

**ANTIGUA AND BARBUDA**



**THE PATENTS ACT, 2012**

**No. 8 of 2012**

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[ L.S.]



I Assent,

**Dame Louise Lake-Tack,**  
*Governor-General.*

28th December, 2012.

**ANTIGUA AND BARBUDA**

**THE PATENTS ACT, 2012**

**No. 8 of 2012**

**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, 2012 and shall come into operation on such date as the Minister may appoint by Order published in the *Gazette*.

**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 certificate granted for an invention under Part XII of this Act.

## 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 applicant or his predecessor in title; or

(b) an abuse committed by a third party with regard to 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) 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;

(d) plants and animals other than micro-organisms;

(e) essentially biological processes for the production of plants or animals other than non-biological microbiological processes;

(f) plant varieties;

- (g) 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) 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.

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

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

(8) 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.

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

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

## **15. 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.

#### **16. 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.

#### **17. 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.

#### **18. 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 Organisation.

(2) Where the application contains a declaration under subsection (1), the Registrar may require the applicant to furnish, within the prescribed time, 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 Registrar may require 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.

**19. 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.

**20. 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 49 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.

**21. 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 16, 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.

## **22. Examination**

(1) After according a filing date, and if the application is not withdrawn, the Registrar shall examine the application to determine whether—

(a) it complies with the requirements of this Act;

(b) it complies with the requirements of the Regulations.

(2) The Registrar may take into account, for the purposes of subsection (1)—

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

(ii) a search and examination report submitted under section 20 (2) (a) relating to, or a final decision submitted under Section 20 (2) (c) on the refusal to grant a patent on, a corresponding foreign application; and/or

(iii) a search and examination report which was carried out upon his request by an external search and examination authority.

## **23. Refusal or grant of patent**

(1) Subject to section 21 (2) to (4), where the Registrar is not satisfied that the requirements of the Act and the Regulations have been complied with, he shall so inform the applicant and shall give him an opportunity within a specified period to make observations on the determination and to amend the application so as to comply with those requirements, and if the applicant fails either to satisfy the Registrar that the said requirements are complied with, or amend the application so

as to comply with them, the Registrar 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 refuses an application under subsection (2), he shall so inform the applicant in writing, stating the reasons for his refusal.

(4) Where the Registrar is satisfied that the application, as originally filed or as amended, complies with the requirements of this Act or Regulations made pursuant to this Act, he shall grant the applicant a patent.

(5) Where the Registrar grants a patent, he shall—

(a) publish, in the *Gazette*, a notice of the grant of the patent;

(b) issue a certificate of the grant of the patent and a copy of the patent to the applicant; and

(c) record the patent in the Register.

(6) The Registrar shall, on payment of the prescribed fee, make a copy of any patent granted under this section available to any person who requests such copy.

(7) The Registrar shall, upon the request of the owner of the patent, amend the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the amendment would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

(8) The patent shall be deemed to be granted on the date on which the Registrar publishes a notice of the grant of the patent in the *Gazette*.

## **PART VI**

### **PROVISIONS AS TO PATENTS AFTER GRANT**

#### **24. 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 or a patent application shall be deemed to have been withdrawn 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*.

## **25. 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 his patent or one or more claims contained in his patent.

(2) Where an offer is made under this section, the Registrar shall advertise the offer in the prescribed manner and any interested person may, within the prescribed period commencing on the date of the publication of the advertisement, give notice to the Registrar of his opposition to the proposed surrender.

(3) Where notice of opposition is duly given 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.

## **26. 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**

#### **27. 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 28 (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 28 (2) (b), a licence 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.

## **28. 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

#### 29. Rights conferred by 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 30, 31 and 34, 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 authorisation.

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

(a) acts in respect of articles which have been put on the market in Antigua and Barbuda 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.

(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.

### **30. Right to continue use begun before date of filing or priority**

(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.

### **31. 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 29;  
or
- (iii) the grant of a non-voluntary licence under section 34.

(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.

### **32. Prevention of indirect use of 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 commercial working of the patented invention) with means relating to the idea of that 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 29.

(3) Any person who commits an act referred to in paragraph (c) or (d) of section 29(4) shall not be considered to be a person authorized to engage in commercial working of the invention for the purposes of subsection (1).

## **PART IX**

### **VOLUNTARY AND NON-VOLUNTARY LICENCES**

#### **33. Voluntary licences**

(1) Subject to section 28, 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 29 and 32.

(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 29 and 32.

(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.

#### **34. Non-voluntary licences**

(1) At any time after the expiration of three years from the date of grant of a patent under this Act, any person interested may apply to the Court for the grant of a licence on the ground, that a market in Antigua and Barbuda for the patented invention is not being supplied, or is not being supplied on reasonable terms.

(2) Subject to subsections (4), (5), (6) and (7), if the Court is satisfied that either of the grounds referred to in subsection (1) is established, the Court may make an order for the grant of the licence in accordance with the application on such terms as the Court thinks fit.

(3) A licence granted under this section-

(a) is not exclusive;

(b) shall not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) is limited to the supply of the patented invention predominantly in Antigua and Barbuda.

(4) Where the Court is satisfied that the grounds on which any licence granted under this section have ceased to exist, it may, on the application of any interested party, terminate such licence.

(5) Any person to whom a licence is granted under this section shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed upon between that person and the patentee, or in default of agreement, as is determined by the Court on the application of either party.

(6) A licence shall not be granted under this section unless the person applying for the licence, having taken all reasonable steps to do so, has been unable to obtain a licence, or to obtain a licence on reasonable terms from the patentee.

(7) A licence shall not be granted under this section in respect of a patent relating to an integrated circuit.

(8) Section 31(2) to (12), and 56 (2) shall apply *mutatis mutandis*.

### **35. Exercise of powers on applications under section 34**

The powers of the Court on an application under section 34 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**

#### **36. Infringement**

Subject to the provisions of sections 29 (2), 31 and 34, the performance, in relation to a patent, of any act referred to in sections 29 and 32 without the authorisation of the owner of the patent shall, while it is in force, constitute an infringement.

#### **37. 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 29 (4), 31 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 29(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 by means of which any infringing product or article was produced;

(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 defendant 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.

### **38. 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.

### **39. 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).

### **40. 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.

### **41. Effect of non-registration on infringement proceedings**

Where by virtue of a transaction, instrument or an event to which section 26 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

#### 42. 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 11 or 12, as the case may be;
- (e) that the patentee's application did not satisfy the requirements of section 14 (4) to (7);
- (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**

**43. Application of provisions relating to patents**

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

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

**44. Qualification of invention for utility certificate**

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

(2) An invention for which a utility certificate is applied for shall not be considered new if it differs from earlier inventions only in minor respects or in details which are immaterial to the function or application of the invention.

**45. 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 seven years after the filing date of its application and shall not be renewed.

**46. Invalidation of utility certificate**

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

(a) that the invention relating to the certificate is—

(i) not new or industrially applicable; or

(ii) contrary to public order or morality;

(b) that the description and claim or claims do not 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 do not indicate at least one model known to the applicant for carrying out the invention;

(c) that the claim or claims do not define the matter for which protection is sought;

- (d) that the claim or claims are not clear or concise and are not fully supported by the description;
- (e) that the drawings necessary for the understanding of the invention have not been filed as required under this Act; and
- (f) that the person to whom the utility certificate has been granted is not the inventor or his successor in title.

(2) An application for the invalidation of a utility certificate shall be served on the person to whom the certificate has been issued and filed with the Court in the manner and time prescribed.

(3) The Registrar of the Court shall notify the Registrar of the decision of the Court to invalidate a utility certificate and the Registrar shall forthwith record it and publish a reference thereto in the *Gazette*.

#### **47. 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**

#### **48. 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.

#### **49. Implementation of Patent Cooperation Treaty**

(1) The Patent Cooperation Treaty (referred to in this section as “the Treaty”), the Regulations made thereunder, and the Administrative Instructions made under those Regulations shall be given full effect.

(2) Where reference is made in this section to the Treaty, such reference shall include the Regulations and Administrative Instructions referred to in subsection (1).

(3) The Intellectual Property Office shall process international applications in accordance with the provisions of the Treaty, and in accordance with the provisions of this Act and the Regulations made thereunder.

(4) Notwithstanding any rule of law to the contrary any international application under the Patent Cooperation Treaty designating Antigua and Barbuda filed between March 17<sup>th</sup> 2000, and

the date of commencement of the Patents Act 2012, fulfilling the requirements under the said Treaty and being accorded an international filing date, which date shall be considered to be the actual filing date in Antigua and Barbuda.

(5) Notwithstanding any rule of law to the contrary any international applications referred to in subsection (5) shall be deemed to have been lawfully and validly filed and no legal proceedings or other action whether pending or not shall be entertained in respect of the validity of the filing of such applications for the reason that any such application has been filed before the day on which the Patents Act 2012, entered into force.

(6) Where the provisions of this Act and the Regulations made thereunder conflict with those of the Treaty, the provisions of the Treaty shall prevail.

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

(8) The Intellectual Property Office shall act as a receiving office in respect of any international application filed with it by a resident or national of Antigua and Barbuda.

(9) 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 Registrar within one month of the date of receipt of the international application.

(10) 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 a utility certificate under this Act.

(11) The Intellectual Property Office shall act as an elected office in respect of an international application in which Antigua and Barbuda is designated as referred to in subsection (8) if the applicant elects Antigua and Barbuda for the purposes of an international preliminary examination under Chapter II of the Treaty.

(12) The Intellectual Property Office, as designated office or elected office, shall not commence the processing of an international application before the expiration of the time limit referred to in subsection (11) except if the applicant complies with the requirements of that subsection and files, with the Intellectual Property Office, an express request for the early commencement of such processing.

(13) The applicant in respect of an international application designating Antigua and Barbuda shall, before the expiration of the time limit applicable under Article 22 or 39 of the Treaty, or of such later time limit as may be prescribed in the Regulations—

(a) pay the prescribed fee to the Intellectual Property Office; and

(b) if the international application was not filed in, and has not been published under the Treaty as a translation into, English, file, with the Intellectual Property Office, a translation of the international application, containing the prescribed contents, into English.

(14) Where the applicant does not comply with the requirements of subsection (11) within the time limit referred to in that subsection, the international application shall be considered as having been deemed withdrawn for the purposes of this Act.

(15) With the consent of the Minister, The Intellectual Property Office may make an agreement of the kind referred to in Rule 19.1(b) of the Regulations under the Patent Cooperation Treaty whereby an intergovernmental organization or the national office of another Contracting State of the Patent Cooperation Treaty shall act instead of the Intellectual Property Office as receiving office for applicants who are residents or nationals of Antigua and Barbuda.

(16) In this section, the terms “designate”, “designated office”, “elected office”, “international application”, “international filing date”, “international preliminary examination” and “receiving office” have the same meanings as in the Treaty.

#### **50. 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**

#### **51. 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.

#### **52. 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.

### **53. 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.

(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.

### **54. 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.

### **55. 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.

### **56. 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.

### **57. Offences**

(1) A person who intentionally or willfully performs any act which constitutes an infringement as defined under section 36 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.

### **58. 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.

### **59. 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.

**60. 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 three 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.

**61. 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.

**62. 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.

**63. 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.

#### **64. Costs and security for costs**

(1) The Registrar may, in proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by whom they are to be paid.

(2) If any party by whom notice of any opposition is given under this Act or by whom application is made to the Registrar for the grant of a licence under a patent or for the revocation of a patent, neither resides nor carries on business in Antigua and Barbuda, the Registrar may require him to give security for the costs of the proceedings, and in default of such security being given, may treat the opposition or the application, as the case may be, as abandoned.

#### **65. 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.

#### **66. Regulations**

(1) 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.

(2) Without derogating from the generality of subsection (1), the Minister may make Regulations providing further details for the processing of international applications by, and other functions of, the Registrar in connection with the Patent Cooperation Treaty, including the fees payable, time limits, prescribed languages and other requirements relating to international applications.

#### **67. Repeals**

The Patents Act 2003, No. 23 of 2003 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.

#### **68. 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  
3rd October, 2012.

Passed by the Senate on the 25th October,  
2012.

**D. Gisele Isaac-Arrindell,**  
*Speaker.*

**Hazlyn M. Francis,**  
*President.*

**Romona Small,**  
*Clerk to the House of Representatives.*

**Romona Small,**  
*Clerk to the Senate.*