

CHAPTER 319

TRADE MARKS

ARRANGEMENT OF SECTIONS

SECTION

Citation

1. Short title.

Interpretation

2. Definitions.
3. *Repealed by 2001-16.*
4. Trade, service and collective marks.

Protection of Marks

5. Rights.
- 5A. Special requirements.
6. Excepted uses.
7. Local exception.
8. Unregistrable marks: similarity.
9. Unregistrable marks: inherent defects.

Applications for Registration

10. Application.
11. Priority.
12. Priority claim.

SECTION

13. Temporary protection.
14. Form examination.
15. Substance examination.

Publication of Applications

16. Publishing application.
17. Opposition.
18. Hearing.

Registration

19. Registration.
20. Register.
21. Particulars for registration.
22. Certificate.
23. Publication of marks.
24. Inspection of register.
25. Duration.
26. Application for renewal.
27. Renewal.

Proprietary Activities

28. Transfer of application or mark.
29. Transfer of collective marks.

SECTION

Licence-contracts

- 30. Licence-contracts.
- 31. Joint owners.
- 32. Quality control.
- 33. Further licences.
- 34. Licensee right.
- 35. No transfer of licence.
- 36. Royalties abroad.
- 36A. Licence-contract.
- 36B. Evidence in proceedings before Director.
- 36C. Costs in respect of proceedings before Director.

Renunciation

- 37. Renunciation.

Protective Measures

- 38. Owner's remedies.
- 39. Licensee's remedies.
- 40. Judicial aid.
- 41. Registration removal.
- 42. Court order.
- 43. Invalidity.
- 44. Invalid collective mark.
- 45. Effect of invalidation.

SECTION

46. Copy of court decision.

Appeals

47. Appeals.

Trading Practices Offences

48. Competitive offences.

49. Infringement.

49A. Order of erasure etc. of offending sign.

49B. Order for delivery up of infringing goods, material or articles.

49C. Meaning of "infringing goods, material or articles".

49D. Period after which remedy of delivery-up not available.

49E. Order as to disposal of infringing goods, material or articles.

50. Penalties.

50A. Unauthorised use of trade mark etc. in relation to goods.

50B. Falsification of register etc.

50C. Falsely representing trade mark as registered.

50D. Forfeiture of counterfeit goods etc.

50E. Offences by corporations.

51. Limitation.

Civil Remedies

52. Civil remedies.

SECTION

Administration

- 53. Communications.
- 53A. Notice of objection to importation.
- 53B. Comptroller of Customs.
- 53C. Notice of detention.
- 53D. Forfeiture of goods.
- 53E. Release of goods to owner, no action for infringement.
- 53F. Action for infringement.
- 53G. "Approved form".
- 53H. Manner of disposal of forfeited goods.
- 53I. Power of Comptroller to retain control of goods.
- 53J. Insufficient security.
- 53K. Immunity in respect of official acts.
- 53L. Power to require information.
- 53M. Importation for personal use.

Miscellaneous

- 54. Reciprocity.
- 55. Directions.
- 56. Regulations.
- 57. Effect of former Act.
- 58. Binding Crown.

CHAPTER 319

TRADE MARKS

An Act to revise and reform the law governing signs used as trade marks, service marks or collective marks in connection with the marketing of goods or services.

1981-56.
1984-20.
1988-6.
2001-16.

[1st January, 1985] Commence-
ment.
1984/179.

Citation

1. This Act may be cited as the *Trade Marks Act*. Short title.

Interpretation

2. In this Act Definitions.

"designated owner" means the person identified as the importer of the goods on the entry made in relation to the goods under the *Customs Act*;

2001-16.
Cap. 66.

"Director" means the Registrar of Corporate Affairs and Intellectual Property Office;

1988-6.

"Gazette" means the *Official Gazette* or such other publication as is prescribed for the purpose;

"Industrial Property Office" means the Corporate Affairs and Industrial Property Office established under section 3 of the *Corporate Affairs and Industrial Property Office Act*;

1988-6.
Cap. 21A.

"licence-contract" means a licence-contract referred to in section 30;

"licensee" means the holder of a licence under a licence-contract;

"mark" refers to a trade mark, service mark and, except in sections 28, 30, 31, 32, 33, 34, 35, 39 and 40, a sign used as a collective mark;

2001-16. "Nice Agreement" means the Nice Agreement, dated 15th June, 1957, as revised from time to time, concerning the International Classification of Goods and Services for the purposes of the registration of Marks;

2001-16. "notified trade mark" means a trade mark in respect of which a notice under section 53A is in force;

2001-16. "objector" means any person who has given a notice under section 53A;

2001-16. "Paris Convention" means the Paris Convention for the Protection of Industrial Property dated 20th March, 1883, as revised from time to time;

"register" means the Register of Trade and Service Marks referred to in section 20;

"transfer" extends to every mode (whether direct or indirect, voluntary or involuntary, absolute or conditional) of disposing of or parting with any right vested under this Act, or of any interest in any such right, including retention of title to the right or interest as security for any obligation;

2001-16. "TRIPS Agreement" means the Agreement on Trade Related Aspects of Intellectual Property Rights.

3. *Repealed by 2001-16.*

Trade,
service and
collective
marks.

4. (1) A trade mark is a visible sign used or to be used upon, with or in relation to any goods for the purpose of distinguishing, in the course of trade or business, the goods of one person from those of another person.

(2) A service mark is a visible sign used or to be used in connection with or in relation to any services for the purpose of distinguishing, in the course of business, the services provided by one person from those provided by another person.

(3) A collective mark is a visible sign used or to be used, in the course of trade or business, by a group of business enterprises for the common benefit under an agreement in writing that provides for the specific conditions governing the use of the sign.

(4) Without limiting the generality of subsections (1) to (3), but subject to sections 8 and 9, marks can consist of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

Protection of Marks

5. (1) The registration of a mark vests in the registered owner of the mark the exclusive right to prevent any other person Rights.

(a) from using the mark or any sign so nearly resembling the mark as to be likely to mislead the public

(i) in respect of goods or services for which the mark is registered; or

(ii) in respect of other goods or services in connection with which the use of the mark or a mark resembling it is likely to mislead the public; or

(b) from using, without just cause or in circumstances likely to affect adversely the interests of the registered owner of the mark,

(i) the mark or any sign resembling it; or

(ii) any business name resembling the mark, that is to say, any name or style under which any business or profession will be carried on in Barbados, whether in partnership or otherwise, that resembles the mark.

ss.5A-7

2001-16. (1A) Where an identical sign is used for identical goods or services it shall be presumed that the public is likely to be misled.

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

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

Special
require-
ments.
2001-16.

5A. The use of a trade mark in the course of trade shall not be unjustifiably encumbered by any special requirements, including use with another trade mark, use in a special form, or use in a manner detrimental to the mark's capability of distinguishing the goods or services of one enterprise from those of another enterprise.

Excepted
uses.

6. The registration of a mark under this Act does not vest in the registered owner of the mark any right

- (a) to prevent the use by a person in good faith of his own name, address or pseudonym or a geographical name; or
- (b) to prevent the use by a person in good faith of an exact indication concerning the kind, quality, quantity, destination, value, place of origin, time of production or time of supply of his goods or services,

if that use is confined exclusively to purposes of identification or information and is not likely to mislead the public regarding the source of any goods or services to which the registered mark relates.

Local
exception.

7. (1) The registration under this Act of a mark does not vest in the owner of the mark the right to prevent the use by other persons of the mark in relation to goods lawfully sold in Barbados if those goods have not undergone any change, including change attributable to ageing or weather.

(2) For the purpose of this section "lawfully sold in Barbados" means, in relation to any goods or services, that those goods have been imported into Barbados for sale, or have been purchased in Barbados for sale, in either case with the consent of the registered owner of the mark or his agent, or the goods have been so imported or purchased before the mark was registered in Barbados.

8. (1) An application may not be made under this Act for the registration of any of the following marks:
- Unregis-
trable
marks:
similarity.
2001-16.
- (a) subject to subsection (2), a mark that resembles, in such a way as to mislead the public, a mark registered under this Act by another person, or for which an application for registration by another person is pending under this Act;
- (b) subject to subsection (2), a mark that resembles, in such a way as to mislead the public, a mark sought to be registered under this Act in respect of the same goods or services by a person claiming priority under section 12; 2001-16.
- (c) subject to subsection (2), a mark that resembles, in such a way as to be likely to mislead the public, an unregistered mark in use in Barbados at an earlier period by some other person in connection with identical or similar goods or services, if the applicant is aware or could not reasonably have been unaware of the earlier use; 2001-16.
- (d) subject to subsection (2), a mark that 2001-16.
- (i) is identical with, confusingly similar to or constitutes a translation of a mark or trade name that is well-known in Barbados as being already the mark used by another enterprise for identical or similar goods or services; or
- (ii) is well-known and registered in Barbados with respect to goods or services that are not identical or similar to those in respect of which registration is applied for, if that use of the mark in relation to those goods or services would indicate a connection between those goods or services and

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the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use;

- 2001-16. (e) subject to subsection (2), a mark that, with regard to another mark or trade-name, constitutes a reproduction, in whole or in part, or an imitation, translation or description of that other mark or trade-name, if the other mark or the trade-name
- (i) is well known in Barbados;
 - (ii) belongs to a person other than the applicant; and
 - (iii) its reproduction, imitation, translation or description is likely to mislead the public;
- 2001-16. (f) a mark that infringes the interest of another person or the use of which could lead to a contravention of section 48; or
- 2001-16. (g) a mark that has been registered in another country, or an application for the registration of which has been made by an agent of a person who is the owner of the mark in another country, unless the authorisation of that owner is given or the agent justifies his action.

(2) In determining whether a mark can be registered under this Act, the consent to registration by a person described in paragraph (b), (c), (d) or (e) of subsection (1) whose rights will be or are likely to be infringed if a particular mark is registered under this Act may be taken into account to permit registration of the particular mark.

Unregis-
trable
marks:
inherent
defects.

9. (1) The following marks may not be registered under this Act:
- (a) any mark that consists of a shape or form imposed by the inherent nature of the goods or services to which the mark relates or imposed by the industrial function of the mark;
 - (b) subject to subsection (2), any mark that consists exclusively of a sign or indication that might serve, in the course of trade or business, to designate the kind, quality, quantity, purpose, value,

- place of origin of, or time of supply of, the goods or services to which the mark relates;
- (c) subject to subsection (2), any mark that exclusively consists of a sign or indication that has become, in current language or in the *bona fide* and established practices of the trade or business in Barbados, a customary designation of the goods or services to which the mark relates;
 - (d) subject to subsection (2), any mark by the use of which it is for other reasons impossible to distinguish the goods or services of one business enterprise from those of another business enterprise, unless those business enterprises are using the mark as a collective mark to which they are entitled;
 - (e) any mark that offends public morals or the use of which is likely to provoke a breach of the peace;
 - (f) any mark the use of which is likely to deceive persons in trade or business, or the public in general, regarding the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark relates;
 - (g) any mark that is an imitation of an armorial bearing, flag or other emblem, or is an initial, name or abbreviation of a name of any country or of any intergovernmental or international organisation created by an international convention, unless its use is authorised by an authority in the country or organisation concerned that is competent to authorise the use of the mark as a trade mark, service mark or collective mark, as the case requires;
 - (h) any mark that is a reproduction or imitation of an official sign or hallmark adopted by a country, unless its use is authorised by an authority in the country concerned that is competent to authorise the use of the mark as a trade mark, service mark or collective mark, as the case requires; and

- (i) any mark that resembles, in such a way as to be likely to mislead the public, a collective mark
- (i) the registration of which had expired and had not been renewed; or
- (ii) the renunciation, removal or invalidity of which had been recorded in the register,

in the course of the 3-year period immediately before the application to register the mark is made under this Act.

(2) In determining whether or not a mark can be registered under this Act, account must be taken, for the purposes of paragraphs (b) to (d) of subsection (1), of all the facts, particularly the length of time the mark has been in use in Barbados or in any other country, and whether the mark has been held to be distinctive in any other country.

Applications for Registration

Application. **10.** (1) An application for registration of a mark may be made to the Director upon payment of the prescribed fee.

- (2) The application must contain
 - (a) a request for registration of the mark;
 - (b) the full name and address of the applicant and, if he resides outside Barbados, an address for service within Barbados;
 - (c) 4 copies of a representation of the mark for which registration is requested; and
- 2001-16. (d) a precise statement of the goods or services for which registration of the mark is requested, accompanied by an indication of the general class heading and the class number under the classification referred to in the Nice Agreement corresponding to the goods or services to which the mark is to be applied.

(3) When an application for registration of a mark is made by an agent, the application must be accompanied by a power of attorney authorising the agent to make the application.

(4) When the application is for the registration of a collective mark, the application

(a) must designate the mark a collective mark; and

(b) must be accompanied by a copy of the agreement, which

(i) must be signed by the applicant;

(ii) must contain the conditions governing the use of the mark as a collective mark; and

(iii) must be in compliance with the requirements of subsection (5).

(5) An agreement providing for the use of a collective mark must specify

(a) the common characteristics or quality of the goods or services to which the collective mark is to be applied;

(b) the conditions under which, and the persons by whom, the collective mark can be used;

(c) how effective control of the use of the collective mark in compliance with the conditions governing its use will be exercised; and

(d) the penalties or sanctions that are to be applied if the collective mark is used in contravention of any of the conditions governing its use.

11. Registration of a mark may only be granted under this Act to the person who first complies with section 10 or claims the earliest priority for his application for registration under this Act.

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Priority
claim.

2001-16.

12. (1) An applicant for registration under this Act of a mark who is availing himself of the priority of an earlier application in another country that is a member of the Paris Convention or of the TRIPS Agreement must submit with his application a written statement

2001-16.

- (a) indicating the date of the earlier application; and
- (b) identifying the country in which the earlier application was made.

(2) In a declaration made under subsection (1) the applicant must give an undertaking to the Director to furnish him, within a period of 90 days from the date of the application, with a copy of the earlier application, certified as correct by an authority in the other country competent to so certify.

2001-16.

(2A) An application referred to in subsection (2) that is in a language other than English must be accompanied by a translation into the English language, certified as correct by someone in the other country competent to so certify.

Temporary
protection.

13. (1) Where a person who, having, at an exhibition recognised by the Minister as an official national or international exhibition, exhibited goods bearing a mark or rendered services under a mark, makes, within 6 months from the date on which those goods or services were first exhibited bearing or under that mark at the exhibition, an application for the registration of that mark under this Act, he may, if he so desires, be deemed to have made application under this Act for registration of that mark on the date on which the goods or services were so exhibited.

(2) An exhibition is recognised by the Minister as an official national exhibition or an official international exhibition when the Minister publishes a notice of that fact in the *Gazette*.

Form
examina-
tion.

14. (1) The Director shall examine each application for registration of a mark to determine if sections 10, 12 and, if relevant, section 13 have been complied with.

(2) If the Director determines that section 10 has not been complied with in respect of an application for the registration of a mark, the Director shall refuse to accept the application.

(3) If the Director determines that section 12 or 13, as the case requires, has not been complied with on an application for the registration of a mark, the Director may, subject to section 15, register the mark, but mention may not be made in the register of any priority claimed under section 12 or of any use of the mark at an exhibition described in section 13.

15. (1) When the Director has determined that an application complies with the requirements of section 10, he shall examine the mark for which the application is made to determine if the mark can be registered under this Act having regard to sections 8 and 9. Substance examination.

(2) When the Director determines that the application or the mark being registered would contravene section 8 or 9, the Director shall

(a) refuse registration and inform the applicant by notice in writing why the application cannot be accepted or the mark cannot be registered in Barbados; and

(b) invite the applicant either to withdraw the application or to present, within a period of 60 days from the date of the receipt of the notice, the applicant's comments on the reasons for the refusal to accept the application or to register the mark.

(3) The Director may refuse to register a mark for which the application described in subsection (2) was made

(a) if the applicant does not withdraw his application or present his comments within the time limited therefor by that subsection; or

(b) if the applicant presents his comments and the Director is of the view that he ought not to accept the application or register the mark.

s.16

- 1984-20. (4) When, after considering any comments presented to him by an applicant described in subsection (2), the Director is of the opinion that the mark for which the application has been made cannot be registered under this Act in respect of a part of the goods, or, as the case requires, some of the services mentioned in the application, the
- 1984-20. Director may proceed under section 16 with the application in respect of those goods or services for which the mark can be registered.

Publication of Applications

Publishing
application.

16. (1) Where it appears to the Director that the requirements of this Act governing registration of a mark have been complied with in respect of an application, he may so notify the applicant and require that the applicant, within a period of 60 days from the receipt of the notification, pay the prescribed fee for publication of the notice of the application.

(2) Upon payment of the fee required under subsection (1), the Director shall publish a notice of the application in the *Gazette*; but if the fee is not paid within the time limited for payment thereof by that subsection, the mark for which the application was made may not be registered.

(3) The publication of a notice of an application for registration of a mark must

- (a) specify the date of the application;
- (b) indicate the goods or services for which registration of the mark is being applied for;
- (c) indicate the corresponding class or classes of goods or services to which the mark relates;
- (d) give the name and address of the applicant and, if relevant, the address for service of the applicant;
- (e) indicate any priority claimed, or the date of certified use of the mark at an exhibition within the meaning of section 13; and

- (f) if the mark is a collective mark, contain the statement of conditions governing the use of the collective mark that accompanied the application for its registration.

17. (1) A person who opposes an application for the registration of a mark under this Act may, within 90 days from the date of the publication of the notice of the application, inform the Director, by a notice in the prescribed manner, of that person's opposition and the reasons therefor. Opposition.

(2) If no notice of opposition to the registration of the mark is received by the Director within the period limited therefor under subsection (1), section 19 applies.

(3) A copy of the notice of opposition to registration received by the Director shall be sent by him to the applicant for registration of the mark, who shall, within 30 days from the receipt by him of the notice, send to the Director in the prescribed manner an answer to the opposition in which he must set out the grounds on which he relies to support his application for registration; and, if the applicant fails within the 30 days to send the Director the answer to the opposition to registration, the applicant thereupon abandons his application for registration.

18. (1) When, pursuant to section 17, the Director receives from the applicant for registration of a mark an answer to an opposition to the registration of the mark, the Director, after furnishing a copy of the answer to the person opposing the application, shall require the opposing person and the applicant to attend before the Director, at a time and place fixed by him, to hear the matter of the opposition. Hearing.

(2) At the conclusion of the hearing, the Director may either register the mark that was opposed or refuse its registration; but, in either case, the Director shall state in writing his reasons for his decision.

Registration

Registration. 19. After all the requirements of this Act governing the registration of a mark have been complied with in the case of an application, the applicant is entitled, on payment of the prescribed fee, to have the mark registered under this Act.

Register. 20. (1) The Director shall maintain a Register of Trade and Service Marks and record therein

(a) all marks registered under this Act; and

(b) all transactions required by this Act to be recorded in connection with each mark registered under this Act.

(2) The marks recorded in the register must be numbered in the order of their registration.

(3) A collective mark must be recorded in a separate section of the register reserved for registration of collective marks.

Particulars for registration. 21. (1) A mark is registered when there is recorded in the register

(a) a reproduction of the mark;

(b) the number of the mark;

1984-20. (c) the name and address of the registered owner of the mark and, if he resides outside Barbados, his address for service in Barbados;

(d) the dates of application and registration of the mark;

(e) if priority is claimed, an indication of that fact and the number, date and country of the application with which the priority claim is connected;

(f) if the mark was exhibited within the meaning of section 13, the contents of the certificate relating to its exhibition that has been filed with the Director; and

(g) if the mark is a collective mark, the conditions governing the use of the mark that accompanied the application for its registration as a collective mark.

(2) The registered owner of a mark recorded in the register shall notify the Director of any change in the owner's address, or in his address for service in Barbados; and, upon payment of the prescribed fee, the Director shall record the change in the register.

(3) The registered owner of a collective mark recorded in the register shall notify the Director of any change affecting the conditions governing the use of the mark; and, upon payment of the prescribed fee, the Director shall record the change in the register, after publishing a notice of the change in the *Gazette*.

(4) Sections 16(3), 17 and 18 apply with such modifications as the circumstances require to any change to be made in the register under subsection (3) with regard to any conditions governing the use of a collective mark.

22. Upon the registration of a mark, the Director shall send by registered post to the registered owner of the mark at his address as recorded in the register a certificate of the registration. Certificate.

23. (1) From time to time as prescribed by the regulations, the Director shall publish in the *Gazette* in the order of their registration such marks as have been registered in the register to that time or since the last publication. Publication of marks.

(2) The publication of marks must include all the particulars recorded in the register pursuant to section 21 in respect of the marks.

24. (1) The register is a public record and may be inspected during business hours by any member of the public free of charge. Inspection of register.

(2) An inspection of the register includes making copies or extracts therefrom; but, on payment of the prescribed fee therefor, extracts or copies of any records in the register may be obtained from the Director.

Duration. **25.** Subject to sections 41 to 45, the registration of a mark is valid for a period of 10 years from the date of its registration; but a registration may be renewed for further consecutive periods of 10 years each, upon payment of the prescribed fee on each renewal.

Application for renewal.
2001-16. **26.** An application for renewal of the registration of a mark must be in the prescribed form and signed by the applicant.

Renewal. **27.** (1) Upon the renewal of the registration of a mark, no change may be made in the list of goods or services in respect of which the mark is registered, except to remove any goods or services from that list.

(2) An application for the renewal of the registration of a mark must be in the prescribed form, and is not subject to a fresh examination of the mark by the Director, nor may its renewal be opposed unless the renewal would contravene subsection (1).

(3) An application for renewal of a registration must be made, and the prescribed fee therefor paid, within the 12 months immediately preceding the expiration of the earlier period of registration.

(4) Notwithstanding subsection (3), the registered owner of a mark, upon payment of the prescribed fee therefor, is entitled to renew a previous registration within 6 months from the expiration of the earlier registration.

(5) A renewal of a registration of a mark noting any elimination of goods or services in respect of the mark shall be recorded in the register and a notice thereof published by the Director in the *Gazette*.

Proprietary Activities

Transfer of application or mark. **28.** (1) An application for the registration of a trade mark or service mark, and the registration of a trade or service mark, are both transferable; and a trade mark or service mark may be transferred

(a) independently of any business enterprise in connection with which the trade mark or service mark is used; and

(b) independently of the goods or services in respect of which the application was made or the trade mark or service mark was registered.

(2) A transfer of an application for the registration of a trade mark or service mark, or the transfer of the registration of a trade mark or service mark, must be recorded in the register upon payment of the prescribed fee.

(3) A transfer of an application for the registration of a trade mark or service mark, or the transfer of the registration of a trade mark or service mark, is void as against any person other than the parties to the transfer until the transfer is recorded in the register.

(4) A transfer of an application for registration of a trade mark or service mark, or a transfer of the registration of a trade mark or service mark, is void if the transfer is likely to mislead the public in any way, particularly with respect to the nature, source, manufacturing process, characteristic or suitability for their purpose of the goods or services to which the trade or service mark relates.

(5) In order to be recorded in the register, a transfer, otherwise than by operation of law, of an application for registration of a trade mark or service mark or of a registration of a trade mark or service mark must be in writing and signed by the parties to the transfer.

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

Transfer of
collective
marks.

(2) A transfer of the registration of a collective mark is void until it is recorded in the register; and it may not be recorded unless the application to record the transfer is accompanied by the prescribed fee and a copy of the Director's approval of the transfer.

*Licence-contracts*Licence-
contracts.

30. (1) A registered owner of a trade mark or service mark may, by a licence-contract, grant to another person or an enterprise a licence to use the mark for any of the goods or services for which the mark is registered.

(2) A licence-contract must be in writing and signed by the parties to the contract; and it is void against persons other than the parties thereto until it is recorded in the register.

(3) A licence-contract may be recorded in the register upon payment of the prescribed fee.

(4) The record in the register of a licence-contract relating to a trade mark or service mark shall be cancelled by the Director

(a) at the request of the registered owner of the trade mark or service mark, or at the request of the licensee under the licence-contract; and

(b) on production to the Director of satisfactory evidence by the person making the request that the licence-contract has terminated.

Joint
owners.

31. In the absence of an agreement to the contrary, joint owners of a trade mark or service mark registered under this Act

(a) may separately transfer their share of the mark as well as separately exercise any exclusive right acquired under this Act; but

(b) may by joint action only grant a licence-contract to another person to use the mark for any of the goods or services in respect of which it is registered.

32. (1) A licence-contract relating to a trade mark or service mark is void and may not be recorded in the register if the licence-contract does not contain a stipulation that ensures that the quality of the goods or services to which the mark relates can be effectively controlled by the registered owner of the mark.

Quality
control.

1984-20.

(2) A provision in a licence-contract or a provision in an agreement relating to a licence-contract is void if, in respect of a trade mark or service mark, it purports

- (a) to impose on the industrial or commercial use of the trade mark or service mark a restriction on the licensee that does not derive from the rights vested by registration of the mark under this Act; or
- (b) to impose a restriction that is unnecessary for the purpose of safeguarding the rights vested by registration of the mark under this Act.

(3) Whether a restriction is unnecessary for the purpose of safeguarding the rights vested by registration under this Act is a question of fact to be determined in each case after having due regard to all the circumstances.

33. (1) In the absence of a provision to the contrary in a licence-contract, but subject to subsection (2), the grant of a licence to a person to use a trade mark or service mark in industry or commerce does not prevent the grantor of the licence

Further
licences.

- (a) from granting further licences to other persons to use the same mark; or
 - (b) from using the mark himself.
- (2) If the licence-contract provides that the licence granted under it is an exclusive licence, the grantor of the licence may not
- (a) grant further licences to other persons to use the trade mark or service mark to which the licence-contract relates; or

(b) in the absence of a provision in the licence-contract to the contrary, use the trade mark or service mark himself.

Licensee
right.

34. In the absence of a provision to the contrary in the licence-contract, a licensee thereunder may, while he is a registered licensee under that contract, exercise in Barbados, in relation to the trade mark or service mark to which the licence-contract relates, all the rights vested by registration under this Act in respect of that mark, including the right to apply for renewal of the registration of the mark.

No transfer
of licence.

35. (1) Unless the licence-contract otherwise provides, a licence under a licence-contract is not transferable nor may a licensee thereunder grant a sub-licence.

(2) When a licensee under a licence-contract has authority thereunder to transfer his licence or to grant a sub-licence, sections 30 to 34 and section 36 apply to the transfer or sub-licence.

Royalties
abroad.

36. When in the economic interests of Barbados the Minister responsible for Finance so provides by order,

(a) licence-contracts requiring payment of royalties abroad, or such classes thereof as are described in the order; and

(b) changes or renewals of the licence-contracts referred to in paragraph (a),

have no effect in Barbados without the approval in writing of the Minister responsible for Finance.

Licence-
contract.
2001-16.

36A. A collective mark or an application therefor shall not be applicable to the subject of a licence-contract.

Evidence in
proceedings
before
Director.
2001-16.

36B. (1) In any proceedings under this Act before the Director, the evidence may be given by statutory declaration or by affidavit.

(2) The Director may, in any particular case, take oral evidence in lieu of or in addition to the evidence referred to under subsection (1), and shall, unless he otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) At any stage of any proceedings before the Director, he may direct that such documents, information or evidence as he may reasonably require shall be filed within such period as he may specify.

(4) The Director shall in respect of requiring the attendance of witnesses, the examination of witnesses on oath, the discovery of documents and the production of documents, have all the powers of a judge of the High Court.

(5) The hearing before the Director of any dispute between 2 or more parties relating to any matter in connection with an application for the registration of a mark or a registered mark shall be in public unless the Director, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

36C. (1) The Director may, in any proceedings before him, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid.

Costs in
respect of
proceedings
before
Director.
2001-16.

(2) The Director may require any person who is a party in any proceedings before him under this Act to give security for costs in relation to those proceedings; and he may require security for the costs of any appeal from his decision.

(3) Where security is not given under subsection (2), the party in default may be treated as having withdrawn his application, opposition, objection, answer or intervention, as the case may be.

Renunciation

37. (1) Subject to this section, the registered owner of a mark may renounce registration of the mark by means of a written renunciation addressed to the Director.

Renuncia-
tion.

(2) A renunciation may be limited to a part only of the goods or services for which the mark is registered.

(3) Upon receiving a renunciation, the Director shall record it in the register and publish a notice of the renunciation in the *Gazette* as soon as possible.

(4) A renunciation of a mark has no effect until it is recorded in the register pursuant to subsection (3).

(5) Subject to subsection (6), when a licence-contract is recorded in the register for a trade mark or service mark, a renunciation made in respect of the mark may not be recorded in the register unless the renunciation contains a statement that it was made with the consent of the licensee under the licence-contract.

(6) Subsection (5) does not apply if the licence-contract relating to the mark referred to in that subsection expressly waives the right of the licensee thereunder to prevent the recording of a renunciation without his consent.

Protective Measures

Owner's
remedies.

38. (1) The registered owner of a mark whose rights under this Act are in imminent danger of being infringed, or are being infringed, may institute proceedings in the High Court

- (a) for an injunction to prevent the infringement or to prohibit the continuation of the infringement; or
- (b) for damages for the infringement.

(2) An injunction issued pursuant to subsection (1) does not deprive the registered owner of the mark of any damages that he is entitled to be awarded for any loss sustained by him as a result of an infringement or imminent infringement of his rights under this Act.

39. (1) A licensee under a licence-contract may in writing request the registered owner of the trade mark or service mark to which the licence-contract relates to institute, within a period of 90 days from receipt by him of the request, any necessary legal proceedings in respect of any infringement or imminent infringement of that mark. Licensee's remedies.

(2) A request under subsection (1) must contain a statement of the relief desired.

(3) Subject to subsection (5), if the registered owner of a trade mark or service mark who receives a request under subsection (1) fails to institute legal proceedings within the time limited therefor by that subsection, the licensee who made the request may, unless the licence-contract otherwise provides, institute those proceedings in his own name after notifying the registered owner of the mark of his intention to do so.

(4) The registered owner of the trade mark or service mark may join in any legal proceedings instituted under subsection (3) by a licensee; but the licensee is liable to the registered owner of the mark for any damages that the owner incurs as a result of any unwarranted legal proceedings instituted by the licensee.

(5) When a licensee institutes legal proceedings in his own name under this section, he must prove to the court that the registered owner of the mark to which the proceedings relate failed within the time limited therefor by subsection (1) to institute legal proceedings.

40. (1) Subject to subsection (2), the High Court may, before the expiration of the period of 90 days referred to in section 39(1), grant an injunction to a licensee of a trade mark or service mark to prevent infringement or to prohibit further infringement of the mark. Judicial aid.

(2) In making an application to the High Court to exercise its jurisdiction under subsection (1), the licensee must prove that

- (a) immediate action is necessary to prevent substantial damage from the infringement of the trade mark or service mark for which the application is made; and

- (b) the registered owner of the mark has been requested to institute legal proceedings but has failed to do so.

Registration
removal.

41. (1) Proceedings requesting that the registration of a mark be ordered removed from the register may be made by application to the High Court by any interested person, if

- (a) the mark has become a generic name; or
(b) the mark has fallen into disuse.

(2) A mark becomes a generic name when the registered owner by his action causes or acquiesces in the transformation of the mark into a generic name in respect of one or more of the goods or services for which the mark was registered, so that, in trade and business circles and in the estimation of the public, the mark's significance as a distinctive trade, service or collective mark has been lost.

(3) A mark falls into disuse when its registered owner, without good reason, has, within the 5 years immediately preceding the date of the application to the High Court, failed, after registration of the mark, to use it within Barbados or failed to cause its use within Barbados.

1984-20.

(4) The use of a mark in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered does not of itself cause the mark to lose its significance nor does it diminish the rights of the registered owner under this Act.

(5) In determining whether a mark has fallen into disuse within the meaning of subsection (3), the court may have regard to the following:

- (a) only circumstances beyond the control of the registered owner ought to be taken to be a good reason for failing to use a mark under a licence or otherwise;
- (b) insufficient financial resources ought not to be taken to be a good reason for failing to use a mark under a licence or otherwise; and

- (c) the use of a mark in connection with one or more of the goods or services belonging to any given class in respect of which the mark is registered constitutes use of the mark.

42. After hearing the parties to the proceedings for the removal of a mark from the register under section 41, the court may Court order.

- (a) dismiss the application; or
(b) order a total or partial removal of the mark from the register, as the court thinks appropriate.

43. (1) Proceedings requesting that the registration of a mark be declared invalid may be made by application to the High Court by any interested person claiming that the registration was not permitted under section 8 or 9. Invalidity.

(2) After hearing the parties to the application, the court may declare the registration of the mark invalid if it is shown to the court that the mark ought not to have been registered, having regard to the requirements of section 8 or 9.

(3) Notwithstanding subsection (2), the court shall disregard any ground not existing at the hearing of the application but that ought to have resulted in the refusal of registration when the application was examined under section 15.

(4) When the grounds for invalidating the registration of a mark exist in respect of a part only of the goods or services for which the mark was registered, the declaration of invalidity may be limited by the court to that part only of the goods or services to which the mark applies.

(5) An application under this section for a declaration invalidating a mark

- (a) may be brought within 5 years from the date of registration of the mark, if the mark ought not to have been registered having regard to section 8(1); or

- (b) may be brought within 12 years from the date of registration of the mark, if the mark ought not to have been registered having regard to any other provision of section 8 or 9.

Invalid
collective
mark.

44. (1) In addition to any proceedings under section 43 to have a mark declared invalid, proceedings may also be brought, in the circumstances to which this section applies, in the High Court, by application, to have a collective mark declared invalid.

(2) The circumstances to which this section applies are

(a) when the registered owner of the collective mark uses the mark to the exclusion of its use by other persons, or uses, or permits the use of the collective mark in contravention of the conditions governing its use as recorded in the register; or

(b) uses or permits use of the collective mark in a manner likely

(i) to deceive in trade or business circles, or

(ii) to deceive members of the public as to the origin of any common characteristics of the goods or services in connection with which the mark is used.

(3) For the purposes of paragraph (b) of subsection (2), it is immaterial whether

(a) the registered owner of the collective mark tolerated its use in the manner described in that paragraph while being aware of its being so used; or

(b) the registered owner of the collective mark is ignorant through lack of adequate control of the manner of use of the collective mark.

(4) To prevent doubt, section 43 applies to proceedings brought under this section in like manner as to proceedings brought under that section.

45. (1) When the registration of a mark is declared invalid in whole or in part by the High Court in any proceedings brought under sections 41 to 44, the registration is, to the extent declared by the Court, invalid from the date of the impugned registration. Effect of
invalidation.

(2) When the registration of a trade mark or service mark to which a licence-contract applies is declared invalid by the High Court, no royalties need be repaid by the grantor of the licence under the licence-contract to the licensee thereunder unless it is shown to the court that the licensee has not substantially benefitted from the licence.

46. On the determination of any proceedings under section 41, 42, 43 or 44 in the High Court, the Registrar of the Supreme Court shall transmit a certified copy of the Court's decision to the Director, who shall record the decision in the register and publish a notice of it in the *Gazette*. Copy of
court
decision.

Appeals

47. (1) A person aggrieved by any determination of the Director regarding the registration of, or refusal to register, a mark under this Act may appeal to the High Court from that determination within 14 days after the determination is made known to him. Appeals.

(2) After hearing the appeal, the Court may rescind or confirm the determination of the Director.

(3) The Registrar of the Supreme Court shall transmit a certified copy of the Court's decision to the Director, who shall record the decision in the register and publish a notice of it in the *Gazette*.

(4) The Director may be heard in person or by his attorney on an appeal under this section.

Trading Practices Offences

Competitive
offences.

- 48.** (1) No person shall knowingly
- (a) make use either directly or indirectly of a false or deceptive indication of the source of goods or services, or of the identity of the producer, manufacturer or supplier of goods, or the originator or supplier of services;
 - (b) make use either directly or indirectly of a false or deceptive appellation of origin of goods or services, or imitate an appellation or origin of goods or services, even if
 - (i) the true origin of the goods or services is indicated; or
 - (ii) the appellation is used in translated form or is accompanied by words indicative of a relationship or similarity between the goods or services;
 - (c) commit any act of a nature likely to cause confusion by any means in relation to the business establishment, the goods or services, or the industrial or commercial activities, of a business competitor;
 - (d) make any false allegation in the course of trade or business of such a nature as to discredit the business establishment, the goods or services, or the industrial or commercial activities, of a competitor; or
 - (e) give any indication or make any allegations the use of which, in the course of trade or business, is likely to mislead the public regarding the nature of goods or services, the manufacturing or originating process, the characteristics, suitability for their purpose, or the quantity or quality, of those goods or services.

(2) In this section,

(a) "appellation of origin" means the geographical name of a country, region or locality serving to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural or human factors; and

(b) "indication of source" means any expression or sign that is used to indicate that a product or service originates in a given country or group of countries.

49. No person shall knowingly infringe any right vested in any other person under this Act. Infringe-
ment.

49A. (1) Where a person is found to have infringed a registered trade mark, the court may make an order requiring him Order of
erasure etc.
of offending
sign.
2001-16.

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles.

(2) If an order under subsection (1) is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

49B. (1) The registered owner of a trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business. Order for
delivery up
of infringing
goods,
material or
articles.
2001-16.

s.49C

(2) An application shall not be made after the end of the period specified in section 49D, and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 49E.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 49E is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) Nothing in this section affects any other power of the court.

Meaning of
"infringing
goods,
material or
articles".
2001-16.

49C. (1) In this Act the expressions "infringing goods", "infringing material" and "infringing articles" shall be construed in accordance with this section.

(2) Goods are "infringing goods", in relation to a registered trade mark, if they bear, or their packaging bears, a sign identical or similar to that mark and

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark; or
- (b) the goods are proposed to be imported into Barbados and the application of the sign in Barbados to them or their packaging would be an infringement of the registered trade mark; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(3) Material is "infringing material" in relation to a registered trade mark if it bears a sign identical or similar to that mark and either

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or
- (b) it is intended to be so used and such use would infringe the registered trade mark.

(4) "Infringing articles", in relation to a registered trade mark, means articles

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and
- (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

49D. (1) Subject to subsection (2), an application for an order under section 49B may not be made after the end of the period of 6 years from

Period after which remedy of delivery-up not available. 2001-16.

- (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
- (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
- (c) in the case of infringing articles, the date on which they were made.

(2) If during the whole or part of the period referred to in subsection (1), the registered owner of a trade mark

- (a) is under a disability; or
- (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of 6 years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(3) In subsection (2) "disability" has the same meaning as in the *Limitation of Actions Act*.

Cap. 231.

Order as to disposal of infringing goods, material or articles.
2001-16.

49E. (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 49B, an application may be made to the court

(a) for an order that they be destroyed or forfeited to such person as the court may think fit; or

(b) for a decision that no order under paragraph (a) should be made.

(2) In considering what order should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the registered owner of a trade mark, and any licensee, and protect their interests.

(3) A notice shall be served on any person who has an interest in the goods, material or articles and any such person is entitled

(a) to appear in proceedings for an order under this section, whether or not he was served with notice; and

(b) to appeal against any order made, whether or not he appeared,

and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or articles, the court shall make such order as it thinks just.

(5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were, before being delivered up, is entitled to their return.

Penalties.

50. A person who contravenes section 48 or 49 is guilty of an offence and liable on summary conviction

- (a) to a fine of \$10 000 or to imprisonment for a term of 2 years or to both; and
- (b) in the case of a continuing offence, to a further fine of \$1 000 for each day or part thereof on which the offence continues.

50A. (1) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the registered owner of a trade mark,

Unauthorised use of trade mark etc. in relation to goods. 2001-16.

- (a) applies to goods or their packaging a sign identical to, or likely to be mistaken for, a registered trade mark;
 - (b) sells or lets for hire, offers or exposes for sale or hire, or distributes goods which bear, or the packaging of which bears, a sign referred to in paragraph (a); or
 - (c) has in his possession, custody or control in the course of a business, any goods referred to in paragraph (a) with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (2) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the registered owner of a trade mark
- (a) applies a sign identical to, or likely to be mistaken for, a registered trade mark, to material intended
 - (i) to be used for labelling or packaging goods;
 - (ii) to be used as a business paper in relation to goods; or
 - (iii) to be used for advertising goods; or
 - (b) uses, in the course of a business, material bearing a sign referred to in paragraph (a) for labelling or packaging goods, as a business paper in relation to goods or for advertising goods; or

(c) has in his possession, custody or control in the course of a business, any material referred to in paragraph (a), with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(3) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the registered owner of a trade mark,

(a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trade mark; or

(b) has an article referred to in paragraph (a) in his possession, custody or control, in the course of a business,

knowing or having reason to believe that it has been or is to be used to produce goods or produce material for labelling or packaging goods, or to be used as a business paper in relation to goods, or to be used for advertising goods.

(4) A person does not commit an offence under this section unless

(a) the goods are goods in respect of which the trade mark is registered; or

(b) the trade mark has a reputation in Barbados and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(5) It is a defence for a person charged with an offence under this section to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.

(6) A person who commits an offence under this section is liable

(a) on summary conviction, to a fine of \$10 000 or to imprisonment for 6 months or to both;

- (b) on conviction on indictment, to a fine of \$40 000 or to imprisonment for 10 years or to both.

50B. (1) It is an offence for a person to make, or cause to be made, a false entry in the Register, knowing or having reason to believe that it is false.

Falsification
of register
etc.
2001-16.

(2) It is an offence for a person

- (a) to make or cause to be made anything falsely purporting to be a copy of an entry in the Register; or
- (b) to produce or tender or cause to be produced or tendered in evidence anything referred to in paragraph (a),

knowing or having reason to believe that it is false.

(3) A person who commits an offence under this section is liable

- (a) on summary conviction, to a fine of \$10 000 or to imprisonment for 6 months or to both;
- (b) on conviction on indictment, to a fine of \$40 000 or to imprisonment for 10 years or to both.

50C. (1) It is an offence for a person

- (a) falsely to represent that a mark is a registered trade mark; or
- (b) to make a false representation as to the goods or services for which a trade mark is registered

Falsely
representing
trade mark
as regis-
tered.
2001-16.

knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in Barbados in relation to a trade mark

- (a) of the word "registered"; or
- (b) of any other word or symbol importing a reference, express or implied, to registration,

shall be deemed to be a representation as to registration under this Act, unless it is shown that the reference is to registration elsewhere than in Barbados and that the trade mark is in fact so registered for the goods or services in question.

Forfeiture of
counterfeit
goods etc.
2001-16.

50D. (1) Where there have come into the possession of any person in connection with the investigation or prosecution of a relevant offence

- (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark;
- (b) material bearing a sign referred to in paragraph (a), and intended to be used for labelling or packaging goods to be used as a business paper in relation to goods, or to be used for advertising goods; or
- (c) articles specifically designed or adapted for making copies of a sign referred to in paragraph (a),

that person may apply under this section for an order for the forfeiture of the goods, material or articles.

(2) An application under this section may be made,

- (a) where proceedings have been brought in any court for a relevant offence relating to some or all of the goods, material or articles, to that court;
- (b) where no application for the forfeiture of the goods, material or articles has been made under paragraph (a), by way of complaint to a magistrate's court.

(3) On an application under this section, the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that the relevant offence has been committed in relation to the goods, material or articles.

(4) A court may infer for the purposes of this section that an offence under this section has been committed in relation to any goods, material or articles, if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch or otherwise.

(5) An order under this section may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of an appeal.

(6) Any person aggrieved by an order made under this section by a magistrate's court or by a decision of such a court not to make such an order, may appeal against that order or decision to the Court of Appeal.

(7) Subject to subsection (8), where any goods, material or articles are forfeited under this section, they shall be destroyed in accordance with such directions as the court may give.

(8) On making an order under this section, the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall, instead of being destroyed, be released to such person as the court may specify, on condition that that person

- (a) causes the offending sign to be erased, removed or obliterated; and
- (b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

(9) For the purposes of this section, "relevant offence" means an offence under section 50A, an offence involving dishonesty or deception or such other offence as may be prescribed.

Offences by
corporations.
2001-16.

50E. (1) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he as well as the body corporate, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

Limitation.

51. A prosecution for an offence under section 48 or 49 may be brought at any time within 5 years from the date the offence, or the last date on which the last of any continuing offence, was committed.

Civil Remedies

Civil
remedies.

52. (1) A person who sustains any damage by reason of any acts described in section 48 or 49 may institute proceedings in the High Court to recover his damages, whether or not the person who committed those acts had been successfully prosecuted under that section.

(2) The court may, in addition to awarding damages under subsection (1), grant an injunction prohibiting a person from continuing any contravention of section 48 or 49.

Administration

Communi-
cations.

53. Except as otherwise provided in this Act, any communication with the registered owner of a mark may be validly made by sending the communication to his address, or to his address for service as recorded in the register.

53A. (1) The registered owner of a trade mark may give to the Comptroller of Customs a notice in the approved form objecting to the importation, after the date of the notice, of goods that infringe the trade mark; and the notice shall be given together with any prescribed document.

Notice of objection to importation. 2001-16.

(2) Where

(a) the owner of the registered trade mark has not given a notice under subsection (1); or

(b) any notice given under subsection (1) is no longer in force,

a registered user of the trade mark having power to give a notice under subsection (1) may ask the registered owner to give such a notice in respect of the trade mark.

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

53B. (1) This section applies to goods manufactured outside Barbados that

Comptroller of Customs. 2001-16.

(a) are imported into Barbados; and

(b) are subject to the control of the Comptroller of Customs pursuant to the *Customs Act*.

Cap. 66.

(2) Where goods to which this section applies

(a) have applied to them or in relation to them a mark that, in the opinion of the Comptroller of Customs, is substantially identical with, or deceptively similar to, a notified trade mark; and

s.53C

- (b) are goods in respect of which the notified trade mark is registered or similar or related goods for which the mark is registered,

the Comptroller of Customs shall detain the goods unless satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.

(3) The Comptroller of Customs may from time to time require the objector who has given notice under section 53A to give the Comptroller security or further security within such time and in such manner, whether by way of bond, deposit of a sum of money or otherwise, as the Comptroller may specify, against all actions, proceedings, claims and demands which may be taken or made against, or costs and expenses which may be incurred by, the Comptroller in consequence of the detention of goods to which the notice relates.

(4) The Comptroller of Customs may decide not to detain the goods if he has not been given by the objector such security in accordance with subsection (3).

(5) Goods detained under this section shall be kept in a secure place as directed by the Comptroller of Customs.

Notice of
detention.
2001-16.

53C. (1) The Comptroller of Customs shall, as soon as practicable,

- (a) give either personally or by post to the designated owner of any detained goods a notice in the approved form identifying the goods and stating that they have been detained under section 53B; and
- (b) give either personally or by post to the objector, or to each objector, a notice in the approved form
- (i) identifying the goods and stating that they have been detained under section 53B;

- (ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller of Customs has and that he believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods; and
- (iii) stating that the goods will be released to the designated owner unless an objector brings an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller of Customs notice in writing of the action, within the period of 10 working days after he has been given the notice or, if the Comptroller of Customs extends that period under section 53F, within the extended period.

(2) Where the Comptroller of Customs gives notice under subsection (1), the Comptroller shall allow the designated owner and the objector sufficient opportunity to inspect the detained goods for the purpose of substantiating any claim.

53D. (1) The designated owner of any detained goods may, at any time before an objector starts an action for infringement of a notified trade mark in respect of the goods, consent to the goods being forfeited to the Crown by giving notice in the approved form to that effect to the Comptroller of Customs.

Forfeiture
of goods.
2001-16.

(2) Where the designated owner gives a notice referred to under subsection (1), the goods are forfeited to the Crown.

53E. (1) The Comptroller of Customs shall release the detained goods to their designated owner if, within the action period, the objector has not, or none of the objectors has,

Release of
goods to
owner, no
action for
infringe-
ment.
2001-16.

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

(2) The Comptroller of Customs shall also release the detained goods to their designated owner if

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

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

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

(4) In this section, "action period", in relation to detained goods, means

- (a) if there is only one objector to the importation of the goods, the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under section 53F; or

- (b) if there is more than one objector to the importation of the goods, the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under section 53F and ending at the end of the last day on which an objector may bring such an action under section 53F.

53F. (1) An objector may bring an action for infringement of a notified trade mark in respect of detained goods and give notice of it in the approved form to the Comptroller of Customs,

Action for
infringe-
ment.
2001-16.

- (a) where paragraph (b) does not apply, within the notified period of 10 working days specified in the notice given to the objector in respect of the goods under section 53C; or

(b) where

- (i) the objector has, before the end of the notified period, applied in writing to the Comptroller of Customs for an extension of the notified period; and

- (ii) the Comptroller of Customs, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended the notified period for a number of working days not exceeding 10,

within that period as so extended by the Comptroller of Customs.

(2) The court hearing the action

- (a) may, on the application of a person, allow the person to be joined as a defendant to the action; and

(b) shall allow the Comptroller of Customs to appear and be heard.

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

- (a) at any time, if it thinks it just, order that the detained goods be released to their designated owner, subject to any conditions that the court considers fit to impose; or
 - (b) order that the detained goods be forfeited to the Crown.
- (4) Where
- (a) the court decides that the trade mark was not infringed by the importation of the goods; and
 - (b) the designated owner of the goods, or any other defendant, satisfies the court that he has suffered loss or damage because the goods were detained,

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

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

(6) Where the court orders that the goods be released, the Comptroller of Customs shall, subject to section 53I, comply with the order.

"Approved form".
2001-16.

53G. For the purposes of sections 53A, 53C, 53D, 53E and 53F, "approved form" means such form as is approved by the Comptroller of Customs.

Manner of disposal of forfeited goods.
2001-16.

53H. Where

- (a) goods are forfeited to the Crown under section 53D; or
- (b) the court orders under section 53F that goods be forfeited to the Crown,

the goods are to be destroyed or otherwise disposed of as the Comptroller of Customs directs, except that, in the case of counterfeit goods, the Comptroller shall not permit the re-exportation of those goods in an unaltered state otherwise than in exceptional circumstances.

53I. The Comptroller of Customs

- (a) shall not release, or dispose of, any detained goods; or
- (b) shall not take any action in relation to the goods to give effect to any order of a court under section 53F,

Power of Comptroller to retain control of goods. 2001-16.

if the Comptroller is required or allowed to retain control of the goods under any other law of Barbados.

53J. If security given under section 53B(3) by the objector who gave notice under section 53A in respect of a trade mark is not sufficient to meet the expenses incurred by the Crown, as a result of the action taken by the Comptroller of Customs under this Act by reason of the notice, the amount of the difference between those expenses and the amount of security

Insufficient security. 2001-16.

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

53K. The Crown is not liable for any loss or damage suffered by a person

Immunity in respect of official acts. 2001-16.

- (a) because the Comptroller of Customs detained or failed to detain goods under this Act; or
- (b) because of the release of any detained goods.

53L. (1) Where

- (a) goods that may be detained under this Act are imported into Barbados; and

Power to require information. 2001-16.

(b) the Comptroller of Customs relying on information received, is satisfied on reasonable grounds that the use of a trade mark applied to or in relation to those goods is fraudulent,

the Comptroller of Customs may ask the importer of the goods

(c) to produce any document in his possession relating to the goods; and

(d) to give information about

(i) the name and address of the person by whom the goods were consigned to Barbados; and

(ii) the name and address of the person in Barbados to whom the goods were consigned.

(2) Where the importer intentionally or recklessly fails to comply with the request within the prescribed period, the importer is guilty of an offence, and is liable on conviction on indictment to a fine of \$40 000 or imprisonment for 6 months or to both.

Importation
for personal
use.
2001-16.

53M. Notwithstanding the provisions of sections 53A to 53L, the importation by an individual, for his own personal use, of not more than 5 of the same items bearing a registered trade mark in respect of which a notice has been given in accordance with section 53A shall be permitted, but the Comptroller of Customs may permit the importation of a greater number of items if he is satisfied that they are for the personal use of that individual.

Miscellaneous

Reciprocity. **54.** The Minister may, by order, provide that reciprocal treatment of marks be given in relation to any country that provides similar protection to marks registered in Barbados, and to applications for registration of marks in Barbados, as is given by this Act.

Directions. **55.** The Director may issue directions relating to practice and procedure in the registration of marks under this Act, and regarding the operations of the register generally, but subject to any regulations made under section 56.

56. The Minister may make regulations prescribing for any matters or things required to be prescribed or provided for under this Act, and generally, for the effective operation of this Act. Regulations.

57. (1) After 1st January, 1985, no marks may be registered or renewed under the *Trade Marks Act*.¹ Effect of former Act.

(2) A renewal of a mark registered under the *Trade Marks Act*¹ may be made under section 26.

(2.1) A reference in this Act to a mark registered under this Act or to an application pending under this Act for registration of a mark in any of the following provisions, namely, sections 3, 8(1)(a)(i), 20(1)(a) and (b) and 31, includes, as the circumstances require, 1984-20.

(a) the registration before 1st January, 1985, of a mark under the *Trade Marks Act*;¹

(b) an application for registration of a mark pending under the *Trade Marks Act*¹, on 1st January, 1985,

and this Act applies, *mutatis mutandis*, to a mark registered under the *Trade Marks Act*¹ but without diminishing the rights acquired by virtue of registration under the *Trade Marks Act*¹.

(3) Orders-in-Council made after 1st January, 1985 under the *Patents and Designs Act* of the United Kingdom 1907 and under the *Patents Act, 1949* of the United Kingdom do not extend to Barbados; and trade marks registered in the United Kingdom under the *Trade Marks Act* of the United Kingdom cease to be entitled to registration by virtue only of their having been so registered.

58. This Act is binding on the Crown.

Binding
Crown.

¹Means the former *Trade Marks Act* (1949-52) (Cap. 319) repealed by this Act.

