

Trademarks 2022

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Theodore H Davis Jr and Olivia Maria Baratta

Kilpatrick Townsend & Stockton LLP

Lexology Getting The Deal Through is delighted to publish the eighteenth edition of *Trademarks*, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes a new chapter on the United Kingdom.

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Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Theodore H Davis Jr and Olivia Maria Baratta of Kilpatrick Townsend & Stockton LLP for their continued assistance with this volume.



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LEGAL FRAMEWORK

Domestic law

- 1 | What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks in Saint Lucia is the Trade Marks Act and Trade Marks Regulations, Cap 13:30 of the Revised Laws of Saint Lucia 2013.

International law

- 2 | Which international trademark agreements has your jurisdiction signed?

Saint Lucia has ratified the principal multilateral agreements in respect of trademarks such as the Agreement on Trade-Related Aspects of IP Rights as well as the following treaties:

- the Nice Agreement on International Classification of Goods and Services for the Purposes of the Registration of Marks;
- the Paris Convention for the Protection of Industrial Property;
- the Marrakesh Agreement establishing the World Intellectual Property Organization;
- the Vienna Agreement establishing an International Classification of the Figurative Elements of Marks; and
- the International Classification of Goods and Services (the Nice Classification).

Regulators

- 3 | Which government bodies regulate trademark law?

The Ministry of Home Affairs, Justice and National Security is the government body responsible for the Trade Marks Act and for implementing its regulations.

REGISTRATION AND USE

Ownership of marks

- 4 | Who may apply for registration?

A person or legal entity may apply for registration if that person is the owner of the trademark, or is using or intends to use the trademark.

Scope of trademark

- 5 | What may and may not be protected and registered as a trademark?

Letters, words, names, signatures, numerals, devices, brands, headings, labels, tickets, aspects of packaging, shapes, colours and any combination of these may be registered as trademarks in Saint Lucia pursuant

to the Trade Marks Act. No clear distinction is made in the Trade Marks Act in respect of service marks. Service marks are considered trademarks associated with services and are registered in the same manner as trademarks for goods. Collective and certification trademarks are recognised, and may be protected and registered as trademarks in Saint Lucia. Non-traditional marks such as sounds and smells cannot be registered in Saint Lucia, as the law does not provide for their protection.

Unregistered trademarks

- 6 | Can trademark rights be established without registration?

Trademark rights may be established without registration. Trademark rights in unregistered marks are secured through the wide and exclusive use of the mark for specific goods or services that leads the public to identify the mark as belonging to someone. These marks are protected under the common law tort of passing off. Passing-off claims are costly due to the volume of evidence necessary to support a passing-off claim.

Famous foreign trademarks

- 7 | Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

A famous trademark is offered protection even if it is not used in Saint Lucia. If the famous trademark is not registered or used in Saint Lucia, the owner may nonetheless be able to pursue an infringement action under the common law tort of passing off. The owner will need to prove that the famous trademark is known to the Saint Lucia public and that there was an intention to deceive or confuse, and that the interests of the owner have been negatively prejudiced due to the deception or confusion.

The benefits of registration

- 8 | What are the benefits of registration?

A registered trademark is personal property. A right in respect of a registered trademark is enforceable in the same way as rights in respect of any other personal property. The registered owner of a trademark has the exclusive right to use the trademark and to authorise other persons to use the trademark in relation to goods and services in respect of which the trademark is registered. The registered owner and any authorised users, most importantly, have the right to refuse third-party use of the same or similar mark in the normal course of trade and to obtain relief under the Trade Marks Act in any cases of infringement.

A registered owner of a trademark or an authorised user is protected against infringement of their mark. The Trade Marks Act permits the owner and authorised users to give a notice (in the form prescribed) objecting to any importation after the date of the notice,

of goods that infringe their trademark to the Comptroller of Customs. This notice remains in force for two years unless it is duly revoked, and allows the Comptroller of Customs to effect seizure and to deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered trademark. An action against the infringement of a registered trademark may be brought in the High Court or any other court that has jurisdiction to hear the action. There are no specialised courts in Saint Lucia. The relief that a court may grant in an action against the infringement of a trademark includes an injunction, damages or an account of profits.

Filing procedure and documentation

- 9 What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The following documents are required in support of a trademark application in Saint Lucia:

- a duly notarised authorisation of agent (power of attorney);
- a description of the mark if the mark is a design mark or logo;
- a specification of the colours (if colours are claimed);
- a representation of the mark measuring 8cm x 8cm;
- a description of the classes of goods and services pursuant to the Nice Classification; and
- a certified copy of the application for which priority is claimed;
- a translation of the certified copy (if in a language other than English); and
- trademark search fees as follows:
 - the government fee: EC\$13.50 for up to three searches; and
 - the agent's fee: EC\$675 per hour or part thereof.

Electronic filing is not available. Trademark registrability searches are available but not required or mandatory before filing an application.

Registration time frame and cost

- 10 How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

A trademark registration takes approximately six months from application to registration if the application is without objection. The registration of a trademark has effect from and including the filing date of the application or the priority date in cases where a particular trademark's registration had also been sought in one or more Paris Convention countries, or the applicant claimed a right of priority for the registration of the trademark in respect of particular goods or services. The registration procedure is deemed final on the expiration of the opposition deadline, which is three months following the publication of the registration of the mark in the Official Gazette.

The estimated time for filing the trademark would increase if queries are raised by the Registrar and the applicant must satisfy any office queries by making submissions and convening meetings with the Registrar to ventilate these queries, or if a third party files an objection to the trademark application.

The total cost of registering a trademark in a single prescribed class is EC\$4,698 inclusive of agent and official fees. The fee would increase if the application is in respect of more than one prescribed class and if the mark is a combined mark or a logo, as the publication costs are increased in such cases.

Classification system

- 11 What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

As Saint Lucia is a party to the Nice Agreement, it is obliged to adopt and apply the Nice Classification for the purpose of registration of trademarks. Multi-class applications are available and there is an approximate 50 per cent saving on each additional class registered.

Examination procedure

- 12 What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Registrar carries out a substantive examination and issues a report if they believe there are grounds for rejecting an application. The Registrar examines the representation of the trademark to ensure that it meets the criteria for distinctiveness as well as the specification of goods or services to ensure that they accord with the Nice Classification. Applications are also examined for potential conflicts with other trademarks. The letter of consent is not specified in the Trade Marks Act; however, it has been used in the review of trademark applications after rejection if the parties indicate that the owners of the respective trademarks are affiliated entities.

If, in the course of an examination of an application, the Registrar reasonably believes that the application has not been made in accordance with the Trade Marks Act or the Trade Marks Regulations, or there are grounds for rejecting the application, the Registrar must report that belief in writing to the applicant. Applicants are given the opportunity to respond to objections raised by the trademark office by written submissions to rectify the application and to overcome an objection. The response may:

- contest the Registrar's belief expressed in the report;
- contest any other matter arising out of the report;
- provide further documentary evidence in support of the application; or
- request that the application be amended in accordance with the Trade Marks Act.

Use of a trademark and registration

- 13 Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use is not required for the registration of a trademark or service mark. Proof of use is not required. An intention to use is sufficient.

Foreign applicants may claim priority rights when making an application to register a trademark in Saint Lucia should the same application have been filed in one or more Paris Convention countries and provided that the Saint Lucia application is made within six months of the day on which that application, or the first of those applications, was made.

The applicant must file notice of the claim, which must specify in respect of the earlier application or, if there is more than one earlier

application in respect of each earlier application, the Paris Convention country in which the earlier application was filed, the date on which the earlier application was filed and the number (if applicable) of that earlier application. The claim for priority should be made when filing the application, although the certified copy of the application for which priority is claimed can be furnished to the Registrar within six months of making the application.

Markings

14 | What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

There are no words or symbols prescribed to indicate trademark use or registration in Saint Lucia. Markings are neither provided for under the Trade Marks Act nor used by convention and are not mandatory in Saint Lucia. Symbols, however, offer the benefit of an added level of protection for registered trademark owners as they notify potential infringers that a mark is registered or is in the process of being registered, and assist the registered owner of a trademark in making a case and collecting damages in court for infringement because, by the markings, an infringer would be taken to have had knowledge that the mark was duly registered or was in the process of being registered.

Appealing a denied application

15 | Is there an appeal process if the application is denied?

The nature of the objection and the stage at which the objection is raised dictates how an appeal will proceed. Should the objection of the Registrar be raised at the examination stage and relate to the specification of goods and services, or a clerical error or obvious mistake, the applicant will be granted the opportunity during a further application to convince the Registrar otherwise, or to effect amendments or corrections to the application at that stage.

The applicant may also appeal to the High Court against any decision of the Registrar that leads to the subsequent rejection of an application.

Third-party opposition

16 | Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Third parties may oppose the registration of a trademark by filing a notice of opposition with the Registrar within three months of the day on which the acceptance of the application is published in the Official Gazette. An opponent may request an extension but must satisfy the Registrar that it is reasonable to grant the requested extension.

The Trade Marks Act prescribes the grounds on which an opposition may be made, which are similar to those on which the Registrar may reject an application under the Trade Marks Act, except on the grounds that the trademark cannot be represented graphically. Registration of a trademark may be opposed on the following grounds:

- the applicant is not the owner of the trademark;
- the applicant does not intend to use or authorise the use of the trademark, or to assign the trademark to a body corporate;

- the opponent claims earlier use of a similar or identical trademark;
- the trademark is substantially identical or deceptively similar to a trademark that has acquired a reputation in Saint Lucia and, because of the reputation of the other trademark, the use of the new trademark would be likely to deceive or cause confusion;
- the trademark consists of a false geographical indication;
- the application was amended contrary to the Trade Marks Act;
- the application contains certain signs prescribed by the Trade Marks Act not to be used as a trademark;
- the trademark does not distinguish the applicant's goods or services;
- the trademark is scandalous or its use contrary to law; or
- the trademark is likely to deceive or cause confusion.

The opponent must file the notice of opposition with the Registrar, which must outline the grounds for the opposition. The opponent must also serve a copy of the notice of opposition on the applicant and file a statement setting out the particulars of service on the applicant within two days of the service of the notice. An extension of time to file a notice of opposition may be sought from the Registrar. If the opponent intends to rely on evidence in support of the opposition, the opponent must serve a copy of the evidence within three months of the day on which the notice of opposition is filed.

Likewise, if the opponent does not intend to rely on evidence in support of the notice of opposition, they must, within three months of the day on which the notice of opposition is filed, serve on the applicant notice that the opponent does not intend to rely on evidence. If the opponent does not file evidence in support of the notice of opposition, notice that they will not rely on evidence or apply for an extension of time, the opponent is deemed to have abandoned their opposition.

If the applicant intends to rely on evidence in answer to the opposition, the same procedure applies with respect to the time frame for serving a copy of the evidence in answer. The applicant must also file the original evidence with the Registrar within two days of serving a copy on the opponent. If the applicant does not intend to rely on evidence in answer to the opposition, the same procedure applies when serving a copy of a notice that they do not intend to rely on evidence in answer. If the applicant does not file evidence in answer, serve the notice that they will not rely on evidence in answer or apply for an extension of time to do so, they are deemed to have abandoned their application. If the opponent intends to rely on evidence in reply to the evidence in answer to the opposition, the same procedure applies.

Upon completion of the evidence, the applicant or opponent may ask the Registrar to hear the parties to the opposition proceedings and the Registrar shall honour the request. Unless the proceedings are discontinued or dismissed, the Registrar shall decide to refuse to register the trademark, or to register the trademark with or without conditions or limitations. An applicant or opponent may appeal to the High Court against a decision of the Registrar. No restrictions exist as regards who may oppose a trademark.

The cost of filing a notice of opposition is approximately EC\$2,700 and the cost of filing cancellation of proceedings is approximately EC\$1,080 (both inclusive of agent and official fees).

Duration and maintenance of registration

17 | How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The trademark registration remains in effect for 10 years from the date of filing the application and may be renewed for further 10-year periods. A person may request the Registrar to renew the registration

of a trademark six months prior to the day on which the registration of the trademark expires. If a request for the renewal of the registration is made, the Registrar shall renew the registration for a period of 10 years from the day on which the registration of the trademark would expire if it were not renewed. The cost of filing a renewal of a trademark is approximately EC\$3,375 per single class, inclusive of the cost of the certificate of renewal.

Proof of use is not required for maintenance unless the trademark registration is challenged.

Surrender

18 | What is the procedure for surrendering a trademark registration?

The surrender of a trademark is known under Saint Lucia law as 'cancellation of registration'. If a trademark owner wants to relinquish his or her rights in a trademark, the owner shall make a request to the Registrar who must, upon receiving the request, cancel the registration of the trademark. The Registrar is not obliged to notify a person recorded as claiming a right in respect of, or an interest in, the trademark. If an application has been made to the Registrar for the recordal of the assignment or transmission of the trademark and that assignment has not yet been recorded, the person to whom the trademark has been assigned or transmitted must be notified. Where a third party seeks the cancellation of a registered trademark, an application must be made to the High Court.

Related IP rights

19 | Can trademarks be protected under other IP rights?

Trademarks, including two-dimensional and three-dimensional marks, may qualify for protection as industrial designs if they meet the criteria of new or novel and distinctive as stipulated in the Industrial Designs Act. Trademarks that may be creative or artistic in nature to qualify as a 'work' under the Copyright Act may also qualify for copyright protection.

Trademarks online and domain names

20 | What regime governs the protection of trademarks online and domain names?

The Trade Marks Act offers no protection for online trademarks or domain names.

LICENSING AND ASSIGNMENT

Licences

21 | May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

Licences are not expressly dealt with under the Trade Marks Act. However, they would be deemed an interest in or a right in respect of a trademark and would be dealt with in the same manner as security interests. Under the Trade Marks Act, a person who claims an interest in and rights in respect of a trademark may, by application in the prescribed form, record the particulars of the claim with the Registrar. The Trade Marks Act places no obligation on the Registrar to take any action in respect of notifying third parties of any claims, duly recorded, to an interest in a trademark.

The licensee for the purposes of the Trade Marks Act is an 'authorised user of a trademark' and may take certain actions in respect of the registered trademark should the registered owner fail in his or her

obligation to do so. Unless and until the licensee records their interest in the trademark with the Registrar, the benefits afforded under the Trade Marks Act (eg, asking the registered owner to give notice of objection to importation of goods that infringe the trademark to the Comptroller of Customs or alternatively to give the requisite notice in the event that the registered owner fails to do so) cannot be realised.

The provisions included in a licensing agreement in Saint Lucia are discretionary and, in accordance with contractual freedom, the parties may together agree on the specific provisions they wish to be included therein. As licences are not specifically dealt with under the Trade Marks Act, there are no prescribed or mandatory provisions to record a licence or an interest in a trademark.

Assignment

22 | What can be assigned?

Registered trademarks can be assigned with or without goodwill.

Under the Trade Marks Act, an assignment can be partial in that it may apply to only some of the goods and services under the trademark. However, the assignment may not be partial in relation to the use of a trademark in a particular area. There is no requirement under the law that other assets need to be assigned as part of the trademark assignment to validate the transaction.

A collective trademark cannot be assigned.

A certification trademark can only be assigned with the consent of the Registrar.

Assignment documentation

23 | What documents are required for assignment and what form must they take? What procedures apply?

The documents required for assignment are:

- a document that establishes the title to a trademark of the assignee or of the person to whom the trademark has been transmitted;
- evidence of the assignment or transmission of a registered certification trademark; and
- an Application for Recordal of Assignment or Transmission of Trademark pursuant to the Trade Marks Regulations.

The document evidencing the assignment must be an original or notarised copy.

If an application made to record an assignment of a registered trademark complies with the Trade Marks Act, the Registrar must, within the time provided for in the Trade Marks Regulations, enter the particulars of the assignment or transmission in the Register, and register the person to whom the trademark has been assigned or transmitted as the owner of the trademark in relation to the goods or services, or both, in respect of which the assignment or transmission has effect. The particulars of the assignment are taken to have been entered in the Register on the day on which the application was filed, and the registration of the beneficiary as the owner of the trademark is taken to have had effect from and including that day.

The Registrar must publish notice of the recording of the assignment or transmission and the registration of the beneficiary as the owner of the trademark in the Official Gazette. If there is a record made of a claim to interests in, and rights in respect of, a registered trademark (voluntarily), the Registrar must notify that person in writing, stating that the Registrar will record the assignment or transmission of the trademark at the end of a period of two months from the date of the notice, unless the application to assign is withdrawn, a prescribed court determines otherwise or each person to whom the Registrar must give notice has notified the Registrar that he or she consents to the assignment or transmission.

Validity of assignment

24 | Must the assignment be recorded for purposes of its validity?

Pursuant to the Trade Marks Act, if a registered trademark is assigned, the person registered as the owner of the trademark or the person to whom the trademark has been assigned shall apply to the Registrar for a record of the assignment to be entered in the Register. If the application complies with the Trade Marks Act, the Registrar shall:

- enter the particulars of the assignment in the Register;
- register the person to whom the trademark has been assigned as the owner of the trademark in relation to the goods and services, or both, in respect of which the assignment has effect; and
- publish notice of the recording of the assignment and the registration of the beneficiary as the owner of the trademark in the Official Gazette.

Security interests

25 | Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The Trade Marks Act recognises the voluntary recording of claims to interests in, and rights in respect of, the trademark and provides for the recording in the Register of such claims that may not be recorded otherwise under the Trade Marks Act, and for the Registrar to keep a record thereof. Security interests would, for the purpose of the Trade Marks Act, fall under this general heading of interests in and rights in respect of trademarks.

If a person other than the registered owner of the trademark claims to have an interest in, or a right in respect of, a registered or unregistered trademark other than by an assignment or transmission of the trademark, a joint written application must be made to the Registrar by the person claiming interest and the registered owner of the trademark to have the particulars of the claim recorded. In the case of a registered trademark, the Registrar shall enter the particulars in the Register; in the case of an unregistered trademark, the Registrar shall record this in the manner that the Registrar deems fit, but not in the Register.

As such interests are instruments of agreement or operation of law, there is no requirement for notarisation imposed by the Trade Marks Act. The recordal of such interests is voluntary, and the validity and enforceability of such interests are not contingent on them being recorded.

ENFORCEMENT

Trademark enforcement proceedings

26 | What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Apart from through opposition and cancellation proceedings, the Trade Marks Act protects registered trademarks owners by providing for the Comptroller of Customs to effect seizures and deal with goods that are imported into Saint Lucia if the importation infringes, or appears to infringe, a trademark registered in Saint Lucia.

There are no specialised courts or tribunals in respect of trademarks in Saint Lucia. Consequently, legal proceedings regarding the

enforcement of rights of a trademark owner must be commenced in either the civil or criminal courts. Civil proceedings must originate in the High Court and criminal proceedings in the magistrates' court or the High Court, depending on the size of the claim.

The Trade Marks Act specifies the various criminal offences that could arise in respect of trademarks and the various penalties that may be imposed once there is contravention of these sections of the Trade Marks Act.

Procedural format and timing

27 | What is the format of the infringement proceeding?

Trademark infringement proceedings are commenced like any other civil action in the High Court by filing and serving a claim form and a statement of claim. All other pleadings are filed and served based on a prescribed schedule. The defendant is required to file and serve a defence and any counter claim applicable. Once a defence is filed, a case management hearing will be scheduled by the court. The matter could, at this stage, be referred to a court-appointed mediator (by consent of the parties). Should the parties not agree to mediate, then trial directions will be given and the matter escalated to trial. The Case Management Order defines how disclosure will be made and outlines the timetable by which the parties will progress the trial. Evidence is given via written witness statements with cross-examination and re-examination of witnesses.

Expert witnesses are permitted with the leave of the court. Expert evidence is given via witness statements with cross-examination and re-examination.

Skeleton arguments must be provided to the judge prior to the trial and pursuant to the Case Management Order. The case is heard by a single High Court judge. The time frame of the hearing depends on a number of variables, including the complexity of the matter, and can last from one day to three days.

All criminal offences under the Trade Marks Act would be enforced by the Director of Public Prosecution and would, in the first instance, be heard in the magistrates' court. A decision of the magistrate may be appealed to the High Court.

Burden of proof

28 | What is the burden of proof to establish infringement or dilution?

The burden of proof in a civil action is on the balance of probabilities and, in a criminal action, beyond a reasonable doubt.

Standing

29 | Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A registered owner of a trademark has the exclusive right to obtain relief if the trademark has been infringed. If a trademark is registered in the name of two or more persons as joint owners of the trademark, the rights granted to those persons are to be exercised by them as if they were the rights of a single person.

An authorised user of a registered trademark may also bring an action for infringement of the trademark (subject to any agreement with the trademark owner) if the registered owner refuses or neglects to bring an action within the prescribed period.

The Trade Marks Act does not specify who may bring a criminal complaint; however, a registered owner, an authorised user or an agent of an affected party would have standing to lodge a criminal complaint.

Border enforcement and foreign activities

- 30 | What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?**

The border enforcement measures available to halt the import and export of infringing goods are the usual mandatory searches conducted by local customs officials at the various ports of entry and departure, including both air and seaports, and the detention and confiscation of goods suspected of infringing IP rights, including trademarks.

Under the Trade Marks Act, activities occurring outside Saint Lucia (as the country of registration of the trademark) can support a charge of infringement or dilution. Saint Lucia's trademark laws contain provisions with respect to enforcement of a registered owner's rights in both civil and criminal proceedings to include the award of damages, seizure, forfeiture or destroy orders, imprisonment and fines. The objective of this provision is to protect registered trademarks by allowing the Comptroller of Customs to seize and deal with goods manufactured outside Saint Lucia that are imported into Saint Lucia if the importation infringes, or appears to infringe, a registered trademark.

The registered owner or an authorised user of the registered trademark may give to the Comptroller notice in a prescribed form objecting to the importation of goods that infringe the trademark. The Comptroller must seize such suspected infringing goods unless satisfied that there are no reasonable grounds for believing that the notified trademark has been infringed by the importation of the goods. Should the objector not bring an action for infringement and give notice to the Comptroller within the prescribed period, the Comptroller is obligated to release the seized goods to the designated owner. If a case is made out after examination of the suspected infringing goods, the matter may be passed on to the courts for prosecution.

Discovery

- 31 | What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?**

Disclosure of documents is always pursuant to an order of the court. The judge typically orders standard disclosure but may, at his or her discretion, order specific or other disclosure. Privileged documents, such as 'without prejudice' correspondence, do not have to be produced.

Timing

- 32 | What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?**

It is difficult to offer a typical time frame for litigating an infringement or dilution or related action because there are few, if any, such actions brought in Saint Lucia. Most, if not all, such claims settle via mediation. Generally, the time period for litigation of civil claims in the High Court, from commencement of the claim to receipt of judgment in the matter, is approximately 12 to 18 months. The hearing of an appeal would conclude in a much shorter period of approximately three to six months.

Limitation period

- 33 | What is the limitation period for filing an infringement action?**

The limitation period for filing an infringement action is six years from having knowledge of the infringement, in line with the statutory limitation period for civil matters.

Litigation costs

- 34 | What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?**

The cost of litigating a claim for infringement or dilution of a trademark – including trial preparation, trial and appeal – would be no different from the cost of litigating any civil suit and would be assessed pursuant to the Eastern Caribbean Supreme Court Civil Procedure Rules 2000 (as amended) (the Rules), the overriding objective of which is to deal with cases in ways that are proportionate to the amount of money involved, the importance of the case and the complexity of the issues, among other things. Part 65 of the Rules deals with the ways in which costs are to be quantified, specifies a scale of fixed and prescribed costs, and outlines percentages to be allowed at various stages of any claim from filing to trial.

Appeals

- 35 | What avenues of appeal are available?**

An appeal lies to the High Court against a judgment or order of a lower court exercising jurisdiction under the Trade Marks Act. Appeals to the Court of Appeal against a judgment or order of a single judge of the High Court can occur with the leave of the Court of Appeal. Correspondingly, with special leave of the High Court, an appeal lies to the High Court under the Trade Marks Act.

Defences

- 36 | What defences are available to a charge of infringement or dilution, or any related action?**

There are a number of defences available to a charge of infringement or dilution of a registered trademark, including:

- the defendant used the trademark in good faith;
- the defendant used the trademark for comparative advertising;
- the defendant used a sign in good faith to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic of the goods or services, the time of production of goods, or of the rendering of services;
- the defendant used the trademark in good faith to indicate the intended purposes of the goods;
- the defendant exercised a right to use the trademark given to him or her under the Trade Marks Act;
- the court is of the opinion that the defendant would obtain registration of the trademark if he or she were to apply for it;
- the trademark has been applied to, or in relation to, goods by, or with the consent of, the trademark owner; or
- the defendant can show that he, she or their predecessor in title has continually used the trademark in relation to those goods or services from a time before the registration of the trademark or when the registered owner first used the trademark.

A person aggrieved by the threat of legal action for infringement of a registered trademark may also bring an action either in the High Court or in any other court with jurisdiction against the person making the threat:

- to obtain from the court a declaration that the defendant has no grounds for making the threat;
- to obtain from the court an injunction restraining the defendant from continuing to make the threat; or
- to recover any damages that the defendant has sustained because of the defendant's conduct.

Groundless threats of legal proceedings in respect of infringement of registered trademarks should be avoided.

Remedies

37 | What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The relief available to a successful party in an action for infringement of a registered trademark includes:

- the granting of an injunction, which may be awarded subject to any condition that the court thinks fit;
- delivering up or destruction of the infringing goods, at the option of the claimant; or
- damages or an account of profits and payment of legal costs.

Criminal remedies are available in respect of:

- falsifying a registered trademark;
- falsely applying a registered trademark;
- manufacture and possession of a die for use in the commission of an offence in respect of a registered trademark;
- selling goods with false marks;
- making false representations regarding trademarks;
- making or causing a false entry to be made in the Register;
- disobeying a summons;
- refusing to give evidence; and
- acting in a trademark matter without due authority.

A person who commits any of these offences is liable, upon summary conviction, to fines ranging from EC\$250 to EC\$250,000.

ADR

38 | Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Mediation and arbitration (to a lesser extent) are both available to aggrieved parties to attempt resolution of their disputes by assisted negotiations outside the more formal setting of the court.

Arbitration becomes operational in the event of a dispute if, by agreement, the parties have decided previously to pursue this medium. There are several benefits to arbitration, including the specialised expertise of the arbitrator over that of a judge and potential time savings to the parties. The lack of enough trained arbitrators in Saint Lucia means that significant costs may be incurred by the parties to secure the services of an arbitrator, including travel and accommodation costs.

The courts in Saint Lucia favour settlement of disputes by mediation and there is a Court Connected Mediation Programme in place to assist in this regard. Mediation is usually recommended in the first instance by the court. A matter may, however, be referred to mediation only with the consent of the parties. The benefits to the parties of engaging in mediation are:

- it is a faster process, resulting in cost and time savings;
- it is an informal setting as compared to the court; and
- it is an opportunity for the parties to face each other and discuss their dispute in good faith with intent to settle.

In Saint Lucia, an agreement reached by mediation may be duly filed in the High Court. This decision is made into an order (by consent) of the court, thereby binding the parties.

The risk of using ADR techniques is that, should the parties not reach agreement, the matter must revert to the courts.



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UPDATE AND TRENDS

Key developments of the past year

39 | Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

No updates at this time.

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