

1999

MARKS, COLLECTIVE MARKS  
AND TRADE NAMES

ACT 12

COMMONWEALTH OF DOMINICA

ARRANGEMENT OF SECTIONS

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I assent



V.L. SHAW  
*President.*

26th November, 1999

AN ACT TO PROVIDE FOR THE PROTECTION OF MARKS,  
COLLECTIVE MARKS AND TRADE NAMES IN DOMI-  
NICA, AND FOR MATTERS RELATED THERETO.

(Gazetted 2nd December, 1999)

BE IT ENACTED by the Parliament of the Commonwealth of  
Dominica as follows:

PART I  
PRELIMINARY

1. This Act may be cited as the –

Short title.

**MARKS, COLLECTIVE MARKS AND TRADE NAMES  
ACT 1999.**

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

Interpretation.

“collective mark” means any visible sign designated as such in the application for registration and capable of distinguishing the origin or 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 that sign;

“Court” means the High Court;

“International Classification” means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as last revised;

Act No. 8 of 1999.

“Journal” means the Journal of Intellectual Property created under section 5(d) of the Patents Act 1999;

“mark” means any visible sign capable of distinguishing the goods (“trademark”) or services (“service mark”) of an enterprise;

“Minister” means the Minister responsible for marks, collective marks and trade names;

“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;

“Register” means the Register of Marks referred to in section 23;

“Registrar” means the Registrar of Companies and Intellectual Property; and

“trade name” means the name or designation by which a business or enterprise is identified and distinguished.

## PART II

### MARKS

Acquisition of  
exclusive right to  
mark.

3. The exclusive right to a mark, as conferred by this Act, shall be acquired by registration in accordance with the provisions thereof.

Registrability of mark.

4. A mark cannot be validly registered if it is –

- (a) incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) contrary to public order or morality;
- (c) 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) identical to, or is an imitation of, or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of or official sign or hallmark adopted by, any State, inter-governmental Organisation or Organisation created by an international convention, unless authorised by the competent authority of that State or Organisation;
- (e) identical to, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Dominica for identical or similar goods or services of another enterprise, or if it is well-known and registered in Dominica for goods or services which are not identical, or similar to those in respect of which registration is applied for, provided, in the latter case, that –
  - (i) 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
  - (ii) that the interests of the owner of the well-known mark are likely to be prejudiced by such use; or
- (f) identical to a mark belonging to a different owner 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.

5. (1) An application for the registration of a mark shall be filed with the Registrar on the prescribed form and shall contain the following: Application for registration.

- (a) a request that the mark be registered;
- (b) a reproduction of the mark; and
- (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.

(2) The application shall be accompanied by the prescribed application fee.

(3) The application 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 his predecessor in title in or for any State party to the said Convention or any member of the World Trade Organisation, in which case the Registrar may require that the applicant furnishes, within the prescribed time limit, a copy of the earlier application, certified as correct by the Office with which it was filed.

(4) The effect of the said declaration shall be as provided in the Paris Convention.

(5) Where the requirements of subsection (3) and any regulations pertaining thereto have not been satisfied, the said declaration shall be considered not to have been made.

(6) The applicant may withdraw the application at any time before the mark is registered.

Examination of  
application.

6. (1) The Registrar shall examine the application to determine whether it complies with the requirements of section 5(1) and (2) and the Regulations pertaining thereto.

(2) The Registrar shall also examine and determine whether the mark is a mark as defined in section 2 and complies with the requirements of section 4 of paragraphs (a) to (e) .

(3) Where the Registrar finds that the requirements referred to in subsections (1) and (2) are fulfilled, he shall forthwith cause the application, as accepted, to be published in the Journal in the prescribed manner.

Opposition to  
registration.

7. (1) Any interested 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 ground that one or more of the requirements of section 4 and the regulations pertaining thereto have not been fulfilled, or that the mark is not a mark as defined in section 2.

(2) The Registrar shall send forthwith a copy of such notice to the applicant who shall, within the prescribed period and in the prescribed manner, file, with the Registrar, a counter-statement of the grounds on which he relies for his application.

(3) The applicant shall be deemed to have abandoned his application if he fails to comply with the provisions of subsection (2).

(4) Where the applicant files a counter-statement, the Registrar shall forthwith furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if they wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

(5) After an application is published and until the registration of the mark, the applicant has the same privileges and rights as he would have if the mark had been registered, but it shall be a valid defence to an action brought hereunder 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.

8. (1) Where the Registrar finds that the requirements for the registration of a mark have been fulfilled, and the registration of the mark has not been opposed within the prescribed time limit or the registration of the mark has been opposed but has been decided in the applicant's favour, he shall –

- (a) register the mark in the Register;
- (b) publish a reference to the registration in the Journal; and
- (c) issue to the applicant a certificate of registration.

(2) Where the requirements for registration are not satisfied or an application has been successfully opposed, the Registrar shall refuse the application.

9. (1) No person shall use a registered mark in relation to any goods or services for which it has been registered unless he has the authorisation of the owner to do so.

(2) The registered owner of a mark 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 mark by using the mark without his authorisation or who performs acts which make it likely that infringement will occur.

(3) The right conferred under subsection (2) shall extend 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, where confusion may arise in the public.

(4) The rights conferred by the registration of a mark shall not extend to the use of the mark in respect to goods which have not been put on the market by the registered owner or with his consent.

(5) The rights in a mark may be assigned or transferred by succession.

Duration and renewal of registration.

**10.** (1) The registration of a mark shall expire ten years from the filing date of the application for registration but may, upon the written request of the registered owner and payment of the prescribed renewal fee, be renewed for consecutive periods of ten years.

(2) (a) Where the period prescribed for the payment of the renewal fee expires and payment of the said fee has not been made, the Registrar shall give the registered owner of the mark a period of grace not exceeding six months within which he must pay the renewal fee.

(b) The registered owner of the mark shall, when paying the renewal fee in accordance with paragraph (a), also pay, to the Registrar, the surcharge prescribed for late payment.

Invalidation of mark.

**11.** (1) The Court may, on the application of any interested party, invalidate the registration of a mark on the ground that –

(a) it is not a mark as defined in section 2; or

(b) the requirements of section 4 have not been satisfied.

(2) Where the Court has invalidated the registration of a mark, the Registrar shall, as soon as possible, record the invalidation and publish a reference thereto in the Journal, and any such invalidation shall be deemed to have been effective as of the date of the registration of the mark.



12. (1) The Court may, on the application of any interested person, order the removal from the Register of a mark 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 three years or longer. Removal of mark from Register.

(2) The Court shall not order the removal of a registered mark from the Register if the owner can show that special circumstances existed which prevented the use of the mark, and that there was, in relation to the goods or services referred to in subsection (1), no intention not to use the mark or to abandon it.

13. (1) The owner of a registered mark or an applicant therefor may grant licenses in respect of that mark. Licensing of marks.

(2) A copy of each licence contract concerning a registered mark or an application therefor shall be filed with the Registrar who shall keep its contents confidential, but shall record it and publish a reference thereto in the Journal.

(3) Any licence contract made in relation to the registration of a mark or an application therefor shall provide for the effective control, by the licensor, of the quality of the goods or services of the licensee in connection with which the mark is used.

(4) Where the licence contract does not provide for such quality control or if such quality control is not effectively carried out, the licence contract shall be invalid.

(5) A licence contract shall have no effect against third parties unless it has been recorded.

### PART III COLLECTIVE MARKS

14. (1) Subject to subsections (2), (3) and section 15, sections 3 to 12 shall apply to collective marks. Collective marks.

(2) An application for the registration of a collective mark shall designate the mark as a collective mark and shall be accompa

nied by a copy of the regulations governing the use of the collective mark.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in subsection (2).

(4) For the purposes of subsection (2), “regulations” means the rules made by the person under whose control the collective mark may be used.

Invalidation of collective mark.

15. In addition to the grounds set out in section 11, the Court shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in section 14 (2), or that he uses or permits its use in a manner which is liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Licensing of collective mark.

16. The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

## PART IV

### TRADE NAMES

Trade names.

17. (1) 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.

(2) Notwithstanding any law requiring the registration of trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(3) Any use of the 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.

PART V  
ACTS OF UNFAIR COMPETITION

18. (1) Any act of competition contrary to honest practices in industrial or commercial matters is unlawful. Acts of unfair competition.

(2) The following acts, in particular, shall constitute acts of unfair competition –

- (a) any act of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities of a competitor;
- (b) the making of false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor; and
- (c) indications or the making of allegations which, if used in the course of trade are liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quality of the goods of a competitor.

(3) Any person who performs an act of unfair competition commits an offence and is liable to a fine of not less than ten thousand dollars but not more than thirty thousand dollars.

PART VI  
GENERAL PROVISIONS

19. Any application or other document filed under this Act shall, if not in English, be accompanied by a translation thereof in English, verified by the translator that the translation is to the best of his knowledge, complete and faithful. Where documents not in English.

20. (1) Any change in the ownership of the registration of a mark or collective mark, or in the ownership of an application therefor shall be – Changes in ownership.

- (a) in writing and addressed to the Registrar;
- (b) recorded in the Register by the Registrar at the request of any interested party; and
- (c) published by the Registrar in the Journal, except in the case of an application.

(2) A change referred to in subsection (1) shall have no effect against third parties unless it has been recorded.

(3) Any change in the ownership of the registration of a collective mark, or in the ownership of an application therefor shall require the prior written approval of 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 shall be in writing.

(5) A change in ownership of the registration of a mark or a collective mark shall be 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.

**Agents.**

21. (1) Where an applicant's ordinary residence or principal place of business is outside Dominica, he shall be represented by a legal practitioner resident and practising in Dominica in accordance with the relevant law.

**Registrar.**

22. (1) The Registrar shall perform the functions and exercise the powers conferred on him by this Act and any other enactment.

(2) Without derogating from the generality of subsection (1), the Registrar shall –

- (a) perform all functions relating to the registration of marks and collective marks;
- (b) administer registered marks and collective marks as specified in this Act and the Regulations thereto;
- (c) superintend and perform all duties required by this Act and the Regulations thereto; and

- (d) carry out studies, programs or exchanges of items or services recording domestic and international law on marks, collective marks, trade names and protection against unfair competition.

23. (1) The Registrar shall maintain a register, to be known as Register. the Register of Marks, in which he shall record all matters required by this Act or the Regulations to be recorded.

(2) The Registrar shall register collective marks in a special section of the Register created for that purpose.

(3) Any person may, upon payment of the prescribed fees, and in accordance with the prescribed conditions, consult, inspect or make a copy of or obtain an extract from the Register.

(4) The Register shall be *prima facie* evidence of anything required or authorised by this Act to be registered, and shall be admissible and sufficient evidence of any such thing.

(5) A certificate signed by the Registrar and certifying that any entry which he is authorised to make by this Act has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be *prima facie* evidence and shall be admissible and sufficient evidence of the matters so certified.

(6) Each of the following, that is to say a copy of –

- (a) an entry in the Register or an extract from the Register which is supplied under subsection (3);
- (b) any document kept in the Companies and Intellectual Property Office, or an extract from any such document, or any matter which has been published under this Act, which is a certified copy or a certified extract shall be admitted in evidence without production of the original, and such evidence shall be sufficient evidence of the matters stated therein.

(7) In this section, “certified copy” and “certified extract” means a copy or extract certified by the Registrar and sealed with his seal.

Correction of errors.

24. (1) The Registrar may, of his own volition or upon the written request of any interested person, correct any clerical error or error of translation or transcription in any application filed under this Act, or in any document filed in pursuance of such application, and the Registrar may also correct any clerical error in the Register.

(2) Subsection (1) shall not be construed as giving the Registrar the power to correct in the Register, any application or document in a material way.

Extension of time for applications.

25. (1) Where the Registrar is satisfied that the circumstances justify it, he may, upon the written request of any interested person, and upon such terms as he may direct, extend the time for doing any act or taking any proceeding under this Act or the Regulations, and shall give written notice to the parties concerned.

(2) The extension may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary power.

26. The Registrar shall give any party to a proceeding before him the discretionary opportunity of being heard before exercising any discretionary power vested in him under this Act or the Regulations if the exercise thereof might adversely affect that party.

Jurisdiction of Court.

27. (1) The High 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, may be brought before it.

(2) Any person who is aggrieved by a decision of the Registrar under this Act may, within two months of that decision, appeal to the Court.

Infringement.

28. (1) Subject to section 9(4), an infringement shall consist of the performance, in Dominica, of any act referred to in section 9 by a person other than the owner of the title of protection and without the agreement of the latter.

(2) On the application of the owner of the title of protection, or of a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, the Court may –

- (a) grant an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in sections 17(2), (3), 18 or 29(2);
- (b) award damages;
- (c) order the seizure, forfeiture or destruction of –
  - (i) any infringing product or article, or of any product or article of which the infringing product or article forms an inseparable part; and
  - (ii) any article, instrument or thing by means of which any infringing product or article was produced; or
- (d) grant any other remedy provided for in the general law.

(3) On the application of any competent authority or any interested person, association or syndicate, in particular of producers, manufacturers or traders, the Court may, in the case of an act of unfair competition referred to in section 18, grant the same relief set out in subsection (2).

**29.** (1) Any person who performs an act which constitutes an infringement as defined in section 28 or an unlawful act as defined in sections 17(3) or 18 commits an offence and is liable to a fine of not less than ten thousand dollars but not more than thirty thousand dollars, or to imprisonment for a term of not less than three years but not more than ten years, or to both such fine and such imprisonment.

- (2) Any person who –
  - (a) forges a mark or collective mark ;
  - (b) makes any die, block, machine or other instrument for the purpose of forging or of being used for forging a mark or collective mark;
  - (c) disposes of, or has in his possession, any such die, block, machine or other instrument;

(d) sells, or has in his possession for sale any goods to which is affixed a forged mark or collective mark;

(e) imports, into the State –

(i) any product or article bearing a forged mark or collective mark; or

(ii) any other infringing product or article,

commits an offence and is liable to a fine of not less than fifteen thousand dollars, but not more than forty thousand dollars, or to imprisonment for not less than five years, but not more than twelve years, or to both such fine and such imprisonment.

(3) Any person who, knowing the same to be false –

(a) makes or causes to be made a false entry in the Register;

(b) makes or causes to be made any document falsely purporting to be a copy of an entry in the Register; or

(c) produces, tenders or causes to be produced in evidence any such entry or copy thereof,

commits an offence and is liable to a fine of not less than ten thousand dollars, but not more than thirty thousand dollars, or to imprisonment for not less than three years, but not more than ten years, or to both such fine and such imprisonment.

(4) Any person who, for the purpose of –

(a) deceiving the Registrar or any other officer in the execution of his duties under this Act; or

(b) procuring or influencing the doing or omission of any act under this Act,

makes a false statement or representation knowing the same to be false, commits an offence and is liable to a fine of not less than five thousand dollars, but not more than twenty thousand dollars, or to imprisonment for a term of not less than two years, but not more than five years, or to both such fine and such imprisonment.

Registrar's annual report.

**30.** The Registrar shall, before 1st June every year, make an annual report to the Minister regarding the operation of this Act and the discharge of his functions thereunder.



31. The Minister may make Regulations providing for any matter which is to be prescribed under this Act, or for giving effect to the purposes of this Act. Regulations.

32. The provisions of any international treaty in respect of marks, collective marks, trade names and protection against unfair competition to which Dominica is a party shall apply to matters dealt with by this Act and, in case of conflict with the provisions of this Act, shall prevail over the latter. Application of international treaties.

33. The Trade Marks Act, the Registration of United Kingdom Trade Marks Act and the Merchandise Marks Act are hereby repealed. Répeal.  
Ch. 78:42.  
Ch. 78: 44.  
Ch. 78: 47.

34. (1) Notwithstanding the repeal of the former Acts, trademarks registered thereunder shall remain in force but shall, subject to subsections (2) and (3), be deemed to have been registered under this Act. Transitional.

(2) Trademarks thus registered shall remain in force for the unexpired portion of the period of protection provided for under the Trade Marks Act or the Registration of United Kingdom Act as the case may be, and may be renewed in accordance with the provisions of this Act, upon which renewal they shall be reclassified in accordance with the International Classification. Ch. 78:42.  
Ch. 78: 44.

(3) A person who, on the coming into force of this Act is the owner of a trademark registered in the United Kingdom or has filed an application for the registration of a trademark in the United Kingdom may, within twelve months of the entry into force of this Act, file an application for the registration of the same trademark under this Act, and such application shall be accorded the filing date or priority date accorded to the application or registration in the United Kingdom.

35. (1) This Act shall come into force on such day as the Minister may, by Order published in the *Gazette*, appoint. Commencement.

(2) Different days may be appointed for bringing different provisions into force, or for bringing different purposes of the same provision into force.

Passed in the House of Assembly this 9th day of September, 1999.

RUTH SIMON (MRS.)  
*Clerk of the House of Assembly (Ag.)*

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