

A BILL

for

AN ACT TO MAKE PROVISION FOR THE PROTECTION OF LAYOUT-DESIGNS
(TOPOGRAPHIES) OF INTEGRATED CIRCUITS

4(O)89PwJ 7cbTs: 0 -1.

- Protection 4. (1) Protection by way of registration under this Act may be obtained for layout-designs of integrated circuits if and to the extent that they are original within the meaning of section 5.
- (2) Registration may only be applied for if the layout-design has not yet been commercially exploited, or has been commercially exploited for not more than two years, anywhere in the world.
- Originality 5. (1) A layout-design shall be considered to be original if it is the result of its creator's own intellectual effort and is not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of its creation.
- (2) A layout-design consisting of a combination of elements and interconnections that are commonplace shall be protected only if the combination, taken as a whole, is original within the meaning of subsection (1).
- Right to protection 6. (1) The right to layout-design protection:
- (a) shall belong to the creator of the layout-design;
- (b) may be assigned or transferred by succession; or
- (c) where several persons have jointly created a layout-design, the right shall belong to them jointly.
- (2) Where the layout-design has been created in execution of a commission or an employment contract, the right to layout-design protection shall belong, in the absence of contractual provisions to the contrary, to the person who commissioned the work or to the employer.
- (3) Protection under this Act shall not be available for layout-designs which have been commercially exploited, anywhere in the world, for more than two years prior to the commencement of this Act.
- Effect of protection 7. (1) Protection under this Act shall not depend upon whether or not the integrated circuit which incorporates the protected layout-design is itself incorporated in an article. Subject to subsection (2) and to section 17, the protection shall have the effect that the following acts shall be unlawful if performed without the authorization of the right holder -
- (a) reproducing, whether by incorporation in an integrated circuit or otherwise, the protected layout-design in its entirety or any part thereof; except the act of reproducing any part that does not comply with the requirement of originality referred to in section 5;

- (b) importing, selling or otherwise distributing for commercial purposes the protected layout-design, an integrated circuit in which the protected layout-design is incorporated or an article incorporating such an integrated circuit in so far as it continues to contain an unlawfully reproduced layout-design.

(2) The effect of protection of a layout-design under this Act shall not extend to -

- (a) reproduction of the protected layout-design for private purposes or for the sole purpose of evaluation, analysis, research or teaching;
- (b) the incorporation in an integrated circuit of a layout-design created on the basis of such analysis or evaluation and which it itself original within the meaning of section 5 or the performance of any of the acts referred to in subsection (1) in respect of that layout-design;
- (c) the performance of any of the acts referred to in subsection (1)(b) where the act is performed in respect of a protected layout-design, or in respect of an integrated circuit in which such a layout-design is incorporated, that has been put on the market by, or with the consent of, the right holder;
- (d) the performance of any of the acts referred to in subsection (1)(b) in respect of an integrated circuit incorporating an unlawfully reproduced layout-design or any article incorporating such an integrated circuit where the person performing or ordering such an act did not know and had no reasonable ground to know, when acquiring the integrated circuit or the article incorporating such an integrated circuit, that it incorporated an unlawfully reproduced layout-design:

Provided however, that after receiving notice that the layout-design was unlawfully reproduced, that person may perform any of the said acts only with respect to the stock on hand or stock ordered before receiving such notice and he shall be liable to pay to the right holder a sum equivalent to a reasonable royalty such as would be payable under a freely negotiated licence in respect of such a layout-design; or

- (e) the performance of any of the acts referred to in subsection (1)(b) where the act is performed in respect of an identical layout-design which is original and has been created independently by a third party.
- Commencement and duration of protection
8. (1) Protection of a layout-design under this Act shall commence -
- (a) on the date of the first commercial exploitation, anywhere in the world, of the layout-design by, or with the consent of, the right holder, provided an application for protection is filed by the right holder with the Registrar within the time limit referred to in section 4(2); or
- (b) on the filing date accorded to the application for the registration of the layout-design filed by the right holder, if the layout-design has not been previously exploited commercially anywhere in the world.
- (2) Protection of a layout-design under this Act shall terminate at the end of 10 years after the date of commencement of protection.
- Application requirements
9. (1) Applications for the registration of layout-designs shall be in writing and shall be filed with the Registrar. A separate application shall be filed for each layout-design.
- (2) The application shall -
- (a) contain a request for registration of the layout-design in the Register of Layout-Designs and a brief description thereof;
- (b) indicate the name address, nationality and, if different from the address, the habitual residence of the applicant and, where applicable, the applicant's representative in terms of section 14;
- (c) be accompanied by a copy or drawing of the layout-design along with information defining the electronic function which the integrated circuit is intended to perform;
- Provided however, the application may omit such parts of the copy or drawing that relate to the manner of manufacture of the integrated circuit, if the parts submitted are sufficient to allow the identification of the layout-design;

(d) specify the date of first commercial exploitation of the layout-design anywhere in the world or indicate that such exploitation has not commenced; and

(e)

design as well as the name and address of the right holder and other prescribed particulars.

(4) Any person may consult the Register of Layout-Designs and obtain extracts therefrom, subject to ~~the~~ payment of the prescribed fee.

(5) The fact of the registration of a layout-design shall be published in the Gazette.

Transfer of application from the or registration person may,

11. (1) where the essential content of an application has been taken layout-design of another person without his consent, that other in writing, request the Registrar to transfer the application to him. Where the application has already resulted ~~in~~ registration, that person may, within three years from the publication of ~~the~~ registration, in writing, request the Registrar to transfer the registration to him and to rectify the entry in the Register accordingly.

(2) the Registrar shall send forthwith a copy of such a request to the right holder, and, within the prescribed period and in the prescribed manner, the right holder may send to the Registrar a counter-statement of the grounds on which he relies.

(3) If the right holder sends a counter-statement, the Registrar shall furnish a copy thereof to the person requesting the transfer and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the application or registration should be transferred and, where applicable, whether the Register should be rectified.

Changes in the shall be in ownership

12. (1) Any change in the ownership of a protected layout-design writing, Once the layout-design has ~~been~~ registered, the change in ownership shall, at the request ~~of~~ any interested party, made to the Registrar, be recorded and published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

(2)

registration of a layout-design be cancelled on the grounds that -

- (a) the layout-design is not capable of protection under sections 3,4 and 5;
- (b) the right holder is not entitled to protection under section 6;
or
- (c) where the layout-design has been commercially exploited, anywhere in the world, before the filing of the application for registration of the layout-design, the said application was not filed within the time limit referred to in sections 4(2) and 8(1).

(2) Where the grounds for cancellation are established with respect only to a part of the layout-design, only the corresponding part of the registration shall be cancelled.

(3) A request for cancellation of the registration of the layout-design under subsections (1) and (2) shall be filed with the Court in writing. The request shall state the grounds on which it is based.

(4) Any cancelled layout-design registration, or part thereof, shall be regarded as null and void from the date of the commencement of protection.

(5) The final decision of the Court shall be notified to the Registrar who shall record it and publish in the gazette a reference thereto as soon as possible.

Representation 14. Where an applicant's ordinary residence or principal place of business is outside Tonga, he shall be represented by a law practitioner practising in Tonga.

Infringement 15. (1) Infringement shall consist of the performance of any act which is unlawful under section 7.

(2) On the request of the right holder, or of a licensee if the latter has requested the right holder to institute court proceedings for a specific relief and the right holder has refused or failed to do so within a reasonable period, the court may grant an injunction to prevent infringement, award damages and grant any other remedy provided for in the general law.

(3) An action under subsection (2) may be initiated only after an application for registration of the layout-design has been filed with the Registrar.

Application of
international treaties

20. (1) The provisions of any international treaties in respect of industrial property to which Tonga is a party shall apply to matters dealt with by this Act and, in the case of conflict with any provision of this Act, shall prevail over the latter.
- (2) (a) The provisions of any international treaties to which subsection (1) applies shall be available for inspection and copying at the Registrar's office, or at any other office designated by him, by any person likely to be affected by it.
- (b) Subject to subsection 2(a), no person shall be prosecuted or convicted for contravening the provisions of international treaties in subsection (1) if such provisions are not available for inspection or copying as required by subsection (2)(a), and it is a defence to such a prosecution to show that the

