

## **PROTECTING YOUR INTELLECTUAL PROPERTY IN ANGUILLA**

On August 12, 2002 Anguilla enacted new Intellectual Property legislation which updates the laws relating to Trademarks, Patents, Industrial Designs and Copyright, and introduces registration systems for Layout Designs (Topographies) of Integrated Circuits and Geographical Indications and legislation for the protection of Trade Secrets. This legislation is part of the Government's commitment to the development of the e-commerce sector, and forms part of a comprehensive package of new commercial laws. The legislation was drafted to be more closely harmonised with TRIPS. This article summarizes the Intellectual Property legislation, outlining the main features of each law and the protection available.

Trademarks

Patents

Trade secrets

Copyright

Industrial Designs

Geographical Indications

Layout Designs (Topographies) of Integrated Circuits

### **TRADEMARKS**

Some of the features of the law are as follows:

- Protection is afforded to famous marks
- Adoption of the Nice classification
- Claiming of Priority under the Paris convention
- More streamlined application process, adopting the procedures and formats of the Trademark Law Treaty
- Remedies include provisions for seizure and confiscation of counterfeit goods and criminal prosecution for infringement of trademarks. There is also provision for the conviction of infringers and also officers of corporations who have consented or connived with the commission of an offence by the corporation.

The new law preserves the dual system of registration in Anguilla wherein in addition to the usual provisions for registration of a trademark in Anguilla, proprietors of a mark registered in the UK can apply for registration in Anguilla under a streamlined process requiring no advertisement. Certificates

are usually issued within a week of application under this process and the mark is valid for its period of protection in the UK. See our brochure [Trademark Registration in Anguilla](#).

The law was also drafted to facilitate Community registration. The provision on Community registration will come into force on the date of publication of a notice providing for the reciprocal treatment for Community trademarks in the Official Journal pursuant to Rule 101 of Commission Regulation (EC) 2868/95.

## **PATENTS**

The Registration of Patents in Anguilla is governed by the Patents Act 2002.

### Patentable inventions

A patentable invention is one that is new, involves an inventive step, and is capable of industrial application. Discoveries, scientific theories, mathematical methods, a scheme, rule or method for performing a mental act, playing a game or doing business; or diagnostic, therapeutic and surgical methods for the treatment of humans or animals are excluded from patentability.

### Right to application for a patent

The right to a patent shall belong to the inventor(s). The right to a patent may be assigned or may be transferred by succession.

### Application

An application shall contain—

(a) *A request for the grant of the patent.* The request must contain a petition to the effect that a patent be granted, the name of and other prescribed data concerning the applicant, the inventor and the agent, if any, and the title of the invention. Where the applicant is not the inventor, a statement justifying the applicant's right to the patent must accompany the request.

(b) *A description of the invention.* The description must disclose the invention in a manner which is clear and complete enough for the invention to be carried out by a person having ordinary skill in the art, and should, in particular, indicate at least one mode known to the applicant for carrying out the invention.

(c) *One or more claims and any drawings referred to in the description or any claim.* The claim or claims shall define the matter for which protection is sought, be clear and concise and be fully supported

by the description. Drawings shall be required when they are necessary for the understanding of the invention. The description and the drawings may be used to interpret the claims.

(d) *An abstract.* The purpose of the abstract is to give technical information. It will not be taken into account for the purpose of interpreting the scope of the protection.

#### Application: unity of invention; amendment and division

The 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.

#### Right of priority

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 Paris Convention. Where the application contains such a declaration, the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application certified as correct by the registry with which it was filed.

#### Filing date and examination

The Registrar shall accord the date of receipt of the application as the filing date if, at the time of receipt, the application contains—

- (a) an express or implicit indication that the granting of a patent is sought;
- (b) indications allowing the identity of the applicant to be established; and
- (c) a part which on the face of it appears to be a description of an invention.

#### Grant of patent and changes in patents

Where after examining the application, the Registrar is satisfied that an application for a patent ought to be granted, he shall grant the patent. Otherwise, he shall refuse the application and notify the applicant of that decision. When he grants a patent, 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.

### Rights conferred by patent

The exploitation of the patented invention in Anguilla by persons other than the owner of the patent shall require the agreement of the owner. The owner of the patent shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the patent.

### Duration and annual fees

A patent expires 20 years after the filing date of the application. Maintenance fees are payable for each year, starting one year after the filing date of the application for grant of the patent. A grace period of 6 months is allowed for the late payment of the annual fee on payment of the prescribed surcharge. If the annual fee is not paid in accordance with the provisions of this subsection, the patent application shall be deemed to have been withdrawn or the patent shall lapse.

### Exploitation by Government or authorized person

The Act contains provisions for non-voluntary licenses in accordance with Article 31 of the TRIPS Agreement. Where the public interest, and in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires; or the Court has determined that the manner of exploitation by the owner of the patent or his licensee is anti-competitive, and the Governor in Council is satisfied that the exploitation of the invention in accordance with this subsection would remedy such practice, the Governor in Council may decide that, even without the agreement of the owner of the patent, a Government agency or a third person designated by the Governor in Council may exploit the invention.

### Registration of title to UK and European (UK) patents

The Act makes provisions for the registration of UK patents and are similar in most respects to the previous regime.

Any person entered in the United Kingdom register of patents as the grantee of a patent or any person deriving his right to such a grant by assignment, transmission or other operation of law, may apply to the Registrar within 3 years from the date of grant to have the patent registered in Anguilla.

Every application for the re-registration of a United Kingdom patent shall include a certified copy of the specification, together with the drawings (if any) relating to the patent and a certificate of the

Comptroller-General giving full particulars of the grant of the patent or of its taking effect in the United Kingdom on such specification.

#### Effect of registration of title to UK and European (UK) patents

The registered proprietor of a patent shall have the same rights and remedies in Anguilla regarding the use of that patent as such proprietor possesses for the time being in the United Kingdom by virtue of the patent or the title or interest in it being registered in the United Kingdom register of patents. The rights and remedies so conferred shall date from the commencement of term of the patent in the United Kingdom and shall continue in force for so long only as the patent remains in force in the United Kingdom, but no action for infringement shall be entertained in respect of any act prior to the date of issue of the registration in Anguilla.

### **TRADE SECRETS**

The Protection Against Unfair Competition Act, 2002, introduces several separate torts:

- “Passing off
- Commercial disparagement
- False advertising (this provision is based on article 10 of the Paris Convention)
- Business Slander
- Trade Secret Misappropriation (this provision section is based on Article 39 of TRIPS and protects against the acquisition or use of trade secrets without the consent of the owner, in particular that which results from industrial or commercial espionage, breach of contract, breach of confidence, inducement to commit these acts or acquisition by third parties and former employees.

The Unfair Competition Law is comprehensive and conforms with up to date common law standards for these torts. This Act should help encourage foreign business concerns to enter and compete locally.

It aims to provide for protection of commercial reputation, and the development of an orderly market place free from organized crime. It also seeks to encourage open competition.

### **INDUSTRIAL DESIGNS**

The Industrial Designs Act, 2002 provides for the protection of Industrial Designs and fulfils all requirements for this form of protection under the World Trade Organisation Treaty. The designs must relate to physical appearance and aesthetic effect and not to technical results or utilitarian character of the design.

There is an absolute novelty rule in Anguilla. A grace period of one year is allowed for disclosure by applicant, applicant's predecessor in title or an abusive third party.

### Priority, Disclosure

The application may contain a declaration of priority as provided for in the Paris Convention if one or more earlier national or regional applications or international deposits were filed in any State being a party to the Paris Convention.

The applicant has the right to defer publication of design application for a period of one year from effective filing date.

### Remedies

Recourse available for infringement includes specific relief, injunction, damages. A person who intentionally performs an act of infringement is liable to fine and imprisonment.

### Transitional

The previous Patent and Designs Act as it relates to industrial designs is repealed, but industrial designs registered thereunder remain in force for the unexpired period of protection, subject to renewal under the new Act.

There is a special United Kingdom transitional provision. Industrial designs registered in the United Kingdom for a period of less than three years or designs that have been filed in the United Kingdom may, until twelve months of entry into force of the Industrial Designs Act, file an application for registration in Anguilla and be accorded the filing or priority date accorded in the United Kingdom.

### Duration

Protection is for an initial period of five years with two additional renewal periods of five years each subject to payment of a renewal fee.

## **GEOGRAPHICAL INDICATIONS**

### Definition

The Geographical Indications Act, 2002, seeks to protect geographical indications (appellations of origin) as defined along the lines of Article 22.1 of the TRIPS Agreement. A geographical indication is defined as an indication which

*“ identifies a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or characteristic of the good is essentially attributable to its geographical origin”.*

### Remedies for Infringement

The Act provides for civil proceedings to be instituted to prevent unlawful use of geographical indications and criminal sanctions for the intentional wrongful use of geographical indications. The Court is empowered to issue injunctions, award damages and grant any other remedy. Anyone who knowingly and intentionally uses a geographical indication in a wrongful manner is liable on conviction to fine and imprisonment.

### Protection

Registration is not a requirement for protection in Anguilla, but registration raises a presumption that the indication is a geographical indication within the meaning of the Act. Protection is available against geographical indications which, though literally true as to the origin of the goods in question, falsely represent to the public that the goods originate in another territory.

### Registration

The Act creates a registration system and prescribes procedures for application, examination, opposition, right of use, cancellation and rectification. Categories of persons who would be interested in registration are, namely, those who carry on a professional activity in the geographical region concerned with regard to the products covered by the indication, groups of consumers and any competent authority (which could be a semi-official body such as a Chamber of Commerce).

### Overlap with trademarks

The Act takes into account the possible overlap with the protection of trademarks by making provisions in line with the obligations under the TRIPS Agreement. It also allows for interested parties to apply to have misleading trademarks or trademarks for wines or spirits which contain or consists of a geographical indication of wines or spirits to be refused or invalidated. The new law does recognise the rights of prior users provided that the provisions of the TRIPS Agreement are met.

### **LAYOUT DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS**

The Layout Designs (Topographies) of Integrated Circuits Act, 2002 seeks to protect the layout-designs of integrated circuits against reproduction, importing, selling or other distribution. Where the layout-design has not been commercially exploited, protection commences from the filing date of the application for protection. The law is therefore less strict than the law in the U.S. and Europe which requires that, where there is no prior commercial exploitation, protection commences with the registration of the layout-design.

Applications are not to be examined as to substance prior to registration. Integrated circuits containing unlawfully reproduced layout-designs which were acquired innocently may be sold and distributed subject to two provisions:

- upon receiving sufficient notice that the layout-design was unlawfully reproduced, only the stock in hand or ordered before may be imported, sold or distributed.
- the person performing such acts after receiving such notice is liable to pay to the right holder a sum equivalent to a reasonable royalty.

In the case of commercial exploitation preceding the filing of an application of protection, protection may only be in force upon the filing of such an application. The right holder seeking an injunction therefore, must first file an application for registration.

Other features of the new law are as follows:

- The definition of layout-design corresponds with the provisions of the Washington Treaty and the TRIPS Agreement.
- Protection may be obtained for layout-designs of integrated circuits that are original. Two conditions are to be fulfilled to satisfy the condition of originality: (1) the layout-design must be

the result of the creators own intellectual effort. (2) it must not be commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation.

- Where the layout-design has already been commercially exploited any-where in the world, the application for its registration must be filed within two years.
- There is an exception to the right of the right holder in the case of “reverse engineering”, where a person other than a right holder evaluates and analyses a protected layout design, and creates a new layout-design (which may contain the whole or a part of the protected layout design). This exception is made only where the new layout-design satisfies the requirement of originality as laid down in the Act. This provision is considered justified, in accordance with Article 6(2)(b) of the Washington Treaty and the provisions of the TRIPS Agreement, in keeping with the desire to encourage creativity through the improvement of existing layout -designs.
- The period of protection is five years with two successive renewal periods of five years each.
- Remedies available under the Act include specific relief, injunction and the award of damages. A person who deliberately and wrongfully reproduces, imports, sells or distributes a protected layout-design is liable on conviction to fine and imprisonment. Exceptions are made for private use, research, teaching etcetera.

## **COPYRIGHT**

The Copyright Act, 2002 replaces and updates the copyright legislation, making it more consistent with modern copyright laws and principles.

### **Protection**

In the new Act copyright is described as a property right that subsists in literary and artistic works that are the original intellectual creations in the literary and artistic domain. There is no registration system, protection accrues from the moment of creation. Protection is now available for matters that were not expressly covered in the former legislation, such as computer programs. Protection does not extend to ideas, the official text of legislation and political speeches.

### **Rights vested in the owner of the copyright**

The owner of copyright has the exclusive right to do authorize, or prohibit the following acts in relation to the work:

the reproduction, translation , adaptation, arrangement or other transformation of the work; the first public distribution and each copy of the work; the rental or public lending of the work or copy;

importation of copies of the work; public display of the work or copy; the public performance, broadcasting, or communication to the public of the work. The Act also recognizes and provides for the moral rights of the author.

### Duration

The term endures for the author's life plus an additional 50 years after the author's death. In the case of a joint work prepared by two or more authors, the term lasts for 50 years after the death of the last surviving author's death. For anonymous works, the duration of copyright will be 75 years from publication.

In the case of a collaborative work other than a work of applied art and in the case of audio-visual works

75 years from publication or;

75 years from the date work first made available to the public if it has not been published before 25 years after its making or;

100 years from the making of the work the work has been available to the public or published before 25 years after its making

In the case of a work of applied art 25 years from the making of the work.

### Remedies

Remedies for infringement include injunctions, impounding and forfeiture of infringing goods and equipment used in the manufacture thereof, damages, fines and imprisonment.

Border Measures to prevent the importation of pirated and infringing goods are to be introduced in a few weeks.

*The content of this article is intended to provide a general guide to the subject matter. Specialist advice should be sought about your specific circumstances.*