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No. 45 of 2024

PATENTS ACT, 2024

AN ACT TO IMPROVE THE LEGISLATIVE FRAMEWORK RELATING TO GRANT AND ADMINISTRATION OF PATENTS, TO REPEAL AND REPLACE THE PATENTS ACT, 2015 AND TO PROVIDE FOR CONNECTED MATTERS

[Date of Assent - 26th July, 2024]

Enacted by the Parliament of The Bahamas

PART I – PRELIMINARY

1. Short title and commencement.

(1) This Act may be cited as the Patents Act, 2024.

(2) This Act shall come into operation on such day as the Minister may by notice published in the Gazette, appoint.

2. Interpretation.

In this Act —

"applicant" means a natural or legal person that has filed an application for a patent or utility certificate under this Act, or their successor in title;

"application" means an application for a patent or a utility certificate the circumstances may indicate;

"appointed day" means the day appointed under section 1(2) for the coming into operation of this Act;

"Budapest Treaty" means the Budapest Treaty on the International Recognition of the Deposit of Micro-organisms for the Purposes of a Patent Procedure, done at Budapest on April 28, 1977;

"convention country" means any country that is a member of —

(a) the Paris Convention; or

(c) any other treaty which the Minister may designate by Order;

"Court" means the Supreme Court;

"date of filing" means —

(a) in relation to an application for a patent made under this Act, the date of filing of that application as determined in accordance with section 20; and

(b) in relation to any other application, the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing the application or is equivalent to the date of filing an application in that country (regardless of the outcome of the application) by virtue of section 21;

"Examiner" means any person or body appointed or designated as such by the Minister under section 3(8);

"exclusive licence" means a licence from the proprietor of or applicant for a patent which confers on the licensee, or on the licensee and persons authorised by him, to the exclusion of all other persons (including the proprietor or the applicant), any right in respect of the invention to which the patent or application relates and "exclusive licensee" and "non–exclusive licence" shall be construed accordingly;

"Intellectual Property Office" means the Intellectual Property Office established by section 3(1);

"international application for a patent" means an application made under the Patent Co-operation Treaty;

"International Bureau" means the secretariat of the World Intellectual Property Organization established by the convention signed at Stockholm on the 14th day of July, 1967;

"invention" means a creation, whether a product or process, in all fields of technology, which provides a technical solution to a technical problem;

"inventor" means a natural person who has created an invention;

"joint inventor" means natural individuals who collaboratively contribute to the conception or creation of an invention;

"journal" means a publication issued by the Intellectual Property Office and published in the *Gazette*;

"Minister" means the Minister with responsibility for intellectual property;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property signed in Paris on the 20th day of March, 1883 as amended from time to time;

"patent" means means the title granted to protect an invention under this Act;

"patent area" means the territory of The Bahamas;

"patentee" means the person for the time being entered on the Register as the grantee or proprietor of a patent;

"patent application" means an application under this Act for a patent;

"Patent Co-operation Treaty" means the treaty signed at Washington on the 19th day of June, 1970 as revised from time to time;

"patented invention" means an invention for which a patent is granted and "patented process" shall be construed accordingly;

"patented product" means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

"prescribed" means, in the case of proceedings before the Court, prescribed by rules of the Court, and, in any other case, prescribed by regulations made under this Act;

"priority date" means the date determined in accordance with section 21;

"published" means made available to the public and a document shall be taken to be published if a reproduction thereof can be inspected as of right by members of the public whether on payment of a fee or not;

"Register" means the Register of Patents referred to in section 38

"Registrar" means the Registrar of the Intellectual Property Office and any reference to the Registrar shall be construed as including a reference to any officer discharging the functions of the Registrar;

"right" in relation to any patent application or patent includes an interest in the patent application or patent and, without prejudice to the foregoing, any reference in this Act to a right in a patent includes a reference to a share in the patent;

"utility certificate", unless the context otherwise requires, means a utility certificate referred to under Part XV.

PART II – ADMINISTRATIVE PROVISIONS

INTELLECTUAL PROPERTY OFFICE

3. Intellectual Property Office.

(1) An office to be known as the Intellectual Property Office is hereby established under the supervision of the Minister responsible for Legal Affairs.

(2) The Minister shall appoint a Registrar and such other officers to discharge the duties and responsibilities of the Intellectual Property Office as the Minister may deem appropriate.

(3) The Registrar and such other officers that the Minister may designate by instrument in writing, shall be holders of a public office as addressed in the Constitution.

(4) The Registrar shall submit a report at the end of each financial year on the operations of the Intellectual Property Office and the Minister shall present such report to Parliament.

(5) The Minister may give such directions to the Registrar as the Minister may deem appropriate, in connection with the functions to the carried out by the Intellectual Property Office under this Act and under any other relevant Act.

(6) The Registrar shall have responsibility for the Intellectual Property Office and for personnel and other activities of the Office and for the timely and efficient administration of all laws relating to intellectual property and shall —

(a) exercise the powers and perform the functions conferred by this Act and any other law relating to intellectual property; and

(b) act under the general direction and supervision of the Minister.

(7) The Registrar shall adopt a seal in a form approved by the Minister which shall be used to authenticate all documents issued by the Intellectual Property Office and impressions of such seal shall be judicially noticed and admitted in evidence.

(8) The Minister may appoint or designate such Examiners as may be necessary for exercising the powers conferred and performing the functions required by or under this Act.

(9) The provisions of this section shall apply to the role of the Registrar under any other law relating to intellectual property and no proceedings shall lie against the Registrar or any member of staff of the Intellectual Property Office in respect of any matter for which, by virtue of this section, the Registrar is not liable.

(10) The Intellectual Property Office shall be open during normal business hours for the purpose of the transaction by the public of business under this Act and under all other laws relating to intellectual property.

(11) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

4. Restrictions on officers of Intellectual Property Office.

(1) No —

(a) patent application may be filed by;

(b) patent may be granted to;

(c) rights relating to patents may be held by,

the Registrar, officers and other employees of the Intellectual Property Office.

(2) No officer or other employee of the Intellectual Property Office including the Registrar shall, during his period of employment or thereafter, communicate information obtained in such capacity, to a person not entitled to the information or make other use of such information for personal gain.

(3) Any person who contravenes subsection (2) commits an offence and is liable on summary conviction to a fine of two thousand dollars or to imprisonment for one year.

FUNCTIONS OF REGISTRAR

5. Functions of Registrar.

(1) For the purposes of this Act, the Registrar shall be responsible for —

(a) the grant and administration of patents and utility certificates;

(b) the provision of patent information services; and

(c) the promotion of inventiveness among citizens of The Bahamas.

(2) The Registrar shall make available for use by the public, and on payment of the prescribed fees, if any —

(a) patent and relevant non-patent literature, including all domestic documents required to apply for a patent; and

(b) such documents required to apply for a foreign patent as are available.

(3) The Minister may issue to the Registrar directions in writing, not inconsistent with the provisions of this Act, concerning the exercise and performance of the Registrar's powers and functions in relation to any matter which appears to the Minister to concern the development of intellectual property and other matters connected therewith and the Registrar shall give effect to any such direction.

6. Exercise of discretionary power by Registrar.

Where any discretionary power is by or under this Act given to the Registrar, he shall not exercise adversely that power against any party in proceedings before him without giving that party an opportunity of being heard as regards such exercise.

PART III - PATENTABILITY OF INVENTIONS

7. Patentable inventions.

Subject to section 11, a patent may be granted only if —

(a) the invention is new;

(b) it involves an inventive step; and

(c) it is capable of industrial application,

and references in this Act to a patentable invention shall be construed accordingly.

8. Novelty.

(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art shall be taken to comprise all matter, (whether a product, a process, information about either, or anything else) that has been made available to the public (whether in The Bahamas or elsewhere) by written or oral description, by use or in any other way prior to the filing date of the patent application or where applicable, to the claimed priority date.

(3) For the purposes of this section, the disclosure of matter that would otherwise form part or all of the state of the art under subsection (2) shall not be taken into consideration if such disclosure occurred not more than one year immediately preceding the date of filing the patent application or where applicable, 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.

(4) In the case of an invention consisting of a substance or composition for—

(a) use in a method of treatment of the human or animal body by surgery or therapy;

(b) the diagnosis practised on the human or animal body,

the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

9. Inventive step.

An invention shall be taken to involve an inventive step if, having regard to the state of the art within the meaning of section 8(2) and the qualification set out in 8(3), it is not obvious to a person having ordinary skill in the art.

10. Industrial application.

An invention shall be taken to be capable of industrial application if, without limitation, it can be made or used in any kind of industry.

11. Exclusions from patentability.

(1) The following shall not be considered as inventions within the meaning of section 7 —

(a) a discovery, scientific theory or mathematical method;

(b) a literary, dramatic, musical or artistic work or any other aesthetic creation;

(c) a scheme, rule or method for performing a mental act, playing a game or doing business;

(d) the presentation of information;

(e) any living thing, as found in nature, natural biological processes, and biological material, as existing in nature;

(f) computer programs as such.

(2) The following shall be excluded from patent protection —

(a) inventions the commercial exploitation of which would be contrary to public order or morality;

(b) inventions the commercial exploitation of which would be prejudicial to human, animal or plant life, or to health or the environment;

(c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals, except from products, in particular substances or compositions, for use in any of these methods;

(d) plants, plant varieties, and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes;

(e) new uses of known substances or compositions.

PART IV – RIGHT TO APPLY FOR AND OBTAIN A PATENT

12. Right to patent.

(1) A patent for an invention may only be granted —

(a) to the inventor or joint inventors; or

(b) to the successor or successors in title of any person or persons mentioned in paragraph (a).

(2) Where two or more persons have filed a patent application for the same invention independently of each other, the person, whose application —

(a) has the earliest filing date; or,

(b) if priority is claimed, the earliest validly claimed priority date,

shall have the right to the patent as long as such application is not withdrawn, abandoned or rejected.

(3) Where an invention is made by two or more inventors and one of them refuses to make application for a patent or the whereabouts of that inventor cannot be ascertained after diligent inquiry, the other inventors or their successors in title may make an application, and a patent may be granted in the name of the inventors who make the application, on satisfying the Registrar that the joint inventor has refused to make an application or that his whereabouts cannot be ascertained after diligent inquiry.

(4) Notwithstanding subsection (3), the right of the inventor or successor in title to be named in the grant at a later date is preserved.

13. Publication of patent.

(1) An application shall be published, in accordance with procedures determined by the Registrar, promptly after the expiration of a period of eighteen months from the filing date or the priority date as the case may be.

(2) At the request of the applicant, an application may be published earlier than the end of the period referred to in subsection (1).

(3) No information concerning published patent applications shall be made available to the public except as determined by the provisions of this section or the procedures determined by the Registrar.

(4) Notwithstanding any other provision of law, a determination by the Registrar to release or not to release information concerning a published patent application shall be final.

(5) An application shall not be published in such circumstances as may be prescribed.

14. Invention made by an employee or pursuant to a commission.

(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.

15. Judicial assignment of patent application or patent.

(1) Where the essential elements of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, whether intentionally or not, 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 upon, in relation to an application made pursuant to subsection (1), may make such order as it sees fit.

(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 a proprietor 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 in which case there shall be no limitation period within which to bring an application under this section.

16. Mention of inventor.

(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention unless in a written declaration addressed to the Registrar the inventor indicates or in the case of joint inventors, they indicate a desire not to be named.

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

PART V – APPLICATION FOR PATENT

17. Making of application.

Every application for a patent shall be —

(a) made in the prescribed form;

(b) accompanied by the prescribed filing fee; and

(c) filed at the Intellectual Property Office in accordance with this Act.

18. Contents of application.

(1) Every application for a patent shall contain —

(a) a request for the grant of a patent;

(b) a specification as described in section 19(3) containing a description of the invention, a claim or claims and any drawings referred to in the description or any claim;

(c) an abstract;

(d) where the applicant's ordinary residence or principal place of business is outside The Bahamas, an address within The Bahamas for service; and

(e) where the applicant is not the sole inventor or the applicants are not the joint inventors, a statement justifying his or their right to be granted the patent.

(2) The purpose of the abstract referred to in subsection (1)(c) is to give technical information and, upon publication, it shall not form part of the

state of the art by virtue of section 8(2), and the Registrar may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.

(3) Without prejudice to the provisions of sections 19(3) and (4), regulations may be made prescribing the circumstances in which the specification of an application which requires for its performance the use of a micro-organism is to be treated for the purposes of this Act as complying with section 19(3).

19. Contents of specification.

(1) Every application for a patent shall be accompanied by a specification of the invention which shall describe the invention and shall begin with a title indicating the subject to which the invention relates.

(2) Drawings may, and shall if the Registrar so requires, be supplied for the purposes of any specification and any drawings so supplied shall, unless the Registrar otherwise directs, be deemed to form part of the specification.

(3) Every specification shall —

(a) particularly describe the invention and the methods by which it is to be performed;

(b) disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art;

(c) disclose the best method of performing the invention which was known to the applicant (or his predecessor in title) at the filing date of the application, or where applicable, at the relevant priority date;

(d) in the case of a process, explain the necessary sequence, of any, of the various steps, so as to distinguish the invention from other inventions; and

(e) end with a claim or claims defining the subject matter of the invention claimed.

(4) The claim or claims of a specification must —

(a) relate to a single invention or to a group of inventions linked so as to form a single inventive concept;

(b) be clear and succinct; and

(c) be fairly based on the matter disclosed in the specification.

(5) Subject to the foregoing provisions of this section a specification describing and claiming an invention in respect of which convention priority is sought may describe and claim developments of or additions to the said invention being developments or additions in respect of which the

applicant is entitled to apply for a patent in accordance with the provisions of section 12 of this Act.

(6) Where a specification refers to a deposit of biological material, the deposit shall be considered part of the specification and, to the extent that subsection (3) cannot otherwise reasonably be complied with, the deposit shall be taken into consideration in determining whether the specification complies with that subsection.

(7) A reference to a deposit of biological material in a specification does not create a presumption that the deposit is required for the purpose of complying with subsection (3).

20. Date of filing application.

(1) The date of filing an application for a patent shall, subject to the provisions of this section, be the earliest date on which the following conditions are satisfied in relation to the application, that is to say, the documents filed —

(a) contain a description of the invention for which a patent is sought whether or not the description complies with the other provisions of this Act and the relevant regulations;

(b) contain an indication that a patent is sought in pursuance of the application; and

(c) identify the applicant or applicants for the patent.

(2) If the Registrar finds that the application does not comply with subsection (1), the Registrar shall —

(a) invite the applicant to file the required correction;

(b) accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed, and

(c) notify the applicant or agent within seven days of the filing date if the application does not comply with subsection (1).

(3) Where the application refers to drawings which in fact are not included in the application, the Registrar shall—

(a) invite the applicant to furnish the missing drawings;

(b) if the applicant complies, accord as the filing date the date of receipt of the missing drawings;

(c) if the applicant does not comply, accord as the filing date the date of receipt of the application and shall treat any reference to the drawings as non-existent.

(4) The applicant may, at any time before notified by the Registrar that the application is in order for grant, divide the application into two or more

applications ("divisional applications"), provided that each divisional application —

(a) shall not go beyond the disclosure in the initial application;

(b) shall be entitled to the filing date and, where applicable, the priority date of the initial application.

(5) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation of the patent.

21. Priority date.

(1) Subject to subsection (2), a patent application may contain a declaration claiming priority to one or more earlier applications filed by the applicant or his predecessor in title in a country that is a party to the Paris Convention, if the application is made within twelve months of the filing date of the earlier application.

(2) If the provisions of section 77 of this Act have not been complied with, an applicant shall not be entitled to convention priority but may nevertheless claim priority based on the date of application in The Bahamas.

(3) The declaration shall indicate the date of such filing and the country in which it was made.

(4) Where the application contains a declaration under subsection (1), the Registrar may require that the applicant furnish within the prescribed time a copy of the earlier application certified as correct —

(a) by the office with which it was filed; or

(b) where the earlier application is an international application filed under the Patent Co-operation Treaty, by the office with which the international application was filed,

and if the earlier application is not in English, a translation thereof in English verified by the translator that the translation is to the best of his knowledge complete and faithful.

(5) The applicant may correct the declaration of priority before the expiry of the earlier of —

(a) sixteen months from the earliest priority date claimed; or

(b) where the correction would cause a change in the earliest priority date claimed, within sixteen months from the corrected earliest priority date,

provided that such a correction may be submitted until the expiry of four months from the date of filing.

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

(7) Where any of the requirements of this section or any regulations pertaining thereto have not been complied with, the declaration referred to in subsection (1) shall be deemed to be invalid.

22. Information on corresponding foreign application.

(1) The applicant shall, at the request of the Registrar, furnish the Registrar with the date and number of any other application for a patent or other title of protection made in an industrial or intellectual property office of any other country, or within a regional industrial or intellectual property office (hereafter in this section referred to as a "foreign application"), relating to the same or essentially the same invention as that claimed in the application filed with the Registrar.

(2) The applicant shall, upon request, furnish the Registrar with the following documents relating to one or more of the foreign applications referred to in subsection (1) —

(a) a copy of any communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application;

(b) a copy of the patent or other title of protection granted on the basis of the foreign application;

(c) a copy of any final decision rejecting the foreign application or refusing the patent requested in the foreign application;

(d) a copy of any final decision invalidating the patent or other title of protection granted on the basis of the foreign application referred to in subsection (1).

(3) Documents furnished pursuant to subsections (1) and (2) —

(a) 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; and

(b) may be used only for facilitating the evaluation of the novelty and inventive step of the invention for which the patent application is made.

(4) The applicant for a patent may submit comments on any documents furnished by him under subsections (1) and (2).

23. Disclosure of matter, etc., between earlier and later applications.

Where an application is made for a patent and a declaration is made in accordance with section 21(1) or in connection with that application specifying an earlier application, the first–mentioned application and any patent granted in pursuance thereof shall not be invalidated by reason only of the fact that any subject matter disclosed in the earlier application was made available to the

public within the twelve months before the date of filing of the said later application.

24. Examination of application.

(1) When the specification has been filed in respect of an application for a patent, the Registrar shall examine the application and specification and may, if he thinks fit, refer the application and specification to an examiner who shall report thereon to the Registrar.

(2) The applicant may divide the application into two or more applications ("divisional applications"), at his discretion, or upon determination during examination that the claims do not meet the provisions of section 19(4)(a), provided that each divisional application —

(a) shall not go beyond the disclosure in the initial application;

(b) shall be entitled to the filing date and, where applicable, the priority date of the initial application;

(c) shall be filed before the initial application has been granted.

(3) If the Registrar is of the opinion, or if, after reference to an examiner, such examiner reports, that the application and the specification filed in pursuance thereof do not comply with the requirements of sections 17 and 18 of this Act or of the regulations made thereunder, or that there is lawful ground of objection to the grant of a patent in pursuance of the application the Registrar may either —

(a) refuse to proceed with the application; or

(b) require the application or the specification to be amended before proceeding with the application.

(4) At any time after the application has been filed under this Act and before the acceptance of the specification the Registrar may at the request of the applicant and upon payment of the prescribed fee, direct that the application shall be post-dated to such date as may be specified in the request, provided that —

(a) no application shall be post-dated under this subsection to a date later than six months from the date on which it was actually made or would but for this subsection be deemed to have been made; and

(b) an application in respect of which convention priority is claimed shall not be post-dated under this subsection to a date later than the last date on which, under the foregoing provisions of this Act, the application could have been made.

(5) Regulations made by the Minister under this Act may make provision for securing that where, at any time after an application has been filed under this Act and before the acceptance of the specification a fresh application is filed in respect of any part of the subject-matter of the first-mentioned

application, the Registrar may direct that the fresh application shall be ante-dated to a date not earlier than the date of filing of the first-mentioned application.

(6) An appeal shall lie from any decision of the Registrar under subsection (4) of this section.

25. Search and substantive examination.

(1) If the application meets the formal requirements prescribed in section 17 and 18 of this Act, the Registrar shall proceed with the publication of the application in the Official Gazette after eighteen months from the filing date, including the abstract of the invention, any drawings or particulars relating thereto.

(2) Upon payment of the prescribed fee, at any time between the filing date and the end of the eighteen-month period, the applicant may request to the Registrar an early publication of the application.

(3) The Registrar shall, on the request of the applicant made in such manner as may be prescribed and on payment of a prescribed fee, cause an application for a patent to be examined by one or more competent examiners to be employed in or by the Intellectual Property Patent Office for that purpose.

(4) A request under subsection (3) shall be made within the prescribed time and the prescribed fee shall be paid within that time.

(5) If the request of examination that subsection (3) refers to is not submitted within the prescribed time the application shall be deemed abandoned.

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

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

(b) a search and examination report submitted in relation to an application for a patent made by the applicant in another jurisdiction; or

(c) a copy of the patent granted pursuant to a foreign patent application or a final decision on the refusal or invalidation of the patent/on a corresponding foreign application.

(7) Where the Registrar is not satisfied that the requirements set forth in sections 7 to 11 and any regulations made hereunder have been complied with, he shall notified the applicant the corresponding observations, and shall give him the opportunity to file arguments and amend the application, within the period specified in the Regulations.

(8) If the applicant fails to file any response within the prescribed term, the application may deemed abandoned.

26. Withdrawal of application.

At any time before a patent is granted under this Act, the applicant may in the prescribed manner, withdraw his application and any such withdrawal may not be revoked.

27. Grant or refusal of patent.

(1) If the Registrar determines that any of the requirements of this Act or the regulations made thereunder are not 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, subject to section 28(2), 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 to amend the application so as to comply with them, the Registrar shall, subject to section 6, refuse the application.

(2) If the Registrar determines that the application, whether as originally filed or as amended in pursuance of section 24, this section, or section 28, complies with the requirements of this Act and the relevant regulations made thereunder, he shall notify the applicant of that fact and on payment within the prescribed period of the fee prescribed for the grant, grant him a patent, and if the said fee is not so paid, the application shall be deemed to be withdrawn.

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

(4) If the Registrar refuses the application under subsection (1) or (3), he shall inform the applicant in writing of his decision and of the reasons for his decision.

(5) The patent shall be deemed to be granted on the date the Registrar publishes under section 29, a notice of the grant of the patent.

28. Amendment of application.

(1) At any time before a patent is granted under this Act, the applicant may, in accordance with the prescribed conditions and subject to subsection (2), amend the application of his own volition.

(2) No amendment of an application shall be allowed under section 24(4)(b) or section 27(1) or this section if such amendment extends the matter

beyond that which could reasonably be inferred from the original application as filed.

29. Notification of grant and publication of specification.

When a patent is granted, the Registrar shall—

(a) publish a reference to the grant of the patent;

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

(c) record the patent; and

(d) make available copies of the patent to the public, on payment of the prescribed fee.

PART VI – PROVISIONS AS TO PATENTS AFTER GRANT

30. Term of patent.

A patent granted under this Act shall take effect as of the date of application and, subject to this Act, shall continue in force until the end of the period of twenty years beginning with the date of filing of the application for the patent in The Bahamas.

31. Patent of addition.

(1) Subject to the provisions of this section where application is made for a patent in respect of any improvement in or modification of an invention (in this Act referred to as "the main invention") and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof the Registrar may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Subject to the provisions of this section, where an invention being an improvement in or modification of another invention is the subject of an independent patent and the patentee of that patent is also the patentee in respect of the patent for the main invention, the Registrar may, if the patentee so requests, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition in respect thereof, bearing the same filing date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the specification was the same as or later than the date of filing of the specification in respect of the main invention.

(4) A patent of addition —

(a) shall not be granted before the grant of the patent for the main invention;

(b) may be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired.

(5) A patent referred to in subsection (4), shall remain in force during its term or until the previous cesser of the patent for the main invention and no longer, provided that if the term of the patent for the main invention is revoked under this Act, the Court may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.

(6) No renewal fees shall be payable in respect of a patent of addition; but, if any such patent becomes an independent patent by virtue of an order under subsection (5) of this section, the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

(7) The validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(8) An appeal shall lie from any decision of the Registrar under this section.

32. Annual fees.

(1) In order to maintain the patent or patent application, an annual maintenance fee in such amount as shall be prescribed, shall be paid to the Intellectual Property Office before the expiration of the first year from the date of filing the application for grant of a patent and thereafter before the expiration of each successive year during the term of the patent.

(2) A grace period of six months shall be allowed for the late payment of the annual maintenance fee on payment of the prescribed surcharge.

(3) If an annual maintenance along with any applicable surcharge is not paid in accordance with this section, the patent application shall be deemed to have been withdrawn or the patent shall lapse.

(4) If a patent ceases to have effect under this section, the lapse of the patent shall be entered in the Register and published in the journal.

33. Surrender of patent or of claim.

(1) The proprietor 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 and the offer to surrender should comprise —

(a) a declaration no action is pending before the court for infringement or for revocation of the patent; or

(b) if an action before the court is pending, full particulars of the court in writing.

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

(3) Where notice of opposition is duly given under this section the Registrar shall notify the patentee and determine the question.

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

(5) As from the date when notice of acceptance is published in a journal 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 those persons.

(7) No surrender of a patent or one or more claims contained therein shall affect the validity of any patent or claim validly filed and subsisting in any convention country nor the rights of any person deriving from such foreign patent or claim.

34. Restoration of lapsed patents.

(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee and applicable surcharge if any, within the prescribed period and the Registrar is satisfied, upon application being made that —

(a) the failure was unintentional;

(b) the application for restoration is made within the prescribed time limit; and

(c) the application for restoration is accompanied by the prescribed fee,

the Registrar, subject to the provisions of this section, may by Order restore the patent and any patent of addition specified in the application which ceased to have effect on the cesser of the patent.

(2) An application under this section may be made by the person who was the patentee or by his successor in title, and where the patent was held by two

or more persons jointly, the application may, with the leave of the Registrar, be made by one or more of them or their successors in title without joining the others.

(3) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to pay the renewal fee; and the Registrar may require from the applicant such further evidence as may be deemed necessary.

(4) If after hearing the applicant (if the applicant so required or the Registrar thinks fit) the Registrar is satisfied that a *prima facie* case has been made out for an order under this section, the Registrar shall advertise the application in the *Gazette*; and within the prescribed period any person may give notice to the Registrar or opposition thereto on the grounds that the failure to pay the renewal fee was not unintentional.

(5) If notice of opposition is given within the period aforesaid, the Registrar shall notify the applicant, and shall give to the applicant and to the opponent an opportunity to be heard before the matter is decided.

(6) If no notice of opposition is given within the period aforesaid or if, in the case of opposition, the decision of the Registrar is in favour of the applicant, the Registrar shall upon payment of any unpaid renewal fee and such additional fee as may be prescribed, make the order in accordance with the application.

(7) An order under this section for the restoration of a patent —

(a) may be made subject to such conditions as the Registrar thinks fit, including in particular a condition requiring the registration in the Register of Patents of any matter in respect of which the provisions of this Act as to entries in that register have not been complied with; and

(b) shall contain such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the patented invention between the date when the patent ceased to have effect and the date of the application under this section,

and if any condition of an order under this section is not complied with by the patentee, the Registrar may, after giving to the patentee an opportunity to be heard, revoke the order and give such directions consequential on the revocation as the Registrar thinks fit.

(8) An appeal shall lie from any decision of the Registrar under this section.

35. Restoration of lapsed applications for patents.

(1) Where a patent has not been granted by reason only that the prescribed request was not made within the time allowed for that purpose, then if the

Registrar is satisfied, upon application made by the applicant for the patent that the failure to make the request was unintentional, the Registrar may order the patent to be granted.

(2) An application under this section shall contain a statement (to be verified in such manner as may be prescribed) fully setting out the circumstances which led to the failure to make the prescribed request; and the Registrar may require from the applicant such further evidence as he may think necessary.

(3) If after hearing the applicant (if the applicant so requires or the Registrar thinks fit) the Registrar is satisfied that a prima facie case has been made out for an order under this section, he shall advertise the application in the *Gazette*; and within the prescribed period any person may give notice to the Registrar of opposition thereto on the ground that the failure to make the prescribed request was not unintentional.

(4) If notice of opposition is given within the period aforesaid, the Registrar shall notify the applicant and shall give to him and to the opponent an opportunity to be heard before deciding the case.

(5) If no notice of opposition is given within the period aforesaid, or if in the case of opposition the decision of the Registrar is in favour of the applicant, the Registrar shall, upon payment of the fee prescribed in respect of the making of the request and of such additional fee as may be prescribed, make the order in accordance with the application.

(6) An order under this section for the grant of a patent shall contain such provision as may be prescribed for the protection of persons who may have begun to avail themselves of the invention between the date when the time allowed for making the prescribed request expired and the date of the application under this section.

(7) An appeal shall lie from any decision of the Registrar under this section.

PART VII – PROPERTY IN PATENT APPLICATIONS AND PATENTS

36. Nature of, and transactions in, patents.

(1) Any 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 37(3), 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 37(3) a licence may be granted 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 representative.

(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 such application;

(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 54 for a previous infringement.

37. Co–ownership of patents and applications for patents.

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

(2) Subject to the provisions of this section, where two or more persons are proprietors of a patent, then, subject to any agreement for the time being in force, each of those persons shall be separately entitled, by himself or his agents, in respect of the invention concerned, for his own benefit and without accounting to the other or others —

(a) to do any act which would, apart from this subsection, amount to an infringement of the patent concerned and any such act shall not amount to an infringement of that patent; or

(b) to bring civil proceedings for infringement of the patent pursuant to section 54.

(3) Subject to any agreement for the time being in force, where two or more persons are proprietors of a patent, one of them shall not, without the consent of the other or others, grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to the provisions of this section, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other 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 registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and —

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) to a patented product shall be construed accordingly.

PART VIII – REGISTER OF PATENTS, EVIDENCE OF REGISTER, DOCUMENTS, ETC.

38. Register of Patents.

(1) There shall be kept and maintained by the Registrar at the Intellectual Property Office a Register of Patents in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents and notice of all matters which are required by or under this Act to be entered in the Register and of such other matters affecting the validity of proprietorship of patent as may be prescribed by regulations.

(2) Without prejudice to subsection (1) or any other provision of this Act, regulations may make provisions with respect to the following matters including provisions imposing requirements as to any of those matters —

(a) the registration of patents and of applications for patents;

(b) the registration of transactions, instruments or events affecting rights in or under patents and applications;

(c) the furnishing to the Registrar of any prescribed documents or description of documents in connection with any matter which is required to be registered;

(d) the correction of errors in the Register and in any documents filed at the Intellectual Property Office in connection with registration;

(e) the publication and advertisement of anything done under this Act or regulations in relation to the register.

(3) Notwithstanding anything in subsection (2)(b), no notice of any trust, whether express, implied or constructive, shall be entered in the Register and the Registrar shall not be affected by any such notice.

(4) The Register may be kept either manually or electronically.

(5) Save as otherwise provided by regulations, the public shall have a right to inspect the Register at the Intellectual Property Office at all convenient times.

(6) Any person who applies for —

(a) a certified copy of an entry in the Register or a certified extract from the Register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts;

(b) an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(7) An application made under subsection (6) shall be made in such manner as may be prescribed by regulations.

(8) In relation to any portion of the Register kept otherwise than in documentary form —

(a) the right of inspection conferred by subsection (5) is, a right to inspect the material on the Register; and

(b) the right to a copy or extract conferred by subsection (6) is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

39. 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 which appears on the Register by virtue of any transaction, instrument or event to which this section applies shall be entitled to be recognized as the person entitled to the patent or right in the

application as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event —

(a) the earlier transaction, instrument or event was not registered; or

(b) in the case of any application, notice of the earlier transaction, instrument or event had not been given to the Registrar; and

in any case, the person claiming under the later transaction, instrument or event, did not know of the earlier transaction, instrument or event.

(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, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section applies to the following transactions, instruments and events —

(a) the assignment of a patent or application for a patent, or a right in it;

(b) the mortgage of a patent or application or the granting of security over it;

(c) the grant, assignment of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application;

(d) the death of the proprietor or one of the proprietors of any such patent or application or of any person having a right in or under a patent or application and the vesting by an assent of the personal representative of a patent, application or any such right; and

(e) any order or direction 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, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a), registration of the application shall be treated as registration of the transaction, instrument or event.

40. Information about and inspection of patent applications and patents.

(1) The Registrar shall, on a request being made to him in the prescribed manner and on payment of the prescribed fee, if any, give the person making the request such information as may be prescribed.

(2) Subject to subsection (4), and section 13 until a patent is granted documents or information constituting or relating to the application shall not, without the written consent of the applicant, be published or communicated to any person by the Registrar.

(3) Where a patent application has been withdrawn in accordance with section 26 documents or information constituting or relating to the application shall not, without the written consent of the applicant, be published or communicated to any person by the Registrar.

(4) Subsection (2) shall not prevent the Registrar from publishing or communicating to others any prescribed bibliographic information about an unpublished patent application.

41. Correction of errors.

(1) The Registrar may, in accordance with the provisions of this section, correct any linguistic error, error of transcription, clerical error or mistake in any specification of a patent, any application for a patent, or any document filed in pursuance of such an application, or any error in the Register.

(2) A correction may be made in pursuance of this section either upon a request made in the prescribed manner and accompanied by the prescribed fee, or without such a request.

(3) Where the Registrar proposes, or a request is made, to make a correction referred to in subsection (1), he shall before determining the matter give notice of the proposal to the proprietor of or applicant for the patent, as the case may be, and to any person, other than the person by whom the request is made, who appears to him to be concerned.

42. Rectification of Register.

(1) The Court may, on the application of a person aggrieved, order the Register to be rectified by the making, or the variation or deletion of any entry in it.

(2) In proceedings under this section the Court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the Register.

(3) Rules of Court may provide for the notification of any application under this section to the Registrar and for his appearance on the application and for giving effect to any order of the Court on the application.

43. Evidence of Register, documents, etc.

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

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

(3) Each of the following, that is to say —

(a) a copy of an entry in the Register or an extract from the Register which is supplied under section 38(6);

(b) a copy of any document kept in the Intellectual Property Office, or an extract from any such document, any specification of patent drawings or other matter which has been published under section 29,

which purports to be a certified copy or a certified extract shall be admitted in evidence without further proof and without production of the original, and such evidence shall be sufficient evidence of the matter therein stated.

(4) In this Part, "certified copy" and "certified extract" means a copy and extract certified by the Registrar and sealed with the seal of the Intellectual Property Office.

PART IX – RIGHTS OF OWNER OF PATENT

44. Rights of owner of patent.

(1) Subject to the other provisions of this Part, the patentee shall have the exclusive right to —

(a) exploit the patented invention;

(b) assign or transmit the patent;

(c) conclude licence agreements.

(2) The patentee shall have the right, subject to sections 47 and 62, to take action against any person exploiting the patented invention in the patent area without the patentee's consent.

(3) For the purposes of this Part, "to exploit" or "exploiting" a patented invention means any of the following acts in relation to the patent, when the patent has been granted —

(a) in respect of a product —

(i) making, importing, offering for sale, selling or using the product; or

(ii) stocking such product for the purposes of offering for sale, selling or using;

(b) in respect of a process —

(i) using the process; or

(ii) doing any of the acts referred to in paragraph (a), in respect of a product obtained directly by means of the process.

45. Owner of patent may request Comptroller of Customs to treat imports as prohibited goods.

(1) Where goods which are being imported into the Bahamas infringe the rights granted to a patentee under this Act, the patentee may give notice in writing to the Comptroller of Customs of such infringement and request the Comptroller to treat the goods in issue as prohibited goods under the Customs Management Act.

(2) The Comptroller of Customs shall not be obliged to act in respect of a notice presented in accordance with subsection (1), unless the Comptroller is satisfied that the patentee has presented information which demonstrates sufficient proof of the infringement.

46. Prevention of indirect use of invention.

(1) While in force, a patent shall confer on its proprietor the right to prevent all persons not having his consent from supplying or offering to supply in The Bahamas a person (other than a person entitled to engage in commercial working of the patented invention) with means relating to an essential element of that invention, for putting it into effect therein, provided that that 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 when the means referred to therein are staple commercial products, except when the person induces the person supplied to commit acts which the proprietor of the patent is entitled to prevent by virtue of section 44.

(3) Persons performing acts referred to in paragraphs (a), (b), or (c) of section 47 shall not be considered to be persons entitled to engage in commercial working of the invention for the purposes of subsection (1).

47. Limitation of effect of patent.

(1) The rights conferred by a patent shall not extend to —

(a) acts done privately for non-commercial purposes;

(b) acts done for experimental purposes relating to the subject matter of the relevant patented invention;

(c) 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; and

(d) the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, the territory or territorial waters of The Bahamas.

(2) It is not an infringement of a patent for any person to make, construct, use or sell the patented invention solely for uses reasonably related to the development and submission of information required under any law of The Bahamas that regulates the manufacture, construction, use or sale of any product.

48. Exhaustion of rights.

The rights conferred by a patent shall not extend to acts in respect of articles which have been put on the market in the patent area by the patentee or with his consent.

49. Extent of protection.

(1) The extent of the protection conferred by a patent shall be determined by the terms of the claim, and the description and drawings shall be used to interpret the claims.

(2) Protection conferred by a patent shall not apply to anything in a design which serves solely to obtain a technical or functional result.

PART X – AMENDMENT OF SPECIFICATION

50. Amendment of specification with leave of the court.

(1) In any action for infringement of a patent or any proceeding before the Court for the revocation of a patent, the Court may, subject to the provisions of section 51 of this Act, by order allow the patentee to amend his specification in such manner, and subject to such terms as to costs, publications or otherwise, as the Court may think fit, and if in any such proceedings for revocation the Court decides that as a result of the

specification the patent is invalid, the Court may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application under this section is made to the Court, the applicant shall give notice of the application to the Registrar and the Registrar shall be entitled to appear and be heard, and shall appear if so directed by the Court.

51. Supplementary provisions as to amendment.

(1) After the acceptance of a specification, no amendment thereof shall be effected except by way of disclaimer, correction or explanation and no amendment thereof shall be allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendments, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Where any amendment of a specification is allowed by the Court under this Act the right of the patentee to make the amendment shall not be called in question except on the ground of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification:

Provided that in construing the specification as amended reference may be made to the specification as originally published.

(3) Where any amendment of a specification is allowed as aforesaid, the fact that the specification has been amended shall be advertised in the *Gazette*.

PART XI - VOLUNTARY LICENCES

52. Voluntary licences.

(1) Subject to section 37, a patentee or an applicant may grant a licence in respect of the relevant invention.

(2) A licence contract shall be in writing and may, on payment of the prescribed fee, be recorded in the Register and the relevant notice published in a journal as prescribed by the regulations; and until such contract has been so recorded, the licence shall have no effect against third parties, unless otherwise decided by the Court.

(3) 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 patentee in accordance with subsection (1), nor may the licensee assign or mortgage the licence.

(4) In the absence of any provision to the contrary in the terms of a licence contract and subject to subsection (5), the patentee may continue to enjoy the rights conferred on him by sections 44 and 46.

(5) If a licence has been granted as an exclusive licence, the proprietor may not grant a further licence in respect of the invention to a third person and may not himself do any of the acts referred to in sections 44 and 46 unless otherwise specifically provided for in such exclusive licence.

(6) If before the expiration of the licence contract —

(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 a patent is refused; or

(d) the patent is revoked,

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

(7) In any of the cases referred to in subsection (6), 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 he has not, or practically has not, benefited, from the licence.

53. Use of patented invention in the public interest.

(1) In respect of a patented invention, the Minister may grant a compulsory licence to a Government agency or any person ("proposed user"), authorizing the agency or person to make, use, exercise or vend the patented invention in the circumstances outlined in and subject to the provisions of this section.

(2) The Minister may grant the compulsory licence to a proposed user only. if –

(a) —

(i) demand in The Bahamas for the patented invention is not being met on reasonable terms;

(ii) authorisation to exploit the patented invention is essential to meet that demand;

(iii) the patentee has given no satisfactory reason for failing to exploit the patent to the extent necessary to meet the demand in The Bahamas for the patented invention;

(iv) it is in the public interest to provide the proposed user with authorisation to exploit the patented invention; and

(v) the proposed user has tried for a reasonable period, but without success, to obtain authority from the patentee to exploit the patented invention on reasonable terms and conditions; or

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

(c) a judicial or regulatory body has determined that the patentee is abusively exercising his exclusive rights and/or neglecting in taking measures to prevent his licensee(s) from abusively exercising the licensed exclusive rights; or

(d) if the proposed user is the patentee of another invention (the dependent invention) and is seeking the authorisation for the purposes of exploiting the dependent invention and —

(i) the dependent invention cannot be exploited bye the third person without exploiting the patented invention; and

(ii) the dependent invention involves an important technical advance of considerable economic significance on the patented invention.

(3) Subsection (2)(a)(v) shall not apply during 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 is reasonably practicable.

(4) An order for a compulsory licence granted under subsection shall require that adequate compensation be paid to the patentee, taking into account the economic value of the exploitation.

(5) Before granting an order for a compulsory licence under this section, the Minister shall give notice to, hear and consider the views of the patentee and any other interested party who may wish to be heard.

(6) Subsection (5) does not apply in the case of a national emergency.

(7) The Minister may upon the request of any of the parties, vary the terms of the authorization for a compulsory licence.

(8) Upon the request of the patentee, the Minister shall terminate the authorisation if he is satisfied that the circumstances which led to his decision have ceased to exist and are unlikely to recur, or that the authorised user has failed to comply with the terms of the authorisation.

(9) Notwithstanding subsection (8), the Minister shall not terminate the authorisation if he is satisfied that the need for adequate protection of the public interest justifies maintaining the decision.

(10) Subsection (7) shall not apply in cases of national emergency or other circumstances of extreme urgency,

(11) Any action done by an authorized user shall not amount to an infringement of the patent.

(12) Any decision of the Minister under this subsections (1), (7) or (8) may be subject to judicial review.

PART XII – INFRINGEMENT

54. Infringement.

Except as otherwise specifically provided in this Act, the performance of any of the acts referred to in sections 44 and 46, in relation to a patent while it is in force, without the authorisation of the patentee, shall constitute an infringement.

55. Action for infringement.

(1) Subject to the provisions of this Part, civil proceedings may be brought in the Court by the patentee in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court) in those proceedings a claim may be made —

(a) for an injunction restraining the defendant from any apprehended act of infringement;

(b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;

(c) for damages in respect of the infringement;

(d) for an account of the profits derived by him from the infringement; or

(e) for a declaration that the patent is valid and has been infringed by him.

(2) The Court shall not, in respect of the same infringement, award the proprietor of a patent both damages and order that he shall be given an account of the profits.

56. Restrictions on recovery of damages for infringement.

(1) In proceedings for infringement of a patent, damages shall not be awarded, and no order shall be made for an account of profits against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing that the patent existed; and a person shall not be taken to have been so aware or to have

had reasonable grounds for so supposing by reason only of the application to a product of the word "patent" or "patented", or any word or words expressing or implying that a patent has been obtained or applied for the product, unless the number of the patent or the application for the patent, accompanied the word or words in question.

(2) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the Court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

57. 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 plaintiff proves that the specification for the patent 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.

(3) As a condition of relief under this section the Court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 68 and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

58. Certificate of contested validity of patent.

(1) If 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, then, if in any subsequent proceedings before the Court for infringement of the patent concerned or for revocation of the patent 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 counsel and attorney and

client (other than the costs of expenses of any appeal in the subsequent proceedings).

59. 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 proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the patentee 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 consideration 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.

(3) In any proceedings taken by an exclusive licensee by virtue of this section, the patentee shall be made a party to the proceedings, but if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

60. Effect of non–registration on infringement proceedings.

Where by virtue of a transaction, instrument or event to which section 39 applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, before the transaction, instrument or event is registered, in proceedings for such an infringement, the Court shall not award him costs or expenses 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.

61. Remedy for groundless threats of infringement proceedings.

(1) Where a person (whether or not the patentee or otherwise entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in Court against the person making the threat, claiming any relief mentioned in subsection (3).

(2) In any such proceedings the plaintiff shall, if he proves that the threats were so made and satisfies the Court that he is a person aggrieved by them, be entitled to the relief claimed unless —

(a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and

(b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is—

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) damages in respect of any loss which the plaintiff has sustained by the threats.

(4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.

(5) The mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

62. Power of Court to make declaration as to non–infringement.

(1) Without prejudice to the Court's jurisdiction to make a declaration apart from this section, a declaration that an act (that is to say, the use by any person of any process, or the making or use or sale by any person of any product) does not, or a proposed act would not, constitute an infringement of a patent, may be made by the Court in proceedings between the person doing or proposing to do the act and the patentee, notwithstanding that no assertion to the contrary has been made by the patentee, if it is shown —

(a) that person has applied in writing to the proprietor for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the patentee has refused or failed within a reasonable time to give any such acknowledgement.

(2) No declaration under subsection (1) shall be made if the act in question is already the subject matter of an infringement proceeding.

63. 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 The Bahamas an act which would

constitute an infringement of the patent if it were then in force, or makes in good faith effective and serious preparation to do such an act, shall have the rights specified in subsection (2).

(2) Any such person shall have the right —

(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 has 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 proprietor of the patent.

PART XIII – REVOCATION OF PATENT

64. Application for revocation of patent.

(1) Subject to the provisions of this section and section 65, any person may apply to the Court for revocation of a patent.

(2) An application for the revocation of a patent on the ground mentioned in paragraph (e) of section 65 may be granted only by a person found by the Court pursuant to section 15 to be entitled to be granted that patent or to be granted a patent for part of the matter covered by the patent, or, in case more than one person is found to be so entitled, by all those persons.

(3) An application under this section may be filed even if the patent has lapsed.

65. Grounds for revocation.

An application for revocation of a patent may be made only on any of the following grounds, that is to say —

(a) the subject matter of the patent is not patentable under Part III;

(b) the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;

(c) 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;

(d) the protection conferred by the patent has been extended by an amendment which should not have been allowed;

(e) the patent was granted to a person who was not entitled thereto under section 12 or section 14, as the case may be.

66. Examination of application for revocation.

(1) If on an application for revocation of a patent the Court considers that the grounds for revocation mentioned in section 65 prejudice the maintenance of the patent, the Court may by order unconditionally revoke the patent.

(2) If on an application for revocation of a patent the Court considers that the ground of revocation mentioned in section 65 affects the patent only partially, the Court may make an order for the revocation of the patent unless within a time specified by the Court the relevant specification is amended to the satisfaction of the Court.

(3) If required by the Court, the patentee shall furnish to the Court such information as may be required in relation to foreign applications filed for protection of the invention or documents filed with any other national or regional industrial property office or in connection with any proceedings relating to an application, a patent or other title of protection for the same or essentially the same invention.

PART XIV – PUTTING VALIDITY IN ISSUE

67. Circumstances in which validity of patent may be put in issue.

(1) Subject to the following provisions of this section, the validity of a patent may be put in issue before the Court only —

(a) by way of defence in proceedings for infringement under section 55 or 59;

(b) in proceedings under section 53, 60, 61 or 64.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

(3) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground specified in paragraph (e) of section 65 unless —

(a) it has been determined, either in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue, that the patent should have been granted to him and not some other person; and

(b) except it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced before the end of the period of two years beginning with the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(4) Where the validity of a patent is put in issue by way of defence, the Court shall if it thinks just to do so, give the defendant an opportunity to comply with the condition in subsection (3)(a).

(5) In subsection (3), "entitlement proceedings" in relation to a patent, means proceedings to determine the question whether a patent was granted to a person not entitled to it.

68. Amendment of patent in infringement or revocation proceedings.

(1) Subject to subsection (5), in any proceedings before the Court in which the validity of a patent is put in issue the Court may allow the proprietor of the patent to amend the patent in such manner and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the Court thinks fit.

(2) A person may give notice to the Court of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the Court shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Where an application for an order under this section is made to the Court, the applicant shall notify the Registrar who shall be entitled to appear and be heard and shall appear if so directed by the Court.

(5) No such amendment shall be allowed if it discloses matter which extends beyond that disclosed in the specification of the granted patent or extends the scope of the protection conferred by the patent.

69. Infringement proceedings by a co-owner.

One of two or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others made a defendant or defender shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

70. Infringement of rights conferred by publication of application.

(1) If an application for a patent for an invention is published, subject to subsections (2) and (3) below, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court for damages in respect of any act which would have infringed the patent

(2) Subject to subsections (2) and (3) references in sections 60 to 62 and 66 to 68 above to a patent and the patentee shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly

(3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only —

(a) after the patent has been granted; and

(b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Intellectual Property Office.

(4) The court shall consider the amount of any damages for such an infringement whether or not it would have been reasonable to expect from a consideration of the application as published under section 13 above, that a patent would be granted conferring on the patentee of the patent protection from an act of the same description as that found to infringe

those rights, and if the court finds that it would not have been reasonable, it shall reduce the damages to such an amount as it or he thinks just.

PART XV – UTILITY CERTIFICATES

71. Provisions applicable to utility certificates.

(1) The provisions in this Act relating to patents or to patent applications shall, unless otherwise provided under this Part, be applicable to utility certificates or to utility certificate applications, as the case may be.

(2) Sections 7, 9, 25, 30, section 32(1) and section 65(a) shall not apply to utility certificates nor to utility certificate applications.

72. Protection by utility certificate.

(1) A utility certificate may be granted only for an invention which is new and is capable of industrial application.

(2) An invention for which a utility certificate is requested 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.

73. Term of utility certificate.

A utility certificate granted under this Act shall take effect on the date on which notice of its grant is published in a journal, shall continue in force until the end of a period of ten years beginning on the date on which the utility certificate application or, where relevant, the patent application was filed and shall not be renewed.

74. Grounds for revocation.

An application for revocation of a utility certificate may be made only on the grounds —

(a) that the subject matter of the utility certificate may not be protected by a utility certificate under Part III and this Part; and

(b) mentioned in paragraph (b), (c), (d) or (e) of section 65.

75. Conversion of application.

(1) At any time before a patent is granted or before the refusal of a patent application is notified under this Act, an applicant for a patent may, in accordance with the prescribed conditions and upon payment of the

prescribed fee, request that his application be treated as a utility certificate application.

(2) 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.

(3) The Registrar shall refuse a request under subsection (1) or (2) if the patent application or the utility certificate application has already been the subject of a request under either of those subsections.

76. Registration of utility certificates.

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.

PART XVI – INTERNATIONAL ARRANGEMENTS

77. Notification as to convention countries.

The Minister may, with a view to the fulfilment of a treaty or international convention or arrangement, by order declare that any country specified in the Order is a convention country for the purposes of section 21.

78. Implementation of Patent Co–operation Treaty.

(1) The Patent Co-operation Treaty (in this section referred to as "the Treaty") and any regulations made thereunder shall be given full effect.

(2) Where the provisions of this Act conflict with those of the Treaty, the provisions of the Treaty shall prevail.

(3) Where this Act does not provide for any matter provided for by the Treaty, the provisions of the Treaty shall apply.

(4) The Intellectual Property Office shall act as a receiving office, designated office and elected office as provided for in the Treaty.

(5) The processing and examination of an international application for a patent designating The Bahamas shall not commence before the expiration of the time limit prescribed in Articles 22 and 39 of the Treaty, except that such processing and examination may commence if the applicant files an express request at the Intellectual Property Office within that time limit.

(6) The Registrar shall not grant or refuse to grant a patent on an international application before the expiration of the time limit prescribed in Rule 52 as

provided for in Article 28 or in Rule 78 as provided for in Article 41 as the case may be, except with the consent of the applicant in writing.

(7) Where an international application for a patent which purports to designate The Bahamas is refused an international filing date under the Treaty because —

(a) it is declared considered withdrawn;

(b) the International Bureau has made a finding under Article 12(3) of the Treaty; or

(c) the receiving office has declared that the designation of The Bahamas is considered withdrawn,

and the Registrar determines that such refusal was caused by an error or omission in the receiving office or any other institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act.

79. Implementation of The Budapest Treaty.

(1) The Budapest Treaty and any regulations made thereunder shall have full effect in the event that The Bahamas becomes a Contracting Party thereto.

(2) In the event that The Bahamas becomes a Contracting Party to the Budapest Treaty, where the provisions of this Act conflict with those of the Budapest Treaty, the provisions of the Budapest Treaty shall prevail.

(3) In the event that The Bahamas becomes a Contracting Party to the Budapest Treaty, where this Act does not provide for any matter governed by the Budapest Treaty, the provisions of the Treaty shall apply.

80. Judicial notice of certain treaties and instruments thereunder.

(1) Judicial notice shall be taken of the Paris Convention, the Patent Co-operation Treaty and of any bulletin, journal or gazette published under such Convention or Treaty.

(2) Judicial notice shall be taken of the Budapest Treaty and of any bulletin, journal or gazette published under such Treaty In the event that Bahamas becomes a Contracting Party thereto.

(3) Any document mentioned in any such bulletin, journal or gazette referred to in subsection (1) and (2) shall be admissible as evidence of any instrument or other act thereby communicated, or of any institution established by or having functions under any Convention or Treaty mentioned in subsection (1) and (2).

PART XVII – OFFENCES

81. Falsification of Register, etc.

If a person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be liable on summary conviction, to a fine of five thousand dollars or to imprisonment for two years or to both.

82. Unauthorised claim of patent rights.

(1) If a person falsely represents that anything disposed of by him for value is a patented product or process he shall, subject to the following provisions of this section, be liable on summary conviction to a fine of two thousand dollars.

(2) For the purposes of subsection (1), 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.

(3) Subsection (1) does 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 revoked 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).

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

83. Unauthorised claim that patent has been applied for.

(1) If a person 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,

he shall, subject to the following provisions of this section, be liable on summary conviction to a fine of two thousand dollars.

(2) Subsection (1)(b) shall not apply where the representation is made (or continues to be made) before the expiry of a period which commences with the refusal or withdrawal and 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).

(3) For the purposes of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it 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.

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

84. Misuse of title "Intellectual Property Office".

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 two thousand dollars.

85. Offences by corporations.

(1) 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, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) 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.

86. Time limit for prosecution.

No prosecution for an offence under this Act shall be commenced after the expiration of five years after the commission of the offence or one year after the discovery thereof, whichever date last occurs.

87. General penalty.

Any person who commits an offence under this Act for which no penalty is otherwise specifically provided, shall be liable on summary conviction to a fine

not exceeding two hundred and fifty thousand dollars or to a term of imprisonment for a term of five years or to both that fine and imprisonment.

PART XVIII – LEGAL PROCEEDINGS

88. Agent.

(1) A counsel and attorney shall be entitled to represent any party in any matter or proceedings before the Registrar under this Act.

(2) Where an applicant's ordinary residence or principal place of business is outside The Bahamas, he shall be represented by a counsel and attorney who is resident in The Bahamas and practising in The Bahamas in accordance with the relevant law.

(3) The Minister may make regulations requiring the keeping of a register of persons who act as agents for other persons for the purpose of applying for or obtaining the registration of patents.

(4) The regulations may require the payment of fees by persons requiring to be registered as agents.

(5) No person who is not an agent shall carry on business under any name, description or style which contains the words “registered patent agent” or hold himself out or otherwise describes himself as such an agent.

(6) A person who contravenes subsection (5) commits an offence and is liable on summary conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding three years, or to both such fine and imprisonment.

(7) For the purposes of this Act, “counsel and attorney” has the meaning assigned to it by section 2 of the Legal Profession Act (*Ch. 64*).

89. Appeal against order of Registrar.

(1) An appeal to the Court shall lie from any order or decision of the Registrar under this Act except unless otherwise specifically provided.

(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.

90. Right of appeal from order or decision of Court.

(1) An appeal to the Court of Appeal from an order or decision made by the Court in proceedings under this Act shall lie on any of the following grounds, but no other —

(a) that the Court had no jurisdiction in the matter; but it shall not be competent for the Court of Appeal to entertain such ground of appeal, unless objection to the jurisdiction of the Court has been formally taken at some time during the progress of the matter before the making of the order or decision;

(b) that the Court has exceeded its jurisdiction in the matter;

(c) that the order or decision of the Court has been obtained by fraud;

(d) that any finding or decision of the Court in any matter is erroneous in point of law; or

(e) that some other specific illegality not mentioned above, and substantially affecting the merits of the matter, has been committed in the course of the proceedings.

(2) On the hearing of an appeal in any matter under subsection (1), the Court of Appeal shall have power —

(a) if it appears to the Court of Appeal that a new hearing should be held, to set aside the order or decision appealed against and order that a new hearing be held; or

(b) to order a new hearing on any question without interfering with the finding or decision upon any other question,

and the Court of Appeal may make such final or other order as the circumstances of the matter may require.

(3) The Court of Appeal may in any matter brought on appeal before it dismiss the appeal if it considers that no substantial miscarriage of justice has actually occurred notwithstanding that it is of the opinion that any point raised in the appeal might have been decided in favour of the appellant.

91. 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 confidential manufacturing or commercial information.

92. Extension of privilege for certain communications.

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 a counsel and attorney or a person acting on his behalf, or in relation to information obtained or supplied for submission to a counsel and attorney 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 Co-operation Treaty.

93. 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 The Bahamas, 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.

(3) Any order made under subsection (1) for the payment of costs may be enforced as if it were a money judgment passed by a Magistrate's Court.

PART XIX – GENERAL AND MISCELLANEOUS

94. Power of Court to order certain information.

(1) Where legal proceedings have been instituted by an interested party against an opposing party that is alleged to have engaged in acts which infringe an intellectual property right granted under this Act on a

commercial scale, the Court may, on the application of the interested party, order the opposing party a financial services provider or any other person within the jurisdiction of the court, to disclose to the interested party or the Court, the banking or other commercial information the opposing party.

(2) Where in any case the court has adjudged that one or more persons have engaged in conduct which infringes an intellectual property right granted under this Act, the Court may order any of or all such persons to provide to an interested party or the Court, information, on the origin and distribution of networks of the goods in issue.

95. Immunity as regards official acts.

Neither the Minister nor any public employee —

(a) shall be taken to warrant the validity of any patent granted under this Act or any treaty or international convention to which The Bahamas is a party; or

(b) shall incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act, or any such treaty or convention, or any report or other proceedings consequent on any such examination or investigation.

96. Service by post.

Any notice required or authorised to be given by or under this Act and any application or other document so authorised or required to be made or filed, may be given, made or filed by post or in any other prescribed manner.

97. Registrar's annual report.

(1) The Registrar shall, before the 1st June in every year, make an annual report to the Minister with respect to the operation of this Act and the discharge of his functions thereunder which shall be laid before Parliament.

(2) Every such report shall include an audited account of all fees and other monies received and paid by him under this Act during the previous year.

98. Failure of application.

(1) If it is not determined that an application for a patent complies before the end of the prescribed period with all the requirements of this Act and any regulations made thereunder, the application shall be treated as having been refused by the Registrar at the end of that period.

(2) If at the end of that period an appeal to the court is pending in respect of the application or the time within which such an appeal could be brought has not expired, that period where —

(a) such an appeal is pending or is brought within the said time or before the expiration of any extension of that time granted in the case of a —

(i) first extension on an application made within that time; or

(ii) subsequent extension on an application made before the expiration of the last previous extension,

shall be extended until such date as the court may determine;

(b) no such appeal is pending or is so brought, shall continue until the end of the same time or, if any extension of that time is so granted, until the expiration of the extension or last extension so granted.

99. Reinstatement.

(1) Subject to any regulations made an application that is deemed to be abandoned may be reinstated if —

(a) the applicant, within the time prescribed—

(i) makes a request for reinstatement to the Registrar;

(ii) states, in the request, the reasons for the failure to take the action that should have been taken in order to avoid the abandonment;

(iii) takes the action that should have been taken in order to avoid the abandonment; and

(iv) pays the prescribed fee; and

(b) the Registrar determines that the failure to take the required action occurred in spite of the applicant having made reasonable efforts to act with due care to ensure that the required action was taken by the circumstances having been taken.

(2) The Registrar shall inform the applicant of a determination that the applicant shall be reinstated.

100. Observations by third party on patentability.

(1) Where an application for a patent has been published but a patent has not yet been granted to the applicant, any other person may make observations in writing to the Registrar on the question whether the invention is a patentable invention, stating reasons for the observations, and the Registrar shall consider the observations in accordance with prescribed rules.

(2) A person shall not become a party to any proceedings under this Act before the Registrar by reason only that he makes observations under this section.

101. Post grant amendments.

(1) Subject to the following provisions of this section, the Registrar may, on an application made by the patentee, allow the specification of the patent to be amended after the grant has been made, subject to such conditions, if any, as he thinks fit.

(2) No such amendment shall be allowed under this section where there are pending before the court or the Registrar proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) The Registrar may, without an application being made to him for the purpose, amend the specification of a patent so as to acknowledge a registered trade-mark.

(5) A person may give notice to the Registrar of his opposition to an application made under this section by the patentee, and if he does so the Registrar shall notify the patentee and consider the opposition in deciding whether to grant the application.

(6) The Registrar shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change 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.

102. Saving of rights.

Nothing in this Act affects the right of the Crown or any public employee to dispose of or use articles forfeited under the laws relating to customs and excise.

103. Act binds Crown.

This Act binds the Crown.

104. Regulations.

The Minister may make such regulations as he considers expedient for regulating the business of the Intellectual Property Office in relation to patents and applications for patents (including international applications for patents) and

for regulating all matters placed by this Act under the direction or control of the Registrar.

105. Repeals.

The —

(a) Industrial Property Act *(Ch. 324);* and

(b) Patents Act, 2015 *(No. 40 of 2015),*

are hereby repealed.

106. Transitional provisions.

(1) Where, upon the commencement of this Act an application made under the repealed Act is pending, such an application shall, notwithstanding the provisions of section 105 be dealt with under the repealed Act but the grant shall thereafter be subject to this Act.

(2) The Registrar shall, on or after the appointed day —

(a) perform all the functions of, and exercise all the powers conferred on, the Registrar in relation to patents under the repealed Act; and

(b) be the custodian of the Register of patents kept under the repealed Act and of the patents granted under that Act together with the certificates of registration and other relevant records.

(3) A patent granted under the repealed Act before the appointed day shall remain in force for twenty years from the date of the application.

(4) Nothing in this Act applies to or affects —

(a) any proceedings for revocation or infringement of a patent, commenced before the coming into operation of this Act;

(b) any existing licence, or any application for a licence made before the commencement of this Act.

(5) In this section, "repealed Act" means the Industrial Property Act repealed under section 105.