

**DRAFT AS AT 17 SEPTEMBER 2001**

REPUBLIC OF VANUATU

BILL FOR THE  
PATENTS ACT NO. OF 2001

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REPUBLIC OF VANUATU

BILL FOR THE  
PATENTS ACT NO. OF 2001

An Act to make provision for the registration of patents

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

**INTERPRETATION**

1. In this Act unless the contrary intention appears:

"court" means the Supreme Court;

"examiner" means a person or organisation approved by the Registrar to deal with questions relating to patents, including the search and

“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 on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;

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

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

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

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

"National Cultural Council" means the Vanuatu National Cultural Council established by the Vanuatu National Cultural Council Act [CAP 186];

"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 51;

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

## **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





- (a) of an invention to which an application for a patent relates; and
- (b) of any matter contained in the application;

is the filing date of the application.

(2) Subsections (3) and (4) apply if:

- (a) an applicant for a patent (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.

## **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.



- (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.

## **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.





## **EXAMINATION AS TO FORM**

16. (1) The Registrar must, as soon as practicable after receiving an application, examine the application to determine whether the application complies with this Act.
- (2) If the Registrar determines the application does not comply with this Act, the Registrar must:
  - (a) tell the applicant this; and
  - (b) ask the applicant to amend the application.
- (3) Any amendment must not include additional matter that extends beyond the matter disclosed in the original application.
- (4) If an applicant does not amend the application as asked, the Registrar may reject the application.
- (5) The Registrar must tell the applicant in writing if the Registrar rejects the application and must state the reason for the rejection.

## **SEARCH AND EXAMINATION**

17. (1) If, after an examination under subsection 16(1), the Registrar is satisfied that an application complies with this Act, the Registrar must, in writing, tell the applicant of this.
- (2) The applicant then:
  - (a) must ask for a search; and
  - (b) may also ask for an examination.
- (3) The applicant's request for a search must be accompanied by the prescribed fee.



- (i) whether the invention is new, involves an inventive step, and is capable of industrial application (the criteria in subsection 2(1)); and
  - (ii) whether the specification complies with subsections 12(4) and (5).
- (2) The Registrar must send a copy of the search and examination report to the applicant.

## **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;
  - (e) any amendment or division of the8r division of the8r div.01en-ent;

- (h) the surrender or revocation of the patent;
- (i) any other prescribed matters.

### **DURATION OF PATENT**

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

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

- 26. (1) After a patent has been granted, any person claiming a proprietary interest in the patent may apply to the Registrar to determine:
  - (a) who is the true owner of the patent; or
  - (b) whether the patent should have been granted to the person to whom it was granted; or
  - (c) whether a right in the patent should be transferred to another person.
- (2) The Registrar must notify all persons registered as owners of the patent of the application.

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- (e) make any other order necessary to give effect to his or her decision.
- (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.









- (b) may jointly:
  - (i) withdraw the patent application; or
  - (ii)

## **LICENCE OF RIGHT**

32. (1) The owner of a patent may apply to the Registrar for an entry to be made

- (b) all licensees under the patent consent to the application.
- (3) Once an entry is ca





- (c) the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art; or
- (d) the matter disclosed in the specification of the patent extends beyond that disclosed in the application for the patent as filed;
- (e) the protection conferred by the patent has been extended by an

- (5) An order under this section revoking a patent has effect from the date of the grant of the patent.
- (6) An application for an order to revoke a patent must be in writing and be accompanied by the prescribed fee.

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40. (1) If it appears to the Registrar that an invention for which a patent has been



## 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
  - (b) if the invention is a process – the person uses the process, or offers it for use in Vanuatu, when the person knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the owner would be an infringement of the patent; or
  - (c) if the invention is a process – the person disposes of, offers to dispose of, uses or imports a product obtained directly through the process, or keeps a product of that kind, whether for disposal or otherwise.
- (2) An act does not constitute an infringement of a patent if:
- (a) it is done privately and for purposes which are not commercial; or
  - (b) it is done for experimental purposes relating to the subject-matter of the invention; or
  - (c) it consists of:
    - (i) the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner; or
    - (ii) dealing with a medicine prepared in that way.

## **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**

34. (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.

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

45. As well as any other remedies, the court may make a declaration that:
- (a) an act does not; or
  - (b) a proposed act would not;
- constitute an infringement of a patent in proceedings between the person doing or proposing to do the act and the owner of the patent.

## **APPEALS**

46. (1) A person may appeal to the court against a decision or order made by the Registrar under this Act.
- (2) The court has the same discretionary powers as are coa2 213.02 Tm[~~((1))~~] s10 against a

## **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 Cultural Council.
- (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 Cultural Council, 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 and the National Cultural Council have entered into an agreement on the payment by the applicant to the National Cultural Council of an equitable share of the benefits from exploiting the patent.
- (4) Before entering into an agreement under subsection (3), the National Cultural Council must consult the National Council of Chiefs.
- (5) If an agreement mentioned in subsection (2) or (3) has not been entered into within 12 months after the patent application has been lodged:
- (a) the Registrar may grant the patent; and
  - (b) the owner may exploit the patent; and

- (c) the Registrar is to determine the amount payable to the custom owners or the National Cultural Council by the owner of the patent, being payment of an equitable share of the benefits from exploiting the patent.
- (6) Any payments made to the National Cultural Council under an agreement mentioned in subsection (3) or a determination under paragraph (5)(c) must be used for the purposes of indigenous cultural development.
- (7) An appeal lies to the Court from a decision of the Registrar determining an amount under paragraph (5)(c).
- (8) An agreement mentioned in subsection (2) or (3) may contain other conditions, including how and when the invention is to be used.
- (9) The National Cultural Council may issue written guidelines for the purposes of this section.



(b)





## **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.