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## **PART 12 – INDIGENOUS KNOWLEDGE**

**REPUBLIC OF VANUATU**

**Assent: 21<sup>st</sup> July, 2003**  
**Commencement: 10<sup>th</sup> November 2003**

**PATENTS ACT NO. 2 OF 2003**

An Act to make provision for the registration of patents

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

“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;

“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;

"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 overaining to a pall.

"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;

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

"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;

"priority date" means the date determined as the priority date 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 52;

"Registrar" means the Registrar of Patents appointed under section 51, and includes a person acting in the position of the Registrar.

## PART 2

### PATENTABILITY

#### **PATENTABLE INVENTION**

2. (1) Subject to section 3, an invention is patentable if:
  - (a) it is new; and
  - (b) it involves an inventive step; and
  - (c) it is capable of industrial application.
- (2) 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 behaviour.
- (2) For the purposes of subsection (1), behaviour is not offensive, immoral or antisocial only because it is prohibited by a law in force in Vanuatu.
- (3) The following inventions are not 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 a 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, for an invention, comprises all matter that, at any time before the priority date of that invention, has 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, for an invention to which a patent application or a patent relates, also comprises matter contained in an application for another patent if:
  - (a) the application for that other patent has been published on or after the priority date of that invention; and
  - (b) the matter was disclosed in the application for that other patent as published; and
  - (c) 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 process or 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 if the disclosure occurred within 12 months before the date of the patent application and:
  - (a) the disclosure was made because the matter was obtained unlawfully or in breach of confidence by a person from:
    - (i) the inventor; or
    - (ii) a person to whom the matter was made available in confidence by the inventor; or



- (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) the disclosure was made in breach of confidence by a person who obtained the matter in confidence from:
  - (i) the inventor; or

is the filing date of the application.

- (2) Subsections (3) and (4) apply if:
  - (a) an applicant 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 protection for an invention.

## **CONVENTION COUNTRIES**

9. The Minister may, by order published in the Gazette, declare that a country specified in the order is a convention country for the purposes of section 8.

## 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
  - (b) a person who under a law of Vanuatu or another country 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 in title of a 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 of an invention has a right to be mentioned as the inventor:
  - (a) in a patent granted for the invention; and
  - (b) in an application for a patent for the invention, if known to the applicant.
- (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 whom the applicant believes to be the inventor; and
  - (b) if the applicant is not the sole inventor—showing why the applicant has the right to be granted the patent.

- (3) If a person ("the inventor") has been mentioned as an inventor, another person who alleges that the inventor should not 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 defining the matter for which the applicant seeks protection; and
    - (iii) any drawing referred to in the description or claim; and;
  - (c) an abstract of the application.
- (4) The specification 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) show the best method known to the applicant for carrying out the invention.
- (5) The claim:
  - (a) must be clear and concise; and

- (b) must be supported by the description of the invention; and
  - (c) may relate to one invention or to a group of inventions that form a single inventive concept.
- (6) An application may be withdrawn at any time.

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

13. The filing date of an application for a patent:
- (a) is the date when 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 publication any matter:
- (a) that in the Registrar's opinion is likely to damage a person; or
  - (b) whose publication or exploitation 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

the Registrar may prohibit or restrict the publication of that information.

PART 5

PROCEDURE FOR GRANT OF PATENT



- (4) If the applicant does not ask for a search, or does not pay the prescribed fee, the Registrar must treat the application as having been abandoned.
- (5) If the applicant has also filed an application for a patent in another country, the applicant must, within one month after receiving the information under subsection (1), give the Registrar details of the application.

### **PROCEDURE FOR SEARCH**

18. (1) If the applicant has asked for a search, the Registrar must refer the application to an examiner for a search to discover the prior relevant art (if any) contained in the application.
  - (2) The Registrar must send a copy of the examiner's report to the applicant.
  - (3) The applicant may then, on payment of the prescribed fee, ask the Registrar to refer the application to an examiner to determine:
    - (a) whether the invention is new, involves an inventive step, and is capable of industrial application (the criteria in subsection 2(1)); and
    - (b) whether the specification complies with subsections 12(4) and (5).
  - (4) The Registrar must send a copy of the examiner's report to the applicant.
  - (5) If the applicant has made an application in another country, as mentioned in subsection 17(5), the Registrar may, from time to time, in writing ask the applicant to tell the Registrar of the results of the searches carried out in that country.

### **PROCEDURE FOR SEARCH AND EXAMINATION**

19. (1) If the applicant also asked for an examination, 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 to determine:



## PART 6

### REGISTRATION OF PATENTS

#### PUBLICATION OF GRANT

23. As soon as practicable after a patent has been granted under this Act, the Registrar must:
- (a) publish in the Gazette:
    - (i) a notice that it has been granted; and
    - (ii) the specification of the patent; and
    - (iii) the names of the owner and (if different) the inventor; and
  - (b) give the owner a certificate of the grant of the patent.

#### PATENT TO BE RECORDED IN THE REGISTER

24. The Registrar must record in the Register each 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 owner;
  - (c) if the owner 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;



- (4) If it appears to the Registrar that the matter would more properly be determined by the court, the Registrar may refer it to the court for determination.

## PART 7

### RIGHTS OF OWNER OF PATENT

#### **OWNER'S RIGHTS**

27. (1) The owner of a patent has the exclusive right to exploit the patented

- (c) do not preclude a person who has rights arising from prior manufacture or use (as in section 29), or a licensee, from exploiting the patented invention; and
- (d) 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 at the priority date of a patent application:
- (a) a person, in good faith, in Vanuatu:
    - (i) was making the product, or using the process, the subject of the invention claimed in the application; or
    - (ii) had made serious preparations towards making that product or using that process; and
  - (b) the person did not get his or her knowledge of the invention from a disclosure that is to be disregarded under subsection 5(2);
- the person has the right to exploit the patented invention in spite of the grant of the patent.
- (2) The person must not assign or transmit the right except as part of the person's business.

## PART 8

### ASSIGNMENT AND JOINT OWNERSHIP

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

30. (1) A patent application may be assigned by the applicant and a patent may be assigned by the owner.
- (2) Nothing in this Act prevents the transmission of rights in a patent application or patent.
- (3) 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.
- (4) 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 both parties.
- (5) An assignment or transmission does not have effect against third parties unless it is recorded in the Register.

#### JOINT OWNERSHIP OF PATENT

31. In the absence of any agreement to the contrary between the parties, joint applicants of a patent application and joint owners 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; and



- (b) may jointly:
  - (i) withdraw the patent application; or
  - (ii) surrender the patent; or
  - (iii) enter into a licensing contract.

## PART 9

### LICENCES

#### LICENCE OF RIGHT

32. (1) The owner of a patent may apply to the Registrar for an entry to be made in the register stating that licences under the patent are to be available as of right.
- (2) The Registrar must:
- (a) notify any person registered as having a right in the patent of the application; and
  - (b) make the entry in the Register, as long as the Registrar is not aware of an existing agreement that would prevent the owner from granting licences.
- (3) After an entry under subsection (2) is made, any person is at anytime entitled as of right to a licence under the patent.
- (4) The terms of the licence:
- (a) may be agreed between the owner and the licensee; or
  - (b) if there is no agreement, may be determined by the Registrar.
- (5) The Registrar may, on the application of the holder of a licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right.

#### CANCELLATION OF ENTRY

33. (1) At any time after an entry has been made that licences of right are available for a patent, the owner of the patent may apply to the Registrar for cancellation of the entry.
- (2) The Registrar may cancel the entry if satisfied that:
- (a) there is no existing licence under the patent; or



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 infringe the patent.
- (3) The purchaser of any articles sold under this section, and any person claiming through the purchaser, may deal with articles as if the patent were held on behalf of the Government.

#### **DUTY TO INFORM OWNER**

36. If any use of a patented invention is made by or with the authority of the Government under section 35, the Government must, as soon as practicable after the use of the patented invention has begun;
- (a) tell the owner of the patent in writing about the use; and
- (b) give the owner the information about the use that the owner may from time to time reasonably require.

#### **OWNER ENTITLED TO REMUNERATION**

37. The Government must pay the owner for the use an amount agreed on, or determined by a method agreed between the Government and the owner, having regard to the economic value of the patented invention.

## PART 10

### SURRENDER AND REVOCATION OF PATENTS

#### SURRENDER OF PATENTS

38. (1) The owner of a patent may at any time by notice given to the Registrar offer to surrender his or her 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 tell the owner of the patent in writing.
- (3) If the Registrar is satisfied that there is no reason why the patent should not be surrendered, the Registrar must:
- (a) accept the offer; and
  - (b) record it in the Register; and
  - (c) publish details of the surrender in the Gazette.
- (4) A surrender takes effect from the date that Registrar accepts the offer.
- (5) An action for infringement does not lie for any act done after the date of acceptance.
- (6) A right to compensation does not accrue for any use of a patented invention after that date for the services of the Government.

#### POWER TO REVOKE PATENTS ON APPLICATION

39. (1) 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; or
  - (b) the patent was granted to a person who was not entitled to41wVorar



- (6) An application for an order to revoke a patent must be 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 because of subsection 4(3), the Registrar may by order in writing revoke 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 without the consent or authority of the owner:
- (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



## **PROCEEDINGS FOR INFRINGEMENT OF PATENT**

42. (1) The owner of a patent may bring proceedings in court for any act alleged to infringe the patent.
- (2) As well as any other remedies, the owner may apply 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 for 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 award both damages and an account of profits for the same infringement.
- (4) The court may grant the relief claimed under subsection (2), and any other relief as the court thinks appropriate.

## **REVERSAL OF BURDEN OF PROOF**

43. (1) In proceedings for the infringement of a patent, the burden of proving that a product is not made by the process covered by the patent is on the alleged infringer if:
- (a) the product is new; or
  - (b) it is likely that the product is made by the process and the owner 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 the party to disclose a manufacturing or commercial secret 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 owner of the patent to bring proceedings for an infringement of the patent committed while the licence is in force.
- (2) In awarding damages or granting any other relief in proceedings by the exclusive licensee, 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) the profits made from the infringement.
- (3) The owner of the patent must be made a party to proceedings under this section, but is not liable for costs unless he or she enters an appearance and takes part in the proceedings.

## PART 12 INDIGENOUS KNOWLEDGE

### **REGISTRATION OF PATENT INVOLVING INDIGENOUS KNOWLEDGE**

47. (1) If it appears to the Registrar that an application is for the grant of a patent for an invention 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 grant a patent for an invention 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 grant; 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 exploiting the patent.
- (3) However, the Registrar may grant the patent 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 grant the patent unless the applicant



PART 13  
REGULATIONS AND OFFENCES

- (b) makes a written statement purporting to be a copy or reproduction of an entry in the Register, or causes a statement of that kind to be made; or
- (c) produces or tenders or causes to be produced or tendered in evidence written statement of that kind;

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**

50. (1) If a person falsely represents that anything disposed of by the person for

## PART 14

### ADMINISTRATION

#### **REGISTRAR OF PATENTS**

51. (1) There is to be a Registrar of Patents to be appointed by the Minister with the prior approval of the Council of Ministers.
- (2) The Registrar has the powers and functions given to him or her under this Act and the regulations.

#### **REGISTER OF PATENTS**

52. (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 15

### MISCELLANEOUS

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

53. The Government, the Registrar and any examiner:
- (a) is not taken to warrant the validity of a patent granted under this Act; and
  - (b) does not incur any liability because of an examination or investigation required or authorised by this Act or the Regulations.

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

54. (1) The Registration of United Kingdom Patents Act [CAP. 80] (“the old Act”) is repealed.
- (2) In spite of the repeal of the old Act, every rule or regulation under the old Act in force on the date of commencement of this Act is taken to be a regulation made under this Act if it is not inconsistent with this Act.
- (3) The validity of an entry relating to a patent on the register of patents existing under the old Act is to be determined in accordance with the law in force at the date of the entry.
- (4) Every patent registered under the old Act retains its original date, but for all purposes it is taken to have been registered under this Act.

#### **COMMENCEMENT**

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