

**CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

Responses from Barbados

**Introductory Remarks**

The Agreement on Trade-Related Aspects of Intellectual Property Rights covers eight (8) international standards concerning the availability, scope and use of intellectual property rights. The required minimum standards are set out in Sections 1 to 8 of Part II of the Agreement. Under Barbados Law, these rights may be broadly classified into two (2) distinct categories, as follows:

Rights granted by a Registrar following a registration process, namely:

- patents (granted under the Patents Act, 1981 and the Patents Bill, 2001<sup>2</sup>);
- trade and service marks (registered under the Trade Marks Act of 1981);
- industrial designs (registered under the 1981 Industrial Designs Act);
- geographical indications (registered under the Geographical Indications Act, 1998);
- layout-designs of integrated circuits (registered under the Integrated Circuits Act, 1998);
- plant breeders' rights (registered under the Protection of New Plant Varieties Bill, 2001<sup>3</sup>).

Rights which are created or which arise automatically by operation of law, namely:

- copyright (and related rights) governed by the Copyright Act, 1998;
- rights of action or other entitlement to institute civil proceedings for infringement and enforcement which arise either at "common law"<sup>4</sup> or by virtue of the provisions of the Protection Against Unfair Competition Act, 1998, the Patents act, the Trade Marks

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<sup>1</sup> Document IP/C/5.

<sup>2</sup> See Annex I of document IP/N/1/BRB/2 for a brief description. The Patents Bill, 2001 is expected to be in force by 30 June 2001.

<sup>3</sup> See Annex I of document IP/N/1/BRB/2 for a brief description. The Protection of New Plant Varieties Bill, 2001 is expected to be in force by 30 June 2001.

<sup>4</sup> E.g. the English "Common Law" action for "passing off" (which provides a remedy for misrepresentation of the origin of goods and services and therefore gives protection against the unauthorised use of trade marks which while unregistered have gained through their use a reputation in the relevant market).

Act, the Industrial Designs Act, the Integrated Circuits Act or under the other intellectual property statutes.

As a former colony of Great Britain, Barbados inherited its legal system from the United Kingdom. Like many former colonies of Great Britain, Barbados' legal system is founded on English common law received at independence, statute law, case law and a written constitution, which is the supreme law which provides the foundational framework for all other laws of Barbados.

The Constitution sets out and guarantees several fundamental rights and freedoms including protection from deprivation of property and also establishes the main organs and offices of State, including the Supreme Court of Judicature.

In Barbados, registered intellectual property rights are granted or registered through the Office of the Registrar of Corporate Affairs and Intellectual Property (the Registrar). The intellectual property rights statutes provide the Registrar with largely administrative powers in relation to the grant or registration of intellectual property rights. However, a few of the intellectual property rights statutes confer limited judicial functions on the Registrar to hear and determine specific issues and resolve disputes which may arise between the applicant and third parties in the course of an application<sup>5</sup> for registration of an intellectual property right. All decisions, acts or omissions of the Registrar are subject to appeal to the High Court, with the possibility of further appeals to the Court of Appeal, and even to the British Privy Council, as the judicial body vested with final appellate jurisdiction in civil and criminal matters in Barbados.

Laws relating to intellectual property in Barbados grant private rights to the right holder. As with all other private rights, the responsibility for enforcement of intellectual property rights lies primarily with the right holder. In addition to instituting civil proceedings for enforcement of his rights, the right holder is also entitled to make a formal complaint or other report to the police authorities that a criminal offence in relation to his intellectual property rights has been committed. In these circumstances, the complaint is investigated and criminal charges may be instituted against the alleged perpetrator.

## **Civil and Administrative Procedures and Remedies**

### *(a) Civil judicial procedures and remedies*

#### **1. Specify the courts which have jurisdiction over IPR infringement cases.**

There are no specialist courts established exclusively for the adjudication of intellectual property matters in Barbados. Accordingly, general jurisdiction over all civil cases (including intellectual property right cases) is vested in the Supreme Court of Judicature, consisting of the High Court and the Court of Appeal. Below the Supreme Court is a system of Magistrates' Courts which have jurisdiction in minor civil matters. Rights of final appeal from the Supreme Court are vested in the British Judicial Committee of the Privy Council.

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<sup>5</sup> The Trade Marks Act, Cap. 319; the Geographical Indications Act, 1998-22; the Integrated Circuits Act, 1998-21.

**2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?**

Which persons have standing to assert IPRs?

The owner of the intellectual property right, or his duly authorised licensee, may assert his right in intellectual property by way of proceedings in the civil courts. The rights in trade marks<sup>6</sup>, patents, industrial designs, geographical indications, plant breeders' rights and the layout-designs of integrated circuits are all enforceable by the right holder or the licensee, provided that such person is recorded as the proprietor or licensee in the appropriate register held by the Registrar of Corporate Affairs and Intellectual Property.

Copyright and its related rights are capable of assertion by the "first owner" of the rights in the work. Unlike the above-mentioned intellectual property rights which are all registerable, there is no formal registration of copyright and its related rights in Barbados. The owner of the right may initiate proceedings in respect of copyright infringement, whether such ownership arose by way of creation of the work, by subsequent operation of law, or by way of assignment of other transmission of the right. A holder of an exclusive license in the work may also commence civil action against the infringer.

In the case of the registerable intellectual property rights, the owner or licensee of those rights is legally bound to have his rights recorded in the Register. The relevant enactments providing for the registration of the categories of intellectual property rights identified in the first part of the introductory remarks under "Rights granted by a Registrar following a registration process" above, allow any interested party to initiate enforcement proceedings against anyone who uses those rights in an unlawful manner.

In the case of trade marks, the common law action of "passing off" remains an option in the instance where an unregistered mark is infringed.

How may they be represented?

A natural person is entitled to enter a personal appearance before the Magistrates' Court or the Supreme Court, however, a corporate entity must be represented by an attorney-at-law called to the Barbadian Bar who is qualified to practice law in Barbados. In Barbados, unlike in the United Kingdom, the legal profession is "fused", which means that a qualified attorney-at-law called to the Bar in Barbados has a right of audience before any court without the need for the litigant to engage both a solicitor and barrister-at-law.

Are there any requirements for mandatory personal appearances before a court by the right holder?

There are no requirements for mandatory personal appearances, however the right holder must be identified as such, and a person representing the right holder must enter an appearance on behalf of the right holder and establish his right to present the claim in question on the right holder's behalf.

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<sup>6</sup> See Annex I of document IP/N/1/BRB/2 for a brief description of the Trade Marks Act, Cap. 319. The term "trade mark" includes "service mark".

**3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence that lies within its control?**

Under the provisions of the Rules of the Supreme Court and the Evidence Act, the Supreme Court has the power to order the production of documents in court. A party to litigation is legally obligated to allow "discovery" of all relevant documents in its custody. During "discovery", the documents relevant to the case are listed by both sets of litigants and the list is given to the other party for inspection; and copies of those documents are then provided to that party. The only exceptions to this rule are those documents for which legal or professional privilege is claimed, such as documents relating to attorney/client communications. In the event that a party does not provide discovery of documents, that party's statement of claim or defence, as the case may be, may be "struck out" under applicable rules of court.

In Barbados, there is also provision for the court to order that documents or other material relevant to proceedings be protected if there is a legitimate fear that such documents or material will be destroyed prior to their production before the court. This is set out in more detail in the answer to question 10 below.

**4. What means exist to identify and protect confidential information brought forward as evidence?**

The legislation in Barbados makes no provision as to the treatment of confidential information arising from evidence given in court. The court retains discretion as to the treatment and security of such information. It is for the party claiming confidentiality of the information to place the court on notice of the nature of the information and to request the court's ruling on the issue. The court will, if necessary, make orders relating to the type and manner of protection of such information.

While most litigation in Barbados is held in open court, when the public and press may be present, some *in limine* matters and *in camera* proceedings are held in closed session, where the public will not be allowed to be present and journalists will be prohibited from publishing anything concerning the evidence in the matter.

**5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use;**

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Injunctions

Under the provisions of Barbadian law, including those relating to intellectual property, the court is empowered to grant an injunction directed to the defendant forbidding any further infringement of the action complained of. An injunction may be permanent or interlocutory in nature.

Generally, an interlocutory injunction is obtained before trial of the case, once the court is satisfied that

- there is a serious issue to be tried; and
- the damage to the right holder/plaintiff, in the event of the injunction not being granted, will not be adequately ameliorated by monetary damages.

The party seeking the interlocutory injunction must give an undertaking to compensate the other party in the event that the injunction is later found to be unjustified.

A permanent injunction is granted following a full trial of the issues and where the court makes a finding that the acts of the defendant have amounted to an infringement of an intellectual property right.

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

The courts in Barbados exercise a general jurisdiction to award damages for infringement. Once a court has found that an infringement of an intellectual property right has occurred, the right holder/plaintiff is entitled automatically to an award of damages. Damages consist largely of the quantum of commercial loss due to the infringement of the plaintiff's intellectual property rights. The court will make an award based upon evidence adduced by the right holder regarding the direct loss which has been suffered as a result of the infringing acts of the defendant established at the trial.

There may also be an order by the court that the offending party pay the legal costs of the proceedings incurred by the other party. In respect of court costs and attorney's fees, such costs are normally ordered by the court to be taxed or agreed between the parties. In the instance that the parties cannot agree on the quantum of costs, the Registrar of the Supreme Court will assess (tax) the costs payable. The costs that are assessed are those that the Registrar will deem reasonable in the circumstances of the case.

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

The courts possess the power to order the infringing parties to deliver up infringing items (inclusive of copies), along with the means to create the infringing items and materials. Under the provisions of the Copyright Act, the court may make such orders for delivery up, seizure and destruction or other disposal of the infringing material.

The Trade Mark (Amendment) Bill, 2001<sup>7</sup> also contains provisions covering criminal penalties to be imposed in cases of wilful counterfeiting and provides for the circumstances in which infringing goods and material may be seized, forfeited and destroyed.

#### Any other remedies

Under the Rules of the Supreme Court<sup>8</sup>, a right holder may, upon a finding of infringement of his rights, elect to seek instead of an award of damages, an "account of profits".

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<sup>7</sup> See Annex I of document IP/N/1/BRB/2 for a brief description of the Trade Marks (Amendment) Bill, 2001, which is expected to be in force by 15 July 2001.

<sup>8</sup> See Annex II of document IP/N/1/BRB/2 for a brief description of the Rules of the Supreme Court, 1982. Order 43 of the Rules governs the procedure for obtaining an account or inquiry.

- 6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods of services found to be infringing and of their channels of distribution?**

This matter has never been raised in the local courts, but it is likely that as in the United Kingdom, courts may consider that they also have an inherent power to make such orders including an order to a defendant requiring the provision of information identifying those who have supplied him with infringing articles.

- 7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

As mentioned above, the court will issue the injunction against an offending party only upon the giving of an undertaking by the party seeking the injunction that the other party will be indemnified in damages if found to be innocent or wrongly enjoined. The usual practice in this situation is that the party seeking the injunction will give "security of costs" either by way of a deposit of money to the Supreme Court Registry or by a bank guarantee. This is also done in the case of appeals.

To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

At common law, the Judiciary of Barbados are immune from litigation in respect of their decisions, either in cases of their decisions being overturned by a higher appellate court, or by a court in another case reaching a different conclusion.

The Registrar is (under the various intellectual property right statutes relating to registered intellectual property rights) generally immune from liability resulting from the performance of his/her statutory duties.

- 8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Describe provisions governing the length and cost of proceedings

While certain preliminary procedures must be carried out within specified time periods as provided by the Rules of the Supreme Court (unless such time periods are "enlarged" by mutual consent of the parties), the actual length of trial proceedings is largely dependent upon the complexity of the legal issues and whether the parties are willing to settle the matter prior to the conclusion of litigation. In addition, there is the possibility that one party may apply for an order of the Court with the proviso that if it is not complied with in a specified time-frame, the matter will be deemed to be determined against the non-compliant party.

Prior to the commencement of the trial on the substantive issues, the pleadings of the case must be exchanged between the parties, together with any defence and counterclaim or reply that may be necessary. Under recent changes in the civil law of Barbados, skeleton arguments to be used in the case are also to be filed prior to the commencement of trial.

As mentioned in the answer to question 3 above, there is also the process of "discovery" of documents relevant to the issues at trial. Once all preliminary matters are complete, the Registrar of the Supreme Court will then set the matter down for trial.

Provide any available data on the actual duration of proceedings and their cost

As stated above, the actual duration of trial is largely dependent upon the complexity of the legal issues and the volume of evidence to be considered by the trial judge in each individual case. As a result, there is no meaningful data available upon which to base an opinion as to the duration and cost of any proceedings, including intellectual property right proceedings.

(b) *Administrative procedures and remedies*

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

As indicated in the before-last paragraph of the introductory remarks, a few of the intellectual property right statutes (namely the Trade Marks Act, Cap. 319, the Geographical Indications Act, 1998-22, the Integrated Circuits Act, 1998-21) confer very limited judicial functions on the Registrar of the Corporate Affairs and Intellectual Property Office to hear and determine specific issues and resolve disputes which may arise between the applicant and third parties in the course of an application to register intellectual property rights. The Registrar, however, has no power to grant injunctions, award damages or order the destruction of infringing goods and materials which can only be ordered by the judges of the Supreme Court.

The Registrar has power to award costs to the successful party following the hearing of opposition proceedings before him/her and to require security for costs in relation to those proceedings<sup>9</sup>. In trade mark proceedings<sup>10</sup>, the Registrar also has power to order the attendance of witnesses, the examination of witnesses on oath, the discovery of documents and the production of documents relevant to the proceedings before him/her.

**Provisional Measures**

(a) *Judicial measures*

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

The court is empowered at Common Law and by way of various Intellectual Property Statutes to:

- Adjudicate upon enforcement of intellectual property rights and, may, upon application by the affected party, grant interlocutory injunctions (see the answer to question 5 above).
- Grant the relief known as the "Anton Piller" order, so-called after a British case of similar name. Under the terms of this order, the affected party, his appointed agent, or an officer of the court, may enter upon the premises of the suspected infringer, search for and take possession of any document or item specified in the order as being possible evidence in a trial for the purposes of preservation of that document or item. This order may also be worded as to prevent the suspected infringer from further infringement of the right.

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<sup>9</sup> See Section 36C of the Trade Marks (Amendment) Bill, 2001, which is expected to be in force by 15 July 2001.

<sup>10</sup> See Section 36B of the Trade Marks (Amendment) Bill, 2001.

- Grant a so-called "Mareva" injunction, which is designed to prevent the disposal of monetary assets held by a suspected infringer until the conclusion of the trial.
- Issue an order restraining the suspected infringer from leaving the jurisdiction of the Court until the conclusion of the case.
- Order payment of interim award of damages in the instance where the court is satisfied that the offended party has demonstrated that there will be an award of substantial damages at the conclusion of the case. The offended party may be ordered to preserve the sum for reparation to the other party in the event that there is no award of damages, or the award is for a lesser quantum than the interim payment.

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

Where the court is of the view that the injunction applied for should be issued immediately, usually in cases of exceptional urgency, due to the strong probability of serious and irreparable harm to the applicant if the injunction is not issued, it will be done on an *ex parte* basis. Such *ex parte* relief is granted on a short-term basis, and the applicant must seek a subsequent injunction, this time in the presence of the suspected infringer, on the appropriate grounds.

Special injunctions, such as the Anton Piller and Mareva injunctions, are usually granted on an *ex parte* basis due to the need to prevent the other party from having foreknowledge of the measures to be taken against him, and thus giving him time to destroy or remove vital evidence or assets.

**12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

The applicant is normally required to file a writ of summons to initiate the action prior to the application for an injunction. However, in extreme circumstances, the court will allow an application for an *ex parte* injunction. The applicant is required under these circumstances to give an undertaking to the court that the writ of summons will be subsequently filed at the earliest opportunity.

During any subsequent hearing in the presence of a suspected infringer, the usual Rules of Court will apply; the measures for the protection of the alleged infringer's interests as set out in the answer to question 5 above are also to be considered.

**13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

There are no provisions regulating the length or cost of legal proceedings in respect of provisional measures, such matters being dictated by the complexity of the legal issues and the discretion of the trial judge. The court will, in the interests of limiting potential loss to the applicant, expedite the hearing of the matter if necessary.

Any order as to costs in such matters are awarded in the discretion of the trial judge, and are usually dealt with as "costs in the cause" to be taxed or agreed, and paid at the end of the trial. The judge retains the discretion to order payment of costs between the parties at any stage of the trial.



(b) *Administrative measures*

**14. Reply to the above questions in relation to any administrative provisional measures.**

There are no administrative bodies in Barbados empowered to grant such provisional or interlocutory relief. However, the Customs Department is granted certain powers of a non-judicial nature, as discussed in the answers relating to border measures below.

**Special Requirements Related to Border Measures**

**15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51)

At common law in Barbados, the court may hear applications from holders of intellectual property rights, who have reasonable grounds for suspecting that infringing goods are being imported into Barbados, for orders restraining such importation. Legislation concerning intellectual property rights relating to trademarks and copyright also contain provisions granting the Customs Department powers to seize and detain counterfeit trademark goods and pirated copyright goods at points of entry into Barbados, upon application by the right holder<sup>11</sup>.

The Copyright Act, Section 49, allows the Customs Department to seize imported copies of published copyright material on application by the right holder or another authorised person to the Comptroller of Customs<sup>12</sup>.

Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

The importation by an individual for his own personal use of not more than five (5) of the same items bearing a registered trade mark in respect of which a notice has been given in accordance with Section 53A of the Trade Marks (Amendment) Bill, 2001 is permitted and the Comptroller of

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<sup>11</sup> See Sections 53A to 53L of the Trade Marks (Amendment) Bill, 2001, which is expected to be in force by 15 July 2001.

<sup>12</sup> See Section 49 of the Copyright Act, 1998-4.

Customs may permit the importation of a greater number of items if he is satisfied that the goods are for the personal use of that individual.<sup>13</sup>

**16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

As provided by Sections 207 and 210 of the Customs Act and Section 49 of the Copyright Act, the Comptroller of Customs is the competent authority for dealing with the suspension of release of goods.

The right holder is required to initiate proceedings by giving notice in writing to the Comptroller of Customs of his objections to the importation of the goods, together with any documents as may be required by the Comptroller. The notice remains in force for five (5) years from the day it was initially given. A security must be given by the copyright owner, his exclusive licensee, or, any other authorised person to cover any expenses incurred by the comptroller in seizure and detention of the goods.

With regard to trade marks, the Comptroller is entitled to seize infringing goods being imported into Barbados and subject to the control of the Customs Department within the provisions of the Customs Act. If the goods bear a mark which in the opinion of the Comptroller is identical with, or deceptively similar to, a trademark registered in Barbados and are in the class for which the trademark is registered, the Comptroller shall seize the goods unless satisfied that there are no reasonable grounds for seizure and detention on the grounds of infringement.

The Comptroller shall give notice of the seizure to the importer of the goods, as well as to the objecting party.

The Customs Act also provides that the notice must state that the goods that are seized and detained will be released to the importer if the objector fails to bring an action in the court with respect to the alleged infringement, and informs the Comptroller of the existence of that action, within days of the filing of the notice, unless the Comptroller extends the period for such information to be brought to him.

Failure to give the Comptroller notice of the action before the court will result in his releasing of the goods to the importer or owner. If during the intervening period the Comptroller has notice of any information indicating that the goods are in fact not infringing any intellectual property rights, he shall release the goods to the importer or owner. The Comptroller in his discretion may allow both parties to inspect the seized goods for evidentiary purposes.

The Supreme Court retains jurisdiction to order that the goods may be released to the importer in the event that it is satisfied that there has been no infringement. On the other hand, the court may also order, on application by the right holder, the exclusive licensee or authorised agent, that the infringing goods be delivered up, forfeited to the applicant, or destroyed or otherwise dealt with as the court deems fit.

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<sup>13</sup> See Section 53L of the Trade Marks (Amendment) Bill, 2001, which is expected to be in force by 15 July 2001.

In any event, if the court decides that there has been no infringement, the applicant may be ordered to compensate the importer or owner.

- 17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost

The Copyright Act, 1998, as well as the Trade Mark (Amendment) Bill, 2001, provide for border measures in order to prevent the importation of infringing goods, as stated in the answers to questions 8 and 13, the amount of time and cost of such proceedings will depend on the complexity of the issues involved and whether the required information has been provided to trigger action by the Comptroller of Customs. These matters will also depend on the extent of the alleged infringement and the quantum of infringing goods to be seized. However, since no requests for seizure have been made, there is no available data and the foregoing answer is merely hypothetical.

How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

The action before the Court in respect of the seizure and detention, or suspension of release of goods, must be filed within ten (10) working days of notice being given to the objector by the Comptroller of the suspension of release or seizure. During this ten (10) day "action period" or during an extension of this period, the right holder must apply to the court for an order preventing the release of the goods into free circulation.

Where after three (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.

- 18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

Are competent authorities required to act upon their own initiative and, if so, in what circumstances?

All actions in respect of intellectual property rights in Barbados must be initiated by the right holders, the exclusive licensee or an authorised agent, or the registered owner of the right. The authorities usually do not commence action except on the instance of the right holder or owner, or unless a right vested in the Crown is infringed.

Are there any special provisions applicable to *ex officio* action?

No.

- 19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

All remedies applicable to intellectual property rights are decided by the court. See the answers provided to question 5 above.

## **Criminal Procedures**

### **20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

Under the provision of the various intellectual property laws and the Magistrates' Courts Act, the Magistrates' Courts are provided with jurisdiction over summary offences. In respect of matters triable on indictment, the Supreme Court of Judicature Act empowers the High Court to exercise this jurisdiction. Appellate jurisdiction lies first with the Barbados Court of Appeal, and rights of hearing final appeals are vested in the Judicial Committee of the Privy Council, based in the United Kingdom.

### **21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?**

The Copyright Act provides at Section 46 for offences of infringement of any rights under that Act. An infringement of any copyright or related right as defined within the Act whether or not for profit, will result in criminal charges being brought against the infringer.

Any unauthorised reproduction, making, importing, selling or distribution of integrated circuits will constitute an offence under the Integrated Circuits Act. The Industrial Designs Act makes the unauthorised reproduction, selling, or importing for commercial purposes, a copy of a registered industrial design a criminal offence.

### **22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?**

The Royal Barbados Police Force is responsible for the investigation, detection and prevention of criminal offences. By virtue of the provisions mentioned in the answer to question 21, the Force will also have responsibility for dealing with crimes relating to intellectual property. Any decision to prosecute crimes will be that of the Director of Public Prosecution. The enforcement of the criminal law is usually as a result of reports received by the police from members of the public. The law does, however, make provision for the initiation of prosecution by members of the public.

### **23. Do private persons have standing to initiate criminal proceedings and, if so, who?**

Any person or body corporate possessing a public reason to do so may bring a private prosecution in order to enforce the criminal law. It should be noted that the permission of the Director of Public Prosecutions (or his *fiat*) must be obtained prior to the initiation of a private prosecution.

### **24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:**

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

It is an offence under the Trade Marks Act, for a person to apply to goods or their packaging a trademark identical to or capable of being confused with a registered trademark. It is also an offence to sell or let for hire, offer or expose for sale or hire, or to distribute, goods that bear such an infringing trademark. Possession of such goods with the intent to do any of the acts mentioned above will also constitute an offence.

It is an offence for a person to apply an infringing mark to goods without consent of the registered owner of the mark, with a view to enriching himself or causing loss to another. This applies to use of any item used in the reproduction of that infringing mark.

It is also an offence to make an item that will enable a person to make copies of an infringing mark.

Under Section 49(1) of the Trade Marks Act it is an offence for a person to knowingly infringe any rights in a registered trademark vested in a person under the Act. The penalty for infringement under the Act before a Court of summary jurisdiction is a fine of BD\$ 10,000.00 or a term of imprisonment of two years, or both; in the case of a continuing offence, a further fine of BD\$ 1,000.00 for each day the offence continues may be imposed.

Under Section 46 of the Copyright Act, the penalty for infringement for profit-making purposes by a person knowing or having reason to believe that he is committing an infringement, in summary conviction is a fine of BD\$ 25,000.00 and/or to one year imprisonment. The defendant convicted on indictment may receive a fine of BD\$ 100,000.00 and/or three years imprisonment.

Where there has been no decision on such remedies in civil proceedings, the magistrate or judge has the inherent jurisdiction to order the impounding of suspected copies or works on sound recordings, as well as the implements that could be used for the making of such copies; to order the forfeiture and seizure of all copies of works or sound recordings manufactured, reproduced, distributed, sold or otherwise used, intended for use or possessed with intent to use in contravention of the rights of the owner and all plates, moulds, 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; to order the destruction or other reasonable disposition of infringing copies.

Where an offence under Section 46 committed by a body corporate is proved to have been committed with the consent or connivance or attributable to neglect on the part of any director, manager, secretary or person purporting to act in any such capacity, he as well as the body corporate is guilty and liable to the above penalties.

The court retains inherent jurisdiction to forfeit counterfeit goods on the application of a person under the section. On such forfeiture, the court can order the destruction of any such goods; or cause the offending sign to be erased or obliterated and make an order for costs.

**25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.**

There are no provisions governing the length or cost of proceedings. Furthermore, no data is available on the actual duration of criminal and civil proceedings and their cost.

Where proceedings are contested, costs increase. As a general rule, costs in the Magistrates' Court are lower than in the High Court and in the Court of Appeal.

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