

**Council for Trade-Related Aspects
of Intellectual Property Rights**

Original: English/
anglais/
inglés

**MAIN DEDICATED INTELLECTUAL PROPERTY
LAWS AND REGULATIONS NOTIFIED UNDER
ARTICLE 63.2 OF THE AGREEMENT**

GRENADA

The present document reproduces the text¹ of the Industrial Property Bill 2002, which has been notified by Grenada in addition to its initial notification under Article 63.2 of the Agreement, by a communication dated 13 June 2002. The Bill, once adopted, will repeal the Patents Act (CAP. 227) (distributed in document IP/N/1/GRD/P/1); the Patents Rules; the Registration of United Kingdom Patents Act (Cap. 283) (distributed in document IP/N/1/GRD/P/2); the Registration of United Kingdom Patents Rules; the Registration of United Kingdom Trade Marks Act (Cap. 284) (distributed in document IP/N/1/GRD/I/2); and the Registration of United Kingdom Trade Marks Rules.

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA
PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES AU TITRE
DE L'ARTICLE 63:2 DE L'ACCORD**

GRENADE

Le présent document contient le texte¹ du projet de loi sur la propriété industrielle de 2002, notifié par la Grenade par une communication datée du 13 juin 2002, qui s'ajoute à sa notification initiale au titre de l'article 63:2 de l'Accord. Une fois adoptée, la loi abrogera la Loi sur les brevets (CAP. 227) (qui figure dans le document IP/N/1/GRD/P/1); le Règlement sur les brevets; la Loi relative à l'enregistrement des brevets du Royaume-Uni (CAP. 283) (qui figure dans le document IP/N/1/GRD/P/2); le Règlement relatif à l'enregistrement des brevets du Royaume-Uni; la Loi relative à l'enregistrement des marques de fabrique ou de commerce du Royaume-Uni (CAP. 284) (qui figure dans le document IP/N/1/GRD/I/2); et le Règlement relatif à l'enregistrement des marques de fabrique ou de commerce du Royaume-Uni.

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA PROPIEDAD
INTELLECTUAL NOTIFICADOS EN VIRTUD DEL PÁRRAFO 2
DEL ARTÍCULO 63 DEL ACUERDO**

GRANADA

En el presente documento se reproduce el texto¹ de la Ley de Propiedad Industrial 2002, notificado por Granada además de su notificación inicial de conformidad con lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo, mediante una comunicación de fecha 13 de junio de 2002. La Ley, una vez sancionada, derogará la Ley de Patentes (CAP. 227) (distribuida en el documento IP/N/1/GRD/P/1); las Normas sobre Patentes; la Ley de Registro de Patentes del Reino Unido (Cap. 283) (distribuida en el documento IP/N/1/GRD/P/2); las Normas sobre el Registro de Patentes del Reino Unido; la Ley de Registro de Marcas de Fábrica o de Comercio del Reino Unido (Cap. 284) (distribuida en el documento IP/N/1/GRD/I/2), y las Normas sobre el Registro de Marcas de Fábrica o de Comercio del Reino Unido.

¹ In English only./En anglais seulement./En inglés solamente.

GRENADA

A BILL FOR

AN ACT to provide protection for patents, industrial designs, marks and trade marks in Grenada, and for related matters.

ENACTED by the Parliament of Grenada -

PART I - PRELIMINARY

Short title

1. This Act may be cited as the
INDUSTRIAL PROPERTY ACT 2002.

Interpretation

2. In this Act, unless the context otherwise requires –

“appraisal period means ___;

“court” means the court referred to in section [49];

“international classification” means, as regards industrial designs, the classification according to the Locarno Agreement Establishing an International Classification for Industrial Designs of October 8, 1968, as last revised, and, as regards marks, the classification according to the Nice Agreement Concerning the Industrial Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as last revised;

“Minister” means the [Minister of Legal Affairs];

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“registers” means the registers kept pursuant to section [46];

“Registrar” means the [Registrar of the Supreme Court];

“Registry” means [the Industrial Property] Registry established under section [45];

“regulations” means regulations made under section [52].

PART II - PATENTS

Definitions of “patent” and “invention”

3. (1) For the purposes of this Act, a “patent” means the title granted to protect an invention.

(2) (a) For the purposes of this Act, “invention” means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.

(b) An invention may be, or may relate to, a product or a process.

(3) The following, even if they are inventions, are excluded from patentability -

(a) a discovery, scientific theory or mathematical method;

- (b) a scheme, rule or method for performing a mental act, playing a game or doing business;
- (c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals, and products for use in any of those methods.

**Patentable
inventions**

4. (1) A patent may be granted only for an invention which -

- (a) is new;
 - (b) involves an inventive step; and
 - (c) is capable of industrial application.
- (2) (a) An invention is new if it is not anticipated by prior art.
- (b) Prior art consists of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where appropriate, the priority date, of the application claiming the invention.
 - (c) For the purposes of paragraph (b), disclosure to the public of the invention will not be taken into consideration if such disclosure occurred within 12 months preceding the filing date or, where applicable, the priority date of the application, and the disclosure was due to or in consequence of -
 - (i) acts committed by the applicant or the applicant's predecessor in title; or
 - (ii) an abuse committed by a third party with regard to the applicant or the applicant's predecessor in title.

(3) An invention involves an inventive step if, having regard to the prior art relevant to the application claiming the invention and as defined in subsection (2)(b), it is not obvious to a person having ordinary skill in the art.

(4) An invention is industrially applicable if it can be made or used in any kind of industry in its broadest sense, including handicraft, agriculture, fishery and services.

(5) Inventions the commercial exploitation of which would be contrary to public order or morality are not patentable.

**Right to patent;
naming of
inventor**

5. (1) The right to a patent belongs to the inventor.

(2) Where 2 or more persons have jointly made an invention, the right to the patent belongs to them jointly.

(3) Where and to the extent to which 2 or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, has the right to the patent, as long as the application is not withdrawn, abandoned or rejected.

(4) The right to a patent may be assigned, or may be transferred by succession.

(5) If an invention is made in execution of an employment contract, the right to the patent belongs, in the absence of contractual provisions to the contrary, to the employer.

(6) The inventor must be named as such in the patent, unless in a special written declaration signed by the inventor and addressed to the Registrar the inventor indicates that he or she wishes not to be named. Any promise or undertaking by the inventor made to any person to the effect that the inventor will make such a declaration is of no legal effect.

**Application for
a patent**

6. (1) An application for a patent must be filed with the Registrar and be accompanied by the prescribed application fee.

(2) An application for a patent must contain -

- (a) a request for the grant of the patent;
- (b) a description of the invention;
- (c) one or more claims and any drawings referred to in the description or any claim;
- (d) an abstract.

(3) (a) The request must contain a petition to the effect that a patent be granted, the name of and other prescribed information concerning the applicant, the inventor and the agent, if any, and the title of the invention.

(b) If the applicant is not the inventor, the request must be accompanied by a statement justifying the applicant's right to the patent.

(4) The description must disclose the invention in a manner which is clear and complete enough for the invention to be carried out by a person having ordinary skill in the art, and must, in particular, indicate at least one mode known to the applicant for carrying out the invention.

(5) The claim or claims must –

- (a) define the matter for which protection is sought;
- (b) be clear and concise;

(c) be fully supported by the description.

(6) Drawings must be provided if they are necessary for the understanding of the invention.

(7) The description and the drawings may be used to interpret the claim.

(8) The purpose of the abstract is to give technical information and it must not be taken into account for the purpose of interpreting the scope of the protection.

(9) The applicant may, up to the time when the application is in order for grant, withdraw the application at any time during its pendency.

**Unity of
invention;
amendment
and division of
application**

7. (1) The application must relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

(2) The applicant may, up to the time when the application is in order for grant, amend the application, but the amendment must not go beyond the disclosure in the initial application.

(3) (a) The applicant may, up to the time when the application is in order for grant, divide the application into two or more applications (“divisional application”), but each divisional application must not go beyond the disclosure in the initial application.

(b) Each divisional application is entitled to the filing date and, where applicable, the priority date of the initial application.

(4) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under subsection (1) is not a ground for the invalidation of the patent.

**Rights of
priority**

8. (1) A patent application may contain a declaration claiming the priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or the applicant's predecessor in title in or for any State party to that Convention [or any Member of the World Trade Organisation].

(2) If the application contains a declaration under subsection (1), the Registrar may require the applicant to furnish, within a specified time, a copy of the earlier application certified as correct by the registry with which it was filed.

(3) The effect of a declaration under subsection (1) is as provided in the Paris Convention.

(4) If the Registrar finds that the requirements under this section and the relevant regulations have not been fulfilled, the declaration is invalid.

**Information
Concerning
corresponding
foreign
applications for
patents**

9. (1) The applicant must upon request furnish the Registrar with the date and number of any application for a patent filed by the applicant abroad ("foreign application") relating to the same or essentially the same invention as that claimed in the application filed with the registry.

(2) The applicant must, upon request, furnish the Registrar with the following documents relating to any of the foreign applications referred to in subsection (1) -

- (a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (b) a copy of the patent granted on the basis of the foreign application;

- (c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application;
- (d) a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in subsection (1).

**Filing date;
examination**

10. (1) The Registrar must accord the date of receipt of the application as the filing date if, at the time of receipt, the application contains -

- (a) an express or implicit indication that the granting of a patent is sought;
- (b) indications allowing the identity of the applicant to be established; and
- (c) a part which on the face of it appears to be a description of an invention.

(2) If the Registrar finds that the application did not, at the time of receipt, fulfill the requirements of subsection (1), he or she must invite the applicant to file the required correction and must accord as the filing date the date of receipt of the required correction, but if no correction is made, the application must be treated as if it had not been filed.

(3) If the application refers to drawings which are not included in the application, the Registrar must invite the applicant to provide the missing drawings.

(4) If the applicant complies with the invitation referred to in subsection (3), the Registrar must accord as the filing date the date of receipt of the missing drawings. Otherwise, the Registrar must accord as the filing date the date of receipt of the application and treat any reference to the drawings as non-existent.

(5) After according a filing date, the Registrar must examine -

- (a) whether the application complies with the requirements of section [6] (1) to (3) and the relevant regulations and any requirements of this Act and the regulations which are designated by the regulations as formal requirements for the purposes of this Act;
- (b) whether any information requested under section [9], has been provided.

(6) If the Registrar is of the opinion that the application complies with the requirements of subsection (5), the Registrar must take a decision as to whether the requirements of sections [3](2) and (3), [4], [6](4), (5) and (6) and [7] and the relevant regulations are fulfilled and for this purpose may, as provided for in the regulations, cause the application to be examined.

(7) The Registrar must take into account, for the purposes of subsection (6) -

- (a) the results of any international search report and any international preliminary examination report established under the Paris Convention in relation to the application;
- (b) any search and examination report submitted under section [9](2)(a) or a final decision submitted under section [9](2)(c) relating to the patent on a corresponding foreign application;
- (c) any search and examination report which was carried out upon the Registrar's request by an external search and examination authority.

**Grant of patent;
changes in
patents**

11. (1) If the Registrar is of the opinion that the application complies with the requirements of section [10](6), the Registrar must grant the patent. Otherwise the Registrar must refuse the application and notify the applicant of the decision.

(2) If the Registrar grants a patent, the Registrar must -

- (a) publish a reference to the grant of the patent;
- (b) issue to the applicant a certificate of the grant of the patent and a copy of the patent;
- (c) record the patent; and
- (d) make available copies of the patent to the public, on payment of the prescribed fee.

(3) The Registrar must, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by it, unless the change would result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

**Rights conferred
by patent**

12. (1) The exploitation of the patented invention in Grenada by persons other than the owner of the patent require the agreement of the latter.

(2) For the purposes of this Act, “exploitation” of a patented invention means any of the following -

- (a) if the patent has been granted in respect of a product -
 - (i) making, importing, offering for sale, selling or using the product;
 - (ii) stocking the product for the purposes of offering for sale, selling or using it;

- (b) if the patent has been granted in respect of a process -
 - (i) using the process;
 - (ii) doing any of the acts referred to in paragraph (a) in respect of a product obtained directly by means of the process.

(3) The owner of the patent has, in addition to any other rights, remedies or actions available, the right, subject to subsection (4) and section 14, to institute court proceedings against any person who infringes the patent by performing, without the owner's agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

- (4) (a) The rights under the patent do not extend -
 - (i) to acts in respect of articles which have been put on the market in Grenada by the owner of the patent or with the owner's consent;
 - (ii) to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Grenada;
 - (iii) to acts done only for experimental purposes relating to a patented invention;
 - (iv) to acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted, was using the invention or was making effective and serious preparations for such use in Grenada.

- (b) The right of prior user referred to in paragraph (a)(iv) may be transferred or devolve together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for the use have been made.

**Duration;
annual fees**

13. (1) Subject to subsection (2), a patent expires 20 years after the filing date of the application for the patent.

(2) In order to maintain the patent or patent application, an annual fee must be paid in advance to the Registrar for each year, starting one year after the filing date of the application for grant of the patent. A grace period of 6 months is allowed for the late payment of the annual fee on payment of the prescribed surcharge.

(3) If the annual fee is not paid in accordance with the provisions of this subsection, the patent lapses.

**Exploitation by
Government or
authorised
person**

14. (1) If –

- (a) the public interest (in particular, national security, nutrition, health or the development of other vital sectors of the national economy) so requires; or
- (b) the [Minister of Finance] has determined that the manner of exploitation by the owner of the patent or a licensee is anti-competitive, and the Minister [for Legal Affairs] is satisfied that the exploitation of the invention in accordance with this subsection would remedy such practice,

the Minister [for Legal Affairs] may decide that, even without the agreement of the owner of the patent, a Government agency or a third person designated by the Minister may exploit the invention.

(2) The exploitation of the invention under this section is limited to the purpose for which it was authorized and is subject to the payment to the

owner of adequate remuneration, taking into account the economic value of the Minister's decision, as determined in the said decision, and, where a decision has been taken under paragraph (b) of subsection (1), the need to correct anti-competitive practices.

(3) The Minister [of Finance] and the Minister [of Legal Affairs] must take a decision under subsection (1) only after hearing the owner of the patent and any interested person who wishes to be heard.

(4) Upon the request of the owner of the patent, of the Government agency or of the third person authorized to exploit the patented invention, the Minister [of Legal Affairs] may, after hearing the parties, if either or both wish to be heard, vary the terms of the decision authorizing the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(5) (a) Upon the request of the owner of the patent, the Minister [of Legal Affairs] must terminate the authorization if the Minister is satisfied, after hearing the parties, (if either or both wish to be heard) that the circumstances which led to the decision have ceased to exist and are unlikely to recur or that the Government agency or third person designated has failed to comply with the terms of the decision.

(b) Notwithstanding paragraph (a), the Minister must not terminate the authorization if he or she is satisfied that the need for adequate protection of the legitimate interests of the Government agency or third person designated justifies the maintenance of the decision.

(6) If a third person has been designated by the Minister under subsection (1), the authorization may only be transferred with the enterprise or business of that person or with the part of the enterprise or business within which the patented invention is being exploited.

(7) The authorization must not exclude -

- (a) the conclusion of licence contracts by the owner of the patent;
- (b) the continued exercise, by the owner of the patent, of the rights under section [12](2); or
- (c) the issue of a non-voluntary licence under subsections (1) and (2) of section [14 A.]

(8) (a) A request for the Minister's authorization must be accompanied by evidence that the owner of the patent has received, from the person seeking the authorization, a request for a contractual licence, but that that person has been unable to obtain such a licence on reasonable commercial terms and conditions and within a reasonable time.

- (b) Paragraph (a) of this subsection does not apply in cases of national emergency or other circumstances of extreme urgency, but in such cases the owner of the patent must be notified of the Minister's decision as soon as reasonably practicable.

(9) The exploitation of the invention by the Government agency or third person designated by the Minister must be predominantly for the supply of the market in Grenada.

(10) The exploitation of an invention in the field of semi-conductor technology can only be authorized for public non-commercial use or if a judicial or administrative body has determined that the manner of exploitation of the patented invention, by the owner of the patent or the owner's licensee, is anti-competitive and if the Minister is satisfied that the issuance of the non-voluntary licence would remedy such practice.

(11) Decisions of a Minister under any of subsections (1) to (10) may be the subject of an appeal to the High Court.

**Non-voluntary
licences**

[14A. (1) If the invention claimed in a patent (“later patent”) cannot be exploited in Grenada without infringing a patent granted on the basis of an application benefiting from an earlier filing or, where appropriate, priority date (“earlier patent”), and if the invention claimed in the later patent involves an important technical advance of considerable economic importance in relation to the invention claimed in the earlier patent, the [Registrar] [Court], upon the request of the owner of the later patent, may issue a non-voluntary licence to the extent necessary to avoid infringement of the earlier patent.

(2) If a non-voluntary licence is issued under subsection (1), the [Registrar] [Court], upon the request of the owner of the earlier patent, must issue a non-voluntary licence in respect of the later patent.

(3) If a non-voluntary licence is issued under subsection (1) or (2), the issuing authority must fix the scope and function of the licence, the amount of the remuneration to be paid to the owner of the patent and the conditions of payment.

(4) In the case of a non-voluntary licence issued under subsection (1), the transfer may be made only with the later patent, or, in the case of a non-voluntary licence issued under subsection (2), only with the earlier patent.

(5) The issue of a non-voluntary licence is subject to payment of the prescribed fee.

(6) If a non-voluntary licence is issued under subsection (1) or (2), subsections (2) to (8) and (10) of section [14] apply with necessary modifications.]

Invalidation

15. (1) Any interested person may apply to the court to invalidate a patent.

(2) The court must invalidate the patent if the person requesting the invalidation proves that any of the requirements of sections [3](2) and (3), [4] and [6](4), (5) and (6) is not fulfilled or if the owner of the patent is not the inventor or the inventor's successor in title.

(3) Any invalidated patent, or claim or part of a claim, is null and void from the date of the grant of the patent.

(4) The decision of the court must be notified to the Registrar who must record it and publish a reference to it as soon as possible.

PART III – INDUSTRIAL DESIGNS

**Definition of
“industrial
design”**

16. (1) For the purposes of this Act, any composition of lines or colours or any three-dimensional form, whether or not associated with lines or colours, is deemed to be an industrial design, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

(2) The protection under this Act does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

**Registrable
industrial
design**

17. (1) An industrial design is registrable if it is new.

(2) An industrial design is new if it has not been disclosed to the public anywhere in the world -

(a) by publication in tangible form; or

(b) by use or in any other way prior to the filing date or, where applicable, the priority date of the application for registration.

(3) Section [4](2)(c) applies with necessary modifications to industrial designs.

(4) Industrial designs that are contrary to public order or morality are not registrable.

**Right to
registration of
design; naming
of creator**

18. Section [5] applies with necessary modifications to industrial designs.

**Application for
registration**

19. (1) An application for the registration of an industrial design must be filed with the Registrar and be accompanied by the prescribed application fee.

(2) An application for registration of an industrial design must contain -

- (a) a request for registration of the design;
- (b) drawings, photographs or other adequate graphic representations of the article embodying the industrial design;
- (c) an indication of the kind of products for which the industrial design is to be used.

(3) The application may be accompanied by a specimen of the article embodying the industrial design, if the industrial design is two-dimensional.

(4) If the applicant is not the creator, the request must be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

(5) Section [8] applies with necessary modifications to industrial designs.

(6) Two or more industrial designs may be the subject of the same application if they relate to the same class of the International Classification or to the same set or composition of articles.

(7) An application may contain a request that the publication of the industrial design, upon registration, be deferred for a period not exceeding 12 months from the date of filing or, if priority is claimed, from the date of priority, of the application.

(8) An applicant for the registration of an industrial design may withdraw the application at any time during its pendency.

**Examination,
registration and
publication of
industrial design**

20. (1) The Registrar must accord the date of receipt of the application as the filing date if, at the time of receipt, the application contains indications enabling the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design.

(2) Section [10](1)(b) applies with necessary modifications to industrial designs.

(3) After according a filing date, the Registrar must examine the application for compliance with the requirements of section [19](1) to (4) and the relevant regulations and must examine the industrial design for compliance with the requirements of sections [4] and [16] and the relevant regulations.

(4) If the Registrar is satisfied that the conditions referred to in subsection (3) are fulfilled, he or she must register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design. Otherwise, the Registrar must refuse the application.

(5) (a) Notwithstanding subsection (4), if a request has been made under section [19](7) for deferment of publication, upon registration of the industrial design neither the representation

of the design nor any file relating to the application is to be open to public inspection.

- (b) The Registrar must publish a notice of the deferment of the publication of the industrial design which must contain information identifying the registered owner, the filing date of the application, the length of the period for which deferment has been requested and any other particulars prescribed.
- (c) At the expiry of the period of deferment, the Registrar must publish the registered industrial design.
- (d) The institution of legal proceedings on the basis of a registered industrial design during the period of deferment of publication is subject to the condition that the information contained in the register and in the file relating to the application has been communicated to the person against whom the action is brought.

**Rights conferred
by registration**

21. (1) The exploitation of a registered industrial design in Grenada by persons other than the registered owner requires the agreement of the latter.

(2) For the purposes of this Act, exploitation of a registered industrial design means the making, selling or importation of articles incorporating the industrial design.

(3) Section [12](4)(a)(i) applies with necessary modifications to industrial designs.

(4) The registered owner of an industrial design has, in addition to any other rights, remedies or actions available, the right to institute court proceedings against any person who infringes the industrial design by performing, without the owner's agreement, any of the acts referred to in

subsection (2) or who performs acts which make it likely that infringement will occur.

**Duration;
Renewal**

22. (1) The registration of an industrial design is for a period of 5 years from the filing date of the application for registration

(2) The registration of an industrial design may be renewed for two further consecutive periods of 5 years by the payment of the prescribed renewal fee.

(3) A grace period of 6 months is allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation

23. (1) Any interested person may request the court to invalidate the registration of an industrial design.

(2) The court must invalidate the registration if the person requesting the invalidation proves that any of the requirements of sections [16] and [17] is not fulfilled or if the registered owner of the industrial design is not the creator or the creator's successor in title.

(3) Section [15](3) and (4) applies with necessary modifications to industrial designs.

PART IV – MARKS, COLLECTIVE MARKS AND TRADE NAMES

**Definition of
“mark,”
“collective
mark” and
“trade name”**

24. For the purposes of this Act –

- (a) “mark” means any visible sign capable of distinguishing the goods (“trademark”) or services (“service mark”) of an enterprise;
- (b) “collective mark” means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different

enterprises which use the sign under the control of the registered owner of the collective mark;

- (c) “trade name” means the name or designation identifying and distinguishing an enterprise.

**Acquisition of
the exclusive
right to a mark**

25. The exclusive right to a mark, as conferred by this Act, is acquired by registration in accordance with the provisions of the Act.

Registrability

26. A mark must not be registered -

- (a) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) if it is contrary to public order or morality;
- (c) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (d) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorized by the competent authority of that State or organisation;
- (e) if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Grenada for identical or similar goods or services of another enterprise;

- (f) if it is registered in Grenada and well-known for goods or services which 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 the owner of the well-known mark and the interests of the owner of the well-known mark are likely to be damaged by such use;
- (g) if it is identical with a mark belonging to a different proprietor and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Application for registration 27. (1) An application for the registration of a mark must be filed with the Registrar and accompanied by the prescribed application fee.

(2) An application for the registration of a mark must contain -

- (a) a request for registration of the mark;
- (b) a reproduction of the mark;
- (c) a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification.

Priority 28. (1) An application for the registration of a mark may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or the applicant's predecessor in title in or for any State party to the said Convention [or any Member of the World Trade Organisation].

(2) If an application contains a declaration under this section, the Registrar may request that the applicant furnish, within the specified time, a copy of the

earlier application, certified as correct by the Registry with which it was filed.

(3) The effect of the said declaration is as provided in the Paris Convention.

(4) If the Registrar finds that the requirements under this section and the relevant regulations have not been fulfilled, the declaration must be considered not to have been made.

Examination

29. The Registrar must -

- (a) examine whether the application complies with the requirements of section [27](2) and the relevant regulations; and
- (b) examine and determine whether the mark is a mark as defined in section [24](a) and is registrable under section [26].

Publication

30. If the Registrar is satisfied that the conditions referred to in section [29] are fulfilled, he or she must forthwith cause the application, as accepted, to be published in the prescribed manner.

Opposition

31. (1) Any person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on the grounds that one or more of the requirements of sections [24](a) and [26] and the relevant regulations are not fulfilled.

(2) The Registrar must forthwith send a copy of any such notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant must send to the Registrar a counter-statement of the grounds on which the applicant relies; if the applicant does not do so, the applicant is deemed to have abandoned the application.

(3) If the applicant sends a counter-statement, the Registrar must furnish a copy of it to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, must decide whether the mark should be registered.

**Rights before
registration**

32. (1) After an application is published and until the registration of the mark, the applicant has the same privileges and rights as the applicant would have if the mark had been registered.

(2) It is a defence to an action brought in respect of an act done after the application was published, if the defendant establishes that the mark could not validly have been registered at the time the act was done.

**Withdrawal of
application**

33. An applicant for the registration of a trademark may withdraw the application at any time during its pendency.

**Registration of
mark**

34. If the Registrar is satisfied that the conditions referred to in section [29] are fulfilled, and either -

- (a) the registration of the mark has not been opposed within the period referred to in section [31]; or
- (b) the registration of the mark has been opposed and the opposition has been withdrawn or has been decided in the applicant's favour,

the Registrar must register the mark, publish a reference to the registration and issue to the applicant a certificate of registration. Otherwise the Registrar must refuse the application.

**Rights conferred
by registration**

35. (1) The use of a registered mark in relation to any goods or services for which it has been registered, by any person other than the registered owner, requires the agreement of the latter.

(2) The registered owner of a mark has, in addition to any other rights, remedies or actions available, the right to institute court proceedings against any person who infringes the mark by using the mark without the owner's agreement or who performs acts which make it likely that infringement will occur.

(3) Where needed to avoid confusion to the public, the right under subsection (1) extends to the use of a sign similar to the registered mark and use in relation to goods and services similar to those for which the mark has been registered.

(4) The rights conferred by registration of a mark do not extend to acts in respect of articles which have been put on the market in Grenada by the registered owner or with the owner's consent.

(5) The provisions of section [26](e) and (f) apply with necessary modifications in any action instituted by the owner of a well-known mark against any person in respect of the unlawful use of the well-known mark.

**Duration;
renewal**

36. (1) The registration of a mark is for a period of 10 years from the filing date of the application for registration.

(2) The registration of a mark may, upon request, be renewed for consecutive periods of 10 years by the payment of the prescribed renewal fee.

(3) A grace period of 6 months is allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation

37. (1) Any interested person may make a request to the [Court] [Registrar] for the registration of a mark to be invalidated.

(2) The [Court] [Registrar] must invalidate the registration of a mark if the person requesting the invalidation proves that any of the requirements of sections [24](a) and [26] is not fulfilled.

(3) The invalidation of a registration of a mark is deemed to have been effective as of the date of registration, and the Registrar must record and publish a reference to the invalidation as soon as possible after it.

**Removal on
grounds of
non-use**

38. (1) Any interested person may request the [Court to order the removal of] [Registrar to remove] a mark from the register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of 3 years or longer.

(2) A mark must not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon it in respect of those goods or services.

**Collective
marks**

39. (1) Subject to subsections (2) and (3), sections [25 to 38] apply to collective marks, except that references therein to section [24](a) are to be read as references to section [24](b).

(2) (a) An application for registration of a collective mark must designate the mark as a collective mark and must be accompanied by a copy of the regulations governing the use of the collective mark.

(b) The registered owner of a collective mark must notify the Registrar of any changes made in respect of the regulations referred to in paragraph (a).

(3) In addition to the grounds specified in section [37], the [Court] [Registrar] must invalidate the registration of a collective mark if the person requesting the invalidation proves –

(a) that only the registered owner uses the mark;

- (b) that the owner uses or permits its use in contravention of the regulations referred to in subsection (2)(a); or
 - (c) that the owner uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.
- (2) (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names are protected, even prior to or without registration, against any unlawful act committed by third parties.
- (b) In particular, any subsequent use of a trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, is unlawful.

**Licensing of
marks and
collective marks**

40. (1) A licence contract concerning the registration of a mark, or of an application for registration, must provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used.

(2) If the licence contract does not provide for quality control or if such quality control is not effectively carried out, the licence contract is not valid.

(3) The registration of a collective mark, or of an application for registration, cannot be the subject of a licence contract.

Trade names

41. A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

PART V – GENERAL PROVISIONS

Changes in ownership

42. (1) Any change in the ownership of a patent, the registration of an industrial design or the registration of a mark or collective mark, or in the ownership of an application for any of them, must be in writing and must, upon the request of any interested party to the Registrar, be recorded and, except in the case of an application, published by the Registrar.

(2) A change which should be recorded under subsection (1) has no effect against third parties until such recording is effected.

(3) Any change in the ownership of the registration of a collective mark, or of an application for registration, requires previous approval by the Minister.

(4) Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name and must be in writing.

(5) A change in ownership of the registration of a mark or a collective mark is invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

Licence contract

43. (1) A copy of each licence contract concerning a patent, a registered industrial design or a registered mark, or concerning an application for any of them, must be submitted to the Registrar, who must keep its contents confidential but must record it and publish a reference to it.

(2) Until the contract is so recorded it has no effect against third parties.

Agents

44. An applicant whose ordinary residence or principal place of business is outside Grenada must be represented by a legal practitioner resident and practising in Grenada.

**Organisation of
the Industrial
Property]
registry**

45. (1) (a) The [Industrial Property] Registry is established within the Ministry of [Legal Affairs].
- (b) The [Industrial Property] Registry has all functions relating to the procedure for the grant of patents and the registration of industrial designs, marks and collective marks and for the administration of granted patents and registered industrial designs, marks and collective marks as specified in this Act and the regulations.
- (2) (a) [The Registrar is appointed by the [.....].]
- (b) The Registrar must be assisted by a Deputy and such Assistant Registrars as may be appointed and must superintend and perform all duties required by this Act and the regulations and has the authority to carry out studies, programs or exchanges of items or services regarding domestic and international industrial property law.
- (c) Decisions under this Act must be signed by the Registrar or an official designated by the Registrar.
- (3) The Minister must determine the organisational structure and regulate all questions concerning the financial and budgetary system of the [Industrial Property] Registry.

**Registers;
Gazette**

46. (1) (a) The [Industrial Property] Registry must maintain separate registers for patents, industrial designs and marks. Collective marks must be registered in a special section of the Register of Marks. All the recordings provided for in this Act must be effected in those Registers.
- (b) The Registers may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the regulations.

(2) The [Industrial Property] Registry must publish in the *Gazette* all the publications provided for in this Act.

Corrections of errors; extension of time

47. (1) The Registrar may, subject to the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the [Industrial Property] registry or in any recording effected pursuant to this Act or the regulations.

(2) If the Registrar is satisfied that the circumstances justify it, he or she may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the regulations, upon notice to the parties concerned and upon such terms as the Registrar directs.

(3) An extension under subsection (2) may be granted even though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary powers

48. The Registrar must give any party to a proceeding before him or her an opportunity of being heard before exercising adversely to that party any discretionary power vested in the Registrar by this Act or the regulations.

Competence of court; appeals

49. (1) The [.....] Court has jurisdiction in cases of dispute relating to the application of this Act and the regulations and in matters which under this Act and the regulations are to be referred to the court.

(2) Any decision taken by the Registrar under this Act, in particular the grant of a patent or the registration of an industrial design or of a mark or collective mark, or the refusal of an application for such a grant or registration, may be the subject of an appeal by any interested party before the [.....] Court and such appeal must be filed within [2] months of the date of the decision.

Infringement

50. (1) Subject to sections [12](4), [14], 21(3) and 35(3), the performance of any of the acts referred to in sections [12], [21], and [35] in Grenada by a

person other than the owner of the title of protection, and without the agreement of the latter, constitutes an infringement.

(2) On the request of the owner of the title of protection, or of a licensee if the licensee has requested the owner to institute court proceedings for specific relief and the owner has refused or failed to do so, the court may grant an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in section [41](2), and may award damages and grant any other remedy provided for in the general law.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) or an unlawful act as defined in section [41](2) commits an offence and is liable on summary conviction to a fine of \$___ and to imprisonment for ___ years.

(4) For the purposes of proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of the patent referred to in subsections (1) and (2), if the subject matter of the patent is a process for obtaining a product, the burden of establishing that a product was not made by the process is on the alleged infringer if either of the following conditions is fulfilled -

- (a) the product is new;
- (b) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(5) In requiring the production of evidence, the court before which the proceedings referred to in subsection (4) take place must take into account the legitimate interests of the alleged infringer in not disclosing manufacturing and business secrets.

**Application of
International
Treaties**

[51. (1) Subject to subsection (2), the provisions of any international treaty in respect of industrial property to which Grenada is a party apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, prevail over it.]

(2) Minister may make regulations amending this Act to conform to provisions of a treaty etc.]

**Regulations;
administrative
instructions**

52. (1) The Minister may make regulations prescribing any matter required for the implementation of this Act. The regulations may, in particular, provide for the payment of fees in connection with applications for the grant of patents and for the registration of industrial designs, marks and collective marks and matters related thereto.

(2) The Registrar may issue Administrative Instructions relating to the procedures under this Act and the regulations as well as to the other functions of the [Industrial Property] Registry.

**Repeal and
Transitional
Provisions**

53. (1) The following are repealed -

Patents Act (Cap. 227)

Patents Rules

[Registration of United Kingdom Patents Act (Cap. 283)]

[Registration of United Kingdom Patents Rules]

[Registration of United Kingdom Trade Marks Act (Cap. 284)]

[Registration of United Kingdom Trade Marks Rules]

(2) Notwithstanding the repeal of [.....], patents granted and trademarks registered thereunder remain in force and, subject to subsections (3) and (4), are deemed to have been granted or registered under this Act.

(3) Patents deemed to have been granted by virtue of subsection (2) remain in force for the unexpired portion of the period of protection provided under this Act, subject to the payment of annual fees provided for in this Act.

(4) Trademarks deemed to have been registered by virtue of subsection (2) are due for renewal within the same period as under [.....] and, upon renewal, will be reclassified in accordance with the International Classification.

(5) The Minister may by Order make any further transitional or saving provisions that appear to the Minister to be necessary or desirable.

Commencement

54. (1) This Act comes into force on a date or dates appointed by the Minister by order published in the *Gazette*.

(2) The Minister may appoint different dates for the coming into force of different provisions.
