

CHAPTER 309A

**INDUSTRIAL DESIGNS
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CHAPTER 309A

INDUSTRIAL DESIGNS

An Act to provide for the protection of industrial designs and for related matters. 1981-57.
1988-6.

[1st January, 1985] Commence-
ment.
1984/180.

Citation

1. This Act may be cited as the *Industrial Designs Act*. Short title.

Interpretation

2. In this Act, Definitions.

"Director" means the Registrar of Corporate Affairs and Intellectual Property; 1988-6.

"Industrial Property Office" means the office within the public service designated by the Minister responsible for establishments as the Industrial Property Office;

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

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

"licence-contract" means a licence-contract referred to in section 29;

"register" means the Industrial Designs Register referred to in section 21;

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

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Purpose.

3. The purpose of this Act is to protect industrial designs registered under this Act and to protect applications made for the registration of industrial designs under this Act so that the laws of Barbados will accord with its obligations under the Paris Convention for the protection of Industrial Property of March 20, 1883, as revised from time to time, hereinafter referred to as the "Paris Convention".

Industrial designs.

4. An industrial design is

(a) any composition of lines or colours; or

(b) any 3 dimensional form whether or not associated with lines or colours

that gives a special appearance to the product of industry or handicraft and serves as a pattern for a product of industry or handicraft.

Protection of Industrial Designs

Rights protected.

5. (1) The registration of an industrial design vests in the registered owner of the design the exclusive right to prevent other persons from performing any of the following acts

(a) reproducing the industrial design in the manufacturing of a product;

(b) importing, offering for sale, or exposing for sale, or selling, a product in or by which the industrial design is reproduced; or

(c) stocking any product described in paragraph (a) or (b) for the purpose of sale.

(2) An act described in paragraph (a) or (b) of subsection (1) does not fall outside the ambit of that subsection by reason only that

(a) a reproduction of an industrial design differs from the protected industrial design in minor respects, or

(b) the reproduction concerns a type of product that is different from the protected industrial design.

(3) The rights vested in the owner of an industrial design by registration of an industrial design protect only against acts done for industrial or commercial purposes; and, in particular, the rights so protected do not extend to acts done in respect of a product embodying the protected industrial design after the product has been lawfully sold in Barbados.

(4) For the purposes of this section, "lawfully sold" means that the product has, with the consent of the registered owner of the industrial design, been imported into Barbados for sale in Barbados or has been purchased, with the consent of the registered owner of the industrial design, for sale or use in Barbados.

6. (1) The right to protect an industrial design by registration pursuant to this Act vests in the creator of the design and his successors in title, but subject to section 7. Creator's rights.

(2) If an industrial design has been created jointly by 2 or more persons, the right referred to in subsection (1) vests jointly in them and afterwards in their successors in title; but no right is acquired under this provision by a person who only assisted in the creation of an industrial design if his assistance did not amount to a contribution of a creative nature.

(3) Subject to section 7, a person is presumed to be the creator of an industrial design if

- (a) he is the first person to make application for the registration under this Act of the industrial design; or
- (b) he is the first person properly to claim the earliest priority for his application for registration under this Act of the industrial design.

7. (1) Subject to any enactment relating to contracts of employment or to the terms of any specific contract of service or for services, when an industrial design is created by an individual Employee creators.

- (a) in the course of his employment for the Crown, a body corporate or an individual; or

(b) under a contract for services with, or as a work commissioned by the Crown, a body corporate or an individual,

then, in respect of that design, the right to protect the design by registration under this Act vests in the Crown, body corporate or individual who employed the creator or commissioned the design, as the case requires.

(2) When an employee under a contract of service who is not required to engage in any creative activity creates an industrial design by the use of information or means that his employer put at the employee's disposal, the right to protect the industrial design by registration under this Act vests in the employer, but subject to the like exceptions as apply to subsection (1).

(3) An employee described in subsection (2) is entitled to remuneration calculated after due regard is given to the amount of his salary and the economic importance of the industrial design he created; but if an employer and employee fail to agree on the amount of the remuneration, it must be fixed by the High Court on the like calculation.

Extent of
rights.

8. The exclusive rights vested by section 5 in the registered owner of an industrial design do not

Cap. 300.

(a) affect any right acquired in the industrial design under the *Copyright Act*, 1981, or under any other enactment or at common law; or

(b) extend to anything in the industrial design that serves only to obtain a technical result.

Newness.

9. An industrial design may not be registered under this Act unless it is new.

Breaching
peace.

10. An industrial design may not be registered under this Act if it is likely to provoke a breach of the peace.

Novelty.

11. (1) An industrial design is new if, before the date of an application for registration under this Act or before the priority date properly claimed for the industrial design, the industrial

design had not been made available to the public through description, use, or in any other manner, anywhere, or at any time.

(2) An industrial design is not to be taken to have been made available to the public by reason only that, within a period of 6 months preceding the application for its registration under this Act, the industrial design appeared in an exhibition recognised by the Minister as being an official national or an official international exhibition.

(3) An industrial design is not new by reason only that it differs from earlier embodiments of an industrial design in minor respects or that it concerns a type of product different from those earlier embodiments of an industrial design.

(4) Subject to this section, an application for the registration of an industrial design under this Act gives rise to a presumption that the industrial design is new.

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

Application for Registration

12. (1) An application for registration of an industrial design may be made to the Director upon payment of the prescribed fee. Registra-
tion.

(2) The application must contain

(a) a request for registration of the industrial design;

(b) the full name and address of the applicant, and, if he resides outside Barbados, an address for service within Barbados,

(c) either

(i) a specimen of the article containing the industrial design, or

(ii) a photograph or a graphic representation of the industrial design, and, if the design is in colour, the photograph or representation must be in colour;

(d) an indication of the kind of product with which the industrial design is to be used; and

(e) an indication of the classes of products to which the industrial design relates, if the regulations provide for classification of products.

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

Mention
of creator.

13. (1) When an industrial design is being registered under this Act, the creator of the design is entitled to have his name and address entered on the register as being that of the creator of the industrial design.

(2) Any agreement that would have the effect of waiving or avoiding subsection (1) is void.

(3) An application for the registration of an industrial design may be accompanied by a statement of the creator of the design claiming his entitlement under subsection (1); but the statement must be in writing and signed by him.

Elements
of earlier
designs.

14. (1) Subject to subsection (2), when an application is made for the registration of an industrial design the essential elements of which have been obtained from another industrial design created by another person who has not consented to the obtaining of those essential elements from his industrial design, or to the making of the application for registration, the other person may demand of the Director that the application or registration, as the case requires, be transferred to him.

(2) The creator of an earlier industrial design may consent to its essential elements being comprised in another industrial design even if the consent is requested after application for registration of the other design comprising the essential elements obtained from the earlier design; and the consent when so given is retroactive to the date of the application for registration of the other industrial design.

15. An application for registration under this Act may comprise as many as 50 industrial designs if Number of designs.

- (a) the products indicated in the application as products to which the industrial designs relate are of the same kind; or
- (b) the products to which the industrial designs relate are within the same class, if the regulations provide for classifications of products.

16. (1) An applicant for registration under this Act of an industrial design who is availing himself of the priority of an earlier application in another country that is a member of the Paris Convention must submit with his application a written statement Priority.

- (a) indicating the date and number of the earlier application in the other country;
- (b) identifying the country in which the earlier application was made; and
- (c) containing the name of the applicant who made the earlier application in that other country.

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

(3) This section does not come into operation until the day that Barbados accedes to the Paris Convention.

17. (1) The Director must examine each application for registration of an industrial design to determine if the provisions of sections 10, 12 and 16 have been complied with. Form examination.

(2) If the Director determines that the provisions of section 10, 12 or 16 have not been complied with, a notice of the defect in the application shall be served upon the applicant by the Director, requesting the applicant, within a period of 90 days from the date he receives the notice, to complete his application or make any necessary changes to it, as the circumstances require.

(3) If the applicant fails to comply with a request under subsection (1) within the time limited therefor, the Director shall

- (a) refuse the application for registration if the design is likely to provoke a breach of the peace or there was a failure to comply with section 12; or
- (b) if the defect was a failure to comply with section 16, register the industrial design for which the application was made, but without making any mention of the priority claimed in respect of the industrial design by an earlier application in another country.

(4) An application for registration of an industrial design is invalid unless it is complete and regular as to form.

Substance
examina-
tion.

18. (1) The Director shall examine each application for registration of an industrial design to determine

- (a) that the subject-matter of the application amounts to an industrial design;
- (b) that the industrial design is new at the time of the application; and
- (c) that no earlier application for registration of the same industrial design has been made in Barbados, or that no earlier application benefitting from an earlier priority relating thereto has been made in Barbados.

(2) When the Director determines that the subject of the application is not an industrial design, that the industrial design is not new, or that there has been an earlier application for registration thereof made in Barbados, the Director shall refuse registration and inform the applicant by notice in writing why the design cannot be registered in Barbados, and invite him either to withdraw the application or to present, within a period of 60 days from the receipt of the notice, the applicant's comments on the reasons for the refusal of registration.

(3) If the applicant referred to in subsection (2) either fails to withdraw his application or to present his comments within the period limited therefor by that subsection, or presents his

comments and the Director is not of the view that the design ought to be registered, the Director may

- (a) refuse registration in respect of the application; or
 - (b) grant an extension of a further period of not more than 60 days for the presenting of comments if the applicant resides outside Barbados, or if the Director thinks fit for any other reason to grant such an extension.
- (4) This section operates only if the Minister by order so determines and only to the extent provided in that order.

Registration

19. If the Director is satisfied that the requirements of this Act governing registration of industrial designs have been complied with in the case of an application, the applicant is entitled on payment of the prescribed fee to have the industrial design registered under this Act.

Registration of industrial designs.

20. Registration of an industrial design under this Act does not give any statutory assurance of the validity of the design.

No assurance.

21. (1) The Director shall maintain an Industrial Designs Register and record therein

Register.

- (a) all industrial designs registered under this Act; and
- (b) all transactions required by this Act to be recorded in connection with each industrial design registered under this Act.

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

22. (1) An industrial design is registered when there is recorded in the register

Contents of register.

- (a) a reproduction of the industrial design;
- (b) the registration number of the industrial design;

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- (c) the name and address in Barbados of the registered owner of the industrial design, or his address for service in Barbados, as the case requires;
- (d) the dates of application and registration of the industrial design;
- (e) if priority is claimed, an indication of that fact, and the number, date and country of the application with which the priority claim is connected;
- (f) the kinds and, if required by the regulations, the classes of products to be used in connection with the industrial design; and
- (g) the name and address of the creator of the industrial design, if the creator has requested mention in the register.

(2) When a change of address of a registered owner of an industrial design recorded in the register is received by the Director, the change shall be recorded in the register by the Director.

Certificate. 23. Upon the registration of an industrial design, the Director must send by registered post a certificate of the registration to the registered owner at his address as recorded in the register.

Registration. 24. (1) From time to time as prescribed by the regulations, the Director shall publish in the *Gazette*, in the order of the registration, such industrial designs as have been registered in the register to that time or since the last such publication.

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

Inspection of register. 25. (1) The register is a public record and may be inspected during business hours by any member of the public free of charge.

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

26. (1) Subject to sections 36, 40 and 41, the registration of an industrial design is valid for a period of 5 years from the date of the application for its registration; but a registration may be renewed for 2 further consecutive periods of 5 years each, upon payment of the prescribed fee for each renewal. Duration and renewal.

(2) The renewal fee must be paid to the Director within the 12 months immediately preceding the expiration of an earlier period of registration.

(3) Notwithstanding subsection (2), the registered owner, upon payment of the prescribed fee therefor, is entitled to renew a previous registration within 6 months from the expiration of the earlier registration.

(4) A renewal of a registration of an industrial design shall be recorded in the register and a notice thereof published by the Director in the *Gazette*.

Proprietary Activities

27. (1) An application for the registration of an industrial design may be transferred by the applicant or anyone claiming under him. Transfers.

(2) A transfer of an application for registration of or of a registered industrial design must be recorded in the register upon payment of the prescribed fee.

(3) A transfer of an application for registration of or of a registered industrial design has no effect against any person other than the parties to the transfer until it is recorded in the register.

28. In order to be recorded in the register, a transfer that is made, otherwise than by operation of law, of an application for registration of an industrial design or of an industrial design must be in writing and signed by the parties to the transfer. Form requirements.

29. (1) A registered owner of an industrial design may, by a licence-contract, grant another person or an enterprise a licence to use the industrial design for industrial or commercial purposes. Licence-contract.

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(2) A licence-contract must be in writing and signed by the parties, and it has no effect, as against persons other than the parties thereto, until it is recorded in the register.

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

(4) The recording in the register of a licence-contract relating to an industrial design shall be cancelled by the Director

(a) at the request of the registered owner of the industrial design or at the request of the licensee under the licence-contract; and

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

Joint ownership.

30. In the absence of an agreement to the contrary, joint owners of an industrial design for which an application has been made for registration, or that has been registered under this Act

(a) may separately assign or transfer their shares of the industrial design and separately use the industrial design as well as separately exercise the exclusive rights vested in them under section 5 as registered owners; but

(b) may by joint action only grant a licence-contract to another person to use the industrial design for industrial or commercial purposes.

Invalid provision.

31. A provision in a licence-contract or a provision in an agreement relating to a licence-contract is void if it purports

(a) to impose on the industrial or commercial use of an industrial design a restriction on the licensee that does not derive from the rights vested by registration of an industrial design under this Act; or

(b) to impose a restriction that is unnecessary for the purpose of safeguarding the rights vested by registration of an industrial design under this Act.

32. (1) In the absence of a provision to the contrary in a licence-contract, but subject to subsection (2), the grant of a licence to a person to use an industrial design for an industrial or commercial purpose does not prevent the grantor of the licence

Further
licences.

(a) from granting further licences to other persons to use the same industrial design for industrial or commercial purposes; or

(b) from using the industrial design himself for industrial or commercial purposes.

(2) If the licence-contract provides that the licence granted under it is an exclusive licence, the grantor of the licence may not

(a) grant further licences to other persons to use the same industrial design for industrial or commercial purposes; or

(b) in the absence of a provision in the licence-contract to the contrary, use the same industrial design himself for an industrial or commercial purpose.

33. In the absence of a provision to the contrary in the licence-contract, a licensee thereunder is entitled for the duration of his licence to exercise in Barbados, in relation to the industrial design to which the licence-contract refers, the exclusive right conferred by section 5; and he may apply for the renewal of the registration of the industrial design under this Act.

Licensee's
rights.

34. (1) Unless the licence-contract otherwise provides, the licensee thereunder may not transfer his licence nor may he grant a sub-licence thereof.

Transfer
restricted.

(2) When a licensee under a licence-contract has authority thereunder to transfer his licence or to grant a sub-licence thereof, sections 29 to 33 and section 35 apply to any such transfer, or sub-licence.

35. When, in the economic interests of Barbados, the Minister of Finance so provides by order

Royalties
abroad.

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

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(b) changes or renewals of the licence-contracts referred to in paragraph (a),
have no effect in Barbados without the approval of the Minister of Finance.

Renuncia-
tion.

36. (1) Subject to this section, a registered owner of an industrial design may renounce registration by a written renunciation addressed to the Director.

(2) A renunciation may be limited to one kind of product or to one class of product, or, if the registration relates to several industrial designs, to some only of those designs.

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

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

(5) Subject to subsection (6), when a licence-contract is recorded in the register for an industrial design, a renunciation made in respect of the industrial design may not be recorded in the register unless the renunciation is accompanied by evidence that it was made with the consent of the licensee under the licence-contract.

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

Protective Measures

Legal pro-
ceedings
by regis-
tered owner.

37. (1) The registered owner of an industrial design whose exclusive rights under section 5 are in imminent danger of being infringed or are being infringed may institute proceedings in the High Court

(a) for an injunction to prevent the infringement or to prohibit the continuation of the infringement; or

(b) for damages for the infringement.

(2) An injunction issued pursuant to subsection (1) does not deprive the registered owner of the industrial design of any damages that he can be awarded for any loss sustained by him as a result of any infringement or imminent infringement of his exclusive rights under section 5.

38. (1) A licensee under a licence-contract may in writing request the registered owner of the industrial design to which the licence-contract relates to institute, within a period of 90 days from receipt by him of the request, any necessary legal proceedings in respect of any infringement of that industrial design.

Legal proceedings by licensee.

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

(3) If the registered owner of an industrial design who receives a request under subsection (1) fails to institute legal proceedings within the time limited therefor by that subsection, the licensee who made the request may institute those proceedings in his own name after notifying the registered owner of his intention to do so.

(4) The registered owner of the industrial design may join in any legal proceedings instituted under subsection (3) by a licensee.

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

39. (1) Subject to subsection (2), the High Court may, before the expiration of the period of 90 days referred to in subsection (1) of section 38, grant an injunction to a licensee of an industrial design to prevent infringement, or to prohibit further infringement, of the industrial design.

Injunction before expiration of prescribed period.

(2) In making an application to the High Court to exercise its jurisdiction under subsection (1), the licensee must prove that immediate action is necessary to prevent substantial damage from the infringement of the industrial design for which the

application is made and that the registered owner of the industrial design had been requested to institute legal proceedings but had failed to do so.

Declared
invalidity.

40. (1) Proceedings requesting that the registration of an industrial design be declared invalid may be instituted in the High Court by any interested person.

(2) After hearing the parties to the proceedings, the High Court may declare the registration invalid if

- (a) the industrial design ought not to have been registered because of its being likely to provoke a breach of the peace;
- (b) the industrial design is not an industrial design within the meaning of section 4;
- (c) the industrial design is not new within the meaning of section 11;
- (d) the same industrial design had been previously registered following an earlier application or following an application benefitting from an earlier priority; or
- (e) the industrial design was usurped.

(3) When the application for registration included several designs and the proceedings for a declaration of invalidity of the registration relates only to some of the industrial designs, the decision of the court applies only to the industrial designs to which the proceedings relate.

Effect on
industrial
design of
declaration
of invalidity.

41. (1) When the registration of an industrial design is declared invalid in whole or in part by the High Court in any proceedings instituted under section 39, the registration is, to the extent decided by the court, invalid from the date of the impugned registration.

(2) On the determination of any proceedings instituted under section 38, the Registrar of the Supreme Court must transmit a copy of the court's decision to the Director who must thereafter record the decision in the register and publish a notice of the decision in the *Gazette*.

42. When the registration of an industrial design to which a licence-contract applies is declared invalid by the High Court, no royalties need be repaid by the grantor of the licence to the licensee under the licence-contract unless it is shown to the court that the licensee had not substantially benefitted from that licence.

Effect of
declaration
of
invalidity
on licence-
contract.

Appeals

43. (1) A person aggrieved by any determination of the Director regarding the registration or refusal to register an industrial design may appeal to the High Court by notice of motion from that determination.

Appeals.

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

(3) The Registrar of the Supreme Court shall transmit a certified copy of the court's decision on an appeal under this section to the Director who must thereupon record it in the register and publish a notice of it in the *Gazette*.

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

Offence

44. (1) Notwithstanding any other provision of this Act, a person is guilty of an offence who knowingly infringes any of the exclusive rights of a registered owner of an industrial design.

Offences.

(2) A person who is guilty of an offence under subsection (1) is liable on summary conviction

(a) to a fine of \$10 000 or to imprisonment for a term of 12 months, or to both; and

(b) in the case of a continuing offence, to a further fine of \$1 000 a day for each day or part of a day on which the offence continues after a conviction was first obtained.

Limita-
tion.

45. A prosecution for an offence under section 44 may be brought at any time within 5 years from the date the offence, or the last date on which the last of any continuing offence, was committed.

Civil Remedies

Civil
remedies.

46. (1) A person who sustains any damage by reason of any acts described in section 44 may institute proceedings in the High Court to recover his damages, whether or not the person who committed those acts had been successfully prosecuted under that section.

(2) The court may, in addition to awarding damages under subsection (1), grant an injunction prohibiting a person from continuing any of the acts described in section 44.

Administration

Reci-
procuity.

47. The Minister may, by order, provide for reciprocal treatment in relation to industrial designs to be given to any country that provides similar protection to industrial designs registered in Barbados, and to applications for registration of industrial designs in Barbados, as that given by this Act.

Directions.

48. The Director may issue directions relating to the practice and procedure for applying for registration of industrial designs, registering industrial designs under this Act, and governing the operations of the register generally, but subject to any regulations made under section 49.

Regula-
tions.

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

Binding
Crown.

50. This Act binds the Crown.