



Vanuatu Intellectual Property Office

Ministry of Trade, Tourism & Industry

PMB 9056

Port Vila

VANUATU.

Tel : 678 25674/25675

24th May 2017

IN THE MATTER of The Vanuatu Patents Act No. 2 of 2003

IN THE MATTER of an application by **Crystal Lagoons (Curacao) B.V., Kaya W.F.G. (Jombi), Mensing 14, Willemstad/CW**, seeking new Patent for Localized Disinfection Method for Large Water Bodies in the name of Crystal Lagoons (Curacao) B.V.

DECISION

Introduction

This is an application submitted by George Vasaris & Co of Second Floor, Law House, Kumul Highway, P.O. Box 166, Port Vila, VANUATU acting as agent for Munro Leys Lawyers & Notaries Public of Pacific House, Butt Street, GPO Box 149 Suva, FIJI.

Munro Leys is the authorize agent for Crystal Lagoons (Curacao) B.V. Kaya W.F.G. (Jombi), Mensing 14, Willemstad/CW.

The name of the inventor is Fernando Benjamin FISCHMANN of 12th Floor, Vitacura, Santiago, CHILE. The title of invention which seek patentability is: **Localized Disinfection System for Large Water Bodies.**

This application was first being filed in the European Patent Office on 18/12/2013 and the application was published on 25/06/2014. Patent was then granted on 5/08/2015. The Designated Contracting States to the European Patent Organisation are: Albania; Austria;

Belgium; Bulgaria; Switzerland; Cyprus; Czech Republic; Germany; Denmark; Estonia; Spain; Finland; France; United Kingdom; Greece; Croatia; Hungary; Ireland; Iceland; Italy; Liechtenstein; Lithuania; Luxembourg; Latvia; Monaco; Former Yugoslav Republic of Macedonia; Malta; Netherlands; Norway; Poland; Portugal; Romania; Serbia; Sweden; Slovenia; San Marino; and Turkey.

The priority date claimed under the Patent Corporation Treaty is 19/12/2012.

Field of the Invention

The present disclosure relates to a method for controlling the microbiological properties of a portion of water within large water bodies, by focusing on treating such portion of water, where said portion of the large water body complies with specific microbiological sanitary conditions. The present disclosure allows people to use large water bodies for recreational purposes in a safe manner, avoiding the treatment of the total water body. The method also comprises dispensing chemicals governed by a parameter determination method based on the ORP, the temperature, the salinity, and optionally the diffusion of chemicals, and the dilution power of the water as well. Thus, the present disclosure can allow people to use certain zones within large artificial or natural water bodies, such as lakes, lagoons, reservoirs, dams, spas, ponds, or the sea; for recreational purposes in a safe manner, overcoming the limitation or impossibility of treating the whole water body.

Legal Issue

The legal issue that needs to be decided is, Whether the Application meets the formality criteria under **section 16** the **Patent Act**.

Law

Since this is a Patent Application, the relevant applicable law is the **Patent Act No. 2 of 2003** and its subsequent sections which dictates the manner in which an application ought to be accessed to determine whether all requirements are being met by the Applicant.

Deliberations and Legal Analysis

I will now assess this application and state my reasons as to whether or not this Application meets the formality requirements. This is a preliminary issue that needs to be determine before the application is then referred to the next stage of search and substantive examination under **section 17, 18, and 19** of the Act.

The starting point of my legal reasoning begins with **section 16** and its subsequent **sections** of the **Patents Act**. It deals with the manner in which an application is being launched with the Registry. **Section 16** of the Act states: *16(1) The Registrar must, as soon as practicable*

after receiving an application, examine the application to determine whether the application complies with this Act.

(2) If the Registrar determines that application does not comply with this Act, the Registrar must: (a) tell the applicant this; and (b) ask the applicant to amend the application.

(3) Any amendment must not include additional matter that extends beyond the matter disclosed in the original application.

(4) If an application does not amend the application as asked, the Registrar may reject the application.

(5) The Registrar must tell the applicant in writing if the Registrar rejects the application and must state the reasons for rejection.

Pursuant to **section 16 (1)**, I am obliged to examine the application as to form to ensure that, all formalities are being met. This is the first step of examination, before moving to the substantive examination as directed by **section 17** of the Act. As such, fundamental procedural questions need to be asked. I am grateful for the examination of formalities as provided to me by IP Officer Sam Rallau. The procedural questions are as follows:

1. Is the appropriate form being filed by the applicant as required by section 12 (2) (a) of the Act?
2. Is the correct form being correctly filed?
3. Is the form duly completed and are the information provided correct and complete?
4. Does it provide information on the technical problem and the solution it is addressing?
5. Does it provide information on the technical field of the invention?
6. Who is the authorized representative (agent)?
7. The content of the request- specification containing a description of the invention, a claim defining the matter for which the application seeks protection and any drawing referred to in the description or claim and an abstract of the application pursuant to **section 12(1)(2)(3)(4)(5)** of the Act?
8. Does the information provide for in the specification is sufficiently concise and clear to aid understanding?
9. Check for priority dates if it complies with the requirement of **section 8** of the Act?
10. Check if the invention has already formed part of the state of the art - Novelty requirement under section 4 of the Act?

I will now address each question as per formality checklist.

1. **Is the appropriate form being filed by the applicant as required by section 12 (2) (a) of the Act?**

Section 12 (1) (2) (a) states: *(1) A person may apply for all grant of a patent by filing an application with the Registrar. (2) The application must: (a) be in a form approved by the Registrar;*

In light of the requirement of **section 12(2) (a)**, I bear in mind the term "must" as mandatory. Whilst conducting formality examination, it shows that the application was not submitted in the appropriate form that was approved by the Registrar. The application was submitted by a cover letter from Munro Leys Lawyers with another cover letter from George Vasaries & Co.

And so the application has failed to meet the requirements of **section 12 (1) (a)** of the Act.

2. Is the correct form being correctly filed?

Since the application was not being filled in the appropriate form, the content of the application where not being filed in the appropriate format.

3. Is the form duly completed and are the information provided correct and complete?

The answer to this question is in the negative, as the appropriate form was not being used and so the information required within the form was never filled by the applicant.

4. Does it provide information on the technical problem and the solution it is addressing?

The answer is in the affirmative, and the information is being provided in the earlier application that was filed in the European Patent Office. The legal issue is that, the Republic of Vanuatu is not a designated contracting party to the European Patent Organisation and so I am not obliged to adhere to their formalities. There is no legal instrument that binds me to accept this application once it is being filed in the European Patent Office. Also, the Parliament of the Republic of Vanuatu did not ratify and accede to the Patent Corporation Treaty. I am operating under the axis of the sovereignty of the Republic as per the Patent Act which was enacted by the Vanuatu Parliament. This is a cross border issue which requires an international legal instrument that dictates the processing and registration of Patent application within different sovereign States. At the moment such legal relationship is not in existence. I bear in mind the legal doctrine of "territoriality" within Intellectual Property Rights system.

5. Does it provide information on the technical field of the invention?

The answer is in the affirmative, and the information is being provided in the earlier application that was filed in the European Patent Office. However, as mentioned above, the current Patent Act does provide for formalities to be adhered to and the Applicant did not provide this information on the technical field of invention on the required form.

6. Who is the authorized representative (agent)?

The authorized agent is MUNRO LEYS Lawyers.

7. The content of the request- specification containing a description of the invention, a claim defining the matter for which the application seeks protection and any drawing referred to in the description or claim and an abstract of the application pursuant to section 12(1)(2)(3)(4)(5) of the Act?

The answer is in the affirmative, and the information is being provided in the earlier application that was filed in the European Patent Office. However, as mentioned above, the current Patent Act does provide for formalities to be adhered to and the Applicant did not provide that information on the technical field of invention on the required form.

As such, information provided is not being importantly filled within the appropriate sections of the required form for assessment purposes as to whether or not the application met the requirements of the local Patent's Act. Although much of the information is being contained in the earlier application, the Applicant is still obliged to comply with **section 12(1) (2) (a)** of the Act. I am obliged to observe all the letters of the law in this section.

8. Does the information provide for in the specification is sufficiently concise and clear to aid understanding?

The answer to that question is in the affirmative. The information provided in the attached earlier application filed in the European Patent Office. The information provided is sufficiently clear and concise to aid understanding for the invention to be evaluated, and implemented by a person skilled in the relevant art.

9. Check for priority dates if it complies with the requirement of section 8 of the Act?

Claiming for priority date is a legal right of the Applicant, and it must be stated in application form. In order to qualify and claim priority date, the Applicant must fulfil the requirements of **section 8** of the Act. **Section 8** states:

- (1) Subject to subsections (3) and (4), the priority date:
 - (a) of an invention to which an application for a patent relates; and*
 - (b) of any matter contained in the application; is the filing date of the application.**
- (2) Subsections (3) and (4) apply if:
 - (a) An application for a patent (in this section called the "current patent application") makes a declaration specifying one or more earlier relevant applications made by the applicant or a predecessor in title of the applicant; and*
 - (b) The relevant earlier application was filed during the 12 months before the filing date of the current patent application.**
- (3) If the invention to which the current patent application relates is supported by a matter disclosed in the earlier relevant application, the priority date of the invention is:
 - (a) The filing date of the earlier relevant application; or*
 - (b) If the matter was disclosed in more than one relevant application – the filing date of the earliest application.**
- (4) If any matter contained in the current patent application was also disclosed in an earlier relevant application, the priority date of the matter is:
 - (a) The filing date of the earlier relevant application; or*
 - (b) If the matter was disclosed in more than one relevant application – the filing date of the earliest application.**
- (5) In this section "relevant application" means:
 - (a) an application for a patent under this Act; or*
 - (b) an application in a convention country specified under section 9 for the protection for an invention.**

In this file, the Applicant has filed her application on 18/12/2013. Her application was published on 25/12/2014 and Letter of Patent was granted on 05/08/2015. Priority date was claimed to be 19/12/2012 as appeared on the European Patent Specification documents.

Applying law to the facts of this file, the status of this file is known as "current patent application" by virtue of **section 8(2) (a)**. She gained that status due to the fact, that the applicant had made a declaration of an earlier relevant application filed with the

European Patent Office. Under **section 8 (2)(b)**, it does prescribe a timeframe of 12 months in which, if this application is filed with the European Patent Office, the applicant is also obliged to launch this same application with the Vanuatu Intellectual Property Office.

The current Patent application was filed through the agent of Munro Leys Lawyers here in Vanuatu, which is George Vasaris & Co on 28th September 2016.

The earliest relevant date of the application is 18/12/2013. Counting the 12 month period within the legal rule of **section 8(2) (b)** would indicate that, the 12 month period would lapse on 18/12/2014. And so from 18/12/2013 to 18/12/2014, the applicant should file its application within this period of time to claim legal right to priority date.

However, the application was filed on 28 September 2016 through George Vasaris & Co acting on behalf of Munro Leys Lawyers as the authorised agent for the application. As such, the applicant has failed to meet the requirements of **section 8(2) (b)**.

There is also another issue that I would like to raise which caught my attention. Pursuant to the earlier filing of the current file with the European Patent Office, the date of the filing is 18/12/2013. The Applicant claim priority to be 19/12/2012. The rule in **section 8 (1)** is very clear. The right to claim priority only begins on the date when an application is filed. The Applicant cannot claim priority date as of 19/12/2012 when, she filed her application on 18/12/2013. There is inconsistency in her claim for priority date.

The rationale behind the rule of filing claim within the 12 months' period is to ensure that novelty of invention does not form state of the art of an existing invention widely in use. The mechanics of the law that protects novelty of an invention, is **section 4** of the Act. This is a requirement to claim patentability of a new invention. The 12 month period was adopted, and implanted into domestic legislation out of **Article 4 paragraph A, B, C (i)** of the **Paris Convention on the Protection of Industrial Property**.

Conclusion

Based on the above legal analysis and deliberations, I have reached my conclusions that, this application has failed to meet the requirements of the Patents Act. I am duty bound under **section 16(1)** to ensure that all applications received by the registry must comply with the precept of this Act. The Applicant has failed to file its application under the prescribe form as required under **section 12(2) (a)**. And secondly, that the claim for priority has failed due to the fact that, the application was

not launched within the 12 month period of which the earlier application was being filed with the European Patent Office. Therefore, the application did not meet the requirements of **section 8 (2) (a)**. I have also made my remarks in relation to the inconsistency between the filing dates and priority dates as shown from the Applicant's documents.

There is liberty to ask the applicant to amend its application and refile it with the registry as an option under **section 16 (2) (3)** of the Act. However, that exercise cannot be done as the 12 months period had lapse, and the invention may now become the state of the art. There is no logic in following that approach.

The elements of novelty requirement would no longer be valid as a condition precedent to determine the patentability of the application. I therefore humbly exercise my powers as Registrar under **section 16 (5)** of the **Patents Act** to reject this application.



Brittien Yosef

Registrar of Patents



Vanuatu Intellectual Property Office