

# **Designs Act 2003**

*Commencement: 8<sup>th</sup> February 2011*

## **REPUBLIC OF VANUATU**

### **DESIGNS ACT NO. 3 OF 2003**

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# **REPUBLIC OF VANUATU**

Assent: 21<sup>st</sup> July, 2003

Commencement: NOT YET COMMENCED

## **DESIGNS ACT NO. 3 OF 2003**

Act to provide for the registration of designs

Be it enacted by the President and parliament as follows:

### **PART 1 - PRELIMINARY**

#### **INTERPRETATION**

1. In this Act, unless the contrary intention appears:

“applicant” means the person in whose name an application is for the time being proceeding;

“approved form” means a form approved by the Registrar;

“article” has the meaning given by section 3;

“artistic work” has the same meaning as in the Copyright Act No 42 of 2000;

“authorised user”, for a design, means a person using the design with the consent of the owner of the design;

“commencement day” means the day this Act commences;

“Convention country” means a country declared by the regulations to be a Convention country for the purposes of this Act;

"corresponding design" means a design that:

- (a) when applied to an article, is a reproduction of an artistic work; and
- (b) is not a design consisting solely of features of two-dimensional pattern or ornament that can be applied to a surface of an article;

“Court” means the Supreme Court;

“date of registration”, for the registration of a design, means the day from which the registration of the design is taken to have had effect under subsection 34(1) or (2);

“design” has the meaning given by section 2;

“expression of indigenous culture” means any way in which indigenous knowledge appears or is manifested, including:

(a) material objects; and

(b) names, stories, histories and songs in oral narratives; and

(c) dances, ceremonies and ritual performances and practices; and

(d) the delineated forms, parts and details of designs and visual compositions; and

(e) specialised and technical knowledge and the skills required to implement the knowledge, including knowledge and skills about biological resources, biological resource use and systems of classification.

“file” means to file with the Registrar;

“filing date”, for an application for the registration of a design, means the day on which the application is filed;

“indigenous knowledge” means any knowledge:

(a) that is created, acquired or inspired for traditional economic, spiritual, ritual, narrative, decorative or recreational purposes; and

(b) whose nature or use has been transmitted from generation to generation; and

(c) that is regarded as pertaining to a particular indigenous person or people in Vanuatu.

“infringement proceedings” means an action or proceedings for the infringement of the monopoly in a registered design;

“monopoly”, for a registered design, means the exclusive right to apply the design to an article for which the design is so registered;

“owner” means:

(a) for a design that is not a registered design - the person who is the owner of the design in accordance with section 5; or

(b) for a registered design - the person who is registered as the owner of the registered design;

and includes an authorised user of the design;



“predecessor in title”, for a person who claims to be the owner of a design, means any person who was a previous owner of the design;

“priority date” has the meaning given by section 4;

“Register” means the Register of Designs;

“registered” means registered under this Act;

“registered design” means a design registered under this Act;

“Registrar” means the Registrar of Designs, and includes a person acting in the office of Registrar;

“representation”, for an article to which a design is applied, means:

- (a) a drawing, tracing or specimen of the article to which the design is applied; or
- (b) a photograph of the drawing, tracing or specimen;

“sale” includes hiring or offering or exposing for sale or hire;

“set of articles” has the meaning given by section 3;

“statement of monopoly”, for a design, means a statement about the representations of an article to which the design is applied that shows:

(a) the features of the representations for which the applicant claims a monopoly;  
and

(b) the features of the representations that are to be disregarded in considering the extent of the monopoly protection;

"statement of novelty" means a statement about the representations of an article to which a design is applied that shows the features of the representations for which novelty or originality is claimed.

## **DEFINITION OF DESIGN**

2. (1) A design consists of features of shape, configuration, pattern or ornamentation that can be applied to an article. The features must be able to be judged by the eye in the finished article.

(2) A method or principle of construction is not a design.

## **DEFINITION OF “ARTICLE” AND “SET OF ARTICLES”**

3. (1) An article means any article of manufacture, including a part of an article if made separately, but does not include:

(a) an integrated circuit, or part of an integrated circuit, within the meaning of the Circuit Layouts Act No. 51 of 2000; or

(b) a thing used to make a circuit.

(2) A set of articles is a number of articles:

- (a) that are of the same general character; and
- (b) that are ordinarily on sale, or intended to be used, together; and
- (c) each of which has:
  - (i) the same design; or
  - (ii) a design that differs only in immaterial details or in features commonly used in the relevant trade from the design the other articles have.

(3) A reference in this Act to an article includes a reference to:

- (a) a set of articles; and
- (b) each article in a set of articles ; and
- (c) both a set of articles and each article in that set.

## **DEFINITION OF “PRIORITY DATE”**

4. The priority date for the registration of a design for a particular article is:

(a) if the design is registered—the date of registration of the design for that article;  
or

(b) if the registration of the design is being sought—the day that would be the date of registration of the design for the article if the design were registered.

## **PART 2—DESIGNS AND DESIGN RIGHTS**

### **OWNERSHIP OF UNREGISTERED DESIGN**

5. (1) This section deals with unregistered designs.

(2) Subject to this section, the author of an unregistered design is the owner of the design.

(3) If a person or the person's employee makes a design for another person, that other person is the owner of the design.

(4) In spite of subsection (3), if a design is made by a person in the course of his or her employment, the employer is the owner of the design.

(5) The owner of a design or the assignee of an interest in a design may assign to another person the whole or any part of his or her interest in the design.

## **WHAT DESIGNS MAY BE REGISTERED**

6. (1) Any new or original design may be registered.

(2) If

(a) the owner of the copyright in an artistic work applies to register a corresponding design; and

(b) the work has been previously used commercially by the owner;

the design is not new or original.

(3) In subsection (2), "used commercially" means used in a way that includes the sale or hire of an article to which the design has been applied industrially.

(4) A design is not to be registered for an article if the design:

(a) differs only in immaterial details or in features commonly used in the relevant trade from a design that was registered, published or used in Vanuatu for the same article before the priority date for the application for registration; or

(b) is an obvious adaptation of a design that was registered, published or used in Vanuatu for another article before the priority date for the application for registration.

(5) A design for an article that is primarily literary or artistic in character is not to be registered.

(6) A design may be registered although the design consists of, or includes, features of shape or configuration that serve, or serve only, a functional purpose.

## **RIGHTS GIVEN BY REGISTRATION OF DESIGN**

7. (1) The registered owner of a design has, subject to this Part, the exclusive rights:

(a) to use the design; and

(b) to authorise other persons to use the design.

(2) The registered owner of a design has also the right to take action under this Act if the design has been infringed.

(3) The registered owner has these rights from the date of registration of the design.

(4) If the design is registered subject to conditions or limitations, the rights of the registered owner are subject to those conditions or limitations.

(5) If the design is registered in the name of 2 or more persons as joint owners of the design, the rights granted to those persons under this section are to be exercised by them as if they were the rights of a single person.

## **REGISTERED OWNER MAY DEAL WITH DESIGN**

8. (1) The registered owner of a design may deal with the design as its absolute owner, subject only to any rights vested in another person.

(2) This section does not protect a person who deals with the registered owner otherwise than:

- (a) as a purchaser in good faith for value; and
- (b) without notice of any fraud on the part of the owner.

### **POWERS OF AUTHORISED USER OF REGISTERED DESIGN**

9. (1) The authorised user of a design may do any of the following, subject to any agreement with the registered owner:

- (a) use the design, subject to any condition or limitation of the registration;
- (b) (subject to subsection (2)) bring an action for infringement of the design if the registered owner refuses or neglects to do so within 6 months;
- (c) anything else that the registered owner of a design may do.

(2) If the authorised user brings an action for infringement of the design, the authorised user must make the registered owner of the design a party in the action. However, the registered owner is not liable for costs if he or she does not take part in the proceedings.

## **PART 3—APPLICATION FOR REGISTRATION OF DESIGNS**

### **APPLICATION FOR REGISTRATION**

10. (1) The owner of a design may apply for the registration of the design.
- (2) Where 2 or more persons own interests in a design, all of the persons owning the interests, acting jointly, may apply for the registration of the design.
- (3) The application for registration:
- (a) must be in accordance with the approved form and be filed with the Registrar;  
and
  - (b) must have with it three representations of an article to which the design is applied; and
  - (c) may have with it a statement of monopoly for the design.

(4) The Registrar may ask the applicant to provide a statement of novelty for the design.

(5) If the owner of a design wishes to register the design for more than one article, the owner must make a separate application for each article.

(6) For the purposes of subsection (5), a set of articles is to be regarded as one article.

## **CONVENTION COUNTRY—PRIORITY OF APPLICATION**

11. (1) If:

(a) a person has made an application for the registration of a design in one or more than one Convention country; and

(b) within 6 months after the day on which that application, or the first of those applications, was made, that person or the person's successor in title applies to the Registrar for the registration of the design;

that person or that person's successor in title may, when filing the application, claim a right of priority for the registration of the design.

(2) The priority claimed is for the registration of the design:

(a) if an application to register the design was made in only one Convention country—from (and including) the day on which the application was made in that country; or

(b) if applications to register the design were made in more than one Convention country—from (and including) the day on which the earliest of those applications was made.

(3) To claim priority, the person must give the Registrar a copy of the first application, certified by the Registrar of the country where the application was made.

## **PARTICULARS OF APPLICATION TO BE PUBLISHED**

12. The Registrar must publish details of each application in the Gazette within 28 days after the application is filed.

## **REGISTRAR TO EXAMINE APPLICATION**

13. The Registrar must examine the application and decide:

- (a) whether the application has been made in accordance with this Act; and
- (b) whether there are grounds under section 18 or 19 for rejecting it.

## **APPLICATION ACCEPTED OR REJECTED**

14. (1) The Registrar must then accept the application unless he or she is satisfied that:

- (a) the application has not been made in accordance with this Act; or
  - (b) there are grounds for rejecting it.
- (2) The Registrar may accept the application subject to conditions and limitations.

(3) If the Registrar is satisfied that:

- (a) the application has not been made in accordance with this Act; or
- (b) there are grounds for rejecting it;

the Registrar must reject the application.

(4) The Registrar must not reject an application without giving the applicant an opportunity of being heard.

## **NOTICE OF DECISION**

15. The Registrar must:

- (a) notify the applicant in writing of his or her decision; and
- (b) advertise the decision in the Gazette.

## **LAPSING OF APPLICATION**

16. (1) Subject to subsection (2), an application lapses if it is not accepted within one year after the date of filing.



(2) If, after that period has expired, the Registrar extends under section 81 the period within which the application may be accepted, the application:

- (a) is taken not to have lapsed when one year expired; and
- (b) lapses if it is not accepted within the extended period.

## **REVOCATION OF ACCEPTANCE**

17. (1) If, before a design is registered, the Registrar is satisfied:

- (a) that the application for registration of the design was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the design should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;

the Registrar may revoke the acceptance of the application.

(2) If the Registrar revokes the acceptance:

- (a) the application is taken to have never been accepted; and
- (b) the Registrar must examine the application as necessary under section 13; and
- (c) sections 16 and 17 again apply to the application.

## **DESIGN LIKELY TO DECEIVE OR CAUSE CONFUSION**

18. An application for the registration of a design must be rejected if the use of the design would be likely to deceive or cause confusion.

## **IDENTICAL DESIGNS**

19. (1) Subject to subsection (3), an application for the registration of a design (“applicant’s design”) must be rejected if:

- (a) the applicant’s design is substantially identical with, or deceptively similar to:
  - (i) a design registered by another person; or
  - (ii) a design whose registration is being sought by another person; and

(b) the priority date for the registration of the applicant's design is the same as or after the priority date for the registration of the other design.

(2) If the Registrar is satisfied:

(a) that there has been honest concurrent use of the 2 designs; or

(b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's design subject to any conditions or limitations that the Registrar thinks fit to impose.

(3) If the Registrar is satisfied that the applicant, or the applicant and applicant's predecessor in title, have continuously used the applicant's design for a period:

(a) beginning before the priority date for the registration of the other design; and

(b) ending on the priority date for the registration of the applicant's design;

the Registrar must not reject the application because of the existence of the other design.

## **PART 4—OPPOSITION TO REGISTRATION**

### **OPPOSITION**

20. (1) If the Registrar has accepted an application for the registration of a design, a person may oppose the registration by filing a notice of opposition.

(2) The notice of opposition must be in the approved form and must be filed within 28 days after details of the application are published in the Gazette.

(3) The opponent must serve a copy of the notice on the applicant.

(4) The registration of a design may be opposed on any of the grounds specified in section 23, 24, 25 or 26 and on no other grounds.

(5) If:

(a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and

(b) the other person notifies the Registrar in writing of this, and does not withdraw the opposition;

the opposition is to proceed as if the notice of opposition had been filed in that other person's name.

## **OPPOSITION PROCEEDINGS**

21. The Registrar must give the opponent and the applicant an opportunity of being heard on the opposition.

## **DECISION**

22. Unless the proceedings are discontinued, the Registrar must, at the end, decide:

(a) to refuse to register the design; or

(b) to register the design (with or without conditions or limitations);

having regard to how far any ground of the opposition has been established.

## **REGISTRATION MAY BE OPPOSED ON SAME GROUNDS AS FOR REJECTION**

23. The registration of a design may be opposed on any of the grounds on which an application for the registration of a design may be rejected.

## **APPLICANT DOES NOT OWN OR INTEND TO USE DESIGN**

24. (1) The registration of a design may be opposed on the ground that the applicant is not the owner of the design.

(2) The registration of a design may be opposed on the ground that the applicant does not intend:

(a) to use, or authorise the use of, the design in Vanuatu; or

(b) to assign the design to a person for use by the person in Vanuatu.

## **DESIGN SIMILAR TO DESIGN USED IN VANUATU**

25. The registration of a design (the “new design”) may be opposed on the ground that:

(a) it is substantially identical to a design that had been used in Vanuatu before the priority date for the registration of the new design; and

(b) because of the reputation of that other design, the use of the new design would be likely to deceive or cause confusion.

## **APPLICATION DEFECTIVE**

26. The registration of a design may be opposed on the ground that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

# **PART 5—AMENDMENT OF DOCUMENTS**

## **AMENDMENT OF APPLICATION FOR REGISTRATION**

27. (1) The Registrar may, at the written request of the applicant, amend an application for the registration of a design in accordance with section 28 or 29.

(2) If:

(a) an application for the registration of a design may be amended under section 28; and

(b) the applicant has not asked in writing that the application be amended;

the Registrar may, on his or her own initiative, amend the application as mentioned in section 28 to remove any ground on which the application could be rejected.

### **AMENDMENT BEFORE APPLICATION PUBLISHED**

28. An application may be amended to correct a clerical error or an obvious mistake if the particulars of the application have not yet been published under section 12.

### **AMENDMENT AFTER APPLICATION PUBLISHED**

29. (1) If the particulars of the application have been published under section 12, the application may only be amended as provided in this section.

(2) An amendment may be made to the representation of the design if the amendment does not substantially affect the identity of the design as at the time when the particulars of the application were published.

### **AMENDMENT OF OTHER DOCUMENTS**

30. The Registrar may, at the written request of a person who has filed an application (other than an application for the registration of a design), a notice or other document for the purposes of this Act or at the written request of the person's agent, amend the application, notice or document:

(a) to correct a clerical error or an obvious mistake; or

(b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

## **PART 6—REGISTRATION OF DESIGNS**

### **OBLIGATION TO REGISTER**

31. (1) The Registrar must register a design that has been accepted for registration:

- (a) if there has been no opposition to the registration; or
  - (b) if there has been an opposition—if the Registrar’s decision, or (in the case of an appeal against the Registrar’s decision) the decision on appeal, is that the design should be registered.
- (2) On registering the design, the Registrar must give it a registration number to identify it.

## **REGISTRATION**

32. (1) The design must be registered:

- (a) in the name of the applicant for registration; and
- (b) subject to the conditions (if any) and the limitations (if any) imposed by the Registrar (or the Court, on appeal).

The Registrar must enter these particulars in the Register.

(2) The Registrar must also enter in the Register:

- (a) a representation of the design; and
  - (b) its registration number; and
  - (c) any other particulars that are required by this Act to be entered in the Register.
- (3) If two or more persons applied together for the registration of the design, the applicants must be registered as joint owners of the design.

## **NOTIFICATION OF REGISTRATION**

33. When a design has been registered, the Registrar must:

- (a) publish notice of registration in the Gazette; and
- (b) give the registered owner a certificate of registration in the approved form.

## DATE AND TERM OF REGISTRATION

34. (1) Subject to subsection (2), the registration of a design is taken to have had effect from (and including) the filing date of the application for registration.

(2) If:

(a) the application was for a design whose registration had also been sought in one or more than one Convention country; and

(b) the applicant claimed a right of priority under section 11 for the registration of the design; and

(c) the design is registered under this Act;

the registration of the design is taken to have had effect:

(d) if an application to register the design was made in only one Convention country—from (and including) the day on which the application was made in that country; or

(e) if applications to register the design were made in more than one Convention country—from (and including) the day on which the earliest application was made.

(3) If:

(a) a registered design was, when it was registered, a corresponding design in relation to an artistic work in which copyright subsisted under the Copyright Act No. 42 of 2000; and

(b) because of a previous use of that artistic work, the design was only registered under this Act because of subsection 6(2); and

(c) the copyright expires before the registration of the design ceases;

the registration of the design ceases at the same time as the copyright and must not be extended after that time.

(4) Unless it is earlier cancelled, or the design is earlier removed from the Register, the registration of the design expires 10 years after the filing date of the application for its registration.

## **CEASING OF REGISTRATION**

35. The registration of a design ceases if:

- (a) the design is removed from the Register under section 38 or 45; or
- (b) the registration of the design is cancelled.

## **REQUEST FOR RENEWAL**

36. (1) Any person may, within 3 months before the registration of a design expires, ask the Registrar to renew the registration.

(2) The request must be in the approved form and be filed with the Registrar.

## **RENEWAL BEFORE REGISTRATION EXPIRES**

37. (1) if a request for the renewal of the registration of a design is made in accordance with section 36, the Registrar must renew the registration for 10 years from the day on which the registration of the design would expire if it were not renewed.

(2) The Registrar must give notice of the renewal to the registered owner of the design.

## **FAILURE TO RENEW**

38. If the registration of a design is not renewed, then:

- (a) Subject to section 39, the registration ceases to have effect when it expires; and
- (b) The Registrar must remove the design from the Register 12 months after the day on which the registration expired.



## **RENEWAL WITHIN 3 MONTHS AFTER REGISTRATION EXPIRES**

39. (1) If, within 3 months after the registration of a design has expired, a person asks the Registrar to renew the registration of the design, the Registrar must renew the registration of the design for 10 years from the day on which the registration expired.

(2) The request must be in the approved form and be filed with the Registrar.

(3) If:

(a) the registration of a design (“unrenewed design”) has not been renewed; and

(b) within 3 months after the registration expired, an application for the registration of a design is made by a person other than the person who was registered as the owner of the unrenewed design;

the unrenewed design is taken to be a registered design for the purposes of the application.

## **PART 7—AMENDMENT AND CANCELLATION OF REGISTRATION**

### **CORRECTION OF REGISTER**

40. (1) The Registrar may, on his or her own initiative, correct any error or omission made in entering in the Register any particular in respect of the registration of a design.

(2) The Court may, on the application of an aggrieved person, order that the Register be rectified by:

(a) entering in the Register particulars that were wrongly omitted from it; or

(b) correcting an error in an entry in the Register.

(3) When the Registrar amends any information entered in the Register about a design, the Registrar may also amend the certificate of registration to ensure it reflects the information in the Register.

## **CANCELLATION OF REGISTRATION BY REGISTRAR**

41. (1) The Registrar must cancel the registration of a design if the registered owner asks in writing that the registration be cancelled.

(2) Before cancelling the registration of the design, the Registrar must notify:

(a) any person recorded under section 56 as claiming a right or interest in the design; and

(b) if:

(i) an application has been made to the Registrar for the assignment or transmission of the design to a person to be recorded in the Register (see section 54); and

(ii) the assignment or transmission has not yet been recorded;

the person to whom the design has been assigned or transmitted.

## **AMENDMENT OR CANCELLATION BY COURT**

42. (1) The Court may, on the application of an aggrieved person, order that the Register be rectified by:

(a) cancelling the registration of a design; or

(b) removing or amending any entry in the Register relating to the design;

on the ground that a condition or limitation entered in the Register for the design has been contravened.

(2) Subject to subsection (3) and section 43, the Court may, on the application of an aggrieved person, order that the Register be rectified by:

(a) cancelling the registration of a design; or

(b) removing or amending an entry wrongly made on the Register; or

(c) entering any condition or limitation affecting the registration of a design that ought to be entered.

(3) An application under subsection (2) may be made on any of the following grounds, and on no other grounds:

(a) any of the grounds on which the registration of the design could have been opposed under Part 4; or

(b) that an amendment of the application for the registration of the design was obtained as a result of fraud or misrepresentation; or

(c) because of the circumstances applying at the time when the application for rectification is filed, the use of the design is likely to deceive or cause confusion for a reason other than one for which the application for the registration of the design could have been rejected under section 18 or 19; or

(d) if the application is about an entry in the Register—the entry was made, or has been previously amended, as a result of fraud or misrepresentation.

### **NO RECTIFICATION IF REGISTERED OWNER NOT AT FAULT**

43. (1) The Court may decide not to grant an application for rectification made:

(a) on the ground that the design is liable to deceive or confuse (a ground on which its registration could have been opposed, see paragraph 42(3)(a)); or

(b) on the ground referred to in paragraph 42(3)(c);

if the registered owner of the design satisfies the Court that the ground relied on by the applicant has not arisen through any act or fault of the registered owner.

(2) In making a decision under subsection (1), the Court may take into account any matter that the Court considers relevant.

### **DUTIES AND POWERS OF REGISTRAR**

44. (1) A person applying to the Court under this Part must give notice of the application to the Registrar.

(2) The Registrar may appear before the Court and be heard at his or her discretion.

(3) The applicant must give to the Registrar a copy of any order made by the Court under this Part and the Registrar must comply with the order.

## **APPLICATION FOR REMOVAL FOR NON-USE**

45. (1) A person aggrieved because a design is or may be registered but is not being used may make an application (“non-use application”) to the Registrar for the design to be removed from the Register.

(2) A non-use application may be made on the ground that, on the day the application for the registration of the design was filed, the applicant for registration did not intend:

(a) to use the design in Vanuatu; or

(b) to authorise the use of the design in Vanuatu; or

(c) to assign the design to a person for use by the person in Vanuatu;

and the registered owner has not used the design in Vanuatu at any time before the day on which the non-use application is filed.

(3) A non-use application may also be made on the ground that:

(a) the design has remained registered for a continuous period of 3 years ending on the day on which the non-use application is filed; and

(b) the registered owner did not use the design in Vanuatu at any time during that period.

(4) A non-use application may only be made on the grounds mentioned in subsections (2) and (3).

(5) A non-use application may be made:

(a) if it is on the ground set out in subsection (2)—at any time after the filing date for the application for the registration of the design; and

(b) if it is on the ground set out in subsection (3)—at any time after a period of 5 years has passed from the filing date in respect of the application for the registration of the design.

(6) The non-use application must be made by filing the approved form.

(7) The Registrar must:

(a) give notice of the application to the registered owner of the design; and

(b) publish a notice of the application in the Gazette.

(8) A non-use application may not be made if an action about the design is pending in the Court, but the person aggrieved may apply to the Court for an order directing the Registrar to remove the design from the Register.

(9) If the right or interest on which the person relied to make the application becomes vested in another person, the other person may, on giving notice of the relevant facts to the Registrar or the Court (as the case requires), be substituted for the first-mentioned person as the applicant.

## **REFERRAL TO COURT**

46. If:

(a) an application to remove a design for non-use has been made to the Registrar; and

(b) the Registrar is of the opinion that the matter should be decided by the Court;

the Registrar may refer the matter to the Court and the Court may hear and determine the matter as if the application had been made to it.

## **NOTICE OF OPPOSITION**

47. Any person may oppose an application under section 45 by filing a notice of opposition in the approved form with the Registrar or the Court, as the case requires.

## **REMOVAL OF DESIGN IF NON-USE APPLICATION UNOPPOSED**

48. (1) If there is no opposition to an application to the Registrar, the Registrar must remove the design from the Register.

(2) If there is no opposition to an application to the Court, the Court must order the Registrar to remove the design from the Register. The Court must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.

## **PROCEEDINGS BEFORE REGISTRAR**

49. If an application to the Registrar is opposed, the Registrar must:

- (a) give both parties an opportunity to be heard; and
- (b) make a decision whether to remove the design.

## **DECISION ON OPPOSED APPLICATION**

50. (1) Subject to subsection (3), if:

- (a) the application to the Registrar has not been withdrawn or dismissed; and
- (b) the Registrar is satisfied that the grounds on which the application was made have been established;

the Registrar may decide to remove the design from the Register.

(2) Subject to subsection (3), if at the end of the proceedings the Court is satisfied that the grounds on which the application was made have been established, the Court may order the Registrar to remove the design from the Register.

(3) If satisfied that it is reasonable to do so, the Registrar or the Court may decide that the design should not be removed from the Register even if the grounds on which the application was made have been established.

(4) The Court must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.

## **CERTIFICATE—USE OF DESIGN**

51. (1) If in proceedings about an opposed application, the Registrar or the Court has found that:

- (a) the design has been used in good faith during a particular period; or
- (b) the design has not been used during a particular period solely because of circumstances that were an obstacle to its use;

the Registrar or the Court must, if so requested by the registered owner of the design, give the registered owner a certificate of those findings.

(2) In any subsequent proceedings in which non-use of the design is alleged the certificate is evidence of the facts stated in it.

## **PART 8—ASSIGNMENT AND TRANSMISSION OF DESIGNS**

### **ASSIGNMENT AND TRANSMISSION OF DESIGN**

52. (1) A registered design, or a design whose registration is being sought, may be assigned or transmitted in accordance with this section.

(2) The assignment or transmission may be with or without the goodwill of the business concerned in using the design.

### **RECORDING ASSIGNMENT OR TRANSMISSION OF DESIGN IF REGISTRATION IS SOUGHT**

53. (1) If a design whose registration is being sought is assigned or transmitted:

- (a) the applicant for the registration of the design; or
- (b) the person to whom it has been assigned or transmitted;

must apply to the Registrar for the assignment or transmission to be recorded.

(2) The application must be in an approved form and be filed with the Registrar.

(3) If the application complies with this Act, the Registrar must:

- (a) within 3 working days of receiving the application, record, in the papers dealing with the application for registration, the particulars of the assignment or transmission; and

- (b) publish the particulars of the assignment or transmission in the Gazette.

(4) On and after the day on which the Registrar records the particulars of the assignment or transmission, the person to whom the design has been assigned or transmitted is taken, for the purposes of this Act, to be the applicant for the registration of the design.

## **RECORDING ASSIGNMENT OR TRANSMISSION OF REGISTERED DESIGN**

54. (1) If a registered design is assigned or transmitted:

- (a) the person registered as the owner of the design; or
- (b) the person to whom the design has been assigned or transmitted;

must apply to the Registrar for a record of the assignment or transmission to be entered in the Register.

(2) The application must be in the approved form and filed with the Registrar.

(3) If the application complies with this Act, the Registrar must, within 3 working days:

- (a) enter the particulars of the assignment or transmission in the Register; and
- (b) register the person to whom the design has been assigned or transmitted (“beneficiary”) as the owner of the relevant design.

(4) The registration of the beneficiary as the owner of the design is taken to have had effect on the day on which the application was filed.

(5) The Registrar must advertise in the Gazette:

- (a) the recording of the assignment or transmission; and
- (b) the registration of the beneficiary as the owner of the design.

## **NOTICE OF APPLICATION TO RECORD ASSIGNMENT OR TRANSMISSION**

55. If an application for recording of the assignment or transmission of a design complies with this Act, the Registrar must notify in writing any person recorded under section 56 as claiming an interest in, or a right to, the design.



## **RECORDING CLAIMS TO INTEREST—REGISTERED DESIGNS**

56. (1) If:

(a) a person has applied for the registration of a design; and

(b) another person claims to have an interest in, or a right to, the design;

they may together apply to the Registrar for a record to be kept of the other person's claim.

(2) If a person (other than the registered owner of a design) claims to have an interest in, or a right to, a registered design, the person and the registered owner of the design may together apply to the Registrar to have particulars of the claim recorded in the Register.

(3) The application must be in the approved form and must be filed with the Registrar.

(4) If the application has been made in accordance with this section, the Registrar must:

(a) for a registered design—enter in the Register the particulars of the claim set out in the application; and

(b) for an unregistered design—record, in the papers dealing with the application for registration, the particulars of the claim set out in the application.

(5) After a design is registered, the Registrar must enter the particulars of the claim to an interest in, or right to, the unregistered design in the Register.

## **RECORD NOT PROOF OF EXISTENCE OF RIGHT**

57. The fact that a record has been made in the Register that a person claims an interest in, or a right to, a registered design is not proof or evidence that the person has that right or interest.

## **PART 9—INFRINGEMENT OF DESIGNS**

### **INFRINGEMENT OF REGISTERED DESIGNS**

58. (1) A person infringes a registered design if the person, without the consent of the registered owner of the design:

(a) uses the design; or

(b) imports into Vanuatu for sale, or for use in a trade or business, an article for which the design is used outside Vanuatu without the consent of the person who was the owner of the registered design at the time when the design was so used; or

(c) sells an article :

(i) for which the design has been used in infringement of the monopoly in the design ; or

(ii) for which the design is used outside Vanuatu without the consent of the person who was the owner of the registered design at the time when the design was so used.

### **PRIOR USE OF IDENTICAL DESIGN**

59. A person does not infringe a registered design by using an unregistered design that is substantially identical with, or deceptively similar to, the registered design if the person, or the person and the person's predecessor in title, have continuously used in the course of trade the unregistered design from a time before:

(a) the date of registration of the registered design; or

(b) the registered owner of the registered design, or a predecessor in title, first used the design;

whichever is earlier.

### **ACTION FOR INFRINGEMENT**

60. (1) An action for an infringement of a registered design may be brought in the Court.

(2) The relief that the Court may grant in an action for an infringement of a registered design includes:

(a) an injunction, which may be granted subject to any condition that the Court thinks fit; and

(b) at the option of the plaintiff but subject to section 61, damages or an account of profits.

## **SPECIAL CASE—PLAINTIFF NOT ENTITLED TO DAMAGES**

61. (1) If:

(a) in an action for the infringement of a registered design, the Court finds that the defendant has infringed the design; and

(b) the defendant has applied to the Court under section 45 for an order directing the Registrar to remove the design from the Register; and

(c) the Court finds that, because the design has not during a particular period (“critical period”) been used in good faith by its registered owner, there are grounds (under subsection 45(5)) for removing the design;

the Court is not to grant relief to the plaintiff by way of damages or an account of profits for any infringement of the design that happened during the critical period.

(2) A court may refuse to award damages, or to make an order for an account of profits, for infringement of a registered design if the defendant satisfies the court:

- (a) that, at the time of the infringement, he or she was not aware that the design was registered ; and
- (b) that he or she had, before that time, taken all reasonable steps to find out whether the design was registered.

## **PART 10 - INDIGENOUS KNOWLEDGE**

### **REGISTRATION OF DESIGN INVOLVING INDIGENOUS KNOWLEDGE**

62. (1) If it appears to the Registrar that an application is for the registration of a design that is based on, arose out of, or incorporates elements of, indigenous knowledge, the Registrar must refer the application to the National Council of Chiefs.

(2) The Registrar must not register a design that is based on, arose out of, or incorporates elements of, indigenous knowledge unless:

- (a) the custom owners of the indigenous knowledge have given their prior informed consent to the registration; and

(b) the applicant and the custom owners have entered into an agreement on the payment by the applicant to the custom owners of an equitable share of the benefits from using the design.

(3) However, the Registrar may register the design without the prior informed consent of the custom owners if the Registrar is, after consultation with the National Council of Chiefs, satisfied that:

(a) the custom owners cannot be identified; or

(b) there is a dispute about ownership of the indigenous knowledge concerned.

In such a case, the Registrar must not register the design unless the applicant and the National Council of Chiefs have entered into an agreement on the payment by the applicant to the National Council of Chiefs of an equitable share of the benefits from using the design.

(4) If an agreement mentioned in subsection (2) or (3) has not been entered into within 12 months after the design application has been lodged:

(a) the Registrar may register the design; and

(b) the owner may use the design; and

(c) the Registrar is to determine the amount payable to the custom owners or the National Council of Chiefs by the owner of the design, being payment of an equitable share of the benefits from using the design.

(5) Any payments made to the National Council of Chiefs under an agreement mentioned in subsection (3) or a determination under paragraph (4)(c) must be used for the purposes of indigenous cultural development.

(6) An appeal lies to the Court from a decision of the Registrar determining an amount under paragraph (4)(c).

(7) An agreement mentioned in subsection (2) or (3) may contain other conditions, including how and when the design is to be used.

(8) The National Council of Chiefs may issue written guidelines for the purposes of this section.

(9) The National Council of Chiefs must consult with the Vanuatu National Cultural Council before entering into an agreement under subsection (3) or issuing guidelines under subsection (8).

## **PART 11—OFFENCES**

### **FALSELY USING A REGISTERED DESIGN**

63. (1) A person must not falsely use a registered design in the course of trade, knowing that the design is registered or reckless of whether or not the design is registered.

(2) A person falsely uses a registered design if the person uses the design or a design substantially identical with it:

(a) without the consent of the registered owner, or an authorised user, of the design; and

(b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a Court.

Penalty:

- (a) a fine not exceeding 2,000,000 Vatu; or
- (b) imprisonment for a period not exceeding 2 years; or
- (c) both a fine and a term of imprisonment.

### **SELLING GOODS MADE FROM FALSE DESIGNS**

64. A person must not:

- (a) sell goods; or
- (b) expose goods for sale; or
- (c) have goods in his or her possession for the purpose of trade or manufacture; or
- (d) import goods into Vanuatu for the purpose of trade or manufacture;

knowing that, or reckless of whether or not, the goods were made using a design without the consent of the registered owner, or an authorised user, of the design.

Penalty:

- (a) a fine not exceeding 2,000,000 Vatu; or
- (b) imprisonment for a period not exceeding 2 years; or
- (c) both a fine and a term of imprisonment.

## **FALSE REPRESENTATIONS ABOUT DESIGNS**

65. A person must not make a representation to the effect that a design is a registered design unless the person knows, or has reasonable grounds to believe, that the design is registered in Vanuatu.

Penalty: 200,000 Vatu.

## **FALSE ENTRIES IN REGISTER**

66. A person must not:

- (a) make a false entry in the Register; or
- (b) cause a false entry to be made in the Register; or
- (c) tender in evidence a document that falsely purports to be a copy of, or an extract from, an entry in the Register or a document in the Registrar's office.



Penalty: Imprisonment for 2 years.

## **PART 12—JURISDICTION AND POWERS OF COURT**

### **JURISDICTION OF THE SUPREME COURT**

67. The Supreme Court has jurisdiction with respect to matters arising under this Act.

### **APPEAL**

68. (1) The applicant for registration of a design may appeal to the Court against a decision of the Registrar:

- (a) to accept the application subject to conditions or limitations; or
- (b) to reject the application; or
- (c) to refuse to register the design; or
- (d) to register the design with conditions or limitations.

(2) The applicant or the opponent may appeal to the Court from a decision of the Registrar under section 22.

(3) An appeal lies to the Supreme Court from a decision of the Registrar under Part 5 or section 49.

(4) On hearing an appeal against a decision or direction of the Registrar, the Court may do any one or more of the following:

(a) admit further evidence orally, or on affidavit or otherwise;

(b) permit the examination and cross-examination of witnesses;

(c) order an issue of fact to be tried as it directs;

(d) affirm, reverse or vary the Registrar's decision or direction;

(e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;

(f) order a party to pay costs to another party.

(5) The Registrar may appear and be heard at the hearing of an appeal to the Court against a decision or direction of the Registrar.

## **APPEAL TO COURT OF APPEAL**

69. A person aggrieved by a decision of the Supreme Court may appeal to the Court of Appeal against the decision.

## **PART 13—ADMINISTRATION**

### **REGISTRAR OF DESIGNS**

70. (1) There is to be a Registrar of Designs to be appointed by the Minister with the prior approval of the Council of Ministers.

(2) The Registrar has the powers and functions that are given to him or her under this Act.

(3) The Registrar may not exercise a power under this Act in any way that adversely affects a person applying for the exercise of that power without first giving that person a reasonable opportunity of being heard.

(4) If:

- (a) the Registrar is required under this Act to do an act or thing; and

(b) no time or period is provided within which the act or thing is to be done;

the Registrar is to do the act or thing as soon as practicable.

### **THE REGISTER**

71. (1) The Registrar is to keep a Register of Designs.

(2) The Registrar must enter in the Register in accordance with this Act particulars of designs and all other matters required to be registered under this Act.

(3) The Register may be kept in whole or in part by using a computer.

(4) Any record made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.

## **INSPECTION OF REGISTER**

72. (1) The Register must be available at the Registrar's Office for inspection by any person during the hours when the Office is open for business.

(2) If the Register, or any part of the Register, is kept by using a computer, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

## **EVIDENCE**

73. (1) The Register is *prima facie* evidence of any particular or other matter entered in it.

(2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.

(3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any

of the particulars comprised in the Register or in that part of the Register is admissible in any proceedings as evidence of those particulars.

(4) A certificate signed by the Registrar and stating that:

- (a) anything required or permitted to be done by this Act was done or not done on, or had been done or not been done by, a specified date; or
- (b) anything prohibited by this Act was done or not done on, or had been done or not been done by, a specified date; or
- (c) a document was available for public inspection at the Registrar's Office on a specified date or during a specified period;

is *prima facie* evidence of the matters so stated.

(5) A copy of, or an extract from, a document held in the Registrar's Office that is certified by the Registrar to be a true copy or extract is admissible in any proceedings as if it were the original.

## **PART 14—MISCELLANEOUS**

### **MAKING AND SIGNING APPLICATIONS**

74. An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by:

- (a) a lawyer; or
- (b) a patent attorney; or
- (c) a person authorised in writing by that person and permanently employed by, and only by, that person.

### **FILING DOCUMENTS**

75. A document may be filed with the Registrar by being delivered to him or her:

(a) personally; or

(b) by post or courier.

## **WITHDRAWING APPLICATION .**

76. (1) A person who has filed an application, notice or request may withdraw it, by telling the Registrar in writing, at any time while it is still being considered by the Registrar.

(2) If:

(a) the right or interest on which the person relied to file the application, notice or request has become vested in another person; and

(b) the other person tells the Registrar in writing that the right or interest is vested in him or her;

the other person may withdraw the application, notice or request as provided in subsection (1).

## **ADDRESS FOR SERVICE**

77. (1) The address for service of a person who has filed an application, notice or request is:

(a) the address for service stated in the application, notice or request; or

(b) if the person subsequently notifies in writing another address to the Registrar—that other address.

(2) When:

(a) a design is registered; or

(b) a claim to an interest in, or to a right in respect of, a registered design that a person has is recorded in the Register;

the Registrar must enter in the Register as the address for service of the registered owner or of the person the address last known to the Registrar.

(3) The registered owner of a registered design, or any person whose claim to an interest in, or to a right in respect of, a design is recorded in the Register, must notify the Registrar in writing of any change in his or her address for service and the Registrar must amend the Register accordingly.

(4) The address for service of:

- (a) the registered owner of a registered design; or

(b) a person whose claim to an interest in, or a right in respect of, a design is recorded in the Register;

is the address set out from time to time in the Register as being the address for service of the registered owner or of the person.

(5) An address for service must be an address in Vanuatu.

(6) If this Act provides that a document is to be served on, or given or sent to, a person:

(a) the document may be left at, or sent by post to, the address for service of the person; or

(b) if the person does not have an address for service—the document may be served on an agent of the person in Vanuatu or may be sent by post or courier to any address of the person in Vanuatu that is known to the Registrar.

## **CHANGE OF NAME**

78. (1) If there is a change in the name of a person who has filed an application, notice or request, the person must notify the Registrar in writing of the change.

(2) If there is a change in the name of:



(a) the registered owner of a registered design; or

(b) a person whose claim to an interest in, or to a right in respect of, a design is recorded in the Register;

the registered owner or the person must notify the Registrar in writing of the change and the Registrar must amend the Register accordingly.

## **DEATH OF APPLICANT**

79. (1) If an applicant for the registration of a design dies before registration is granted, his or her legal representative may proceed with the application.

(2) If, at any time after a design is registered, the Registrar is satisfied that the person in whose name the design is registered died (or, in the case of a body corporate, ceased to exist) before registration was granted, the Registrar may amend the Register by substituting for the name entered in the Register the name of the person who should be the registered owner of the design.

## **FEES**

80. (1) The regulations may prescribe the fees to be paid to the Registrar for the purposes of this Act, and may prescribe different fees for doing an act according to the time when the act is done.

(2) If a fee is payable for the Registrar to do an act, the Registrar must not do the act until the fee has been paid.

## **EXTENSION OF TIME**

81. (1) If, because of an error or omission by the Registrar, a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar must extend the time for doing the act.

(2) If, because of:

- (a) an error or omission by the person concerned or by his or her agent; or
- (b) circumstances beyond the control of the person concerned;

a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on written application made by the person concerned, extend the time for doing the act.

(3) In this section:

“relevant act” means:

(a) any act done in relation to a design; or

(b) the filing of any document; or

(c) any proceedings (other than Court proceedings).

## **CONVENTION COUNTRIES**

82. (1) The regulations may declare a foreign country to be a Convention country for the purposes of this Act.

(2) If:

- (a) the regulations declare that, under the terms of a treaty between 2 or more Convention countries, an application made for the registration of a design in one of those countries is equivalent to an application made in another of those countries; and
- (b) an application for the registration of a design is made in one of those Convention countries;

then, for the purposes of this Act, the application for the registration of the design is taken to have also been made in the other Convention country or in each of the other Convention countries (as the case may be).

(3) If:

- (a) the regulations declare that, under the law of a Convention country, an application for the registration of a design made in another country is equivalent to an application made in the Convention country; and
- (b) an application for the registration of a design is made in that other country;

then, for the purposes of this Act, the application for the registration of the design is taken to have also been made in the Convention country.

## **USE OF DESIGN FOR EXPORT TRADE**

83. If a design is used in Vanuatu for articles that are to be exported from Vanuatu (“export articles”), the use of the design, for the purposes of this Act, constitutes use of the design for the export articles.

## **PASSING OFF ACTIONS**

84. (1) Except as provided in subsection (2), this Act does not affect the law relating to passing off.

(2) In an action for passing off arising out of the use by the defendant of a registered design:

- (a) of which he or she is the registered owner or an authorised user;  
and

(b) that is substantially identical with, or deceptively similar to, the design of the plaintiff;

damages may not be awarded against the defendant if the defendant satisfies the Court:

(c) that, at the time when the defendant began to use the design, he or she was unaware, and had no reasonable means of finding out, that the design of the plaintiff was in use; and

(d) that, when the defendant became aware of the existence and nature of the plaintiff's design, he or she immediately ceased to use the design in relation to the goods or services in relation to which it was used by the plaintiff.

## **REGULATIONS**

85. (1) The Minister may make regulations:

(a) prescribing matters required or permitted by this Act to be prescribed; or

(b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act.

(2) Without limiting subsection (1), the regulations may:

(a) require persons to make statutory declarations in support of any application, notice or request filed under this Act; and

(b) prescribe as penalties for offences against the regulations fines not exceeding 50,000 Vatu.

## **COMMENCEMENT**

86. This Act commences on the day on which it is published in the Gazette.