

REPUBLIC OF VANUATU

BILL FOR THE **TRADEMARKS ACT** **NO. _____ OF 1999**

Explanatory Note

This note does not form part of the Bill.

The purpose of this Bill is to provide for the registration of trademarks, and to set out and protect the rights deriving from registration.

The Bill reflects international trends towards greater uniformity in the field of intellectual property law. In particular, this Bill conforms with the minimum standards and principles prescribed for trademarks in the international Agreement on Trade-Related Aspects of Intellectual Property Rights.

Part 1 Preliminary

This Part contains definitions and terms that are used frequently throughout this Bill.

Part 2 Trademarks and Trademark Rights

This Part explains what is a trademark and sets out the rights given by this Act to the registered owner and any authorised user of a registered trademark, such as the right to exclusive use of the trademark.

Part 3 Application for Registration

Division 1 - General

This Division deals with the steps to take to have a trademark registered, such as who may apply and how to apply, and gives the Registrar the power to make the initial decision whether to accept the application.

Division 2 - Grounds for rejecting application

This Division sets out the grounds on which the Registrar may reject an application for registration of a trademark, such as a trademark that contains material contrary to law, or that is likely to deceive or cause confusion.

Part 4 Opposition to Registration

Division 1 - General

This Division deals with opposition to registration of a trademark, such as how to oppose an application for registration.

Division 2 - Grounds for opposing registration

This Division sets out the grounds on which a person may object to the registration of a trademark. The grounds include the same grounds on which the application could be opposed under Part 3, as well as grounds that the trademark is similar to an existing registered trademark, the person applying for registration does not own or intend to use, the trademark or that the trademark consists of a false geographic indication.

Part 5 Amendment of application for registration of a trademark and other documents

This Part sets out how and in what circumstances an application for registration of a trademark may be amended, and deals with amendment before and after details of the application have been published.

Part 6 Registration of trademarks

Division 1 - General

This Division deals with the registration of trademarks by the Registrar, how they are registered, the term of registration, and when registration ceases.

Division 2 - Renewal of registration

This Division sets out what must be done to renew the registration of a trademark, including when renewal may be applied for.

Part 7 **Amendment and cancellation of registration**

This Part sets out how and why particulars of registered trademarks may be amended, and registration cancelled. The grounds for cancellation include that registration was obtained by fraud or misrepresentation, any of the grounds on which registration could have been opposed.

Part 8 Removal of trademark from Register for non-use

This Part deals with the removal of trademarks from the register on the grounds that the trademark has not been used, and sets out who may apply and how an application is opposed.

Part 9 Assignment and transmission of trademarks

This Part deals with the assignment of registered trademarks and of trademarks whose registration has been sought, and with the registration and other recording of assignments

Part 10 Voluntary recording of claims to interests in and rights to trademarks

This Part deals with the recording of the rights and interests that persons (other than registered owners) may have in registered trademarks or trademarks whose registration is being sought, being rights that cannot be recorded under Part 9.

Part 11 Infringement of trademarks

This Part sets out what constitutes an infringement of a trademark, such as using a trademark that is substantially similar to a registered trademark, or using a registered trademark without the consent of the registered owner of the trademark. It also deals with how to obtain redress and relief in cases of infringement.

Part 12 Offences

This Part makes certain types of conduct, such as falsifying a trademark and selling goods with false trademarks, offences against the Act

Part 13 Collective trademarks

This Part deals with collective trademarks, that is, trademarks that may be owned by members of a trade association. It provides that the Act applies to collective trademarks, subject to some changes, including that a collective trademark cannot be assigned.

Part 14 **Jurisdiction and powers of courts**

This Part deals with the jurisdiction of the Supreme Court to hear and determine matters arising under the Bill. It sets out the circumstances when a person aggrieved by a decision of the Registrar may appeal to the Supreme Court, and provides a right of appeal to the Court of Appeal.

Part 15 **Administration**

This Part deals with the Registrar and the keeping of the Register of Trademarks. It provides for the Registrar to be appointed by the Public Service Commission, for the Registrar to be responsible for keeping the Register, and allows for the Register to be kept by computer.

Part 16 **Miscellaneous**

This Part deals with miscellaneous matters such as an address for service, the fixing of fees for applications and other matters under the Bill, the service of documents and the making of regulations. It also deals with the repeal of the *Registration of United Kingdom Trademarks Act* [Cap 81], and how matters dealt with under that Act are to be dealt with under the Bill.

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Arrangement of sections

PART 1- PRELIMINARY

1. Interpretation
2. Use of trademark
3. Definitions of “authorised user” and “authorised use”
4. Definition of “applied to” and “applied in relation to”
5. Definition of “deceptively similar”
6. Definition of “priority date”
7. Definition of “similar goods” and “similar services”
8. Definition of “originate” for wine

PART 2 - TRADEMARKS AND TRADEMARK RIGHTS

9. What is a trademark
10. Certain signs not to be used as trademarks
11. Certain trademarks may be registered
12. Rights given by registration of trademark
13. Power of registered owner to deal with trademark
14. When trademark becomes accepted as sign describing article etc
15. Powers of authorised user of trademark

PART 3 - APPLICATION FOR REGISTRATION

Division 1 - General

16. Application - how made
17. Application for registration of trademark whose registration has been sought in a Convention country - priority

18. Particulars of application to be published
19. Registrar to decide application
20. Applications accepted or rejected
21. Notice etc of decision
22. Lapsing of application
23. Revocation of application

Division 2 - Grounds for rejecting application

24. Trademarks containing etc certain signs
25. Trademark that cannot be represented graphically
26. Trademark not distinguishing applicant's goods or services
27. Trademark scandalous or its use contrary to law
28. Trademark likely to deceive or cause confusion
29. Identical etc trademarks

PART 4 - OPPOSITION TO REGISTRATION

Division 1 - General

30. Opposition
31. Opposition proceedings
32. Decision

Division 2 - Grounds for opposing registration

33. Registration may be opposed on same grounds as for rejection
34. Applicant does not own, or intend to use, trademark
35. Trademark similar to trademark that has acquired a reputation in Vanuatu
36. Trademark containing or consisting of a false geographical indication
37. Application defective

PART 5 - AMENDMENT OF APPLICATION FOR REGISTRATION AND OTHER DOCUMENTS

38. Amendment of application for registration
39. Amendment before particulars of application have been published
40. Amendment after particulars of application have been published
41. Amendment of other documents

PART 6 - REGISTRATION OF TRADEMARKS

Division 1 - Initial registration

42. Obligation to register
43. Registration - how effected
44. Colours in registered trademark
45. Notification of registration
46. Date and term of registration

47.Ceasing of registration

Division 2 -Renewal of registration

48.Request for renewal

49.Renewal before registration expires

50.Failure to renew

51.Renewal within 90 days after registration expires

PART 7 - AMENDMENT AND CANCELLATION OF REGISTRATION

52.Correction of Register

53.Cancellation of registration by Registrar

54.Amendment or cancellation because of contravention of condition

55.Amendment or cancellation - loss of exclusive right to use trademark

56.Amendment or cancellation - other grounds

57.No rectification in certain cases if registered owner not at fault

58.Duties and powers of Registrar

PART 8 - REMOVAL OF TRADEMARK FROM REGISTER FOR NON-USE

59.Application for removal of trademark from Register

60.Referral to court

61.Notice of opposition

62.Removal of trademark from Register if application unopposed

63.Proceedings before Registrar

64.Decision on opposed application

65.Certificate - use of trademark

PART 9 -ASSIGNMENT AND TRANSMISSION OF TRADEMARKS

66. Assignment etc of trademark

67. Recording assignment of trademark whose registration is sought

68. Recording assignment etc of registered trademark in Register

69. Notice of application to be given to person recorded as claiming interest in trademark

PART 10 - VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN TRADEMARKS

70. Recording claims to interest etc - registered trademarks

71. Record not proof of existence of right etc

72. Recording claims to interest etc - unregistered trademarks

PART 11 - INFRINGEMENT OF TRADEMARKS

73. When is a registered trademark infringed?

- 74. Infringement of trademark by breach of restrictions
- 75. When is a trademark not infringed?
- 76. Goods etc to which registered trademark has been applied by or with consent of registered owner
- 77. Prior use of identical trademark etc
- 78. Action for infringement
- 79. Special case - plaintiff not entitled to damages etc

PART 12 - OFFENCES

- 80. Falsifying etc a registered trademark
- 81. Falsely applying a registered trademark
- 82. Selling etc goods with false marks
- 83. False representations about trademarks
- 84. False entries in register etc

PART 13- COLLECTIVE TRADEMARKS

- 85. What is a collective trademark?
- 86. Act applies to collective trademarks
- 87. Application for registration
- 88. Limitation on rights given by registered collective trademark
- 89. Infringement of collective trademark

PART 14 - JURISDICTION AND POWERS OF COURTS

- 90. Jurisdiction of the Supreme Court
- 91. Registrar may appear in appeals
- 92. Powers of Supreme Court
- 93. Appeal to Court of Appeal

PART 15 - ADMINISTRATION

- 94. Registrar of Trademarks
- 95. The Register
- 96. Inspection of Register
- 97. Evidence

PART 16 - MISCELLANEOUS

- 98. Making and signing applications etc
- 99. Filing documents
- 100. Withdrawing application etc
- 101. Address for service
- 102. Change of name

- 103. Death of applicant etc
- 104. Fees
- 105. Extension of time
- 106. Convention countries
- 107. Use of trademark for export trade
- 108. Passing off actions
- 109. Regulations
- 110. Repeal
- 111. Commencement