

**REPUBLIC OF VANUATU**

**BILL FOR THE**  
**PATENTS ACT NO. OF 1999**

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**FINAL DRAFT AS AT 13<sup>TH</sup> SEPTEMBER 1999**

**REPUBLIC OF VANUATU**

**BILL FOR THE**  
**PATENTS ACT NO. OF 1999**

An Act to make provision for the registration of patents

**BE IT ENACTED** by the President and Parliament as follows:

**PART 1**

**PRELIMINARY PROVISIONS**

**INTERPRETATION**

1. In this Act unless the contrary intention appears:

"court" means the Supreme Court;

"examiner" means a person, organisation or international patent office that has been approved by the Registrar to deal with questions relating to patents, including the search and examination of applications for patents;

"exclusive licence" means a licence granted by the proprietor of; or the applicant for, a patent conferring on the licensee, or persons authorised by the licensee, the right to exploit the invention to which the patent or application relates to the exclusion of all other persons (including the proprietor or applicant);

"industry" includes activities related to manufacturing, handicrafts, agriculture, forestry, fisheries and services;

"international exhibition" means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;

"invention" means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;

"inventor", in relation to an invention, means the actual deviser of the invention;

"learned society" includes any club or association constituted in Vanuatu or outside Vanuatu whose main object is the promotion of any branch of learning or science;

"licence" means a licence to exploit, or to authorise the exploitation of, an invention;

"Minister " means the Minister responsible for the administration of patents;

"patent" means the title granted to protect an invention;

"patent application" means an application for a patent under section 12;

"patented invention" means an invention for which a patent is granted under this Act;

"prescribed" means prescribed by regulations made under this Act;

"proprietor" means the person for the time being entered in the Register as the proprietor of a patent;

"priority date" means the date determined as such under section 8;

"published" means made available to the public (whether in Vanuatu or outside Vanuatu) by any means, and includes publication in the Gazette;

"Register" means the Register of Patents kept under section 51;

"Registrar" means the Registrar of Patents appointed under section 50, and includes a person acting in the position of the Registrar;

"this Act" includes the regulations made under this Act.

## PART 2

### PATENTABILITY

#### **PATENTABLE INVENTION**

2. (1) Subject to section 3, an invention is patentable if it:
  - (a) is new; and
  - (b) involves an inventive step; and
  - (c) is capable of industrial application.
- (2) For the purposes of subsection (1), an invention may be a product or process and in any field of technology.

#### **INVENTIONS NOT PATENTABLE**

3. (1) An invention is not patentable if its publication or exploitation would generally be expected to encourage offensive, immoral or anti-social behaviours.
- (2) For the purposes of subsection (1), behaviour is not to be regarded as offensive, immoral or antisocial only because it is prohibited by any law in force in Vanuatu.
- (3) The following inventions are not to be patentable:
  - (a) plants or animals other than micro-organisms;
  - (b) biological processes for the production of plants or animals other than non-biological and micro biological processes;
  - (c) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
  - (d) a discovery, scientific theory or mathematical method;
  - (e) a scheme, rule, or method for performing a mental act, playing a game or doing business;
  - (f) a program for a computer.

- (4) Paragraph (3)(c) does not apply to a product consisting of a substance or composition which is invented for use in any such method mentioned in that paragraph.

## **NOVELTY**

- 4. (1) An invention is taken to be new if it does not form part of the state of the art.
- (2) State of the art in the case of an invention is taken to comprise all matter which has at any time before the priority date of that invention been made available to the public whether in Vanuatu or elsewhere by written or oral description or by use or in any other way.
- (3) State of the art in the case of an invention to which a patent application or a patent relates is to be taken also to comprise matter contained in an application for another patent which has been published on or after the priority date of that invention if:
  - (a) the matter was contained in the application for that other patent as filed and published; and
  - (b) the priority date of that matter is earlier than that of the invention.
- (4) For the purposes of subsections (2) and (3), the matter may be a product, process or information about a product or processor any thing.

## **CERTAIN DISCLOSURES TO BE DISREGARDED**

- 5. (1) For the purposes of section 4, a disclosure of a matter constituting an invention is to be disregarded in the case of a patent or an application for a patent if the disclosure:
  - (a) occurred within 12 months before the date of the patent application; and
  - (b) is a disclosure to be disregarded under subsection (2).
- (2) The following disclosures are to be disregarded:
  - (a) a disclosure, if it was made due to, or in consequences of, the matter having been obtained unlawfully or in breach of confidence by a person from one of the following:
    - (i) the inventor;

- (ii) a person to whom the matter was made available in confidence by the inventor;
  - (iii) a person who obtained the matter from the inventor because the person or the inventor believed that the person was entitled to obtain it; or
- (b) a disclosure of a matter if it was made in breach of confidence by any person who obtained the matter in confidence from:
  - (i) the inventor; or
  - (ii) from any other person to whom the matter was made available or who obtained the matter from the inventor;
- (c) a disclosure if it was made due to, or in consequence of:
  - (i) the inventor displaying the invention at an international exhibition; and
  - (ii) the applicant states, on filing the application, that the invention has been so displayed;
- (d) a disclosure if it was made due to, or in consequence of, the inventor describing the invention in a paper:
  - (i) read by him or her, or another person with his or her consent or on his or her behalf, before any learned society; or
  - (ii) published with his or her consent in the transactions of any learned society.

## **INVENTIVE STEP**

6. An invention is to be taken to involve an inventive step if it is not obvious to a person skilled in the relevant art when compared to any matter which comprises the state of the art under subsection 4(2).

## **INDUSTRIAL APPLICATION**

7. An invention is to be taken to be capable of industrial application if it can be made or used in any kind of industry.

## **PRIORITY DATE**

8. (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 applicant for a patent application (in this section called the “current patent application”) makes a declaration specifying one or more earlier relevant applications made by the applicant or any predecessor in title of the applicant; and
- (b) the relevant earlier application or applications were 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 or applications, 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 or applications, 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 any of the following:

- (a) an application for a patent under this Act; or
- (b) an application in a convention country specified under section 9 for protection in respect of an invention.

## **CONVENTION COUNTRIES**

9. The Minister may, with a view to the fulfilment of any treaty, convention or other arrangement, by order published in the Gazette, declare that any country specified in the order is a convention country for the purposes of section 12.

## PART 3

### RIGHT TO OBTAIN A PATENT

#### **RIGHT TO OBTAIN PATENT**

10. (1) A patent for an invention may only be granted to:
- (a) the inventor or joint inventors; or
  - (b) any person who under any Act or law (including a foreign Act or law) was at the time of making the invention entitled to the whole of the property in it (other than the equitable interest) in Vanuatu; or
  - (c) the successor or successors in title of any person mentioned in paragraph (a) or (b).
- (2) A patent may be granted to a person whether or not he or she is a citizen of Vanuatu.
- (3) If 2 or more persons have jointly made an invention, the right to patent the invention belongs to them jointly.

#### **MENTION OF INVENTOR**

11. (1) An inventor or joint inventors of an invention have a right to be mentioned as such:
- (a) in a patent granted for the invention; and
  - (b) if possible, in any application for a patent for the invention.
- (2) An applicant for a patent must, not later than one month after filing the application, file with the Registrar a statement:
- (a) identifying the person or persons whom the applicant believes to be the inventor or inventors; and
  - (b) if the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or her, or their right to be granted the patent.

- (3) If a person ("the inventor") has been mentioned as a sole or joint inventor in accordance with this section, any other person who alleges that the inventor ought not to have been so mentioned may apply to the Registrar for a certificate to that effect.

## PART 4

### APPLICATION FOR PATENTS

#### **MAKING OF APPLICATION**

12. (1) A person may apply for the grant of a patent by filing an application with the Registrar.
- (2) The application must:
- (a) be in a form approved by the Registrar; and
  - (b) be accompanied by the prescribed fee.
- (3) An application must contain:
- (a) a request for the grant of a patent; and
  - (b) a specification containing:
    - (i) a description of the invention; and
    - (ii) a claim or claims defining the invention; and
    - (iii) any drawing referred to in the description or any claim; and;
  - (c) an abstract of the specification.
- (4) The specification of an application must:
- (a) disclose the invention in a sufficiently clear and complete manner for the invention to be evaluated and carried out by a person skilled in the relevant art; and
  - (b) indicate the best method known to the applicant for carrying out the invention.
- (5) The claim or claims must:
- (a) be clear and concise; and
  - (b) be supported by the description of the invention; and
  - (c) relate to one invention or a group of inventions which are so limited as to form a single inventive concept.

- (6) An application for a patent may be withdrawn at any time before the patent is granted.
- (7) A person may make an application for the grant of a patent either alone or jointly with another.

#### **FILING DATE OF APPLICATION**

- 13. The filing date of an application for a patent:
  - (a) is the date on which the applicant files the application with the Registrar; or
  - (b) if the regulations provide for the determination of a different date as the filing date - the date determined under the regulations.

#### **PUBLICATION OF APPLICATION**

- 14. (1) The Registrar must, as soon as practicable after an application for a patent is filed, publish the application, or such details of the application as are prescribed, in the Gazette.
- (2) The Registrar must not publish an application or the prescribed details if the application is withdrawn.
- (3) The Registrar may omit from the specification of an application for a patent any matter:
  - (a) that in the Registrar's opinion is likely to damage a person; or
  - (b) the publication or exploitation of which would in the Registrar's opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

#### **INFORMATION PREJUDICIAL TO DEFENCE OF VANUATU OR SAFETY OF PUBLIC**

- 15. If it appears to the Registrar that an application filed with the Registrar contains information that might be prejudicial to:
  - (a) the defence of Vanuatu; or
  - (b) the safety of the public;

the Registrar may give directions prohibiting or restricting the publication of that information or its communication to any specified person.

## PART 5

### PROCEDURE FOR GRANT OF PATENT

#### **EXAMINATION AS TO FORM**

16. (1) The Registrar on receiving an application for a grant of patent, must as soon as practicable, examine the application so as to determine whether the application complies with the requirements of this Act.
- (2) If the Registrar determines the application does not comply with the requirements, Registrar must request the applicant to amend the application so as to comply with the requirements.
- (3) If an applicant amends an application, the amendment must not include additional matter that extends beyond that which is disclosed in the application.
- (4) If an applicant fails to amend the application as requested, the Registrar may reject the application.
- (5) The Registrar must notify the applicant in writing if the Registrar rejects the application and must state the reason for the rejection in the notice.

#### **SEARCH AND EXAMINATION**

17. (1) If, after an examination under subsection 16(1), the Registrar is satisfied that an application complies with the requirements of this Act, the Registrar must, in writing, notify the applicant of this.
- (2) The applicant, on being notified under subsection (1), must make:
- (a) a request for a search; or
- (b) a request for a search and examination.
- (3) A request must be made with the prescribed period (if any) or within such other period as the Registrar specifies, and must be accompanied by the prescribed fee.
- (4) If the applicant fails to comply with subsection (2) or (3), the Registrar must treat the application as having been abandoned.
- (5) If the applicant has alone or jointly filed one or more corresponding international applications for a patent, the applicant must, within one

month after receiving the notice under subsection (1), give to the Registrar details of the application or those applications.

## **PROCEDURE FOR SEARCH**

18. (1) If the applicant has made a request under paragraph 17(2)(a), the Registrar must refer the application to an examiner for a search to discover the prior relevant art (if any) contained in the application or such documents as may be prescribed.
- (2) On receiving the search report from the examiner, the Registrar must send a copy of the report to the applicant.
- (3) On receiving a copy of the search report, the applicant may make a request and pay the prescribed fee to the Registrar for the Registrar to refer the application to an examiner to determine:
- (a) whether the invention satisfies the criteria in subsection 2(1); and
  - (b) the specification complies with subsection 12(4) and (5).
- (4) The Registrar must on receiving an examination report send a copy of the report to the applicant.
- (5) The Registrar may, from time to time, by notice in writing, direct the applicant to inform the Registrar of the results of the searches specified in the notice, being searches carried out in a foreign country by an examiner in respect of a corresponding application referred to in subsection 17(5).

## **PROCEDURE FOR SEARCH AND EXAMINATION**

19. (1) If the applicant made a request under paragraph 17(2)(b), the Registrar must refer the application to an examiner for:
- (a) a search to discover the prior relevant art (if any) contained in the application; and
  - (b) an examination so as to determine:
    - (i) whether the invention satisfies the criteria in subsection 2(1); and
    - (ii) the specification complies with subsection 12(4) and (5).



- (2) The Registrar must on receiving the search and examination report send a copy of the report to the applicant.

## **GRANT OF PATENT**

20. The Registrar must grant the applicant for a patent if the Registrar is satisfied that:
- (a) the application complies with all the requirements of this Act; and
  - (b) the search reports and/or examination reports have been received by the Registrar in accordance with the requirement of this Act; and
  - (c) the prescribed fee for the grant of a patent has been paid; and
  - (d) there is no opposition to the grant of the patent.

## **DISPUTES BETWEEN APPLICANTS**

21. If a dispute arises between any 2 or more interested parties in relation to a patent application as to whether, or in what manner, the application should proceed, the Registrar may make any determinations the Registrar thinks fit:
- (a) for enabling the application to proceed in the name of one or more of the parties alone; or
  - (b) for regulating the manner in which it is to proceed.

## **OPPOSED APPLICATIONS**

22. (1) If the grant of a patent is opposed, the Registrar must give the parties concerned an opportunity to be heard.
- (2) The regulations may prescribe how an application for a patent that is opposed is to be determined by the Registrar.

## PART 6

### REGISTRATION OF PATENTS

#### **PUBLICATION AND CERTIFICATE OF GRANT**

23. (1) As soon as practicable after a patent has been granted under this Act, the Registrar must publish in the Gazette:
- (a) a notice that it has been granted; and
  - (b) the specification of the patent; and
  - (c) the names of the proprietor and (if different) the inventor.
- (2) The Registrar must send the proprietor of the patent a certificate of registration that the patent has been granted to the proprietor.

#### **PATENT TO BE RECORDED IN THE REGISTER**

24. The Registrar must record in the Register every patent granted by the Registrar in the order of grant specifying the following:
- (a) the number of the patent;
  - (b) the name and address of the proprietor;
  - (c) if the proprietor is resident outside Vanuatu, a postal address for service in Vanuatu;
  - (d) the dates of application and grant;
  - (e) any change in the ownership of the patent application or patent;
  - (f) any amendment or division of the patent application;
  - (g) any assignment or transmission of the patent application or patent;
  - (h) any valid claim to priority;
  - (i) the surrender or revocation of the patent;
  - (j) other prescribed matters.

## **DURATION OF PATENT**

25. (1) A patent granted under this Act continues in force for a period of 20 years starting on the filing date of the application for the patent.
- (2) A patent ceases if the proprietor does not pay the annual prescribed renewal fee for the patent each year.

## **DETERMINATION OF RIGHT TO PATENT AFTER GRANT**

26. (1) After a patent has been granted for an invention, any person having or claiming a proprietary interest in or under the patent may refer to the Registrar the question:
- (a) who is or are the true proprietor or proprietors of the patent; or
  - (b) whether the patent should have been granted to the person or persons to whom it was granted; or
  - (c) whether any right in or under the patent should be transferred or granted to any other person or persons;
- (2) On a reference under subsection (1), the Registrar must determine the question and make such other order as the Registrar thinks fit to give effect to the determination.
- (3) Without limiting subsection (1), an order under that subsection may contain the all or any of the following provisions:
- (a) directing that the person by whom the reference is made must be included among the persons registered as proprietors of the patent; and
  - (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;
  - (c) granting any licence or other right in or under the patent;
  - (d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.
- (4) The Registrar must not make an order unless notice of the reference is given to all persons registered as proprietors of the patent.

- (5) If it appears to the Registrar on a reference that the question referred would more properly be determined by the court, the Registrar may decline to deal with it and refer it to the court for determination.

## PART 7

### RIGHTS OF PROPRIETOR OF PATENT

#### **PROPRIETOR'S RIGHTS**

27. (1) The proprietor of a patent has the exclusive rights to exploit the patented invention and to authorise another person to exploit the invention.
- (2) For the purposes of this section, "exploit" in relation to a patented invention means:
- (a) if the patent has been granted in respect of a product:
    - (i) making, importing, offering for sale, selling and using the product; or
    - (ii) keeping the product for the purposes of offering for sale, selling or using;
  - (b) if the patent has been granted in respect of a process:
    - (i) using the process;
    - (ii) doing any of the acts referred to in paragraph (a) in respect of a product obtained directly by means of the process.
- (3) The proprietor also has the right:
- (a) to assign the patent; and
  - (b) to transfer by succession the patent; and
  - (c) to enter into licensing contracts.

#### **LIMITATION OF PROPRIETOR'S RIGHTS**

28. The provisions of section 27:
- (a) extend only to acts done for industrial or commercial purposes and in particular not to acts done only for scientific research; and

- (b) do not preclude a person having the rights referred to in section 29 or a licensee from exploiting the patented invention; and
- (c) do not extend to the presence or use of products or foreign vessels, aircraft, spacecraft, or vehicles that temporarily or accidentally enter the waters, airspace or territory of Vanuatu.

## **RIGHTS DERIVED FROM PRIOR MANUFACTURE OR USE**

29. (1) Subject to subsection (2), if a person at the priority date of the patent application:

- (a) was in Vanuatu and was, in good faith, making the product or using the process which is the subject of the invention claimed in the application; or
- (b) had in good faith made in Vanuatu serious preparations towards the making of the product or using the process referred to in paragraph (a);

the person has the right to exploit the patented invention, despite the grant of the patent.

(2) The person referred to in subsection (1) must:

- (a) make the product or use the process which is the subject of the invention in Vanuatu; and
- (b) prove that, if the invention was disclosed under the circumstances referred to in subsection 9(2), that his or her knowledge of the invention was not a result of the disclosure.

(3) The right referred to in subsection (1) must not be assigned or transmitted except as part of the business of the person concerned.

## PART 8

### ASSIGNMENT AND TRANSMISSION AND JOINT PROPRIETORSHIP

#### **ASSIGNMENT AND TRANSMISSION OF PATENT APPLICATIONS AND PATENTS**

30. (1) A patent application may be assigned or transmitted by the applicant and a patent may be assigned or transmitted by the proprietor.
- (2) A person who is entitled by assignment or transmission to a patent application or patent may apply in writing to the Registrar to have the assignment or transmission recorded in the register.
- (3) The Registrar must not record the assignment or transmission in the Register unless:
- (a) the prescribed fee has been paid to the Registrar; and
  - (b) in the case of an assignment, it is in writing and signed by or on behalf of the assignor and the assignee.
- (4) An assignment or transmission does not have effect against third parties unless it is recorded in the Register.

#### **JOINT PROPRIETORSHIP OF PATENT**

31. In the absence of any agreement to the contrary between the parties, joint applicants of a patent application and joint proprietors of a patent:
- (a) may separately:
    - (i) assign or transmit their rights in the patent application or patent; or
    - (ii) exploit the patented invention; or
    - (iii) take action against a person who exploits the patented invention without their consent; or
  - (b) may jointly:
    - (i) withdraw the patent application; or
    - (ii) surrender the patent; or

- (iii) enter into a licensing contract.



## PART 10

### LICENCES OF RIGHT AND COMPULSORY LICENCES

#### **LICENCE OF RIGHT**

32. (1) At any time after the grant of a patent its proprietor may apply to the Registrar for an entry to be made in the register to the effect that licences under the patent are to be available as of right.
- (2) If an application under subsection (1) is made, the Registrar must:
- (a) give notice of the application to any person registered as having a right in or under the patent; and
  - (b) if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent - make the entry referred to in the application.
- (3) If an entry under subsection (2) is made any person is at anytime after the entry is made to be entitled as of right to a licence under the patent on the terms as may be settled:
- (a) by agreement; or
  - (b) in default of agreement, by the Registrar on the application of the proprietor of the patent or the person requiring the licence.
- (4) The Registrar may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled.

#### **CANCELLATION OF ENTRY**

33. (1) At any time after an entry has been made under section 33 in respect of a patent, the proprietor of the patent may apply to the Registrar for cancellation of the entry.
- (2) The Registrar may cancel the entry if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.
- (2) If an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent are after the cancellation to be the same as if the entry had not been made.

## **COMPULSORY LICENCES**

34. (1) At anytime after the expiration of:
- (a) 3 years from the date of the grant of a patent; or
  - (b) 4 years from the filing date of the patent application;
- whichever is the later, a person may apply to the court for the grant of a licence under the patent upon any of the grounds specified in subsection (2).
- (2) The grounds upon which a licence may be granted under this section are that in Vanuatu a market for the patented invention is:
- (a) not being supplied; or
  - (b) not being supplied on reasonable terms.
- (3) If the court is satisfied that either of the grounds referred to in subsection (2) is established, the court may make an order for the grant of a licence in accordance with the application upon such terms as the court thinks fit.
- (4) A licence granted under this section:
- (a) is not exclusive; and
  - (b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and
  - (c) is limited to the supply of the patented invention predominantly in Vanuatu.
- (5) A licence granted under this section may, on the application of any interested party, be terminated by the court if the court is satisfied that the ground upon which the licence was granted has ceased to exist.

## **USE OF PATENTED INVENTIONS FOR SERVICES OF GOVERNMENT**

35. (1) Subject to section 37, the Government, and any person authorised in writing by the Government, may make use, exercise and sell any patented invention for the services of the Government.
- (2) Anything done under subsection (1) does not amount to an infringement of the patent.

- (3) The purchaser of any articles sold in the exercise of the powers conferred by this section, and any person claiming through the purchaser, has power to deal with articles in the same manner as if the patent were held on behalf of the Government.

#### **DUTY TO INFORM PROPRIETOR**

36. If any use of a patented invention is made by or with the authority of the Government under section 36, the Government must, as soon as practicable after the use of the patented invention has begun, notify and furnish the proprietor with such information as to the extent of the use as the proprietor may from time to time reasonably require.

#### **PROPRIETOR ENTITLED TO REMUNERATION**

37. If an Act is done under section 36, the Government must pay such remuneration to the proprietor as may be agreed, or as may be determined by a method agreed between the Government and the patentee having regard to the economic value of the patented invention.

## PART 10

### SURRENDER AND REVOCATION OF PATENTS

#### **SURRENDER OF PATENTS**

38. (1) The proprietor of a patent may at any time by notice given to the Registrar offer to surrender his patent.
- (2) A person may give notice to the Registrar of the person's opposition to the surrender of a patent, and if the person does so the Registrar must notify the proprietor of the patent and determine the question.
- (3) If the Registrar is satisfied that the patent may properly be surrendered, the Registrar must:
- (a) accept the offer; and
  - (b) record it in the Registrar; and
  - (c) publish the record in the Gazette.
- (4) The surrender is to take effect from the date that Registrar accepts the offer under subsection (3).
- (5) An action for infringement does not lie in respect of any act done before the date of acceptance referred to in subsection (3).
- (6) A right to compensation does not accrue for any use of a patented invention before that date for the services of the Government.

#### **POWER TO REVOKE PATENTS ON APPLICATION**

39. (1) Subject to the provisions of this Act, the Registrar may, on the application of any person, by order in writing revoke a patent for an invention on the following grounds:
- (a) the invention is not a patentable invention;
  - (b) the patent was granted to a person who was not entitled to be granted that patent;
  - (c) the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;

- (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed;
  - (e) the protection conferred by the patent has been extended by an amendment which should not have been allowed;
  - (f) the applicant for the patent has:
    - (i) failed to inform the Registrar about any corresponding international application or filed by him as required under section 17; or
    - (ii) furnished any information which is false in a material particular; or
  - (g) the patent was obtained on a misrepresentation.
- (2) On receiving an application for an order to revoke a patent on any of the grounds specified in paragraph (1)(a), (c), (d) or (e), the Registrar may, subject to subsections (3) and (4):
- (a) cause the patent to be re-examined by an examiner so as to determine whether the patent should be revoked on any of these grounds; and
  - (b) require the applicant to pay the prescribed re-examination fee.
- (3) The Registrar must not cause a patent to be re-examined if the applicant for the revocation of the patent fails to give such security for the costs or expenses of the proceedings as the Registrar may specify.
- (4) If the applicant fails to give such security the application for revocation is to be treated as having been abandoned.
- (5) An application for the revocation of a patent on the grounds mentioned in paragraph (1)(b) may only be made by a person:
- (a) found by the court in an action for a declaration; or
  - (b) found by the court or the Registrar on a reference under this Act;
- to be entitled to be granted that patent.
- (6) An order under this section revoking a patent has effect from the date of the grant of the patent.
- (7) An application for an order to revoke a patent must be made in writing and be accompanied by the prescribed fee.

## **REGISTRAR'S POWER TO REVOKE PATENTS**

40. (1) If it appears to the Registrar that an invention for which a patent has been granted formed part of the state of the art by virtue only of subsection 4(3), the Registrar by order in writing revoke the patent.
- (2) The Registrar must before making an order give the proprietor of the patent an opportunity of being heard and amending the specification of the patent.

## PART 11

### ACTS OF INFRINGEMENT

#### **ACTS OF INFRINGEMENT**

41. (1) A person infringes a patent if while the patent is in force, the person does any of the following things in Vanuatu in relation to the invention protected by the patent.
- (a) if the invention is a product – the person makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise; or
  - (b) if the invention is a process – the person uses the process, or offers it for use in Vanuatu when the person knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent; or
  - (c) if the invention is a process – the person disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.
- (2) An act referred to in subsection (1) does not constitute an infringement of a patent if:
- (a) it is done privately and for purposes which are not commercial; or
  - (b) it is done for experimental purposes relating to the subject-matter of the invention; or
  - (c) it consists of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared.

#### **PROCEEDINGS FOR INFRINGEMENT OF PATENT**

42. (1) The proprietor of a patent may bring proceedings in court in respect of any act alleged to infringe the patent.
- (2) Without prejudice to any other jurisdiction of the court, in the proceedings referred in subsection (1), a claim may be made for:

- (a) an injunction restraining the defendant from any alleged act of infringement; or
  - (b) an order for the defendant 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; or
  - (c) damages in respect of the infringement; or
  - (d) an account of the profits derived by the defendant from the infringement; or
  - (e) a declaration that the patent is valid and has been infringed by the defendant.
- (3) The court must not, in respect of the same infringement, both award the proprietor of a patent damages and order the proprietor be given an account of the profits.
- (4) The court may grant any kind of relief claimed under subsection (2), and such other relief as to the court appears just and appropriate.

#### **REVERSAL OF BURDEN OF PROOF**

43. (1) In any proceedings for the infringement of a patent, if the subject matter of the patent is a process for obtaining a new product, the burden of proving that a product is not made by the process is on the alleged infringer if:
- (a) the product is new; or
  - (b) a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used.
- (2) In considering whether a party has discharged the burden imposed upon him or her by this section, the court must not require him or her to disclose any manufacturing or commercial secrets if it appears to the court that it would be unreasonable to do so.

#### **PROCEEDINGS FOR INFRINGEMENT BY EXCLUSIVE LICENSEE**

44. (1) The holder of an exclusive licence under a patent has 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.



- (2) In awarding damages or granting any other relief in any such proceedings, the court must take into consideration:
  - (a) any loss suffered or likely to be suffered by the exclusive licensee as a result of the infringement; or
  - (b) as the case may require, 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 under this section the proprietor of the patent must be made a party to the proceedings.
- (4) However, a defendant must not be liable for any costs or expenses unless the defendant enters an appearance and takes part in the proceedings.

## **DECLARATION AS TO NON-INFRINGEMENT**

- 45. (1) Without limiting the jurisdiction of the court to make a declaration, the court may make a declaration, that:
  - (a) an act does not; or
  - (b) a proposed act would not;constitute an infringement of a patent in proceedings between the person doing or proposing to do the act and the proprietor of the patent.
- (2) The declaration referred to in subsection (1) may be made notwithstanding that no assertion to the contrary has been made by the proprietor if it is shown that:
  - (a) the person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished the proprietor with full particulars in writing of the act in question; and
  - (b) the proprietor has refused or failed to give any such acknowledgment.

## **APPEALS**

- 46. (1) A person may appeal to the court against a decision or order made by the Registrar under this Act.
- (2) In an appeal, the court has and may exercise the same discretionary powers as under this Act conferred upon the Registrar.

- (3) Every judgement or order of the court under this Act is subject to an appeal to the Court of Appeal.

## PART 12

### REGULATIONS AND OFFENCES

#### **REGULATIONS**

47. (1) The Minister may make regulations for the purpose of:
- (a) carrying out or giving effect to the principles and provisions of this Act; and
  - (b) in particular in respect of any matter required under this Act to be prescribed.
- (2) Without limiting subsection (1), the Minister may make regulations in respect of any or all of the following matters:
- (a) for regulating the operations of the Registrar in relation to patents;
  - (b) for regulating all matters by this Act placed under the direction or control of the Registrar;
  - (c) for prescribing the form and manner of execution of applications of patents and of any specifications, or drawings, or other documents which may be filed with the Registrar;
  - (d) for regulating the procedure to be followed in connection with any proceeding before the Registrar and authorising the rectification of irregularities of the procedure;
  - (e) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the Registrar and for remission of fees in the prescribed circumstances;
  - (f) for authorising the preparation, publication, sale, and exchange of copies of specifications, drawings, and other documents relating to patents.
- (3) The Minister may make regulations to provide for an extension of time for any period of time specified for the doing of an act in relation to an application for patent or in proceedings under this Act, not being proceedings in court.
- (4) The regulations may:

- (a) contain such provisions as the Minister thinks fit:
  - (i) regulating the circumstances in which such an extension may be granted; and
  - (iii) providing for the protection and compensation of persons affected by the grant of an extension of time; and
- (b) authorise the Registrar to grant an extension of time notwithstanding that the period has already expired.

#### **FALSIFICATION OF REGISTER ETC.**

48. If a person makes or causes to be made:

- (a) a false entry in the Register; or
- (b) written statement purporting to be a copy or reproduction of an entry in the Register; or
- (c) produces or tenders or causes to be produced or tendered in evidence any such written statement;

knowing the entry or statement to be false, the person is guilty of an offence punishable on conviction by a fine of not more than VT1,000,000 or imprisonment for not more than 1 year, or both.

#### **UNAUTHORISED CLAIM OF PATENT RIGHTS**

49. (1) If a person falsely represents that anything disposed of by the person for value is a patented product, the person is guilty of an offence punishable on conviction by a fine of not more than VT1,000,000 or imprisonment for not more than 1 year or both.

(2) For the purpose of subsection (1), a person who for value disposes of:

- (a) an article having stamped, engraved or impressed on it or otherwise applied to it the word 'patent' or 'patented'; or
- (b) anything expressing or implying that the article is a patented product;

is taken to represent that the article is a patented product.

(3) Subsection (1) does not apply if:

- (a) the representation is made in respect of a product after the patent for that product, or the process in question, as the case requires, has expired or been revoked; and
  - (b) the representation is made 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 is a defence for a person to prove that the person used due diligence to prevent the commission of the offence.

## PART 13

### ADMINISTRATION

#### **REGISTRAR OF PATENTS**

50. (1) There is to be a Registrar of Patents to be appointed by the Public Service Commission in accordance with the Public Service Act No. 11 of 1998.
- (2) The Registrar has the powers and functions given to him or her under this Act.

#### **REGISTER OF PATENTS**

51. (1) The Registrar is to keep a Register of Patents.
- (2) The Register may be kept wholly or partly by use of a computer.

## PART 14

### MISCELLANEOUS

#### **IMMUNITY OF GOVERNMENT, ITS OFFICERS AND EXAMINERS**

52. The Government, the Registrar and any examiner:
- (a) does not to be taken to warrant the validity of a patent granted under this Act; nor
  - (b) does incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act.

#### **REPEAL OF THE REGISTRATION OF UNITED KINGDOM PATENTS ACT**

53. (1) The Registration of United Kingdom Patents Act [CAP. 80] is repealed.
- (2) Notwithstanding the repeal of the Registration of United Kingdom Patents Act [CAP. 80], every rule or regulation as is in force on the date of commencement of this Act is taken to be a regulation made under this Act in so far as the rule or regulation is not inconsistent with this Act.
- (5) The validity of the original entry of a patent on the register of patents existing under the repealed Act before the date of commencement of this Act must be determined in accordance with the law in force at the date of such entry.
- (6) Every such patent must retain its original date but for all purposes it is to be taken to have been registered under this Act.

#### **COMMENCEMENT**

54. This Act commences on the date of its publication in the Gazette.