the TRIPS Agreement requires that patents have a term of protection that does not end before a period of twenty years measured from the date of filing. Please describe the term of protection for patents available under Saint Lucia's patent law and indicate if there is any variation in that term, based upon the area of technology to which the patent relates. If so, please indicate what the variations are and for what technologies and describe Saint Lucia's plans to bring its law into compliance with Article 27.1, which prohibits discrimination in the enjoyment of patent rights based on the field of technology.**

The term of protection as provided by section 32 of the Patents Act 2001 is twenty years. There exists no variation in the term based upon the area of technology to which the patent relates.

**29. (Question 22, IP/C/W/215/Add.1) Please verify that the terms of all patents in existence in Saint Lucia on 1 January 2000, will not end before the expiration a period of twenty years measured from the date of filing.**

Section 110 (2) provides that existing patents expire on the day on which it would have expired under the old law relating to patents. Patents in existence in Saint Lucia before 1 January 2000, comprise mainly United Kingdom registered patents and carry the same term of protection as the UK patent i.e. 20 years.

**30. (Question 23, IP/C/W/215/Add.1) Please describe in detail the manner in which plant varieties are protected under Saint Lucia's laws and cite to the relevant provisions.**

Plant Varieties is to be protected by a separate piece of legislation viz: Plant Varieties Act. This Act is to be passed by Parliament in the short term.

**31. (Question 15, IP/C/W/240) Please describe in detail the way in which the patent law of Saint Lucia implements Article 27 of the TRIPS Agreement, indicating any exceptions provided for, and including details regarding the protection for micro-organisms and non-biological and microbiological processes and plant varieties. Please cite to the relevant provisions of the law.**

The Patents Act 2001 in section 9 provides certain exceptions with regard to inventions which can be patented as detailed in Question 24 above. As far as plant varieties this will be protected by separate legislation. The Patents Act 2001 does not make specific reference to micro-organisms and non-biological processes and does not exempt these from patentability.

**32. (Question 16, IP/C/W/240) Please describe in detail the rights provided patent holders under the patent law of Saint Lucia and cite to the relevant provisions of law.**

The Patents Act 2001 provides that a patent is personal property and therefore any rights in or under the patent which accrue to the patent holder can transferred, created or granted. These rights can also be assigned or mortgaged. The patent holder can also grant licenses for the use of the patent to persons.

**33. (Question 17, IP/C/W/240) Please describe in detail any provisions in the laws of Saint Lucia permitting unauthorized use of a patent, citing to the relevant provisions of law, and describe in detail the conditions under which such use can occur.**

Section 57 of the Patents Act 2001 provides for the use of patented inventions without the consent of the proprietor of the patent for services of Government. The provision is very specific as to the conditions under which such use can be made e.g. where the invention is a product, make, use, import, obtain or keep the product, or sell or offer to sell it where to do so would be incidental or ancillary to making, using, importing, obtaining or keeping it; or in any event, sell or offer to sell it for defence purposes or for the production or supply of any drug and medicine, or dispose or offer to dispose of it for any purpose whatever.

**34. (Question 18, IP/C/W/240) What term of protection does the patent law of Saint Lucia provide for patents? Please describe any provisions for extension of the term of protection and cite to the relevant provisions of the law.**

The Patents Act 2001 provides a twenty (20) year term of protection for patents. Section 32 of the Act provides for renewal at the expiration of the twenty (20) year period.

G. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

**35. (Question 24, IP/C/W/215/Add.1) Please describe in detail how Saint Lucia implements the obligations of Section 6, Part II of the TRIPS Agreement and cite to relevant provisions of law.**

Section 19 of the Layout-Designs (Topographies) of Integrated Circuits Act No. 3 of 2000 implements Article 35 of the TRIPS Agreement by providing that the provisions of any international treaty in respect of intellectual property to which Saint Lucia is a party shall apply to matters dealt with by the Act. It should be noted that Saint Lucia recently deposited instruments of accession to the Treaty on Intellectual Property in Respect of Integrated Circuits.

Section 6(2) of the Act incorporates Article 36 of the TRIPS Agreement with regard to the scope of protection for integrated circuits and consider certain acts unlawful if performed without the authorization of the right holder i.e. reproducing, importing, selling or otherwise distributing for commercial purposes the protected layout-design.

Section 6(3) incorporates Article 37 of the TRIPS Agreement with respect to certain situations which would not be unlawful when looking at the affect of protection.

Section 6(4) incorporates the provision regarding liability to pay the right holder a sum equivalent to a reasonable royalty where a person is aware that a layout-design was unlawfully reproduced.

Section 7 implements Article 38 of the TRIPS Agreement and the term of protection provided under that section is 10 years from (i) the date of the first commercial exploitation anywhere in the world of the layout-design where the application is filed within two years of the commercial exploitation or (ii) the filing date if there has been no previous commercial exploitation.

**36. (Question 19, IP/C/W/240) Please describe in detail the protection for layout-designs of integrated circuits provided under the laws of Saint Lucia, including the term of protection, and cite to the relevant provisions of law.**

Protection for layout-designs under the Layout-Designs (Topographies) of Integrated Circuits Act No. 3 of 2000 may be obtained for layout-designs of integrated circuits if they are original. Protection is not available for layout-designs which have been commercially exploited, anywhere in the world, for more than two years prior to the entry into force of the Act (Section 3).

Protection under the Act does not depend upon whether or not the integrated circuit which incorporates the protected layout-design is itself incorporated in an article (Section 6 (ii)).

The protection offered according to section 6 (2) of the Act has the effect of rendering certain acts unlawful if performed without the authorization of the right holder. These acts are as follows:

- reproducing the protected layout-design in its entirety or any part thereof;
- importing, selling or otherwise distributing for commercial purposes the protected layout-design, an integrated circuit in which the protected layout-design is incorporated or an article incorporating such an integrated circuit in so far as it continues to contain an unlawfully reproduced layout-design.

The term of protection is 10 years (section 7).

#### H. PROTECTION OF UNDISCLOSED INFORMATION

**37. (Question 25, IP/C/W/215/Add.1) Paragraph 2 of Article 39 of the TRIPS Agreement requires Members to provide protection for all undisclosed information, including technical know-how and commercial information, which meets certain criteria. This protection must endure as long as the conditions identified in paragraph 2 of Article 39 are met and protection cannot be conditioned on registration. Please explain how Saint Lucia fulfils this obligation and cite to the relevant provisions of law.**

Section 8 of the Protection Against Unfair Competition Act 2001 provides that an act or practice in the course of industrial or commercial activities that results in the disclosure, acquisition or use by others of trade secrets without the consent of the person lawfully in control of that information and in a manner contrary to honest commercial practices constitutes an act of unfair competition. Subsection (3) details what is considered a trade secret for the purpose of the Act and basically embodies Article 39.2(a)-(c) of the TRIPS Agreement.

**38. (Question 21, IP/C/W/240) Please describe in detail the manner in which protection is provided test data regarding pharmaceutical and agricultural chemical products submitted to the government in order to obtain marketing approval in Saint Lucia and cite to the relevant provisions of law**

Section 8 (4) of the Act makes provision for an act or practice which is considered an act of unfair competition if it consists or results in:

An unfair commercial use of secret test or other data, the origination of which involves considerable effort and which have been submitted to a competent authority for the purposes of obtaining approval of the marketing of pharmaceutical or agricultural chemical products which utilize new chemical entities; or the disclosure of such data.

Protection is granted to the right holder by the provision for action to be taken against the infringer.

**39. (Question 22, IP/C/W/240) Are other applicants for marketing approval for their own versions of a previously approved pharmaceutical or agricultural chemical products permitted to rely on data submitted by the earlier applicant? If so, how long a period of exclusivity is given the earlier applicant before such reliance becomes possible.**

There is no specific provision in the Act which deals with the above issue.

#### I. ENFORCEMENT

**40. (Question 26, IP/C/W/215/Add.1) What measures, as required by Article 42 of the TRIPS Agreement, are taken by judicial authorities in Saint Lucia to protect the confidentiality of undisclosed information furnished by a party during legal proceedings to enforce rights in such information, or for other purposes.**

There are no specific provisions dealing with this issue under the Act and it may be left to the Court to decide that for the purposes of the legal proceedings, that it be held in camera.

**41. (Question 23, IP/C/W/240) Please describe in detail the manner in which the laws of Saint Lucia provide for effective action against infringement of intellectual property rights as required by Article 41.1 of the TRIPS Agreement.**

The system of enforcement of all rights including intellectual property rights is provided through a combination of legislation and common law. The various pieces of legislation make specific procedure and remedies available for infringement of the various forms of intellectual property rights.

**42. (Question 28, IP/C/W/215/Add.1) Please describe in detail what civil actions and what civil remedies are available under Saint Lucia's laws to right holders of each kind of intellectual property covered by Part II of the TRIPS Agreement, including plant variety protection, that permit effective action against any act of infringement to prevent infringement and deter further infringement, and cite to the provisions of law providing for those remedies.**

#### Copyright and Related Rights

Infringement of copyright is actionable in the High Court at the instance of the copyright owner. (Section 36 Copyright Act)

Remedies available: damages, injunction, accounts, all other remedies available in any corresponding proceedings in respect of the infringements of other proprietary rights (section 36); order for delivery up of infringing material (section 37), right to seize infringing works after due notice has been given (section 38); order for the impounding of copies of works or sound recordings suspected of being made or imported without the authorization of the owner of any right protected under the Act where the making or importation of copies is subject to such authorization, as well as the impounding of the packaging of, the implements that could be used for the making of, and the documents, accounts or business papers referring to such copies; order for the forfeiture and seizure of all plates, moulds, matrices, masters, tapes, film negatives, or other articles by means of which such copies of works or sound recordings may be reproduced, and all electronic, mechanical or other devices for manufacturing, reproducing, or assembling such copies of works or sound recordings; (section 139A).

In the case of infringement of moral rights, action can be brought for breach of statutory duty (section 46).

### Trademarks

Remedies: injunction, subject to any condition that the court may impose; damages, accounts (section 109 draft Trademarks Act)

### Geographical Indications

Any interested person may institute proceedings in the Court to prevent in relation to a geographical indication:

- the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good;
- any use which constitutes an act of unfair competition;
- the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question;

Remedies available: injunction, an award of damages or any other remedy which the Court deems fit. (Section 12 Geographical Indications Act No. 4 of 2000)

### Industrial Designs

The owner of a registered design can institute court proceedings against a person who infringes the registration of his industrial design.

Remedies available: injunction, damages and any other remedy which the Court thinks fit. (Sections 9 (4) and 22 Industrial Designs Act No. 3 of 2001)



## Patents

The draft Patents Act will make provision for the right of the owner of patent in respect of which there has been infringement to bring civil proceedings and obtain the following relief:

Injunction, delivery up or destruction of any patented product in relation to which the patent is infringed, damages, account of profits, declaration that patent is valid and has been infringed by the defendant.

## Layout-Designs (Topographies) of Integrated Circuits

Court proceedings can be instituted where there has been infringement of a layout-design by the right holder. The remedies available are: injunction, damages or any remedy provided for in general law. (Layout-Designs (Topographies) of Integrated Circuits Act No. 3 of 2000)

## Protection of Undisclosed Information

Remedies available for prejudice suffered as a result of unfair competition are the remedies obtained under civil law such as injunctions, declarations and damages.

**43. (Question 29, IP/C/W/215/Add.1) Please state whether decisions on the merit in court proceedings are provided in writing and if those written opinions are available to the public so that people can become familiar with the law.**

Yes, decisions from court proceedings are provided in writing and are available to the public on request.

**44. (Question 24, IP/C/W/240) Article 43.1 of the TRIPS Agreement requires that judges be authorized to order production of evidence necessary to substantiate a party's claims where that party has been unable to obtain such evidence from the opposing party. Please describe how the laws or regulations of Saint Lucia provide this authorization, citing to the relevant provisions of law or regulation.**

The Courts have the authority to order the production of documents in court by virtue of the Rules of the Supreme Court 1970. A party to litigation has an obligation to (either automatically or by order of the Court to give "discovery" of such documents which it may have in its possession, custody or control which relate to the particular court proceeding. The Court can also make orders (by way of an Anton Pillar injunction) at the beginning of the proceedings for the protection of evidence and to prevent any possibility of evidence not being available if there is a fear that the defendant may destroy the evidence.

**45. (Question 26, IP/C/W/240) Please describe in detail the provisional procedures and remedies available to right holders under the laws of Saint Lucia, citing to the relevant provisions of law and regulation, and indicate any condition under which a right holder may avail itself of those procedures and remedies.**

Under the Common Law system which operates in Saint Lucia the following provisional procedures and remedies are available:

- (i) The High Court may before full trial of the matter on the merits grant an interim or interlocutory injunction;

- (ii) The Court may grant an Anton Pillar Order. This order allows for the preservation of evidence where there is a fear that the defendant will destroy the evidence. The order allows a person designated by the Court to enter the defendant's premises to search for and take into custody any document or thing which may be vital to the case before the Court;
- (iii) The Court can also grant a Mareva injunction which allows the freezing of the defendant's assets pending the outcome of the trial;
- (iv) The Court may also grant an interim award of damages.

**46. (Question 31, IP/C/W/215/Add.1) Please describe in detail the procedures under Saint Lucia's laws, at least with respect to counterfeit trademarked goods and pirated copyrighted works, that allow right holders to request customs authorities not to release goods into free circulation and cite to the relevant provisions of law. Please indicate if the customs authorities have ex officio authority to take such action.**

#### Copyright

Under the Copyright Act No. 10 of 1995 and the Copyright (Importation Restriction) Regulations S.I. 113 of 2000, the owner of copyright in any published work or film or sound recording may give notice in writing to the Comptroller of Customs that he wishes the Comptroller during a specified period to treat as prohibited goods copies of a work, film or sound recording. The specified period is not to exceed 5 years. (Section 51 Principal Act)

The form of notice to be used is contained in the Copyright (Importation Restriction) Regulations and must contain a declaration by the signatory that the information contained in the notice is true.

A fee of \$100.00 is to be paid to the Comptroller at the time of sending in the notice.

The person giving the notice must furnish the Comptroller with the following at the time the notice is given: a copy of the work, film or sound recording specified in the notice and such evidence as is reasonably required by the Comptroller to establish:

- (a) the person's ownership of the copyright in the work;
- (b) that the goods detained are infringing goods;
- (c) that a person who has signed the notice as agent is duly authorized.

The person giving the notice must give security in such a manner as the Comptroller may require in respect of any liability or expense which he may incur in consequence of the notice by reason of the detention of any article or anything done to an article detained.

By reason of the provisions of section 51 and the Importation Restriction Regulations, infringing goods may be treated as prohibited goods under the Customs (Control and Management) Act 1990 and are therefore liable to seizure.

## Trademarks

The draft Trademarks Act makes provision in section 114 for the Comptroller of Customs to seize and deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered. The section refers to goods manufactured outside of Saint Lucia that are imported into Saint Lucia and are subject to the control of Customs.

Section 116 allows the Comptroller of Customs to seize goods:

- (a) which have applied to them a sign which in the opinion of the Comptroller is identical with or deceptively similar to a notified trademark; and
- (b) are goods in respect of which the notified trademark is registered.

Section 115 allows the registered owner of a trademark to give notice to the Comptroller of Customs objecting to the importation after the date of the notice of goods that infringe the trademark.

The effect of these provisions is that the Comptroller may seize any counterfeit goods.

The competent authority is the Customs & Excise department.

**47. (Question 32, IP/C/W/215/Add.1) Please indicate whether border enforcement is available with regard to other forms of intellectual property rights and cite to the relevant provisions of law.**

Under the law relating to other forms of intellectual property, border enforcement is not available to other forms of intellectual property apart from those listed in Question 46.

**48. (Question 29, IP/C/W/240) Article 58 of the TRIPS Agreement specifies procedures to be followed where the competent authorities can act ex officio. Please explain whether the competent authorities in Saint Lucia are empowered to act ex officio and, if so, please identify the intellectual property areas subject to ex officio action.**

There is no provision which allows competent authorities to act ex officio under the intellectual property legislation of Saint Lucia. All actions must be initiated by the right holder.

**49. (Question 33, IP/C/W/215/Add.1) Please describe in detail how Saint Lucia implements the remaining provisions of Section 4 of Part III of the TRIPS Agreement, citing to the relevant provisions of law.**

Sections 117-126 of the draft Trademarks Act implement Articles 53-57 of the TRIPS Agreement and make provision for the Comptroller of Customs to give notice of seizure to the designated owner. Section 120 makes provision for the indemnification of the designated owner/importer by the person who filed the notice where the court finds that there has been no infringement of a trademark by the imported goods and as a result of the seizure the designated owner has suffered loss. Section 126 gives the Comptroller power to require information from the importer of the goods.

The Copyright Act and the Importation Restriction Regulations have similar provisions.

**50. (Question 30, IP/C/W240) Please describe in detail how the laws of Saint Lucia implement Article 61 of the TRIPS Agreement that requires Members to have criminal procedures and penalties, including imprisonment and/or monetary fines sufficient to act as a deterrent, at least for cases of wilful trademark counterfeiting and copyright infringement on a commercial scale. Please cite to the relevant provisions of law and regulation.**

#### Copyright

Section 52 of the Copyright Act makes it a criminal offence to do certain acts (subsections (a)-(e)) without the licence or authorization of the copyright owner: e.g.

- (a) making for sale or hire;
- (b) in the course of business selling or letting for hire, or offering or exposing for sale or hire, exhibiting in public or distributing;
- (c) importing into Saint Lucia for purposes other than his private or domestic use;
- (d) distributing otherwise than in the course of business with a view to committing any act infringing the copyright;
- (e) possessing in the course of business with a view to committing any act infringing the copyright;

any article which the individual knows or has reason to believe is an infringing work.

The penalties are: with respect to (b) above in the case of first conviction, a fine of two thousand five hundred dollars for each article to which the offence relates and in the case of subsequent conviction, to the fine or to imprisonment for a term not exceeding twelve months.

With respect to any other offence, in the case of first conviction to a fine not exceeding one thousand dollars and in the case of subsequent conviction to such fine or to imprisonment for a term of not exceeding six months.

#### Trademarks

The draft Trademarks Act makes provision for penalties with respect to offences and generally provides penalties of a fine and/or imprisonment. The fines and prison terms can be ascertained when the Act is passed. The draft contains fines ranging from ten thousand dollars to two hundred and fifty thousand dollars.

#### Plant Varieties

The draft Plant Varieties Act will make provision for fines up to fifteen thousand dollars in relation to criminal offences.

**51. (Question 31, IP/C/W240) Article 61 also requires that remedies in appropriate cases include the seizure, forfeiture and destruction of infringing goods and any materials and implements the predominant use of which has been the commission of the offence. Please describe the provisions in the laws of Saint Lucia that provide for such remedies, and describe the circumstances in which those remedies would be imposed, citing to the relevant provisions of law or regulation.**

The Copyright Act allows for the Court to make orders for seizure and forfeiture of any articles which are used to make or reproduce infringing copies under Section 139 A. Section 142 also makes provision for seizure of infringing material by police officers where there is reasonable cause to believe that there is infringing material or that an offence is being committed.

The Court may in the case of the commission of an offence in relation to layout-designs order the seizure, forfeiture and destruction of the layout-designs, integrated circuits or articles concerned and of any materials or implements, the predominant use of which has been in the commission of the offence. (section 15 Layout-Designs (Topographies) of Integrated Circuits Act)

The Draft Trademarks Act makes provision for the seizure of infringing goods by the Comptroller of Customs in section 116; forfeiture of goods to the Government of Saint Lucia in section 118 and the disposal of the goods in section 122. It should be noted that the power to seize arises at the instance of the right holder and not at the instance of the Comptroller of Customs.

Where no specific provision has been made in relation to seizure etc. the Court has a discretion to grant any remedy which it thinks is necessary in the circumstances.

**52. (Question 32, IP/C/W240) Article 61 also indicates that Members may provide for criminal procedures and penalties in cases of wilful infringement of other forms of intellectual property. Please describe any provisions of the laws of Saint Lucia that provide for such procedures and remedies, citing to the relevant provisions of law or regulation.**

#### Layout-Designs

A person who without the authorization of the right holder knowingly performs an act which is unlawful under Section 6 commits an offence for which the penalties are a fine of five thousand dollars or imprisonment for two years. The Court may also order the seizure, forfeiture and destruction of the layout-designs, integrated circuits or articles concerned and of the materials or implements, the predominant use of which has been in the commission of the offence. (Section 15)

#### Geographical Indications

Section 16 states that a person who knowingly and with intent to deceive performs any of the acts referred to in section 12 of the Act commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for two years.

#### Industrial Designs

Under section 22(3) a person who intentionally performs an act which constitutes an infringement commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for five years.

**53. (Question 33, IP/C/W/240) Please provide statistical information related to civil copyright, trademark, geographical indication, industrial design, patent, integrated circuit layout-design, and trade secret enforcement for 2000, including the number of cases filed; injunctions issued; infringing products seized; infringing equipment seized; cases resolved (including settlement); and the amount of damages awarded.**

There have been no cases filed with regard to these areas.

**54. (Question 34, IP/C/W/240) Please provide statistical information related to criminal enforcement in the area of copyright piracy and trademark infringement for 2000, including the number of raids, prosecutions, convictions, and the amount of fines and/or jail terms (including whether the fines were paid and whether the jail term was actually served or was suspended) and any other information establishing that the criminal system operates effectively to deter copyright piracy and trademark counterfeiting.**

There have no cases of criminal enforcement except for the seizure by police of infringing goods from a record shop. The matter was however not pursued.

**55. (Question 39, IP/C/W/215/Add.1) Please describe any new initiatives that are planned to improve enforcement of intellectual property rights in Saint Lucia, particularly initiatives related to criminal enforcement.**

Training seminars will be organized for judges on enforcement issues relating to intellectual property. Training is also to take place for the customs and police departments as a follow up to a seminar which took place last year.

Plans are to ensure that all necessary regulations are put in place to provide the framework for all legislation to operate and be effectively administered.

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