

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Saint Lucia

Introductory Remarks

Saint Lucia's legal system is a mix of common law and civil law systems due to its history, having been a colony of both France and England.

The system for enforcement for all rights in general is provided through a combination of legislation and common law. Intellectual property rights are private rights and therefore the onus of enforcing such rights resides with the right holder.

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

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

The Supreme Court of Saint Lucia which comprises the High Court and the Court of Appeal with the final appeal court being the Judicial Committee of the Privy Council.

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 proprietor of the intellectual property right or a licensee may assert his right through civil proceedings. In the case of trademarks, patents, industrial designs and layout-designs of integrated circuits, the registered proprietor of the rights or the registered licensee may assert that right. In the case of copyright and protection of undisclosed information the proprietor of the intellectual property right may assert the right.

In relation to enforcement of copyright, proceedings may be brought by anyone claiming to be the owner either as a result of creation or by virtue of assignment or other transmission of the rights. An exclusive licensee can also bring such enforcement proceedings. In the case of geographical indication any interested persons or any group of producers or consumers may institute proceedings in the High Court to prevent any unlawful act in respect of geographical indications.

How may they be represented?

Before the Supreme Court an individual may appear in person but a company must be represented by an attorney-at-law entitled to practice in Saint Lucia.

¹ Document IP/C/5.

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

There are no such requirements.

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?

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

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

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

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

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

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 general jurisdiction of the court and under the various intellectual property laws the courts may grant relief for infringement in the form of an interlocutory or perpetual injunction.

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

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

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

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

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

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

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

For patent infringement the court has the power to make an order for the infringer “to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised”.

Any other remedies

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

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?

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

- 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?**

Describe provisions relating to the indemnification of defendants wrongfully enjoined

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

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

Judges of the Supreme Court by common law are immune from litigation in the event that their decisions are overturned by the Court of Appeal.

By virtue of the Crown Proceedings Ordinance the Crown is vicariously liable for any liability incurred by a public officer in the course of the exercise of his duties or statutory powers. However it must be noted that the Crown can indemnify itself against the officer where it has had to pay damages.

- 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 relating to the indemnification of defendants wrongfully enjoined

There are no such provisions in the laws of Saint Lucia. The Rules of the Supreme Court stipulate periods for doing of certain things relating to pre-trial matters and these periods may be extended by agreement between the parties or on application to the Court.

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

There is no data relating to the actual duration of proceedings and their cost, as these will depend on the nature and complexity of the particular case and whether a settlement is reached before the matter actually goes to trial. The cost of a matter will vary depending on its duration and nature.

(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.**

The intellectual property legislation does not make provision for the exercise of administrative procedures that deal with infringement.

Provisional Measures

(a) *Judicial measures*

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

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

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

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

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

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.

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

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

- 13. 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

See the answer to question 8 above.

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

See the answer to question 8 above.

(b) *Administrative procedures*

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

There are no provisions in the laws of Saint Lucia where provisional relief can be given by an administrative body.

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)

Section 51 of the Copyright Act 1995 allows the Comptroller of Customs to seize imported copies of published copyright materials if a notice of objection to importation of the copies has been given to the Comptroller of Customs. The materials that must be the subject of these copies are published works, films, or sound recordings.

Section 116 of the draft Trademarks Act allows the Comptroller of Customs to seize infringing trademarks goods imported into Saint Lucia in respect of which a notice of objection has been filed with the Comptroller of Customs under section 115 by the registered owner of the registered trademark.

Where the infringing goods have applied to them or in relation to them a mark that in the opinion of the comptroller is substantively identical with or deceptively similar to the notified trademark and are goods in respect of which the notified trademark is registered or for similar or related goods, the Comptroller shall seize the goods unless he is satisfied that there are no reasonable grounds for believing that there is an infringement.

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 Copyright Act allows for the interdiction of such goods where their importation is prohibited by the copyright owner. (See the answer to the first part of question 15 above.) The existing intellectual property legislation does not make any provision for procedures with respect to the import of goods put on the market in another country.

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?

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

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

The draft Trademarks Act provides that the Comptroller may seize goods which are manufactured outside of Saint Lucia and imported into Saint Lucia and which are subject to the control of the Comptroller of Customs under the Customs (Control and Management) Act 1990. Similarly, under the Copyright 1995, the Comptroller may seize copies if a written notice of objection in the prescribed form has been given to the Comptroller. If goods have a trademark that, in the opinion of the Comptroller, is identical with, or deceptively similar to, a notified trademark and are goods in a class for which the trademark is registered, the Comptroller must seize the goods unless satisfied that there are no reasonable grounds for believing that infringement has occurred.

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

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

Under section 126 of the draft Act, if goods are seized and the Comptroller is satisfied that the use of a trademark is fraudulent, the Comptroller may ask the importer of the goods or an agent of the importer to produce any document relating to the good and give information about the name and address of the person by whom the goods were consigned to Saint Lucia and the name and address of the person in Saint Lucia to whom the goods were consigned. Failure to comply with this request is an offence and renders the defaulter liable on conviction to a fine of ten thousand dollars.

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

- 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 draft Trademarks Act is yet to be laid before Parliament and as yet does not have any regulations. The relevant regulations under the Copyright Act only came into force in May 2000 and so there has been insufficient time to provide data.

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

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

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

- 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?

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

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

There are no such provisions.

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

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

Criminal Procedures

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

The Magistrate's Court with respect to summary offences, the High Court with respect to indictable offences and on appeal, the Court of Appeal have jurisdiction over criminal acts of infringement. Final appeal lies to the Judicial Committee of the Privy Council.

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

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

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

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

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

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

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 Saint Lucia Police Force is responsible for initiating criminal proceedings in matters and also in the case of intellectual property. The action to prosecute for an offence is one for the Director of Public Prosecutions. In the vast majority of cases the action taken by the police results from complaints being brought. However, an individual is not precluded from bringing a private prosecution for these offences.

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

Persons do have the right to initiate to bring a prosecution. A *fiat* from the Director of Public Prosecutions is necessary in such a case.

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.**

Copyright

Under section 52 of the Copyright Act 1995, the penalty for letting for hire, or offering or exposing or sale or hire or exhibiting in public or distributing a work without the licence of the copyright owner is on summary conviction in the case of a first conviction, a fine not exceeding \$2500 for each article to which the offence relates and on any subsequent conviction to the fine or to imprisonment for a term not exceeding 12 months.

A person who makes for sale or hire, imports into Saint Lucia for purposes other than for private and domestic use, distributes otherwise than in the course of a business, possesses in the course of business with a view to committing any article which he knows or has reason to believe is an infringing copy of that work commits an offence and is liable in the case of a first conviction to a fine not exceeding \$1000 and in the case of a subsequent conviction, to a fine or to imprisonment for a term not exceeding 6 months.

The court has power to make an order for the impounding of copies of works or sound recordings suspected of being made or imported without the authorisation of the copyright owner, as well as the impounding of the packaging of, the implements that could be used for the making of, and the documents, accounts or business papers referring to such documents.

The court may also make an order for the forfeiture and seizure of all plates, moulds, matrices, masters, tapes, film, negatives, or other articles by means of which such copies of works or sound recordings may be reproduced, and all electronic, mechanical or other devices for manufacturing, reproducing, or assembling such copies of works or sound recordings.

Trademarks

The draft Trademarks Act makes provision for penalties with respect to infringement and generally provides penalties of a fine. The fines can be ascertained when the Act is passed. The draft contains fines ranging from ten thousand dollars to two hundred and fifty thousand dollars. Infringement under the Act is not actionable by criminal proceedings but civil. Where there is reference to criminal proceedings relates to falsifying of trademarks and false representations of trademarks.

Patents

The Draft Patents Act will make no provision for infringement of patents to be treated as criminal offences.

Industrial Designs

Section 22 of the Industrial Designs Act 2001 provides that it is an offence to perform an act stated in section 9 of the Act as an infringement. The penalty on summary conviction is a fine of \$10,000 and to imprisonment for five years.

Layout-Designs

Section 15 of the Layout-designs (Topographies) of Integrated Circuits Act 2000 provides that it is an offence to knowingly perform an act which is unlawful under section 6 of the Act. The penalty is: on summary conviction a fine of \$5000 or to imprisonment for two years. The Court may also order seizure, forfeiture and destruction of layout-designs, integrated circuits or articles concerned and of any materials or implements, the predominant use of which has been in the commission of the offence.

Geographical Indications

Section 16 of the Geographical Indications Act 2000 provides that any person who knowingly and with intent to deceive performs any of the acts in section 12 of the Act such as any use which constitutes an act of unfair competition, commits an offence. The penalties are on summary conviction, a fine of \$10,000 and to imprisonment for two years.

Plant Varieties

The draft Plant Varieties Act will make provision for fines up to fifteen thousand dollars in relation to criminal offences in relation to non-compliance or misuse of variety denomination.

- 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 length and cost of proceedings.
