



[L.S.]

I Assent,

James B. Carlisle,
Governor-General.

18th December, 2003.

ANTIGUA AND BARBUDA

No. 19 of 2003

AN ACT to make provision for the protection and registration of industrial designs and other purposes related thereto.

[*31st December, 2003*]

ENACTED by the Parliament of Antigua and Barbuda as follows —

1. (1) This Act may be cited as the Industrial Designs Act, 2003.

Short title and
Commencement.

(2) This Act comes into force on a date to be fixed by the Minister by notice published in the *Gazette*.

2. In this Act,

Interpretation.

"Court" means the High Court;

"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;

"Minister" means the Minister responsible for intellectual property;

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

"register" means the Register of Industrial Designs referred to in section 16;

"Registrar" means the Registrar appointed under the Registrar of Intellectual Property Office Act, 2003;

"regulations" means the regulations made pursuant to section 24.

Definition of "industrial design".

3. (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 designs.

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

(2) An industrial design shall be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.

(3) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if it

(a) occurred within twelve months preceding the filing date or, where applicable, the priority date of the application; and

- (b) if it was by reason or in consequence of acts committed by the applicant or his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title.

(4) An industrial design that is contrary to public order or morality is not registrable.

5. (1) The right to registration of an industrial design shall belong to the creator.

(2) If two or more persons have jointly created an industrial design, the right to registration of that design shall belong to them jointly.

(3) If and to the extent to which two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date shall have the right to register the industrial design, as long as the application is not withdrawn, abandoned or rejected.

(4) The right to the registration of an industrial design may be assigned, or may be transferred by succession.

(5) Where an industrial design is created in execution of an employment contract, the right to registration of the industrial design shall belong, in the absence of contractual provisions to the contrary, to the employer.

(6) The creator shall be named as such in the registration of the industrial design, unless in a special written declaration signed by him and addressed to the Registrar he indicates that he wishes not to be named.

(7) Any promise or undertaking by the creator made to any person to the effect that he will make such a declaration referred to in subsection (6) shall be without legal effect.

6. (1) The application for registration of an industrial design shall be filed with the Registrar and shall contain a request, drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used.

Right to
registration of
industrial designs;
naming of
creator.

Application.

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

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

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

(5) The application, at the time of filing, 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.

(6) The applicant may withdraw the application at any time during its **pendency**.

(7) The application shall be subject to the payment of the prescribed application fee.

Right of priority.

7. (1) The 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 his predecessor in title in or for any State party to that Convention, or Member of the World Trade Organization.

(2) Where the application contains a declaration under subsection (1), the Registrar may request that the applicant furnish, within the prescribed time limit, a copy of the earlier application certified as correct by the Office with which it was filed; and the effect of the declaration shall be as provided in the Paris Convention.

(3) If the Registrar finds that the requirements under this section and the Regulations pertaining to a declaration have not been fulfilled, the **declaration** shall be considered not to have been made.

8. (1) The Registrar shall accord as the filing date the date of receipt of the application, provided that, at the time of receipt, the application contains indications allowing the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design.

Filing date and Examination.

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

(3) After according a filing date, the Registrar shall examine whether the application complies with the requirements of sections 6(1), (2), (3) and (7) and whether the application fee has been paid.

(4) The Registrar shall examine whether the industrial design complies with the requirements of Sections 3 and 4(4).

9. (1) **Where** the Registrar **finds** that the conditions referred to in section 8(3) and (4) are fulfilled, he shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design; otherwise, he shall refuse the application.

Registration and publication.

(2) Notwithstanding subsection (1), where a request has been made under section 6(5) for deferment of publication, upon registration of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection; and the Registrar shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner, and indicating the filing date of the application, the length of the period for which **deferment** has been granted and any other prescribed particulars.

(3) At the expiry of the period of deferment, the **Registrar** shall publish the registered industrial design.

(4) The institution of legal proceedings on the basis of a Registered industrial design during the period of **deferment** of publication shall be subject to the condition that the **informa-**

tion 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.**

10. (1) The exploitation of a registered industrial design in Antigua and Barbuda by persons other than the registered owner shall require the agreement of the latter.

(2) For the purposes of this Act, "exploitation" of a registered industrial design means the making, selling or importation for commercial purposes, of articles bearing or embodying a design which is a copy, or substantially a copy of the industrial design.

(3) The rights conferred by registration of an industrial design shall not extend to acts in respect of articles which have been put on the market in Antigua and Barbuda by the registered owner of the industrial design or with his consent.

(4) The registered owner of an industrial design shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the industrial design by performing, without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

**Duration and
renewal of
registration.**

11. (1) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration.

(2) The registration may be renewed for two further consecutive periods of five years through the payment of the prescribed fee.

(3) A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

**Surrender of
registration.**

12. The owner of a registered industrial design **may surrender** it by written declaration to the Registrar who shall record the surrender in the Register and publish it; and the surrender shall have effect from the date on which it is recorded.

Invalidation.

13. (1) Any interested person may apply to the Court to invalidate the **registration** of an industrial design.

(2) The Court shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Sections 3 and 4 is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title.

(3) Any invalidated registration of an industrial design, or part thereof, shall be regarded as null and void from the date of the registration.

(4) The final decision of the Court shall be notified to the **Registrar** who shall record it and publish a reference to it as soon as practicable.

14. (1) Any change in the ownership of the registration of an **industrial** design, or in the ownership of an application therefor, shall be in writing in the prescribed form and shall, at the request of any interested party made to the Registrar, be recorded and, except in the case of an application, published by the Registrar.

Changes in ownership.

(2) A change under subsection (1) shall be of no effect against **third** parties until it has been recorded.

15. (1) Any licence contract concerning a registered industrial design, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference to it.

Licence contracts.

(2) A licence contract shall be of no effect against third parties **until** it has been submitted to the Registrar in accordance with subsection (1).

16. Where **an** applicant's ordinary residence or principal place of **business** is outside Antigua and Barbuda, he shall be **represented** by a registered agent resident and practising in Antigua and Barbuda before the Registrar of the Intellectual Property **Office**. The procedure for the registration of an agent shall be prescribed in the regulations.

Agents.

17. (1) **The** Registrar shall maintain a separate register for **industrial** designs and all the recordings provided for in this Act shall be effected in that register.

Register.

(b) The register may be consulted by any person, and any person may obtain extracts **therefrom**, under the conditions **prescribed** in the Regulations.

(2) The Registrar shall publish in the *Gazette* or in *an* intellectual property journal published under the authority of the Registrar, or in both, all the publications provided for in this Act.

Correction of errors.

18. The Registrar may, subject to any provision in 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.

Extension of time.

19. (1) If the Registrar is satisfied that the circumstances justify it, he 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 he may direct.

(2) An extension under subsection (1) may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary powers.

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

Competence of Court; appeals.

21. (1) The Court shall **have** jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which under this Act are to be referred to the court.

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

Infringement and offences.

22. (1) **Subject to section 10(3), an infringement shall consist of the performance of any act referred to in section 10 in Antigua and Barbuda by a person other than the owner of the title of protection and without the agreement of the latter.**

(2) **On the request of the owner of the registered industrial design, or of a licensee if he has requested the owner to insti-**

tute court proceedings for a specific relief and the owner has refused or failed to do so, the court may grant an injunction to prevent infringement, or an **imminent infringement**, 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) is guilty of an offence and liable on **summary** conviction to a fine of \$50,000 or to imprisonment for a **term** of 3 years.

23. The provisions of any **international** treaties in respect of industrial property to which Antigua and Barbuda is a party **shall apply to** matters dealt with by **this** Act and, in case of conflict with provisions of **this** Act, shall prevail over the latter.

Application of
international
treaties.

24. (1) **The Minister may make** such regulations as **are** required for better **administration** of this Act, and in particular, the Minister **may** make regulations **prescribing** any matter required or **authorized** by the **Act** to be prescribed;

Regulations.

- (a) prescribing the **fees in respect** of applications for **the** registration of industrial designs and any **sur-**charge payable **under** the Act and **matters** related **thereto**; and
- (b) requiring **the payment of a fee** in respect of the filing, **examination** or **copying** of any document, consultation of the register and obtaining of **extracts therefrom, or in respect to any action** that the Registrar is required or authorized to take **under this Act**.

25. (1) The United Kingdom Designs (Protection) Act is **repealed**.

Repeal of
Cap. 453 and
transitional
provisions.

(2) A person **who** on the date of **entry into force** of this Act is **the proprietor** of an industrial design that has been **registered** in **the United Kingdom** or has filed an application for registration of an **industrial design** in the **United Kingdom** may, **within 12 months from the entry into force of this Act**, file an application for the **registration** of the **same industrial** design under this Act; **and such application shall be accorded the filing date** or, where **priority has been claimed, any priority date accorded to the application, grant or registration** in the **United Kingdom**.

ANTIGUA 10
AND
BARBUDA

The Industrial Designs Act 2003.

No. 19 of 2003.

Passed the House of Representatives
this 8th day of September, 2003.

Passed the Senate this 25th day
of September, 2003.

B. Harris,
Speaker.

M. Percival,
President.

S. Walker,
Clerk to the House of Representatives.

S. Walker,
Clerk to the Senate.

Printed at the Government Printing Office, Antigua and Barbuda,
by Walter A. Massiah, Government Printer
—By Authority, 2003.