ANTIGUA AND BARBUDA

THE PATENTS BILL, 2018

No. of 2018

THE PATENTS BILL, 2018

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ANTIGUA AND BARBUDA

THE PATENTS BILL, 2018

No. of 2018

AN ACT to make provision for the registration of patents and for incidental and connected purposes.

ENACTED by the Parliament of Antigua and Barbuda as follows:

PART I

PRELIMINARY

1. Short title and commencement

This Act may be cited as the Patents Act, 2018.

2. Interpretation

In this Act, unless the context otherwise requires—

"Court" means the High Court;

"foreign application" means any application for a patent filed by an applicant outside Antigua and Barbuda;

"Intellectual Property Office" means the Intellectual Property Office established under the Intellectual Property Office Act, 2003;

"international application" means an application made under the Patent Cooperation Treaty;

"International Patent Classification" means the classification according to the Strasbourg Agreement of March 24, 1971;

"inventor" means the actual deviser of an invention and "joint inventor" shall be construed accordingly;

"invention" means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;

"Minister" means the Minister for the time being with responsibility for Legal Affairs;

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

"patent" means the title granted to protect an invention;

"patentee" means the person to whom a patent has been granted;

"Patent Cooperation Treaty" means the Patent Cooperation Treaty of June 19, 1970;

"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 Patents referred to in section 3 of this Act;

"Registrar" means the Registrar of Intellectual Property;

"Rules of Court" means the Eastern Caribbean Supreme Court Civil Procedure Rules 2000.

"utility certificate" means a technical creation that consists of a new shape or configuration of an object or of a component of an object that increases its functionality or utility.

"TRIPS" means the Agreement on Trade Related Aspects of Intellectual Property Rights of April 15, 1994.

"Budapest Treaty" means the Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of April 28, 1977.

PART II

REGISTER OF PATENTS

3. Register.

(1) The Registrar shall maintain a Register of Patents in which he shall record all matters required by this Act or the Regulations made thereunder to be recorded, and shall also, in a section of the Register created for that purpose, register utility certificates.

(2) Any person may, upon payment of the prescribed fee, and in accordance with any prescribed conditions, search, or make a copy of, or obtain an extract from, the Register.

(3) 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.

(4) A certificate signed by the Registrar and certifying that any entry which he is authorised by this Act to make has or has not been made, or that any other thing which he is 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.

(5) 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 (2); and

(b) any document kept in the Intellectual Property Office, a certified copy of any document or a certified extract from any such document, or any matter which has been published in the Gazette,

shall be admitted in evidence without further proof and without production of the original, and such evidence shall be sufficient evidence of the matters stated therein.

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

4. Seal

(1) The Registrar shall have a seal approved by the Minister, which he may affix to every document issued by him.

(2) Impressions of the Registrar's seal shall be judicially and officially noticed and admitted in evidence.

PART III

PATENTS

5. Patentable inventions

(1) Subject to section 9, a patent may be granted only for an invention which satisfies the following conditions—

(a) the invention is new;
(b) it involves an inventive step; and
(c) it is capable of industrial application.

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

6. Novelty

(1) An invention is considered to be new if it does not form part of the prior art.

(2) For the purpose of this Act, prior art in relation to an invention means anything which has, at any time prior to the filing date or, where priority is validly claimed, the priority date, of the application claiming the invention, been disclosed to the public anywhere in the world by oral or written description, by use, or in any other way.

(3) For the purpose of subsection (2), the disclosure to the public of matter constituting an invention shall not be taken into consideration if it occurred within twelve months immediately preceding the filing date or, where priority is claimed, the priority date of the application, and the disclosure was due to or in consequence of—

(a) acts committed by the inventor, the applicant or his predecessor in title; or
(b) an abuse committed by a third party with regard to the inventor, the applicant or his predecessor in title.

7. Inventive step

An invention shall be considered as involving an inventive step if, having regard to the prior art relevant to the application claiming the invention as defined in section 6(2), it is not obvious to a person having ordinary skill in the art.

8. Industrial application

An invention shall be considered as being capable of industrial application if it can be made or used in any kind of industry including without limitation agriculture, fishery, handicraft and services.

9. Matters excluded from patent protection

The following, even if they are inventions within the meaning of this Act, shall not be protected as patents—

(a) a discovery, scientific theory or mathematical method;
(b) a scheme, rule or method for doing business, performing a mental act or playing a game; and
(c) computer programs as such;
(d) a method for the treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practised on the human or animal body;
(e) plants and animals other than micro-organisms;
(f) Essentially biological processes for the production of plants or animals other than non-biological microbiological processes;
(g) plant varieties;
(h) known substances for which a new use has been discovered
(i) inventions the commercial exploitation of which it is necessary to prevent in Antigua and Barbuda in order—
    (i) to protect public order or morality, including to protect human, animal or plant life or health; or
    (ii) to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by law.

PART IV

RIGHT TO APPLY FOR AND OBTAIN A PATENT

10. Who may apply for a patent

Any person may make an application for a patent, either alone or jointly with another.

11. Right to a patent

(1) The right to a patent shall belong to the inventor.

(2) If two or more persons have made an invention jointly, the right to the invention shall belong to them jointly.

(3) Where two or more persons have made the same invention independently of each other, the person whose application bears the earliest filing date or, if priority is claimed, the person whose application bears the earliest validly claimed priority date shall, unless that application is withdrawn by the applicant, or refused by the Registrar, have the right to the patent.

(4) The inventor shall be named as such in the patent unless in a special written declaration signed by him and addressed to the Registrar, he indicates that he does not wish to be so named.

(5) Any promise or undertaking made by the inventor to any person to the effect that he will make such a declaration shall be void.

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

12. Invention by employee or person commissioned

(1) Where an invention is made in execution of a contract of employment or for the execution of work, the right to the patent shall, in the absence of any agreement to the contrary, belong to the employer or the person who commissioned the work, as the case may be.

(2) Where an invention referred to in subsection (1) acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment or for the execution of work, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.

(3) Where an employee whose contract of employment does not require him to engage in any inventive activity makes, in the field of the activities of his employer, an invention using information or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer in the absence of any provision to the contrary in the contract of employment, provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the invention and any benefit derived from it by the employer.

(4) For the avoidance of doubt, it is hereby declared that when an invention is made by an employee whose contract of employment does not require him to engage in inventive activity, or in a field of activity different from that of his employer, and without using information or means put at his disposal by the employer, the right to the patent for such invention shall accrue to the employee.

(5) The rights conferred on the inventor under subsections (1), (2), (3) and (4) shall not be restricted by contract.

(6) This section shall not apply to an invention made before the coming into force of this Act.

13. Judicial assignment of patent application or patent

(1) Where the idea of the invention claimed in a patent or application for a patent has been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him.

(2) The Court shall make such order as it sees fit upon hearing such application.

(3) No application for the assignment of a patent under subsection (1) shall be entertained by the Court after the expiry of five years from the date of the grant of the patent unless it is shown that any person registered as an owner of the patent knew, at the time of the grant or, as the case may be, of the transfer of the patent to him, that he was not entitled to the patent.

PART V

APPLICATIONS FOR PATENTS

14. Application for a patent

(1) Every application for a patent shall be filed with the Registrar in the prescribed form and shall contain—

(a) a request;
(b) a description;
(c) one or more claims;
(d) one or more drawings where required; and
(e) an abstract.

(2) The request shall contain—

(a) a petition that a patent be granted;
(b) the name of and other prescribed information relating to the applicant, the inventor, and agent, if any; and
(c) the title of the invention.

(3) Where the applicant is not the inventor or a joint inventor, the request shall be accompanied by a written statement justifying the applicant's right to the patent.

(4) The description shall disclose the invention in a manner which is sufficiently clear and complete to permit a person having ordinary skill in the art to carry out the invention, and shall, in particular, indicate at least one mode known to the applicant in which the invention can be carried out

(5) To the extent that the contents of an application for a patent or of a patent discloses an invention, which requires, for its performance, the use of a micro-organism which is not available to the public at the date of filing, these contents shall be treated as disclosing the invention in a manner which is clear and complete enough for the invention to be performed by a person skilled in the art if the following conditions are satisfied—

(a) a culture of the micro-organism has been effected with an international depositary authority (IDA) recognized under the Budapest Treaty on the International Recognition of the Deposit of microorganisms for the Purposes of Patent Procedure of 1977, or with another institution recognized by the competent national office.
(b) the application as filed gives such relevant information as is available to the applicant on the characteristics of the micro-organism; and

(c) the name of the IDA, the date when the culture was deposited and the accession number of the deposit are given in the description of the application.
(d) The receipt of the Deposit issue by the IDA shall be filed to the patent application, no later than 12 months counted from the filing date of the Patent Application.

(6) The claim or claims shall—

(a) define the matter for which protection is sought;
(b) be clear and concise; and
(c) be supported by the description.

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

(8) The Registrar shall require an applicant to file drawings where these are necessary for the understanding of the invention.

(9) The purpose of the abstract is to provide technical information and shall not be taken into account for the purpose of interpreting the scope of the protection sought.

(10) An applicant may, at any time before the patent is granted, withdraw his application.

(11) An application for a patent shall be accompanied by the prescribed application fee.

15 Examination as to the form

(1) After according a filing date, the Registrar shall examine whether the application complies with the requirements of Section 14 and other requirements which are designated by the Regulations as formal requirements.

(2) If the Registrar finds that the application does not fulfil the requirements referred to in subsection (1), he shall invite the applicant to correct the application's defects within a period of three months, counted as of the notification of the request by the Registrar.

(3) If the request that the previous subsection refers to is not submitted within the prescribed term the application shall be deemed abandoned.

(4) The Registrar shall inform the applicant, in writing, the reason for considering the application abandoned.

(5) Where the application formal requirements set out in this Act are met, the Registrar shall proceed with the publication stated in section 24 of this Act.

16. Unity of invention

(1) An application for a patent shall 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, at any time before a patent is granted, divide the application into two or more applications (referred to in this section as "divisional applications"), provided that each

divisional application shall be in good standing, that is it has not been refused or withdrawn and all applicable fees been paid, and shall not include any matter which was not disclosed in the initial application as filed.

(3) Each divisional application shall be accorded 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 requirements of unity of invention under subsection (1) shall not be a ground for the invalidation of the patent.

17. Amendment of application

The applicant may, upon payment of the prescribed fee, at any time before a patent is granted, amend the application, but the amendment shall not include any matter which was not disclosed in the initial application as filed.

18 Divisional applications

(1) The applicant may, upon payment of the prescribed fee, at any time before a patent is granted, divide his application into two or more divisional applications, provided none of them involve any broadening of the protection accorded to the disclosure contained in the original application.

(2) The Registrar may, at any stage in the proceedings, require the applicant to divide the application if it does not fulfill the requirement of unity of invention.

(3) Every divisional application shall have the same filing date and, where applicable, the same priority date, as the original application.

19. Joint application

(1) Where two or more persons apply jointly for a patent, they shall, in the absence of an agreement to the contrary, have equal undivided shares in the application and none of them shall deal with the application in any way without the consent of the other.

(2) Notwithstanding the provisions of subsection (1), if any step is required to be taken to save the application from being abandoned, any applicant may, on his own behalf and on behalf of any other joint applicant, take such step without recourse to the other applicant or applicants.

20. Right of priority

(1) An application for a patent 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 the said Convention or any member of the World Trade Organization.

(2) Where the application contains a declaration under subsection (1), the applicant shall furnish, within the following 3 months counted as of the filing date in Antigua and Barbuda, a

copy of the earlier national, regional or international application certified as correct by the office with which it was filed.

(3) Where the earlier application is not in English, the applicant shall furnish a translation thereof in English verified by the translator that the translation is, to the best of his knowledge, complete and faithful.

(4) The effect of the declaration referred to in subsection (1) shall be as provided in the Paris Convention.

(5) Where any requirement of this section or the Regulations pertaining thereto is not fulfilled, the declaration referred to in subsection (1) shall be considered as having not been made.

21. Conversion of patent applications

(1) At any time before the grant of a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his application into an application for a utility certificate.

(2) No person may convert an application under subsection (1) more than once.

22. Information concerning corresponding foreign applications

(1) The applicant shall, if requested by the Registrar, furnish him with the date and number of any application for a patent filed by him abroad relating to the same invention as that claimed in the application filed with the Registrar.

(2) The applicant shall also, if requested by the Registrar, furnish him with the following documents relating to any foreign application 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; and
(d) a copy of any final decision invalidating the patent granted on the basis of the foreign application referred to in subsection (1).

(3) Subsection (2) (a) and (c) shall not apply where the Intellectual Property Office is an elected office within the meaning of section 51 and has received or will receive an international preliminary examination report.

(4) Any document furnished pursuant to this section 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.

23. Filing Date

(1) The Registrar shall accord as the filing date of an application for a patent, the date of receipt of the application, provided that at the time of its receipt, the following requirements are satisfied—

(a) the documents filed contain an express or implied indication that the granting of a patent is sought;
(b) the documents filed identify the applicant or applicants;
(c) the documents filed contain information which, on the face of it, appears to be a description of the invention.

(2) Where an application does not comply with the requirements of subsection (1), the Registrar shall so inform the applicant in writing and shall request him, subject to section 17, to file the required amendment.

(3) The Registrar shall then accord, as the filing date, the date of receipt of the amendment referred to in subsection (2).

(4) Where the applicant fails to make the required amendment within the time provided by the Registrar, the application shall be treated as if it had not been filed.

(5) Where the application refers to drawings which are not included in the application, the Registrar shall invite the applicant to furnish the missing drawings and, if the applicant complies, the Registrar shall accord as the filing date of the application, the date of receipt of the missing drawings.

(6) Where the applicant fails to comply with subsection (5), the Registrar shall accord as the filing date of the application the date of receipt of the application and shall treat any reference to the said drawings as non-existent.

24. Examination

(1) If the application meets the formal requirements prescribed in section 14 of this Act, the Registrar shall proceed with the publication of the application in the Official Gazette after eighteen months from the filing date, including the abstract of the invention, any drawings or particulars relating thereto. Upon payment of the prescribed fee, at any time between the filing date and the end of the eighteen-month period, the applicant may request to the Registrar an early publication of the application.

(2) Within six (6) months after the publication date of the application, the applicant shall request the Registrar that the patent application be examined as to its compliance with the conditions under sections 5, 6, 7, 8, 9 and 16 of this Act, and pay the prescribed fee.

(3) If the request of examination that the previous paragraph refers to is not submitted within the prescribed term the application shall be deemed abandoned.

(4) The Registrar shall take into account, for the purposes of substantive examination,

(a) the results of any international search report and any international preliminary examination report established under the Patent Cooperation Treaty in relation to the application; and/or

(b) a search and examination report submitted under section 22 (2) (a) , a copy of the patent granted under section 22 (2) (b) or a final decision under section (2) (c) or (d)) on the refusal or invalidation of the patent/on a corresponding foreign application; and or/

(5) (c) a search and examination report which was carried out upon his request by an external search and examination.Where the Registrar is not satisfied that the requirements set forth in sections 6, 7, 8, 9 14 and 16 of the Patent Act and the implementing Regulations have been complied with, he shall notified the applicant the corresponding observations, and shall give him the opportunity to file arguments and amend the application, within the following 2 to 6 months according to what is set forth in the implementing regulations. If the applicant fails to file any response within the prescribed term, the application may deemed abandoned.

25. Refusal or Grant of the patent and publication

(1)Where the Registrar is not satisfied that the requirements set for in sections 6, 7, 8, 9 14, and 16 of the Patent Act and the implementing Regulations, he shall refuse the application and so inform the applicant in writing, stating the reasons for the refusal.

(2) Where two or more patent applications for the same invention, having the same filing date or the same priority date, are filed by the same applicant or his successor in title, the Registrar may, on that ground, refuse to grant a patent in respect of all but one of the applications.

(3) Where the Registrar finds that the conditions referred to in sections 6, 7, 8, 9, 14 and 16 of the Patent Act and the implementing Regulations are fulfilled, the patent shall be granted. . When a patent is granted, the Registrar shall:

(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.

(4) Any third party opposition may be filed after the patent is granted according to the implementing regulations

PART VI

ACTS FOLLOWING THE GRANT OF THE PATENT

26. Duration and maintenance of patent

(1) Subject to subsection (2), a patent shall expire 20 years after the filing date of the application.

(2) In order to maintain a patent or patent application, the owner of the patent or the applicant shall pay in advance to the Registrar for each year starting one year after the filing date of the application for the grant of the patent, the prescribed annual fee.

(3) Where the period prescribed for the payment of the annual fee expires and payment of the said fee has not been made, the Registrar shall give the owner of the patent or the applicant, as the case may be, a period of grace not exceeding six months, within which he must pay the annual fee together with the surcharge prescribed for the late fee.

(4) The owner of the patent or the application, as the case may be, shall, when paying the annual fee in accordance with subsection (2), also pay, to the Registrar, the surcharge prescribed for late payment.

(5) A patent shall lapse if the annual fee is not paid in accordance with the provisions of this section.

(6) If a patent ceases to have effect under this section, the Registrar shall enter the lapse in the Register and publish it in the Gazette.

27. Post grant Amendments

The owner of the patent may request the Registrar, upon payment of the prescribed fee, to amend the patent in order to reflect a change in the name, address, domicile or other particulars of the owner or inventor, or to alter or limit the scope of one or more of the claims. Any amendment to the claims as granted could not exceed the scope of the initial application.

28. Surrender of patent or claim

(1) The owner of a patent may, at any time by notice given to the Registrar in the prescribed manner, offer to surrender or renounce one or more claims of the patent or the patent as a whole.

(2) Where an offer is made under this section, the Registrar shall publish the offer to surrender in the prescribed manner and any interested person may, within the following two

months counted as of the date of the publication, file a reasoned objection contesting the proposed surrender.

(3) Where the objectionis duly filed under this section, the Registrar shall notify the owner of the patent in writing and determine the question.

(4) Where the Registrar is satisfied that the patent or any claim or claims contained in the patent may properly be surrendered, he may accept the offer and record his acceptance in the Register and shall, as soon as practicable, publish a notice of his acceptance in the Gazette.

(5) From the date of publication of the notice under subsection (4), the patent or claim or claims shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date, and no right to compensation shall accrue for any use of the patented invention before that date for purposes of the State.

(6) Where a patent has been granted to two or more persons, a notice in accordance with subsection (1) shall be signed by each of them.

29. Effect of registration, etc, on rights in patents

(1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction to which this section applies if, at the time of the later transaction—

(a) the earlier transaction was not registered; or
(b) in the case of any application, notice of the earlier transaction had not been given to the Registrar; and
(c) in any case, the person claiming under the later transaction did not know of the earlier transaction.

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent by virtue of a transaction to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction to which this section applies.

(3) This section applies to the following transactions—

(a) the assignment of a patent or application for a patent or a right in it;
(b) the grant, assignment of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application;
(c) the death of the owner or one of the owners of any such patent or application or of any person having a right in a patent or application and the vesting, of any such right, by an assent of the personal representative of the applicant or owner of a patent; and
(d) any order or directions of a Court or other competent authority—
    (i) transferring a patent or application or any right in or under it to any person; or

(ii) that an application should proceed in the name of any person, and in either case the event by virtue of which the Court or authority had power to make any such order or give any such directions.

(4) Where an application for the registration of a transaction has been made, but the transaction has not been registered, registration of the application shall, for the purposes of subsection (1) (a), be treated as registration of the transaction.

(5) For purposes of this section, "transaction" includes an instrument and an event.

PART VII

PROPERTY IN PATENT APPLICATION AND PATENTS

30. Nature of, and transactions in, patents

(1) A patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (6).

(2) Subject to section 31 (2) (b), any patent or any such application, or any right in it, may be assigned or mortgaged.

(3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(4) Subject to section 31 (2) (b), a license may be granted under any patent or any such application for working the invention which is the subject of the patent or the application, and—

(a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and
(b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(5) Any of the following transactions, that is to say—

(a) any assignment or mortgage of a patent or any such application, or any right in a patent or any application; or
(b) any assent relating to any patent or any such application or right,

shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative), or in the case of a body corporate, is so signed or is under the seal of that body.

(6) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application may confer, on the assignee or licensee, the right of the assignor or licensor to bring proceedings by virtue of section 37 for a previous infringement.

31. Joint ownership of patent

(1) Where a patent is granted to two or more persons jointly, each of the patentees shall, in the absence of an agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of subsection (4), a joint patentee shall not be entitled, in the absence of an agreement to the contrary, and in the absence of the consent of the joint patentee or patentees, to—

(a) make, use, exercise, or dispose of the patented invention;
(b) grant a licence or assign the whole or any part of his interest in the patent; or
(c) take any step or institute any proceedings relating to the patent; provided that he may without recourse to any other joint patentee, pay any annual fee which is payable.

(3) Where a patented article is disposed of by a joint patentee, the person who acquires the patent, or any person making a claim through him, shall be entitled to deal with that article in the same manner as though the article had been disposed of by the patentees jointly.

(4) Any joint patentee may institute proceedings for infringement and shall give notice thereof to any other joint patentee, and any such other joint patentee may intervene as co-claimant and recover any damages in respect of any damage he may have suffered as a result of the infringement.

PART VIII

RIGHTS OF OWNER OF PATENT

32 . Rights conferred by the patent

(1) The exploitation of a patented invention in Antigua and Barbuda by any person other than the owner of the patent shall require the authorization of the owner.

(2) For the purposes of this section, exploitation of a patented invention means—

(a) where the patent has been granted in respect of a product—
  (i) making, importing into Antigua and Barbuda, offering for sale, selling and using that product;
  (ii) stocking such product for the purposes of offering it for sale or selling or using it; and
(b) where the patent has been granted in respect of a process—
  (i) using that process; and
  (ii) doing any act referred to in paragraph (a) in respect of a product obtained by means of that process.

(3) Subject to subsection (4) and to sections 33, 34 and 35 , the owner of the patent shall have the right to bring an action against any person who exploits the patented invention in Antigua and Barbuda without his authorization.

(4) The rights under the patent shall not extend to—

(a) acts in respect of articles which have been put on the market in any country by the owner of the patent or with his consent;
(b) the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Antigua and Barbuda;
(c) acts done only for experimental purposes relating to a patented invention;
(d) the extemporaneous preparation for individual cases, in a pharmacy, of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared; or;
(e) 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, and in Antigua and Barbuda, was using the invention or was making effective and serious preparations for such use.
(f) acts done privately and on a non-commercial scale or for non-commercial purpose, provided that it does not significantly prejudice the economic interests of the patent owner
(g) acts of making, constructing, using, or selling the patented invention solely for uses reasonably related to the development and submission of information required under any law of Antigua and Barbuda, or another country that regulates the manufacture, construction, use or sale of any product, provided that any product produced under such authority shall not be made, used, or sold in this country other than for purposes related to generating such information, and that the product shall only be exported for purposes of meeting marketing approval requirements.

(5) The right of prior user referred to in subsection (4) (e) may be transferred or devolve only together with the enterprise or business, or with that part of the enterprise or business in which the use or preparations for use have been made.

33. Prior user's right once the patent is granted.

(1) Where a patent is granted for an invention, a person who before the date of filing of the patent application, or if priority was claimed, before the date of priority, does in good faith in Antigua and Barbuda, an act which would constitute an infringement of the patent if it were then in force, or makes effective and serious preparations in good faith to do such an act, shall have the rights specified in subsection (2).

(2) The rights referred to in subsection (1) shall be the following, namely—

(a) to continue to do or, as the case may be, to do that act himself; and
(b) if the act was done or preparations had been made to do it in the course of a business—
(i) to assign the right under paragraph (a);

(ii) to transmit the right under paragraph (a) to his heirs on his death or, in the case of a body corporate, on its dissolution, to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it; or

(iii) to authorise the act to be done by any partners of his for the time being in that business, and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

(4) Where a product which is the subject of a patent is disposed of by any person to another in exercise of a right conferred by subsection (2), that other and any person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole owner of the patent.

34. Exploitation by Government or person authorized thereby

(1) Where—

(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 has determined that the manner of exploitation, by the owner of the patent or his licensee, is anticompetitive, and he is satisfied that the exploitation of the invention in accordance with this subsection would remedy such practice,

the Minister 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 patented invention shall be limited to the purpose for which it was authorised and shall be subject to the payment to the said owner of an adequate remuneration therefor, taking into account the economic value of the Minister's authorisation, as determined in the said decision, and, where a decision has been taken under subsection (1) (b), the need to correct anti-competitive practices.

(3) The Minister shall make his decision after hearing the owner of the patent and any interested person.

(4) A request for the Minister's authorisation to exploit a patented invention shall be accompanied by evidence that the owner of the patent has received, from the person seeking the authorisation, 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.

(5) Subsection (4) shall not apply in cases of—

(a) national emergency or other circumstances of extreme urgency provided, however, that in such cases the owner of the patent shall be notified of the Minister's decision as soon as reasonably practicable;

(b) public non-commercial use; and
(c) anti-competitive practices determined as such by the Minister in accordance with subsection (1) (b).

(6) The exploitation of a patented invention in the field of semi-conductor technology shall only be authorised for public non-commercial use or where a judicial or administrative body has determined that the manner of exploitation of the patented invention, by the owner of the patent or his licensee, is anticompetitive, and if the Minister is satisfied that the issuance of the non-voluntary licence would remedy such practice.

(7) The authorisation shall not exclude—

(i) the conclusion of licence contracts by the owner of the patent; or

(ii) the continued exercise, by the owner of the patent, of his rights under section 32.

(8) Where a third person has been designated by the Minister, the authorisation 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.

(9) The exploitation of the patented invention by the Government agency or third person designated by the Minister shall be predominantly for the supply of the market in Antigua and Barbuda.

(10) Upon the request of the owner of the patent, of the Government agency or of the third party authorised to exploit the patented invention, the Minister may, after hearing the parties, vary the terms of the decision authorising the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(11) Upon the request of the owner of the patent, the Minister shall terminate the authorisation if he is satisfied, after hearing the parties, that the circumstances which led to his decision have ceased to exist and are unlikely to recur, or that the Government agency or third person designated by him has failed to comply with the terms of the decision.

(12) Notwithstanding subsection (11), the Minister shall not terminate the authorisation if he is satisfied that the need for adequate protection of the legitimate interests of the Government agency or third person designated by him justifies the maintenance of the decision.

35: Compulsory Licenses

(1) Where,

(a) the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires;

(b) or a judicial or administrative body has determined that the manner of exploitation, by the owner of the patent or his licensee, is anti-competitive, and the Minister is satisfied that the exploitation of the invention in accordance with this subsection would remedy such practice; or

(c) the owner of the patent is abusively exercising his exclusive rights and/or neglecting in taking measures to prevent his licensee(s) from abusively exercising the licensed exclusive rights; or

(d) the invention is not available in sufficient quantities or quality or at predetermined reasonable prices in the territory of Antigua and Barbuda, either through manufacture in Antigua and Barbuda, or through importation; or

(e) when a patent (the "second patent") claiming an invention that involves an important technical advance of considerable economic significance in relation to an invention claimed in a patent (the "first patent") without infringing which the second patent cannot be exploited.

the Minister 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. Each request for a compulsory license shall be considered by the Minister on its individual merits. The exploitation of the invention shall be limited to the purpose for which it was licensed and shall be subject to the payment to the said owner of an adequate remuneration in the circumstances of each case, 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 item (b) of this paragraph, the need to correct anti-competitive practices. The Minister shall take his decision after hearing the owner of the patent and any interested person if they wish to be heard.

(2) (a) The public interest according to subsection (1) (a) includes public health problems such as HIV, tuberculosis, malaria and other epidemics. Therefore, the Minister in the case of national emergency or other circumstances of extreme urgency has the authority to grant a compulsory license or authorize a public noncommercial use for the importation of a pharmaceutical product, a product produced by a patented process or a process of making a pharmaceutical product provided an alternative process of making the same product is not known or not available, under the terms and conditions contained in Article 31 bis of the TRIPS Agreement, the Annex to the Agreement and the Appendix to the Annex.

(b) Adequate remuneration of compulsory license under subsection 2 (a) shall take place only in the exporting country according to Article 31 bis (2) of the TRIPS Agreement.

(3) A compulsory license may not be applied for on the ground of insufficient availability of the patented product or of the product manufactured with the patented process, as established in subsection (1)(4), before the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last; it shall be refused if the patentee justifies his inaction or insufficient action by legitimate reasons.

(4) Upon request of the owner of the patent, or of the Government agency or of the third person authorized to exploit the patented invention, the Minister 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 shall terminate the compulsory license if he is satisfied, after hearing the parties, if either or both wish to be heard, that the circumstances which led to his decision have ceased to exist and are unlikely to recur or that the Government agency or third person designated by him has failed to comply with the terms of the decision.

(b) Notwithstanding subsection (a) of this paragraph, the Minister shall not terminate the compulsory license if he is satisfied that the need for adequate protection of the legitimate interests of the Government agency or third person designated by him justifies the maintenance of the decision or, if the compulsory license was granted to remedy an anti-competitive practice under subsection (1) (b) if and when the conditions which led to such compulsory license are likely to recur.

(6) The compulsory license 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 compulsory license shall always be non-exclusive. Therefore, it shall not exclude:

(a) the exploitation of the invention by the patent owner himself, either through manufacture in Antigua and Barbuda or through importation or both; and
(b) the conclusion of license contracts by the owner of the patent; and
(c) the continued exercise, by the owner of the patent, of his rights as stated in section 32 of this Act.

(8) (a) A request for the compulsory license shall be addressed to the Minister. It shall be accompanied by evidence that the owner of the patent has received, from the person seeking the compulsory license, a request for a contractual license, but that that person has been unable to obtain such a license on reasonable commercial terms and conditions and within a reasonable time. Unless the particular circumstances of the case show otherwise, a period of up to a maximum of six months between the date on which the patent owner was informed by the proponent of the request and the proposed conditions for a voluntary license and the date on which the proponent of the voluntary license was informed by the patent owner on his final decision to refuse the proposal shall be deemed a reasonable time.

(b) Evidence concerning a previous attempt of obtaining a voluntary license, under paragraph H subsection (1) shall not be required in cases of national emergency or other circumstances of extreme urgency or in cases of public non-commercial use or when the license is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, provided, however, that in such cases the owner of the patent shall 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 licensed by the Minister shall be predominantly for the supply of the market in Antigua and Barbuda, except, when it is permitted to remedy a practice determined to be anticompetitive according subsection (1) (2); or when the compulsory license concerns a patent claiming a pharmaceutical product or a process of making a pharmaceutical product, and the purpose of the license is to export the patented products or the products manufactured by the patented process for an importing Member with no or with insufficient manufacturing capacity, in accordance with the terms and conditions of Article 31 bis of the TRIPS Agreement**.**

(10) Where a compulsory license is granted under subsection (1) (e):

(a) the owner of the first patent shall be entitled to a cross-license on reasonable terms to use the invention claimed in the second patent; and
(b) the license of the first patent shall be non-assignable except with the assignment of the second patent.

(11) The provisions of this article shall apply, where appropriate, and mutatis mutandis, to pending patent applications, except in the case of insufficient availability of the patented product or of the product manufactured with the patented process.

(12) Any decision by the Minister as regards a request for a compulsory license or a compulsory license granted, including the decision relating to the remuneration, may be subject to an appeal by the patent applicant or owner or by the requesting party, in accordance with section 63 of this Act.

36. Indirect infringement of the invention

(1) While in force, a patent shall confer, on its owner, the right to prevent all persons not having his authorisation, from supplying or offering to supply in Antigua and Barbuda, a person (other than a person entitled to engage in the working of the patented invention) with means relating to an essential element of the invention, for putting it into effect therein, provided that the person knows, or it is obvious to a reasonable person in the circumstances that those means are suitable for putting, and are intended to put, that invention into effect.

(2) Subsection (1) shall not apply where the means referred to therein are staple commercial products, except where the person induces the person supplied to commit acts which the owner of the patent is entitled to prevent by virtue of section 32.

PART IX

VOLUNTARY LICENCES

37. Voluntary licences

(1) Subject to section 31, the owner of a patent application or patent may grant a licence in respect of the relevant invention.

(2) Any licence contract concerning a patent or an application therefore shall be filed with the Registrar who shall keep its contents confidential but shall, upon payment of the prescribed fee, record it in the Register and publish a reference thereto in the Gazette in the manner prescribed.

(3) Until such contract has been so recorded, the licence shall have no effect against third parties, unless otherwise decided by the Court.

(4) In the absence of any provision to the contrary in the terms of a licence contract, a licensee may not extend, to another person, the authorisation conferred on him by the owner in accordance with subsection (1), nor may he assign his licence.

(5) In the absence of any provision to the contrary in the terms of a licence contract, the owner of a patent may continue to enjoy the rights conferred on him by sections 32 and 36.

(6) To the extent that the licence has been granted as an exclusive licence, the owner may not grant a licence in respect of the invention to a third person and may not himself do any of the acts referred to in sections 32 and 36.

(7) If, before the expiration of the licence contract, any of the following events occur with respect to any patent application or patent—

(a) the patent application is withdrawn or is deemed to be withdrawn;
(b) the patent application is treated as if it had not been filed;
(c) the grant of the patent is refused; or
(d) the patent is invalidated,

the licensee shall, from the date of the event, no longer be bound to make any payment directly relating to that patent application or patent.

(8) In any case referred to in subsection (7), the licensee shall have the right to repayment of the payments already made and directly relating to the patent application or patent in question, provided that he has not benefited from the licence.

38. Exercise of powers on applications

The powers of the Court on an application shall be exercised with a view to ensuring that the inventor or other person beneficially entitled to a patent receives adequate remuneration having regard to the economic value of the licence.

PART X

INFRINGEMENT

39. Infringement

Subject to the provisions of sections 32(2) and 34, the performance, in relation to a patent, of any act referred to in sections 32 and 36 without the authorisation of the owner of the patent shall, while it is in force, constitute an infringement.

40. Proceeding for infringement

(1) The owner of the patent shall, in addition to any other right, remedy or action available to him, have the right, subject to sections 32(4) and 34, to institute court proceedings against any person who infringes the patent by performing, without his authorisation, any of the acts referred to in section 32(2) or who performs acts which make it likely that infringement will occur.

(2) A claimant in proceedings for infringement shall be entitled to relief by way of—

(a) an injunction;
(b) 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 the predominant use of which has been in the manufacturing of the infringing product or article;
(c) damages;
(d) an account of the profits derived from the infringement; and
(e) any other relief provided for in the general law.

(3) The Court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the claimant be given an account of the profits derived from the infringement.

(4) In any proceedings for infringement, the defendant may counter-claim for the invalidation of the patent and, by way of defence, rely upon any ground on which a patent may be invalidated.

(5) In any proceedings under this section, the claimant shall, before instituting the proceedings, give notice thereof to every licensee under the patent in question whose name is recorded in the Register, and any such licensee shall be entitled to intervene as co-claimant.

(6) In any proceedings for infringement other than criminal proceedings, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that the product was not made by the process shall rest on the defendant if—

(a) the product is new; or

(b) a substantial likelihood exists that the product was made using another process and the owner of the patent has been unable through reasonable efforts, to determine the process used.

(7) In requiring the production of evidence, the court shall take into account the legitimate interests of the party to whom the order is addressed in not disclosing his manufacturing and business secrets.

(8) The Court shall, in awarding damages under this section, calculate such damages taking into account the amount of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the patent concerned.

41. Relief for infringement of partially valid patent

(1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the Court may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the Court shall not grant relief by way of damages, costs or expenses, except where the claimant proves that the description was framed in good faith and with reasonable skill and knowledge and, in that event, the Court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the Court as to costs or expenses and as to the date from which damages should be reckoned.

42. Certificate of contested validity of patent

(1) Where in any proceedings before the Court the validity of a patent to any extent is contested and that patent is found by the Court to be wholly or partially valid, the Court may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section and in any subsequent proceedings before the Court for infringement of the patent concerned or for invalidation, a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the Court otherwise directs, be entitled to his costs or expenses as between attorney-at-law and client (other than the costs or expenses of any appeal in the subsequent proceedings).

43. Proceedings for infringement by exclusive licensee

(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the owner of the patent to bring any proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the owner of the patent in this Act relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings, the Court shall take into account any loss suffered or likely to be suffered by the exclusive licensee as such as a

result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

44. Effect of non-registration on infringement proceedings

Where by virtue of a transaction, instrument or an event to which section 29 applies, a person becomes the owner or one of the owners or an exclusive licensee of a patent and the patent is subsequently infringed, the Court shall not award him damages or order that he be given an account of the profits in respect of such subsequent infringement occurring before the transaction, instrument or event is registered unless—

(a) the transaction, instrument or event is registered within the period of six months beginning with its date; or
(b) the Court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as was practicable thereafter.

PART XI

INVALIDATION OF PATENT

45. Invalidation of patent

(1) Subject to the provisions of this Act, the Court may, on the application of any interested party, invalidate a patent on any of the following grounds—

(a) that the invention is not an invention as defined in this Act;
(b) that the patent concerned is not patentable under section 5 or does not satisfy the requirements of sections 6, 7 and 8;
(c) that the invention is a matter which should, in accordance with section 9, have been excluded from patent protection;
(d) that the patent was granted to a person who was not entitled thereto under section 11or 12, as the case may be;
(e) that the patentee's application did not satisfy the requirements of section 14 (4) to (8);
(f) that the subject matter of the patent extends beyond the content of the patent application as filed or, if the patent was granted on a divisional application, it extends beyond the content of the relevant earlier application as filed; or
(g) that the protection conferred by the patent has been extended by an amendment which should not have been allowed.

(2) Any invalidated patent, claim or part of a claim shall be regarded as being null and void from the date of the grant of the patent.

(3) An application for the invalidation of a patent shall be served on the patentee and filed with the Court in the manner and within the time prescribed.

(4) The Registrar of the Court shall notify the Registrar of the final decision of the Court and the Registrar shall forthwith record it and publish a reference thereto in the Gazette.

PART XII

UTILITY CERTIFICATES

46. Application of provisions relating to patents

(1) Except as otherwise provided under this Part, the provisions of this Act relating to patents and patent applications shall apply mutatis mutandis to utility certificates and applications therefor.

(2) Sections 5, 7, 24 and 42(1) shall not apply to utility certificates and to applications therefor.

47. Qualification of invention for utility certificate

(1) An invention shall qualify for a utility certificate if it is new and industrially applicable.

(2) The description of the utility certificate shall disclose it in a manner sufficiently clear and complete for the utility model to be carried out by a person having ordinary skill in the art, and shall, in particular, indicate how the claimed utility model enhances the utility or functionality of the object.

(3) The following are excluded from utility certificate protection:

(a) Procedures;

(b) items excluded from protection by patents for inventions pursuant to this Patent Act.

(4) The examination by the Registrar of the application for a utility model shall be limited to the compliance, mutatis mutandis, of subsections 6, 8, 9, 14, and 15 of this Patent Act, as well as those of this section.

48. Registration and duration of utility certificate

(1) Particulars of utility certificates granted and notice of all matters which are required by or under this Act or Regulations to be registered, shall be registered in a special part of the register of patents by the Registrar.

(2) A utility certificate shall expire ten years after the filing date of its application and shall not be renewed.

49. Conversion of application for utility certificate

(1) At any time before the grant or refusal of a utility certificate, an applicant may, upon payment of the prescribed fee, convert his application for a utility certificate into an application for a patent, and the latter application shall be accorded the filing date of the initial application.

(2) A person may not convert an application under subsection (1) more than once.

PART XIII

INTERNATIONAL ARRANGEMENTS

50. Application of treaties

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

51. Implementation of Patent Cooperation Treaty

(1) Interpretation

For the purposes of this Section:

(a)"Patent Cooperation Treaty" means the Patent Cooperation Treaty done at Washington on June 19, 1970;

(b) "designate," "designated Office," "elect," "elected Office," "international application," "international filing date," "international preliminary examination", "priority period" and "receiving Office" have the same meanings as in the Patent Cooperation Treaty.

(2) Filing date and effects of international application designating Antigua and Barbuda

An international application designating Antigua and Barbuda shall, subject to this Section, be treated as an application for a patent or utility certificate filed under this Act having as its filing date the international filing date accorded under the Patent Cooperation Treaty.

(3) Intellectual Property Office as Receiving Office

(a) The Intellectual Property Office shall, subject to subsection (3) (c) of this Section, act as a receiving Office in respect of an international application filed with it by a resident or national of Antigua and Barbuda.

(b) An international application filed with the Intellectual Property Office as receiving Office shall be filed in English and the prescribed transmittal fee shall be paid to the Intellectual Property Office.

(c) The Intellectual Property Office shall act as receiving office provided that a formal notice to this effect is issued by the Minister and the International Bureau is notified accordingly. Until said notification the International Bureau will act as Receiving Office.

(4) Intellectual Property Office as Designated Office

(a) The Intellectual Property Office shall act as a designated office in respect of an international application in which Antigua and Barbuda is designated for the purposes of obtaining a national patent or other protection under this Act.

(b) The Intellectual Property Office shall act as an elected office in respect of an international application in which Antigua and Barbuda is designated if the applicant files a demand for the purposes of international preliminary examination under Chapter II of the Patent Cooperation Treaty.

(5) National processing

The Intellectual Property Office acting in its capacity as designated office or elected office, shall not commence processing of an international application before the expiration of the time limit referred to in subsection (6) of this section, unless the applicant files with the Intellectual Property Office an express request for early commencement of such processing and complies with the requirements of that subsection.

(6) Entering national phase

The applicant shall, in respect of an international application designating Antigua and Barbuda and before the expiration of the time limit applicable under Article 22(1) or 39(1)(a) of the Patent Cooperation Treaty or of such later time limit as may be specified in the regulations under this Act, pay the national fee to the Intellectual Property Office and file with the Intellectual Property Office a translation of the international application into a specified language if the international application was not filed in, and has not been published under the Patent Cooperation Treaty as a translation into such a language.

(7) Failure to enter national phase

If the applicant does not comply with the requirements of subsection (6) of this section, within the time limit referred to in that section, the international application shall be considered withdrawn for the purposes of this Act.

(8) Reinstatement of rights after failure to enter national phase

(a) Where the international application is considered withdrawn under subsection (7) of this section, the Intellectual Property Office shall, upon request of the applicant in accordance with the regulations under this Act, reinstate the rights of the applicant with respect to that international application if the Intellectual Property Office finds that the failure to meet the time limit referred to in subsection (6) occurred in spite of due care required by the circumstances having been taken.

(b) The request under subsection (2) of this Section shall be submitted to the Intellectual Property Office within whichever of the following periods expires first:

(i) two months from the date of removal of the cause of the failure to meet the applicable time limit under Article 22 of the PCT as referred to in subsection (6) of this Section;

(ii)12 months from the date of the expiration of the applicable time limit under Article 22 of the PCT as referred to in subsection (6) of this Section.

(c) The Intellectual Property Office shall not refuse a request for reinstatement of rights without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(9) Restoration of right of priority

(a) Where the international application claims the priority of an earlier application and has an international filing date which is later than the date on which the priority period expired but within the period of two months from that date, the Intellectual Property Office shall, upon request of the applicant in accordance with the regulations under this Act, restore the right of priority with respect to that international application if the Intellectual Property Office finds that the failure to file the international application within the priority period was unintentional or occurred in spite of due care required by the circumstances having been taken.

(b) The Intellectual Property Office shall not refuse, totally or in part, a request for restoration of right of priority without giving the applicant the opportunity to make observations on the intended refusal within a time limit which shall be reasonable under the circumstances.

(10) Processing international applications

(a) The Intellectual Property Office shall process international applications in accordance with the provisions of the Patent Cooperation Treaty, the Regulations established thereunder and the

Administrative Instructions under those Regulations, and with the provisions of this Act and the regulations thereunder. In the event of conflict, the provisions of the Patent Cooperation Treaty, the Regulations thereunder and the Administrative Instructions under those Regulations shall prevail. The regulations under this Act may provide for the processing of international applications in such a case.

(b) Further details concerning the processing of international applications by, and other functions of, the Intellectual Property Office in connection with the Patent Cooperation Treaty, including fees payable, time limits, prescribed languages and other requirements in relation to international applications, may be included in the Regulations under this Act.

52. Judicial notice of certain treaties

Judicial notice shall be taken of the Paris Convention, the Patent Cooperation Treaty, or any other industrial property Convention or Treaty to which Antigua and Barbuda may become party.

PART XIV

GENERAL PROVISIONS

53. Changes in ownership

(1) Any changes in the ownership of a patent or utility certificate or in the ownership of the application therefor shall be in writing and shall, upon the request of any interested party to the Registrar, be recorded and, except in the case of an application, be published in the Gazette.

(2) Any surrender in the ownership of a patent or utility certificate shall be in writing and shall, upon the request of any interested party to the Registrar, be recorded and be published in the Gazette.

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

54. Correction of errors

(1) The Registrar may, of his own volition or upon the written request of any interested person, correct any clerical error or error in 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 any power to correct in the Register, any application or document in a material way.

55. Extension of time

(1) Where the Registrar appoints a time for doing any act or taking any proceeding in respect of an application, that application shall be deemed abandoned if that act is not done or the proceeding not taken in the appointed time.

(2) Where the Registrar is satisfied that the circumstances justify it, he may, upon the written request of any interested person, and upon payment of the prescribed fee, extend the time for doing any act or taking any proceeding under this Act and the Regulations made hereunder. The request of the extension should be granted for the same amount of time contemplated in the law.

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

(4) The Registrar shall give written notice of any extension to the parties concerned.

(5) Where an application has been deemed abandoned, and an extension has been granted, any further breach of the conditions required to be met in the extension will result in the application deemed to have been withdrawn.

56. Reinstatement of Rights

(1) If the applicant or the holder of a patent has, despite due care required by the circumstances, failed to perform an act in the course of the procedure before the Registrar within a time limit, the direct result of which is a loss of rights conferred by the patent application, or the patent, the Registrar shall authorize the reinstatement of rights, provided that the applicant—

(a) files a request for the reinstatement of rights, and complies with all of the requirements in respect of which the time limit for the said action applied, within two months counting from the day on which the reason of failure ceased to exist, and if the applicant has later learned of failure, from the day on which he learned of it. Notwithstanding, the request shall be filed, and the relevant requirements shall be complied with, within a period of 12 months from the date of the expiration of the time limit for the action in question. Where a request relates to non-payment of maintenance fee, the indicated deadline shall be counted from the date of expiration of the period of grace provided under section 24 (3) of this law;

(b) indicates the circumstances that prevented him from performing the omitted act on time;

(c) pays the fee and charges in accordance with the Regulations.

(2) If the Registrar finds that the request referred to in this section is unjustified, and intends to refuse it in its entirety or in part, it shall, prior to the refusal, inform the person filing the request of the reasons for the refusal, and shall invite him to file observations on such reasons within two months from the date of receipt of the invitation. The Registrar shall issue a conclusion in writing on the rejection of a request for the reinstatement of rights.

(3) A request for the reinstatement of rights may not be filed in connection with the failure to comply with the time limits for the following acts—

(a) filing of the request for the restoration of rights as provided for this Article; and
(b) for performing all the acts in the appeal procedure.

(2) Any person who has exploited in good faith an invention or has made real and serious preparations for exploiting the invention, which is the subject matter of a published application, may, in the period between the loss of rights referred to in this Article and the publication of data on the acceptance of a proposal for the reinstatement of rights, continue such exploitation, without payment of compensation for damages, for the purposes of his own business and needs related to it.

57. Exercise of discretionary powers

The Registrar shall, before exercising any discretionary power vested in him by this Act or the Regulations made thereunder, give any party to a proceeding before him the opportunity of being heard if his decision might adversely affect that party.

58. Agents

(1) 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 practicing in Antigua and Barbuda before the Registrar of the Intellectual Property Office.

(2) The procedure for the registration of an agent shall be prescribed in the regulations.

59. Jurisdiction of Court

(1) The Court shall have jurisdiction in cases of disputes relating to the application of this Act and the Regulations, made thereunder and in matters which, under this Act, may be brought before it.

(2) A person who has been aggrieved by a decision of the Minister or the Registrar under this Act may, within two months of that decision, appeal to the Court.

60. Offences

(1) A person who intentionally or willfully performs any act which constitutes an infringement as defined under section 39 commits an offence and is liable upon conviction to a fine of not less than fifteen thousand dollars but not more than one hundred thousand dollars, or to imprisonment for a term of not less than five years but not more than twelve years, or to both such fine and such imprisonment.

(2) A 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 or tendered as 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 forty 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.

(3) Any person who, knowing the same to be false, makes a false statement or representation that—

(a) a patent or utility certificate has been granted to him or to any other person in respect of any invention; or

(b) he has been granted an exclusive or non-voluntary licence to use any patent or utility certificate,

which statement or representation induces another person to act thereon, commits an offence and is liable upon conviction to a fine of not less than five thousand dollars, but not more than thirty 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.

(4) Any person who falsely represents that anything disposed of by him for value is a patented product or process shall, subject to subsections (5) to (7), commit an offence and be liable to a fine of not less than five thousand dollars, but not more than fifteen thousand dollars.

(5) For the purposes of subsection (4), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "patent" or "patented" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(6) Subsection (4) shall not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been invalidated and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(7) In proceedings for an offence under this section, it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

(8) Any person who represents that a patent has been applied for in respect of any article disposed of for value by him, and—

(a) no such application has been made; or

(b) any such application has been refused or withdrawn, commits an offence and is liable to a fine of not less than four thousand dollars, but no more than ten thousand dollars.

(9) Subsection (8) (b) shall not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been

invalidated, and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(10) For the purposes of subsection (8), a person who for value disposes of an article having stamped, engraved or impressed upon it or otherwise applied to it the words "patent applied for" or "patent pending" or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of the article.

(11) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to, any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, commits an offence and is liable to be proceeded against and punished accordingly.

(12) Where the affairs of a body corporate are managed by its members, subsection (11) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

(13) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Intellectual Property Office" or any other words suggesting that his place of business is, or is officially connected with, the Intellectual Property Office, he shall be liable on summary conviction to a fine of fifteen thousand dollars.

61. Time limit for prosecution

A prosecution for an offence under this Act shall not be commenced after the expiration of six years after the commission of the offence or one year after the discovery thereof, whichever occurs last.

62. Immunity regarding official acts

Neither the Minister nor any person employed by the State or the Intellectual Property Office shall—

(a) be taken to warrant the validity of any patent granted under this Act; or
(b) incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act or any report or other proceeding consequent upon any such examination or investigation.

63. Appeal against order of Registrar

(1) An appeal to the Court shall lie from any order or decision of the Registrar under this Act or the regulations made thereunder.

(2) In any such appeal or other proceedings before the Court, the Registrar shall be entitled to appear or be represented and shall appear if so directed by the Court.

(3) In any appeal or other proceedings under this Act, the Court may exercise any power which could have been exercised by the Registrar in the proceedings from which the appeal is brought.

(4) Save as otherwise provided in this Act, an appeal under this section shall be made within two months from the date of the order or decision, as the case may be, of the Registrar or within such further time as the Court may allow in accordance with the Rules of Court.

(5) Rules of Court shall make provision for the appointment of scientific advisers to assist the Court in proceedings under this Act, for regulating the functions of such advisers and for payment of such remuneration to them as the Court may determine from time to time.

64. Right of appeal from order and decision of Court

An appeal to the Court of Appeal from an order or decision made by the Court in proceedings under this Act shall lie according to the provisions stipulated in the Rules of Court.

65. Burden of proof in certain cases

(1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the Court shall not require him to disclose any manufacturing or commercial secrets if it appears to the Court that it would be unreasonable to do so.

66. Extension of privilege for certain communications with Attorneys-at-law relating to patent proceedings

For the removal of doubt, it is hereby declared that the privilege from disclosure conferred by law in legal proceedings in respect of communications made with an Attorney-at-law or a person acting on his behalf, or in relation to information obtained or supplied for submission to an Attorney-at-law or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before the Court, extends to such communications so made for the purpose of any pending or contemplated proceedings before the Registrar under this Act or the Patent Cooperation Treaty.

67. Saving in respect of rights to sell forfeited articles

Nothing in this Act shall affect the right of the State or any person employed by it to dispose of or use articles forfeited under the laws relating to customs and excise.

68. Regulations

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.

69. Repeals

The Patents Act 2012, No. 8 of 2012 is hereby repealed save that all Orders, Rules or Regulations made thereunder shall, in so far as they are not inconsistent with this Act, continue in force until revoked by Regulations made under this Act.

70. Transitional

(1) Notwithstanding the repeal of the former Act, patents granted thereunder shall remain in force but shall, subject to subsection (2) and (3), be deemed to have been granted under this Act.

(2) Patents thus granted shall remain in force for the unexpired portion of the period of protection provided under this Act subject to the payment of annual maintenance fees or renewal fees provided for in this Act.

(3) Patent Cooperation Treaty applications that have entered the national phase subsequent to March 17, 2000 shall be treated as if filed under this Act.

(4) Where, upon the entry into force of this Act, an application made under the Patents Act 2003, is pending, such application shall, notwithstanding the provisions of subsection (1), be treated as if filed under this Act.

(5) The Minister may by Order published in the Gazette make any further transitional or saving provisions which appear to him to be necessary or desirable.

Passed by the House of Representatives on the , 2018.

Passed by the Senate on the , 2018.

Speaker.

President.

Clerk to the House of Representatives.

Clerk to the Senate.

EXPLANATORY MEMORANDUM

The purpose of this Bill is to provide for the Registration of Patents in Antigua and Barbuda

The Bill is divided into 14 parts.

Part 1 of the Bill is a preliminary section which outlines the Short Title of the Bill in addition to an Interpretation section.

Part 2 provides for there to be a Register of Patents and outlines the procedure with respect to that Register and the use of the Registrar's Seal.

Part 3 illustrates what is required in order for a patent to be granted, and the type of inventions that would be eligible for classification as a patentable invention.

Part 4 states the conditions pertaining to who has a right to apply for a patent.

Part 5 sets out the criteria for application for a patent.

Part 6 provides for certain provisions that apply after a patent has been granted such as the duration and maintenance of a patent.

Part 7 states what property rights exist in relation to patents.

Part 8 lists provisions that relate to the rights of the owner of a patent, especially the rights conferred by patent.

Part 9 deals with the issue of the grant of voluntary licences with respect to patents.

Part 10 provides for the circumstances where infringement of a patent arises, especially the necessary proceedings that need to be taken and the type of relief that can be granted.

Part 11 sets out the procedure for the invalidation of a patent.

Part 12 illustrates the process relating to utility certificates, namely the areas concerning the application, qualification, registration, invalidation and conversion of a utility certificate.

Part 13 states what obligations apply with respect to international arrangements, such as the application of treaties, the implementation of the Patent Cooperation Treaty and judicial notice of certain treaties.

Part 14 has sections which deal with general provisions namely:

Changes in ownership;
Correction of errors;
Extension of time;
Exercise of discretionary powers;
Agents;

Jurisdiction of Court;
Offences;
Time limit for prosecution;
Immunity regarding official acts;
Appeal against order of Registrar;
Right of appeal from order and decision of Court;
Burden of proof in certain cases;
Extension of privilege for certain communications with Attorneys-at-law relating to patent proceedings;
Costs and security for costs;
Saving in respect of rights to sell forfeited articles;
Regulations;
Repeals;
Transitional.