

**REPUBLIC OF VANUATU**

**TRADEMARKS ACT NO. 1 OF 2003**

**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.

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 of decision
22. Lapsing of application
23. Revocation of application

#### **Division 2 - Grounds for rejecting application**

24. Trademarks containing 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 trademarks

#### **PART 4 - OPPOSITION TO REGISTRATION**

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 ecT**

## **PART 10 - VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN TRADEMARKS**

- 70. Recording claims to interest - registered trademarks
- 71. Record not proof of existence of right
- 72. Recording claims to interest - 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 to which registered trademark has been applied by or with consent of registered owner
- 77. Prior use of identical trademark
- 78. Action for infringement
- 79. Special case - plaintiff not entitled to damages

## **PART 12 - OFFENCES**

- 80. Falsifying a registered trademark
- 81. Falsely applying a registered trademark

## **PART 16 - ADMINISTRATION**

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

## **PART 17 - MISCELLANEOUS**

- 99. Making and signing applications
- 100. Filing documents
- 101. Withdrawing application
- 102. Address for service
- 103. Change of name
- 104. Death of applicant
- 105. Fees
- 106. Extension of time
- 107. Convention countries
- 108. Use of trademark for export trade
- 109. Passing off actions
- 110. Regulations
- 111. Repeal
- 112. Commencement

## REPUBLIC OF VANUATU

**Assent :** 21<sup>st</sup> July 2003

**Commencement:**

### TRADEMARKS ACT NO. 1 OF 2003

An Act to provide for the registration of Trademarks

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

#### PART 1 - PRELIMINARY

##### INTERPRETATION

1. In this Act, unless the contrary intention appears:

“applicant” means the person in whose name an application is for the time being proceeding;

“applied to” and “applied in relation to” have the meanings given in sec-.0028 Tw9(h)1.3(e V7i4.9r2 -1.1671 Tr0027 Tov Tw)]TJon5lon5li

“commencement day” means the day on which this Act commences;

“Convention country” means a country declared by the regulations to be a Convention country for the purposes of this Act;

“Court” means the Supreme Court;

“date of registration”, for the registration of a trademark for particular goods or services, means the day from which the registration of the trademark for those goods or services is taken to have had effect under subsection 46(1) or (2);

“deceptively similar” has the meaning given by section 5;

“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.

“file” means to file with the Registrar;

“filing date”, for an appl

“goods of a person” means goods dealt with or provided in the course of trade by the person;

“indigenous knowledge” means any knowledge:

- (a) that is created, acquired or inspired for traditional economic, spiritual, ritual, narrative, decorative or recreational purposes; and



“predecessor in title”, for a person who claims to be the owner of a trademark, means:

- (a) if the trademark was assigned or transmitted to one or more than one other person before it was assigned or transmitted to the first-mentioned person—that other person or any one of those other persons; or
- (b) if paragraph (a) does not apply—the person who assigned the trademark, or from whom the trademark was transmitted, to the first-mentioned person;.

“priority date” has the meaning given by section 6;

“Register” means the Register of Trademarks kept under section 96;

“registered owner”, for a registered trademark, means the person in whose name the trademark is registered;

“registered trademark” means a trademark whose particulars are entered in the Register;

“Registrar” means the Registrar of Trademarks, and includes a person acting in the position of Registrar;

“registration number”, for a registered trademark, means the number given to it in the Register;

“services of a person” means services dealt with or provided in the course of trade by the person;

“sign” includes a letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent, or any combination of these;

“similar goods” has the meaning given by subsection 7(1);

“similar services” has the meaning given by subsection 7(2);

“trademark” has the meaning given by section 9;

“transmission” includes:

- (a) transmission by operation of law; or
- (b) devolution on the personal representative of a deceased person;

“use of a trademark for goods” means use of the trademark on, or in physical or other relation to, the goods (including second-hand goods);

“use of a trademark for services” means use of the trademark in physical or other relation to the services.

## **USE OF TRADEMARK**

2. (1) A person is taken to have used a trademark if the person has used the trademark with additions or alterations that do not substantially affect the identity of the trademark.
- (2) If a trademark consists of a letter, word, name or numeral, or any combination of those, any aural representation of the trademark is a use of the trademark.
- (3) An authorised use of a trademark by a person (see section 3) is taken to be a use of the trademark by the owner of the trademark.

## **DEFINITIONS OF “AUTHORISED USER” AND “AUTHORISED USE”**

3. (1) A person is an “authorised user” of a trademark if the person uses the trademark, for goods or services, under the control of the owner of the trademark.
- (2) The use of a trademark by an authorised user of the trademark is an “authorised use” of the trademark only if the user uses the trademark under the control of the owner of the trademark.
- (3) A person uses a trademark for goods and/or services under the control of the owner if the owner exercises quality control over the person’s use of the relevant goods and/or services, or financial control over the person’s relevant trading activities. However, this does not limit the meaning of the expression “under the control of” in subsections (1) and (2).

## **DEFINITION OF “APPLIED TO” AND “APPLIED IN RELATION TO”**

4. (1) For the purposes of this Act:
  - (a) a trademark is taken to be applied to any goods, material or thing if it is woven in, im(y gor3.0026s(appxTc0l-1.16711Sed t)]TJ( )-5748.1((a))-299f2,w( )

- (b) a trademark is taken to be applied in relation to goods or services:
  - (i) if it is applied to any covering, document, label, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade; or
  - (ii) if it is used in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services; and
- (c) a trademark is also taken to be applied in relation to goods or services if it is used:
  - (i) on a signboard or in an advertisement (including a televised advertisement); or
  - (ii) in an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document;

and goods are delivered, or services provided (as the case may be) to a person following a request or order made by referring to the trademark as so used.

- (2) In this section:

“covering” includes packaging, frame, wrapper, container, stopper, lid or cap;

“label” includes a band or ticket.

#### **DEFINITION OF “DECEPTIVELY SIMILAR”**

- 5. For the purposes of this Act, a trademark is taken to be deceptively similar to another trademark if it so nearly resembles that other trademark that it is likely to deceive or cause confusion.

#### **DEFINITION OF “PRIORITY DATE”**

6. The priority date for the registration of a trademark for particular goods or services is:
- (a) if the trademark is registered—the date of registration of the trademark for those goods or services; or
  - (b) if the registration of the trademark is being sought—the day that would be the date of registration of the trademark for those goods or services if the trademark were registered.

#### **DEFINITION OF “SIMILAR GOODS” AND “SIMILAR SERVICES”**

7. (1) Goods are similar to other goods:
- (a) if they are the same as the other goods; or
  - (b) if they are of the same description as that of the other goods.
- (2) Services are similar to other services:
- (a) if they are the same as the other services; or
  - (b) if they are of the same description as that of the other services.

#### **DEFINITION OF “ORIGINATE” FOR WINE**

8. For the purposes of this Act:
- (a) a wine is taken to have originated in a foreign country or Vanuatu only if the wine is made within the territory of that country or of Vanuatu, as the case may be; and
  - (b) a wine is taken to have originated in a particular region or locality of a foreign country or Vanuatu only if the wine is made from grapes grown in that region or locality.

## PART 2—TRADEMARKS AND TRADEMARK RIGHTS

### WHAT IS A TRADEMARK?

9. A trademark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services dealt with or provided in the course of trade by another person.

### CERTAIN SIGNS NOT TO BE USED AS TRADEMARKS

10. (1) The Regulations may prescribe signs that are not to be used as a trademark or part of a trademark.
- (2) Regulations made under subsection (1) do not affect any trademark that:
- (a) was a registered trademark; or
  - (b) in the case of an unregistered trademark—was being used in good faith;
- immediately before the regulations were published in the Gazette.

### CERTAIN TRADEMARKS MAY BE REGISTERED

11. A trademark may be registered for:
- (a) goods; or
  - (b) services; or
  - (c) .004h. w[(14h.2h.7(od45.1(oaer subsi)-5.3s; ).1(ocund)-es./TT2 1 Tf0 Tr-4.4 TD0 Tc

for the goods and/or services for which the trademark is registered.

- (2) The registered owner of a trademark has also the right to take action under



## **PART 3—APPLICATION FOR REGISTRATION**

### **DIVISION 1—GENERAL**

#### **APPLICATION—HOW MADE**

16. (1) A person may apply for the registration of a trademark for goods and/or services if:
  - (a) the person claims to be the owner of the trademark; and
  - (b) the person:
    - (i)



**APPLICATION FOR REGISTRATION OF TRADEMARK WHOSE  
REGISTRATION SOUGHT IN A CONVENTION COUNTRY—CLAIM FOR  
PRIORITY**

17. (1) If:
- (a) a person has made an application for the registration of a trademark in one or more than one Convention country; and
  - (b) within 6 months after the day on which that application, or the first of those applications, was made, that person or the person's successor in title applies to the Registrar for the registration of the

**REGISTRAR TO EXAMINE APPLICATION**

19. The Registrar must examine the application and decide:

- (a) whether the application has been made in accordance with this Act; and
- (b) whether there are grounds under sections 24-29 (inclusive) for rejecting it.

**APPLICATION ACCEPTED OR REJECTED**

## **LAPSING OF APPLICATION**

22. (1) Subject to subsection (2), an application lapses if it is not accepted within one year after the date of filing.
- (2) If, after that period has expired, the Registrar extends under section 105 the period within which the application may be accepted, the application:
- (a) is taken not to have lapsed when one year expired; and
  - (b) lapses if it is not accepted within the extended period.

## **REVOCACTION OF ACCEPTANCE**

23. (1) If, before a trademark is registered, the Registrar is satisfied:
- (a) that the application for registration of the trademark was accepted because of an error or omission in the course of the examination; or
  - (b) that, in the special circumstances of the case, the trademark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations;
- the Registrar may revoke the acceptance of the application.
- (2) If the Registrar revokes the acceptance:
- (a) the application is taken to have never been accepted; and
  - (b) the Registrar must examine the application as necessary under section 19; and
  - (c) sections 20 and 21 again apply in relation to the application.

## **DIVISION 2—GROUNDS FOR REJECTING AN APPLICATION**

### **TRADEMARK CONTAINING CERTAIN SIGNS**

24. (1) An application for the registration of a trademark must be rejected if the trademark contains or consists of a sign that, under section 10, is not to be used as a trademark.
- (2) An application for the registration of a trademark may be rejected if the trademark contains or consists of a sign so nearly resembling a sign that under section 10 is not to be used as a trademark as to be likely to be taken for it.

### **TRADEMARK THAT CANNOT BE REPRESENTED GRAPHICALLY**

25. An application for the registration of a trademark must be rejected if the trademark cannot be represented graphically.

### **TRADEMARK NOT DISTINGUISHING APPLICANT'S GOODS OR SERVICES**

26. (1) For the purposes of this section, the use of a trademark by the applicant's predecessor in title is taken to be a use of the trademark by the applicant.
- (2) An application for the registration of a trademark must be rejected if the trademark is not capable of distinguishing the applicant's goods or services for which registration is sought ("designated goods or services") from the goods or services of other persons.
- (3) In deciding whether or not a trademark is capable of distinguishing the designated goods or services from the goods or services of other persons, the Registrar must take into account the extent to which the trademark is adapted to distinguish the designated goods or services from the goods or services of other persons.

### **TRADEMARK SCANDALOUS OR ITS USE CONTRARY TO LAW**

27. An application for the registration of a trademark must be rejected if:
- (a) the trademark contains or consists of scandalous matter; or
- (b) its use would be contrary to law.



(3) If the Registrar in either case is satisfied:

- (a) that there has been honest concurrent use of the 2 trademarks; or
- (b) that, because of other circumstances, it is proper to do so;

the Registrar may accept the application for the registration of the applicant's trademark subject to any conditions or limitations that the Registrar thinks fit to impose.

(4) If the Registrar in either case is satisfied that the applicant, or the applicant and applicant's predecessor in title, have continuously used the applicant's trademark for a period:

- (a) beginning before the priority date for the registration of the other trademark; and
- (b) ending on the priority date for the registration of the applicant's trademark;

the Registrar must not reject the application because of the existence of the other trademark.

## PART 4—OPPOSITION TO REGISTRATION

### DIVISION 1—GENERAL

#### OPPOSITION

30. (1) If the Registrar has accepted an application for the registration of a trademark, a person may oppose the registration by filing a notice of opposition.
- (2) The notice of opposition must be in the approved form and must be filed within 28 days after details of the application are published in the Gazette.
- (3) The opponent must serve a copy of the notice on the applicant.
- (4) The registration of a trademark may be opposed on any of the grounds specified in sections 33-37(inclusive) and on no other grounds.
- (5) If:

- (b) to register the trademark (with or without conditions or limitations) for the goods and/or services then specified in the application;

having regard to how far any ground of the opposition has been established.

## **DIVISION 2—GROUNDS FOR OPPOSING REGISTRATION**

### **REGISTRATION MAY BE OPPOSED ON SAME GROUNDS AS FOR REJECTION**

33. The registration of a trademark may be opposed on any of the grounds on which an application for the registration of a trademark may be rejected, except the ground that the trademark cannot be represented graphically.

### **APPLICANT DOES NOT OWN, OR INTEND TO USE, TRADEMARK**

34. (1) The registration of a trademark may be opposed on the ground that the applicant is not the owner of the trademark.
- (2) The registration of a trademark may be opposed on the ground that the applicant does not intend:
- (a) to use, or authorise the use of, the trademark in Vanuatu; or
  - (b) to assign the trademark to a body corporate for use by the body corporate in Vanuatu;
- for the goods and/or services specified in the application.

### **TRADEMARK SIMILAR TO TRADEMARK THAT HAS ACQUIRED A REPUTATION IN VANUATU**

35. The registration of a trademark (the “new trademark”) for particular goods or services may be opposed on the ground that:
- (a) it is substantially identical with, or deceptively similar to, a trademark that had acquired a reputation in Vanuatu before the priority date for the registration of the new trademark for those goods or services; and



- (b) because of the reputation of that other trademark, the use of the new trademark would be likely to deceive or cause confusion.

**TRADEMARK CONTAINING OR CONSISTING OF A FALSE  
GEOGRAPHICAL INDICATION**

36. (1) The registration of a trademark for particular goods (“relevant goods”) may be opposed on the ground that the trademark contains or consists of a sign that is a geographical indication for goods (“designated goods”) originating in:
- (a) a country, or in a region or locality in a country, that is not the country where the relevant goods originated; or
  - (b) a region or locality in the country where the relevant goods originated that is not the region or locality where the relevant goods originated.
- (2) An opposition on a ground referred to in subsection (1) fails if the applicant establishes that:
- (a) the relevant goods originated in the country, region or locality identified by the geographical indication; or
  - (b) the sign has ceased to be used as a geographical indication for the designated goods in the count

- (3) An opposition on a ground referred to in subsection (1) also fails if the applicant establishes that:
  - (a) although the sign is a geographical indication for the designated goods, it is also a geographical indication for the relevant goods; and
  - (b) the applicant has not used, and does not intend to use, the trademark in relation to the relevant goods in a way that is likely to deceive or confuse members of the public as to the origin of the relevant goods.

**APPLICATION DEFECTIVE**

- 37. The registration of a trademark may be opposed on the ground that the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.



- (2) An amendment may be made to the representation of the trademark if the amendment does not substantially affect the identity of the trademark as at the time when the particulars of

## PART 6—REGISTRATION OF TRADEMARKS

### DIVISION 1—INITIAL REGISTRATION

#### OBLIGATION TO REGISTER

42. (1) The Registrar must register a trademark that has been accepted for registration:
- (a) if there has been no opposition to the registration; or
  - (b) if there has been an opposition—if the Registrar’s decision, or (in the case of an appeal against the Registrar’s decision) the decision on appeal, is that the trademark should be registered.
- (2) On registering the trademark, the Registrar must give it a number by which it may be identified.

#### REGISTRATION

43. (1) The trademark must be registered:
- (a) in the name of the applicant for registration; and
  - (b) for the goods and/or services set out in the application at the time of registration; and
  - (c) subject to the conditions (if any) and the limitations (if any) imposed by the Registrar (or the Court, on appeal).

The Registrar must enter these particulars in the Register.

- (2) The Registrar must also enter in the Register:
- (a) a graphical representation of the trademark; and
  - (b) its registration number; and
  - (c) any other particulars that are required by this Act to be entered in the Register.

- (3) If two or more persons applied together for the registration of the trademark (see section 17), the applicants must be registered as joint owners of the trademark.

### **COLOURS IN REGISTERED TRADEMARKS**

44. (1) A trademark may be registered with or without conditions about colour.
- (2) The conditions may be about the whole, or a part, of the trademark.
- (3) A trademark that is registered without conditions about colour is taken to be registered for all colours.

### **NOTIFICATION OF REGISTRATION**

45. When a trademark has been registered, the Registrar must:
  - (a) publish notice of registration in the Gazette; and
  - (b) give the registered owner a certificate of registration in the approved form.

### **DATE AND TERM OF REGISTRATION**

46. (1) Subject to subsection (2), the registration of a trademark for the goods and/or services for which the trademark is registered is taken to have had effect from (and including) the filing date of the application for registration.
- (2) If:
  - (a) the application was for a trademark whose registration had also been sought in one or more than one Convention country; and
  - (b) the applicant claimed a right of priority under section 17 for the registration of the trademark for particular goods or services; and
  - (c) the trademark is registered under this Act;the registration of the trademark for those goods or services is taken to have had effect:

- (d) if an application to register the trademark was made in only one Convention country—from (and including) the day on which the application was made in that country; or
  - (e) if applications to register the trademark were made in more than one Convention country—from (and including) the day on which the earliest of those applications was made.
- (3) Unless it is earlier cancelled, or the trademark is earlier removed from the Register, the registration of the trademark expires 10 years after the filing date of the application for its registration.

### **CEASING OF REGISTRATION**

47 The registration of a trademark ceases if:

- (a) the trademark is removed from the Register under section 50 or Part 8; or
- (b) the registration of the trademark is cancelled.

### **DIVISION 2—RENEWAL OF REGISTRATION**

#### **REQUEST FOR RENEWAL**

48. (1) Any person may, within 3 months before the registration of a trademark expires, ask the Registrar to renew the registration.
- (2) The request must be in the approved form and be filed with the Registrar.

#### **RENEWAL BEFORE REGISTRATION EXPIRES**

49. (1) If a request for the renewal of the registration of a trademark is made in accordance with section 48, the Registrar must renew the registration for a period of 10 years from the day on which the registration of the trademark would expire if it were not renewed.





**PART 7—AMENDMENT AND CANCELLATION  
OF REGISTRATION**

**AMENDMENT OR CANCELLATION BECAUSE OF CONTRAVENTION OF CONDITION.**

54. The Court may, on the application of an aggrieved person, order that the Register be rectified by:

- (a) cancelling the registration of a trademark; or
- (b) removing or amending any entry in the Register relating to the trademark;

on the ground that a condition or limitation entered in the Register in relation to the trademark has been contravened.

**AMENDMENT OR CANCELLATION—LOSS OF EXCLUSIVE RIGHTS TO USE TRADEMARK**

55. (1) If section 14 applies to a registered trademark, the Court may, on the application of an aggrieved person, but subject to subsection (2) and section 57, order that the Register be rectified by:

- (a) cancelling the registration of the trademark; or
- (b) removing or amending any entry in the Register relating to the trademark;

having regard to the effect of section 14 on the right of the registered owner of the trademark to use the trademark, or any sign that is part of the trademark, in relation to particular goods or services.

(2) If section 14 applies to the trademark because the trademark contains a sign that has become generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service, the Court may decide not to make an order under subsection (1) and allow the trademark to remain on the Register for:

- (a) the article or substance or goods of the same description; or
- (b) the service or services of the same description;

subject to any condition or limitation that the Court may impose.

## AMENDMENT OR CANCELLATION—OTHER GROUNDS

56. (1) Subject to subsection (2) and section 57, the Court may, on the application of an aggrieved person, order that the Register be rectified by:

- (a) cancelling the registration of a trademark; or
- (b) removing or amending an entry wrongly made or remaining on the Register; or
- (c) entering any condition or limitation affecting the registration of a trademark that ought to be entered.

(2) An application may be made on any of the following grounds, and on no other grounds:

- (a) any of the grounds on which the registration of the trademark could have been opposed under Division 2 of Part 4; or
- (b) that an amendment of the application for the registration of the trademark was obtained as a result of fraud or misrepresentation; or
- (c) because of the circumstances applying at the time when the trademark was

- (ii) the application for rectification is made at least 10 years after the filing date; and
  - (iii) in the intervening period, the trademark has not been used to an extent sufficient for it to distinguish, in fact, the goods or services of the registered owner from the goods or services of any other person; or
- (e) if the application is in respect of an entry in the Register—the entry was made, or has been previously amended, as a result of fraud or misrepresentation.

#### **NO RECTIFICATION IN CERTAIN CASES IF REGISTERED OWNER NOT AT FAULT**

57. (1) The Court may decide not to grant an application for rectification made:
- (a) under section 63; or
  - (b) on the ground that the trademark is liable to deceive or confuse (a ground on which its registration could have been opposed, see paragraph 64(2)(a)); or
  - (c) on the ground referred to in paragraph 64(2)(c);
- if the registered owner of the trademark satisfies the Court that the ground relied on by the applicant has not arisen through any act or fault of the registered owner.
- (2) In making a decision under subsection (1), the Court may take into account any matter that the Court considers relevant.

#### **DUTIES AND POWERS OF REGISTRAR**

58. (1) A person applying to the Court under this Part must give notice of the application to the Registrar.
- (2) The Registrar may appear before the Court and be heard at his or her discretion.
- (3) The applicant must give to the Registrar a copy of any order made by the Court under this Division and the Registrar must comply with the order.

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

### APPLICATION FOR REMOVAL FOR NON-USE

59. (1) A person aggrieved by the fact that a trademark is or may be registered may, subject to subsection (4), make an application (“non-use application”) to the Registrar for the trademark to be removed from the Register.
- (2) The non-use application:
- (a) must be made by filing the approved form; and
  - (b) may be made about any or all of the goods and/or services for which the trademark is registered.
- (3) The Registrar must:
- (a) give notice of the application to the registered owner of the trademark; and
  - (b) publish a notice of the application in the Gazette.
- (4) The non-use application may be made:
- (a) if it is on the ground referred to in paragraph (5)(a)—at any time after the filing date for the application for the registration of the trade mark; and
  - (b) if it is on the ground referred to in paragraph (5)(b)—at any time after a period of 5 years has passed from the filing date in respect of the application for the registration of the trade mark.
- (5) A non-use application may be made on either or both of the following grounds, and on no other grounds:
- (a) that, on the day on which the application for the registration of the trade mark was filed, the applicant for registration had no intention in good faith:
    - (i) to use the trade mark in Vanuatu; or
    - (ii) to authorise the use of the trade mark in Vanuatu; or

(iii) to assign the trade mark to a body corporate for use by the body corporate in Vanuatu;

for the goods and/or services to which the non-use application relates and that the registered owner:

(iv)

## **NOTICE OF OPPOSITION**

61. Any person may oppose an application under section 59 by filing a notice of opposition in the approved form with the Registrar or the Court, as the case requires.

## **REMOVAL OF TRADEMARK IF APPLICATION UNOPPOSED**

62. (1) If there is no opposition to an application to the Registrar, the Registrar must remove the trademark from the Register for the goods and/or services specified in the application.
- (2) If there is no opposition to an application to the Court, the Court must order the Registrar to remove the trademark from the Register for the goods and/or services specified in the application. The Court must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.





## PART 9—ASSIGNMENT AND TRANSMISSION OF TRADEMARKS

### ASSIGNMENT AND TRANSMISSION OF TRADEMARK

66. (1) A registered trademark, or a trademark whose registration is being sought, may be assigned or transmitted in accordance with this section.
- (2) The assignment or transmission may be partial, that is, it may apply to some only of the goods and/or services for which registration is sought or the trademark is registered.
- (3) The assignment or transmission may be with or without the goodwill of the business concerned in the relevant goods and/or services.

### RECORDING ASSIGNMENT OF TRADEMARK WHOSE REGISTRATION IS SOUGHT

67. (1) If a trademark whose registration is being sought is assigned or transmitted:
- (a) the applicant for the registration of the trademark; or
- (b) the person to whom it has been assigned or transmitted;
- must apply to the Registrar for the assignment or transmission to be recorded.
- (2) The application must be in an approved form and be filed with the Registrar.
- (3) If the application complies with this Act, the Registrar must:
- (a) within 5(ice3u)-3.9( )-5.1workhig( )-5.1du(reeivhi)-4.9(g(ti)-4.9hn)1.3(e ap)-3.9ppli  
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assigned or transmitted is taken, for the purposes of this Act, to be the

PART 10—VOLUNTARY RECORDING OF CLAIMS TO  
INTERESTS IN TRADEMARKS

**RECORDING CLAIMS TO INTEREST - REGISTERED TRADEMARKS**

70. (1) If:
- (a) a person (other than the registered owner of the trademark) claims to have an interest in, or a right to, a registered trademark; and

**RECORDING CLAIMS TO INTEREST - UNREGISTERED TRADEMARKS**

72. (1) If:

(a) a person has an interest in a trademark, a

## PART 11—INFRINGEMENT OF TRADEMARKS

### WHEN IS A REGISTERED TRADEMARK INFRINGED?

73. (1) A person infringes a registered trademark if the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark for goods or services for which the trademark is registered.
- (2) A person infringes a registered trademark if the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark for:
- (a) goods of the same description as that of the goods (“registered goods”) for which the trademark is registered; or
  - (b) services that are closely related to registered goods; or
  - (c) services of the same description as that of the services (“registered services”) for which the trademark is registered; or
  - (d) goods that are closely related to registered services.

However, the person is not taken to have infringed the trademark if the person establishes that using the sign as the person did is not likely to deceive or cause confusion.

- (3) A person infringes a registered trademark if:
- (a) the trademark is well known in Vanuatu; and
  - (b) the person uses as a trademark a sign that is substantially identical with, or deceptively similar to, the trademark for:
    - (i) goods (“unrelated goods”) that are not of the same description as that of the goods for which the trademark is registered (“registered goods”) or are not closely related to services for which the trademark is registered (“registered services”); or
    - (ii) services (“unrelated services”) that are not of the same description as that of the registered services or are not closely related to registered goods; and

- (c) because the trademark is well known, the sign would be likely to be taken as showing a connection between the unrelated goods or services and the registered owner of the trademark; and
  - (d) for that reason, the interests of the registered owner are likely to be adversely affected.
- (4) In deciding whether a trademark is well known in Vanuatu, a Court must take account of the extent to which the trademark is known within the relevant sector of the public, whether as a result of the promotion of the trademark or for any other reason.

### **INFRINGEMENT OF TRADEMARK BY BREACH OF RESTRICTIONS**

74. (1) This section applies to a registered

- (d) applying another trademark to registered goods or using another trademark in physical relation to them;
  - (e) if the trademark has been applied to registered goods or used in physical relation to them—using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the reputation of the trademark.
- (3) Subject to subsection (4), a person infringes a trademark to which this





## **PRIOR USE OF IDENTICAL TRADEMARK**

77. A person does not infringe a registered trademark by using an unregistered trademark that is substantially identical with, or deceptively similar to, the registered trademark for:

- (a) goods similar to goods (“registered goods”) for which the trademark is registered; or
- (b) services closely related to registered goods; or
- (c) services similar to services (“registered services”) for which the trademark is registered; or
- (d) goods closely related to registered services;

if the person, or the person and the person’s predecessor in title, have continuously used in the course of trade the unregistered trademark for those goods or services from a time before:

- (i) the date of registration of the registered trademark; or
- (ii) the registered owner of the registered trademark, or a predecessor in title, first used the trademark;

whichever is earlier.

## **ACTION FOR INFRINGEMENT**

78. (1) An action for an infringement of a registered trademark may be brought in the Court.
- (2) The relief that the Court may grant in an action for an infringement of a registered trademark includes:
- (a) an injunction, which may be granted subject to any condition that the Court thinks fit; and
  - (b) at the option of the plaintiff but subject to section 79, damages or an account of profits.



## PART 12—OFFENCES

### **FALSIFYING A REGISTERED TRADEMARK**

## **FALSELY APPLYING A REGISTERED TRADEMARK**

81. (1) A person must not:
- (a) falsely apply a registered trademark to goods that are being, or are to be, dealt with or provided in the course of trade; or
  - (b) falsely apply a registered trademark in relation to goods or services that are being, or are to be, dealt with or provided in the course of trade;
- knowing that the trademark is registered or reckless of whether or not the trademark is registered.
- (2) A person falsely applies a registered trademark to goods, or in relation to goods or services if the person applies the trademark or a sign

- (e) knowing that, or reckless of whether or not:
- (f) a falsified registered trademark is applied to them or in relation to them; or
- (g) a registered trademark has been unlawfully removed from them; or
- (h) a registered trademark is falsely applied to them or in relation to them.

Penalty:

- (a) a fine not exceeding 2,000,000 Vatu; or
- (b) imprisonment for a period not exceeding 2 years; or
- (c) both a fine and a term of imprisonment.

### **FALSE REPRESENTATIONS ABOUT TRADEMARKS**

83. (1) A person must not make a representation to the effect that a trademark is a registered trademark unless the person knows, or has reasonable grounds to believe, that the trademark is registered in Vanuatu.

Penalty: 200,000 Vatu.

- (2) A person must not make a representation to the effect that a part of a registered trademark is registered as a trademark unless the person knows, or has reasonable grounds to believe, that that part is registered as a trademark in Vanuatu.

Penalty: 200,000 Vatu.

- (3) A person must not make a representation to the effect that a trademark is

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(5) For the purposes of this section, the use in Vanuatu in relation to a trademark:

- (a) of the word “registered”; or
- (b) of any other word or any symbol referring (either expressly or by implication) to registration;

is taken to be a representation that the trademark is registered in Vanuatu for the goods or services for which it is used except if the trademark is registered in a country other than Vanuatu for those goods or services and:

- (c) the word or symbol by itself indicates that the trademark is registered in that other country or in a country outside Vanuatu; or
- (d) the word or symbol is used, together with other words or symbols of the same or a bigger size, to indicate that the trademark is registered in that other country or in a country outside Vanuatu; or
- (e) the word or symbol is used for goods that are to be exported to that country.

#### **FALSE ENTRIES IN REGISTER**

84 A person must not:

- (a) make a false entry in the Register; or
- (b) cause a false entry to be made in the Register; or
- (c) tender in evidence a document that falsely purports to be a copy of, or an extract from, an entry in the Register or a document in the Registrar’s office.

Penalty: Imprisonment for 2 years.



## **APPLICATION FOR REGISTRATION**

87. An application for the registration of a collective trademark must be made by the association to which the mark belongs.

## **LIMITATION ON RIGHTS GIVEN BY REGISTERED COLLECTIVE TRADEMARK**

88. (1) A member of an association in whose name a collective trademark is registered does not have the right to prevent another member of the association from using the collective trademark in accordance with the rules of the association (if any).
- (2) A collective trademark may not be assigned or transmitted.

## **INFRINGEMENT OF COLLECTIVE TRADEMARK**

89. In an action by an association in whose name a collective trademark is registered seeking relief for infringement of the collective trademark, the association may take into account, in claiming damages, any damage or loss of profits sustained or incurred by the members of the association as a result of the infringement.



## **PART 14—JURISDICTION AND POWERS OF COURT**

### **JURISDICTION OF THE SUPREME COURT**

90. The Supreme Court has jurisdiction with respect to matters arising under this Act.

### **APPEAL**

## **REGISTRAR MAY APPEAR IN APPEALS**

92. The Registrar may appear and be heard at the hearing of an appeal to the Court against a decision or direction of the Registrar.

## PART 15 - INDIGENOUS KNOWLEDGE

### **REGISTRATION OF TRADEMARK INVOLVING INDIGENOUS CULTURE**

94. (1) If it appears to the Registrar that an application is for registration of a trademark that involves an expression of indigenous culture, the Registrar must refer the application to the National Council of Chiefs.
- (2) The Registrar must not register a trademark that involves an expression of indigenous culture unless:
- (a) the custom owners have given their prior informed consent to the registration; 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 derived from the use of the trademark.
- (3) However, the Registrar may register the trademark 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 expression of indigenous culture concerned.

In such a case, the Registrar must not register the trademark unless the applicant and the National Council of Chiefs have entered into an

- (5) Any payments made to the National Council of Chiefs under an agreement mentioned in subsection (3) or a determination under paragraph (4)(c) must be used for the purposes of indigenous cultural development.
- (6) An appeal lies to the Court from a decision of the Registrar determining an amount under paragraph (4)(c).
- (7) An agreement mentioned in subsection (2) or (3) may contain other conditions, including how and when the trademark is to be used.
- (8) The National Council of Chiefs may issue written guidelines for the purposes of this section.
- (9) The National Council of Chiefs must consult with the Vanuatu National Cultural Council before entering into an agreement under subsection (3) or issuing guidelines under subsection (8).



## **INSPECTION OF REGISTER**

97. (1) The Register must be available at the Registrar's Office for inspection by any person during the hours when the Office is open for business.
- (2) If the Register, or any part of the Register, is kept by using a computer, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he or she can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

## **EVIDENCE**

98. (1) The Register is *prima facie* evidence of any particular or other matter entered in it.
- (2) A copy of, or an extract from, the Register that is certified by the Registrar to be a true record or extract is admissible in any proceedings as if it were the original.
- (3) If the Register or a part of the Register is kept by using a computer, a document certified by the Registrar as reproducing in writing a computer record of all or any of the particulars comprised in the Register or in that part of the Register is admissible in any proceedings as evidence of those particulars.
- (4) A certificate signed by the Registrar and stating that:
- (a) anything required or permitted to be done by this Act was done or not done on, or had been done or not been done by, a specified date; or
  - (b) anything prohibited by this Act was done or not done on, or had been done or not been done by, a specified date; or
  - (c) a document was available for public inspection at the Registrar's Office on a specified date or during a specified period;

## PART 17—MISCELLANEOUS

### MAKING AND SIGNING APPLICATIONS

- 99 An application, notice or request required or permitted under this Act to be made or signed by a person may be made or signed, on behalf of that person, by:
- (a) a lawyer; or
  - (b) a patent attorney; or
  - (c) a person authorised in writing by that person and permanently employed by, and only by, that person.

### FILING DOCUMENTS

- 100 A document may be filed with the Registrar by being delivered to him or her:
- (a) personally; or
  - (b) by post or courier.

### WITHDRAWING APPLICATION

101. (1) A person who has filed an application, notice or request may withdraw it, by telling the Registrar in writing, at any time while it is still being considered by the Registrar.
- (2) If:
- (a) the right or interest on which the person relied to file the application, notice or request has become vested in another person; and
  - (b) the other person tells the Registrar in writing that the right or interest is vested in him or her;
- the other person may withdraw the application, notice or request as provided in subsection (1).

## ADDRESS FOR SERVICE

102. (1) The address for service of a person who has filed an application, notice or request is:
- (a) the address for service stated in the application, notice or request; or
  - (b) if the person subsequently notifies in writing another address to the Registrar—that other address.

- (2) When:

- (a) a trademark is registered; or
- (b) a claim to an interest in, or to a right in respect of, a registered trademark that a person has is recorded in the Register;

the Registrar must enter in the Register as the address for service of the registered owner or of the person the address last known to the Registrar.

- (3) The registered owner of a registered trademark, or any person whose claim to an interest in, or to a right in respect of, a trademark is recorded in the Register, must notify the Registrar in writing of any change in his or her address for service and the Registrar must amend the Register accordingly.

- (4) The address for service of:

- (a) the registered owner of a registered trademark; or
- (b) a person whose address for service is recorded in the Register.



- (b) if the person does not have an address for service—the document may be served on an agent of the person in Vanuatu or may be sent by post or courier to any address of the person in Vanuatu that is known to the Registrar.

### **CHANGE OF NAME**

103. (1) If there is a change in the name of a person who has filed an application, notice or request, the person must notify the Registrar in writing of the change.
- (2) If there is a change in the name of:
- (a) the registered owner of a registered trademark; or
  - (b) a person whose claim to an interest in, or to a right in respect of, a trademark is recorded in the Register;

the registered owner or the person must notify the Registrar in writing of the change and the Registrar must amend the Register accordingly.

### **DEATH OF APPLICANT**

104. (1) If an applicant for the registration of a trademark dies before registration is granted, his or her legal representative may proceed with the application.
- (2) If, at any time after a trademark is registered, the Registrar is satisfied thai

## **EXTENSION OF TIME**

106. (1) If, because of an error or omission by the Registrar, a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar must extend the time for doing the act.

(2) If, because of:

(a) an error or omission by the person concerned or by his or her agent; or

(b) circumstances beyond the control of the person concerned;

a relevant act that is required by this Act to be done within a certain time is not, or cannot be, done within that time, the Registrar may, on application made by the person concerned in accordance with the regulations, extend the time for doing the act.

(3) In this section:

“relevant act” means:

(a) any act (other than a prescribed act) done in relation to a trademark; or

(b) the filing of any document (other than a prescribed document); or

(c) any proceedings (other than Court proceedings).

## **CONVENTION COUNTRIES**

then, for the purposes of this Act, an application for the registration of the trademark is taken to have also been made in the other Convention country or in each of the other Convention countries (as the case may be).

- (3) If:
- (a) the regulations declare that, under the law of a Convention country, an application for the registration of a trademark made in another country is equivalent to an application made in the Convention country; and
  - (b) an application for the registration of a trademark is made in that other country;

then, for the purposes of this Act, an application for the registration of the trademark is taken to have also been made in the Convention country.

#### **USE OF TRADEMARK FOR EXPORT TRADE**

108. (1) If:
- (a) a trademark is applied in Vanuatu:
    - (i) to, or in relation to goods that are to be exported from Vanuatu (“export goods”); or
    - (ii) in relation to services that are to be exported from Vanuatu (“export services”); or
  - (b) any other act is done in Vanuatu to export goods or export services which, if done in relation to goods or services to be dealt with or provided in the course of trade in Vanuatu, would constitute a use of the trademark in Vanuatu;

the application of the trademark or the other act is taken, for the purposes of this Act, to constitute use of the trademark in relation to the export goods or export services.

## **PASSING OFF ACTIONS**

109. (1) Except as provided in subsection (2), this Act does not affect the law relating to passing off.
- (2) In an action for passing off arising out of the use by the defendant of a registered trademark:
- (a) of which he or she is the registered owner or an authorised user; and
  - (b) that is substantially identical with, or deceptively similar to, the trademark of the plaintiff;
- damages may not be awarded against the defendant if the defendant satisfies the Court:
- (c) that, at the time when the defendant began to use the trademark, he or she was unaware, and had no reasonable means of finding out, that the trademark of the plaintiff was in use; and
  - (d) that, when the defendant became aware of the existence and nature of the plaintiff's trademark, he or she immediately ceased to use the trademark in relation to the goods or services in relation to which it was used by the plaintiff.

## **REGULATIONS**

110. (1) The Minister may make regulations:
- (a) prescribing matters required or permitted by this Act to be prescribed; or
  - (b) prescribing matters necessary or convenient to be prescribed for carrying out or giving effect to this Act.
- (2) Without limiting subsection (1), the regulations may:
- (a) require persons to make statutory declarations in support of any application, notice or request filed under this Act; and
  - (b) provide for the refund, in specific circumstances, of the whole or part of a fee paid under this Act; and

- (c) provide for the remission of, or the exemption of specified classes of persons from the payment of, the whole or part of a fee; and
- (d) provide for the destruction of documents relating to a trademark at least 25 years after the registration of the trademark has ceased; and
- (e) prescribe as penalties for offences against the regulations fines not exceeding 50,000 Vatu; and
- (f) establish an Intellectual Property Office.

### **REPEAL AND TRANSITIONAL**

111. (1) The Registration of United Kingdom Trademarks Act [Cap 81] is repealed.
- (2) All trademarks that, immediately before the commencement day, were registered under the old Act are registered trademarks for the purposes of this Act.
- (3) Subject to this Part, this Act applies to a trademark registered under this Act because of subsection (2) in the same way as it applies to a trademark registered under Part 6.
- (4) The registration of a trademark registered under the old Act expires on the day on which it would have expired if it had been registered under this Act.
- (5) An application, notice or request that:
- (a) was made in accordance with the old Act; and
  - (b) was pending immediately before the commencement day;
- is to be dealt with in accordance with this Act.
- (6) The application, notice or request is taken to have been filed in accordance with this Act.

### **COMMENCEMENT**

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