

REPUBLIC OF VANUATU

BILL FOR THE
TRADEMARKS ACT

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;

“file” means to file with the Registrar;

“filing date”, for an application for the registration of a trademark, means the day on which the application is filed.

“geographical indication”, in relation to goods originating in a particular country or in a region or locality of that country, means a sign recognised in that country as a sign indicating that the goods:

- (a) originated in that country, region or locality; and
- (b) have a quality, reputation or other characteristic attributable to their geographical origin;

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

“limitations” means limitations on the exclusive right to use a trademark given by the registration of the trademark, including limitations on:

- (a) mode of use; or
- (b) use within a territorial area in Vanuatu; or
- (c) use for goods or services to be exported;

“old Act” means the *Registration of United Kingdom Trademarks Act* [Cap 81];

“opponent”, for the registration of a trademark, means:

- (a) the person who has filed (under section 30) a notice of opposition to the registration of the trademark; or
- (b) the person in whose name the notice of opposition is taken to have been filed;

“originate”, for to wine, has the meaning given by section 8;

“pending”, for an application for the registration of a trademark, includes the period in which an appeal may be made from a decision mn the applicati(m)1t(n;)]TJ15.9126 -1

“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

- (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:

POWER OF REGISTERED OWNER TO DEAL WITH TRADEMARK

- (2) If the authorised user brings an action for infringement of the trademark, the authorised user must make the registered owner of the trademark a defendant in the action. However, the registered owner is not liable for costs if he or she does not take part in the proceedings.

PART 3—APPLICATION FOR REGISTRATION

DIVISION 1—GENERAL

- (2) The priority claimed is for the registration of the trademark for the goods and/or services:
 - (a) 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
 - (b) 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) To claim priority, the person must give the Registrar a copy of the first application, certified by the Registrar of the country where the application was made.

PARTICULARS OF APPLICATION TO BE PUBLISHED

18. The Registrar must publish details of each application in the Gazette within 28 days after the application is filed.

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

20. (1) The Registrar must then accept the application unless he or she is satisfied that:
 - (a) the application has not been made in accordance with this Act; or
 - (b) there are grounds for rejecting it.

- (2) The Registrar may accept the application subject to conditia

(19 Twacs1h9(h)14rtat9

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.

REVOCATION 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 ETC. 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 inherently 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.

TRADEMARK LIKELY TO DECEIVE OR CAUSE CONFUSION

38. An application for the registration of a trademark for particular goods or services must be rejected if the use of the trademark for those goods or services would be likely to deceive or cause confusion.

IDENTICAL ETC. TRADEMARKS

29. (1) Subject to subsections (3) and (4), an application for the registration of a trademark ("applicant's trademark") for goods ("applicant's goods") must be rejected if:
- (a) the applicant's trademark is substantially identical with, or deceptively similar to:
 - (i) a trademark registered by another person for similar goods or closely related services; or
 - (ii) a trademark whose registration for similar goods or closely related services is being sought by another person; and
 - (b) the priority date for the registration of the applicant's trademark for the applicant's goods is the same as or after the priority date for the registration of the other trademark for the similar goods or closely related services.
- (2) Subject to subsections (3) and (4), an application for the registration of a trademark ("applicant's trademark") for services ("applicant's services") must be rejected if:
- (a) it is substantially identical with, or deceptively similar to:
 - (i) a trademark registered by another person for similar services or closely related goods; or
 - (ii) a trademark whose registration for similar services or closely related goods is being sought by another person; and

- (ii) the day the sign was recognised as a geographical indication for the designated goods in their country of origin; whichever is the later; or
 - (d) if the registration of the trademark is being sought for wine or spirits (“relevant wine or spirits”)—the sign is identical with the name that on the commencement day was, in the country where the relevant wine or spirits originated, the customary name of a variety of grapes used in the production of the relevant wine or spirits.
- (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 regisTw[(way0h)-4.3(e rt)3.7(hay0h)r60a(9(h)e-4(bli).3(ay0h6)5.1(g)-2(ark)-1am)11k k

**PART 5—AMENDMENT OF APPLICATION FOR REGISTRATION AND
OTHER DOCUMENTS**

AMENDMENT OF APPLICATION FOR REGISTRATION

38. (1) The Registrar may, at the written request of the applicant, amend an application for the registration of a trademark in accordance with section 39 or 40.
- (2) If:
- (a) an application for the registration of a trademark may be amended under section 40; and
 - (b) the applicant has not asked in writing that the application be amended; the Registrar may, on his or her own initiative, amend the application as mentioned in section 40 to remove any ground on which the application could be rejected.

AMENDMENT BEFORE PARTICULARS OF APPLICATION ARE PUBLISHED

39. If:
- (a) the particulars of the application have not yet been published under section 18; and
 - (b) the request for the amendment is made within 3 months;

PART 6—REGISTRATION OF TRADEMARKS

DIVISION 1—INITIAL REGISTRATION

OBLIGATION TO REGISTER

42. (1) The Registrar must, within 7 working days, 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.
- Otherwise, the application for the registration of the trademark lapses.
- (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:

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

PART 7—AMENDMENT AND CANCELLATION OF REGISTRATION

CORRECTION OF REGISTER

52. (1) The Registrar may, on his or her own initiative, correct any error or omission made in entering in the Register any particular in respect of the registration of a trademark.
- (2) The Court may, on the application of an aggrieved person, order that the Register be rectified by:
- (a) entering in the Register particulars that were wrongly omitted from it; or
 - (b) correcting an error in an entry in the Register.
- (3) When the Registrar amends any information entered in the Register about a trademark, the Registrar may also amend the certificate of registration if it is necessary to ensure it reflects the information in the Register.

CANCELLATION OF REGISTRATION BY REGISTRAR

53. (1) The Registrar must cancel the registration of a trademark if the registered owner asks in writing that the registration be cancelled.
- (2) Before cancelling the registration of the trademark, the Registrar must notify:
- (a) any person recorded under Part 10 as claiming a right or interest in the trademark; and
 - (b) if:
 - (i) an application has been made to the Registrar for the assignment or transmission of the trademark to a person to be recorded in the Register (see section 68); and
 - (ii) the assignment has not yet been recorded;the person to whom the trademark has been assigned or transmitted.

AMENDMENT OR CANCELLATION BECAUSE OF CONTRAVENTION OF CONDITION ETC.

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.

- (i) the Registrar accepted the application for the registration of the trademark because he or she was satisfied, having regard to the extent to which the trademark was inherently adapted to distinguish the goods or services of the applicant for registration from the goods or services of any other person and the intended use of the trademark, that the trademark would distinguish those goods or services as being those of the applicant (see subsection 26(3)); and
 - (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

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

(i) used the trade mark in Vanuatu; or

(a) the application to the Registrar has not been withdrawn or dismissed;
and

(b) the Registrar is satisfied that the grounds on which the application was made have been established;

the Registrar may decide to remove the trademark from the Register for any or all of the relevant goods and/or services.

(2) Subject to subsection (3), if at the end of the proceedings the Court is

PART 9—ASSIGNMENT AND TRANSMISSION OF TRADEMARKS

ASSIGNMENT ETC. 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 ETC. 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 3 working days of receiving the application, record, in the papers dealing with the application for registration, the particulars of the assignment or transmission; and
 - (b) publish the particulars of the assignment or transmission in the Gazette.
- (4) On and after the day on which the Registrar records the particulars of the assignment or transmission, the person to whom the trademark has been

- (b) register the person to whom the trademark has been assigned or transmitted (“beneficiary”) as the owner of the relevant trademark.
- (4) The registration of the beneficiary as the owner of the trademark is taken to have had effect on the day on which the application was filed.
- (5) The Registrar must advertise in the Gazette:
 - (a) the recording of the assi

**PART 10—VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN
TRADEMARKS**

RECORDING CLAIMS TO INTEREST ETC. - 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
 - (b) this interest or right may not be recorded in the Register under Part 9; the person and the registered owner of the trademark may together apply to the Registrar to have particulars of the claim recorded in the Register.
- (2) The application must be in the approved form and must be filed with the Registrar.
- (3) If the application has been made in accordance with this section, the Registrar must enter in the Register the particulars of the claim set out in the application.
- (4) If:
- (a) a trademark is registered; and
 - (b) immediately before the registration, particulars of a claim to an interest in, or right to, the unregistered trademark were recorded under section 72;
- the Registrar must enter those particulars in the Register.

RECORD NOT PROOF ETC. OF EXISTENCE OF RIGHT ETC.

71. The fact that a record has been made in the Register under this Part that a person claims an interest in, or a right to, a registered trademark is not proof or evidence that the person has that right or interest.

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

INFRINGEMENT OF TRADEMARK BY BREACH OF RESTRICTIONS

WHEN IS A TRADEMARK NOT INFRINGED?

75. In spite of section 73, a person does not infringe a registered trademark when:
- (a) the person uses in good faith:
 - (i) the person's name or the name of the person's place of business; or
 - (ii) the name of a predecessor in business of the person or the name of the predecessor's place of business; or
 - (b) the person uses a sign in good faith to show:
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or provision of services; or
 - (c) the person uses the trademark in good faith to show the intended purpose of goods (in particular as accessories or spare parts) or services;
or
 - (d) the person uses the trademark for the purposes of comparative advertising; or
 - (e) the person exercises a right to use a trademark given to the p ven tventade

f

- (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:
- (e) the date of registration of the registered trademark; or
 - (f) 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.

SPECIAL CASE—PLAINTIFF NOT ENTITLED TO DAMAGES ETC.

79. If:
- (a) in an action for the infringement of a trademark registered for particular goods or services, the Court finds that the defendant has infringed the trademark; and
 - (b) the defendend

PART 12—OFFENCES

FALSIFYING ETC. A REGISTERED TRADEMARK

80. (1) A person must not falsify or unlawfully remove a trademark that:
- (a) has been applied to any goods that are being, or are to be, dealt with or provided in the course of trade; or
 - (b) has been applied in relation to any goods or services that are being, or

- (a) without the permission of the registered owner, or of an authorised user, of the trademark; and
- (b) without being required or authorised to do so by this Act, a direction of the Registrar or an order of a Court.

Penalty: (a) a fine not exceeding 2,000,000 Vatu; or
(b) imprisonment for a period not exceeding 2 years; or

- (4) A person must not make a representation to the effect that the registration of a trademark gives exclusive rights to use the trademark in circumstances in which, having regard to conditions or limitations entered in the Register, the registration does not give those rights, unless the person has reasonable grounds to believe that the registration does give those exclusive rights.

Penalty: 200,000 Vatu.

- (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 ETC.

83. 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.

INFRINGEMENT OF COLLECTIVE TRADEMARK

88. 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

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

APPEAL

90. (1) The applicant for registration of a trademark may appeal to the Court against a decision of the Registrar:
- (a) to accept the application subject to conditions or limitations; or
 - (b) to reject the application; or
 - (c) to refuse to register the trademark; or
 - (d) to register the trademark with conditions or limitations.
- (2) The applicant or the opponent may appeal to the Court from a decision of the Registrar under section 32.
- (3) An appeal lies to the Supreme Court from a decision of the Registrar under Part 5 or Part 8.
- (4) On hearing an appeal against a decision or direction of the Registrar, the Court may do any one or more of the following:
- (a) admit further evidence orally, or on affidavit or otherwise;
 - (b) permit the examination and cross-examination of witnesses;

PART 15—ADMINISTRATION

REGISTRAR OF TRADEMARKS

93. (1) There is to be a Registrar of Trademarks, appointed by the Public Service Commission in accordance with the *Public Service Act, Act No.11 of 1998*.
- (2) The Registrar has the powers and functions that are given to him or her under this Act.
- (3) The Registrar may not exercise a power under this Act in any way that adversely affects a person applying for the exercise of that power without

- (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;is *prima facie* evidence of the matters so stated.
- (5) A copy of, or an extract from, a document held in the Registrar's Office that is certified by the Registrar to be a true copy or extract is admissible in any proceedings as if it were the original.

PART 16—MISCELLANEOUS

MAKING AND SIGNING APPLICATIONS ETC

98. 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

99. 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 ETC.

100. (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

101. (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 claim to an interest in, or a right in respect of, a trademark is recorded in the Register;is the address set out from time to time in the Register as being the address for service of the registered owner or of the person.
- (5) An address for service must be an address in Vanuatu.
- (6) If this Act provides that a document is to be served on, or given or sent to, a person:
 - (a) the document may be left at, or sent by post to, the address for service of the person; or
 - (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

102. (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 ETC.

103. (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 that the person in whose name the trademark is registered had died (or, in the case of a body corporate, had ceased to exist) before registration was granted, the Registrar may amend the Register by substituting for the name entered in the Register the name of the person who should be the registered owner of the trademark.

FEES

104. (1) The regulations may prescribe the fees to be paid to the Registrar for the purposes of this Act and may prescribe different fees for doing an act according to the time when the act is done.
- (2) If a fee is payable for the Registrar to do an act, the Registrar must not do the act until the fee has been paid.

EXTENSION OF TIME

105. (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

106. (1) The regulations may declare a foreign country to be a Convention country for the purposes of this Act.
- (2) If:
- (a) the regulations declare that, under the terms of a treaty subsisting between 2 or more Convention countries, an application made for the registration of a trademark in one of those countries is equivalent to an application made in another of those countries; and
 - (b) an application for the registration of a trademark is made in one of those 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

107. (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

108. (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

109. (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.

REPEAL AND TRANSITIONAL

110. (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.