REPUBLIC OF VANUATU

CONSOLIDATION OF THE FRENCH AND ENGLISH TEXTS OF THE LAWS OF VANUATU ACT [CAP 295]

Approval of the English Text of the Trademarks Consolidation Edition 2025 Order No. 128 of 2025

In exercise of the powers conferred on me by subsection 9(1) of the Consolidation of the French and English Texts of the Laws of Vanuatu Act [CAP 295], I, the Honourable JOB SAM ANDY, Minister of Youth, Justice and Community Services, make the following Order:

1 Approval of the English Text of the Trademarks Consolidation Edition 2025

The English Text of the Trademarks Consolidation Edition 2025 is approved.

2 Appointed day

The appointed day for the coming into operation of the Trademarks Consolidation Edition 2025 is the day on which this Order is made.

3 Commencement

This Order commences on the day on which it is made.

Made at Port Vila this 07 day of July, 2025.

REPUBLIC OF VANUATU Ministry of Justice & Community Service MINISTER Ministère de la Justice et services du Communauté RÉPUBLIQUE DE VANUATU

Honourable JOB SAM ANDY
Minister of Youth, Justice and Community Services

Commencement: 8 February 2011

TRADEMARKS ACT NO. 1 OF 2003

Act 1 of 2003
Act 5 of 2019
Act 1 of 2020
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TRADEMARKS ACT NO. 1 OF 2003

An Act to provide for the registration of Trademarks

PART 1 – PRELIMINARY

1. Interpretation

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 section 4;

"approved form" means a form approved by the Registrar;

"association" does not include a body corporate;

"authorised use", for a trademark, has the meaning given by section 3;

"authorised user", for a trademark, has the meaning given by section 3;

"collective trademark" has the meaning given by section 84;

"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 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;

"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;

"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 or in relation 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 on the application;

"person" includes a body of persons, whether incorporated or not;

"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.

2. Use of Trademark

(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.

3. Definitions of "authorised user" and "authorised use"

(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).

4. Definition of "applied to" and "applied in relation to"

(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, impressed on, worked into, or affixed or annexed to, the goods, material or thing; and

(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.

5. Definition of "deceptively similar"

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.

6. Definition of "priority date"

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.

7. Definition of "similar goods" and "similar services"

(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.

8. Definition of "originate" for wine

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

9. What is a Trademark?

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.

10. Certain Signs not to be used as Trademarks

(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.

11. Certain trademarks may be registered

A trademark may be registered for:

(a) goods; or

(b) services; or

(c) both goods and services.

12. Rights given by registration of trademark

(1) The registered owner of a trademark has, subject to this Part, the exclusive rights:

(a) to use the trademark; and

(b) to authorise other persons to use the trademark;

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 this Act if the trademark has been infringed.

(3) The registered owner has these rights from the date of registration of the trademark.

(4) If the trademark is registered subject to conditions or limitations, the rights of the registered owner are restricted by those conditions or limitations.

(5) If the trademark is registered in the name of 2 or more persons as joint owners of the trademark, the rights granted to those persons under this section are to be exercised by them as if they were the rights of a single person.

13. Power of registered owner to deal with trademark

(1) The registered owner of a trademark may deal with the trademark as its absolute owner, subject only to any rights vested in another person.

(2) This section does not protect a person who deals with the registered owner otherwise than:

(a) as a purchaser in good faith for value; and

(b) without notice of any fraud on the part of the owner.

14. When trademark becomes accepted as sign describing article

(1) This section applies if a registered trademark is, or contains, a sign that, after the date of registration of the trademark, becomes generally accepted within the relevant trade as the sign that describes or is the name of an article, substance or service.

(2) If the trademark consists of the sign, the registered owner:

(a) does not have any exclusive rights to use, or authorise other persons to use, the trademark for:

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) is taken to have ceased to have those exclusive rights from and including the day determined by the Court under subsection (4).

(3) If the trademark contains the sign, the registered owner:

(a) does not have any exclusive rights to use, or authorise other persons to use, the sign for:

(i) the article or substance or other goods of the same description; or

(ii) the service or other services of the same description; and

(b) is taken to have ceased to have those exclusive rights from the day determined by the Court under subsection (4).

(4) For the purposes of subsections (2) and (3), the Court may determine the day on which a sign first became generally accepted within the relevant trade as the sign that describes or is the name of the article, substance or service.

15. Powers of authorised user of registered trademark

(1) The authorised user of a trademark may do any of the following, subject to any agreement with the registered owner:

(a) use the trademark for the goods and/or services for which the trademark is registered, subject to any condition or limitation of the registration;

(b) subject to subsection (2), bring an action for infringement of the trademark if the registered owner refuses or neglects to do so within 6 months;

(c) do anything else that the registered owner of a trademark may do.

(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

16. Application – how made

(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) is using or intends to use the trademark for the goods and/or services; or

(ii) has authorised or intends to authorise another person to use the trademark for the goods and/or services; or

(iii) the person intends to assign the trademark to a body corporate that is about to be constituted.

(2) The application must:

(a) be in accordance with the approved form and be filed with the Registrar; and

(b) include a representation of the trademark; and

(c) describe the goods and/or services involved.

(3) If the relations between 2 or more persons interested in a trademark are such that none of them is entitled to use the trademark except:

(a) on behalf of all of them; or

(b) for goods and/or services with which all of them are connected in the course of trade;

they may apply for its registration together.

17. Application for registration of trademark whose registration sought in a Convention country – claim for priority

(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 trademark for some or all of the goods and/or services for which registration was sought in that country or those countries;

that person or that person's successor in title may, when filing the application, claim a right of priority for the registration of the trademark for any or all of those goods and/or services.

(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.

18. Particulars of application to be published

The Registrar must publish details of each application in the Gazette within 90 days after the application is filed.

19. Registrar to examine application

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.

20. Application accepted or rejected

(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 conditions and limitations.

(3) If the Registrar is satisfied that:

(a) the application has not been made in accordance with this Act; or

(b) there are grounds for rejecting it;

the Registrar must reject the application.

(4) The Registrar must not reject an application without giving the applicant an opportunity of being heard.

21. Notice of decision

The Registrar must:

(a) notify the applicant in writing of his or her decision under section 20; and

(b) advertise the decision in the Gazette.

22. Lapsing of application

(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.

23. Revocation of acceptance

(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

24. Trademark containing certain signs

(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.

25. Trademark that cannot be represented graphically

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

26. Trademark not distinguishing applicant's goods or services

(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.

27. Trademark scandalous or its use contrary to law

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.

28. Trademark likely to deceive or cause confusion

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.

29. Identical trademarks

(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

(b) the priority date for the registration of the applicant's trademark for the applicant's services is the same as or after the priority date for the registration of the other trademark in for the similar services or closely related goods.

(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

30. Opposition

(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:

(a) after a person has filed a notice of opposition, the right or interest on which the person relied to file the notice of opposition becomes vested in another person; and

(b) the other person notifies the Registrar in writing of this, and does not withdraw the opposition;

the opposition is to proceed as if the notice of opposition had been filed in that other person's name.

31. Opposition proceedings

The Registrar must give the opponent and the applicant an opportunity of being heard on the opposition.

32. Decision

Unless the proceedings are discontinued, the Registrar must decide:

(a) to refuse to register the trademark; or

(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

33. Registration may be opposed on same grounds as for rejection

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.

34. Applicant does not own, or intend to use, trademark

(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.

35. Trademark similar to trademark that has acquired a reputation in Vanuatu

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.

36. Trademark containing or consisting of a false geographical indication

(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 country where the designated goods originated; or

(c) the applicant, or the applicant's predecessor in title, used the sign in good faith for the relevant goods, or applied in good faith for the registration of the trademark for the relevant goods, before:

(i) the commencement day; or

(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.

37. Application defective

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.

PART 5 – AMENDMENT OF APPLICATION FOR REGISTRATION AND OTHER DOCUMENTS

38. Amendment of application for registration

(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.

39. Amendment before particulars of application are published

If:

(a) the particulars of an application have not yet been published under section 18; and

(b) a request for amendment is made;

an amendment may be made to correct a clerical error or an obvious mistake.

40. Amendment after particulars of application have been published

(1) If the particulars of the application have been published under section 18, the application may only be amended as provided in this section.

(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 the application were published.

(3) An amendment may be made to change the type of registration sought in the application (for example, an application for the registration of a trademark may be amended to an application for registration as a collective trademark).

41. Amendment of other documents

The Registrar may, at the written request of the person who has filed an application (other than an application for the registration of a trademark), a notice or other document for the purposes of this Act or at the written request of the person's agent, amend the application, notice or document:

(a) to correct a clerical error or an obvious mistake; or

(b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

PART 6 – REGISTRATION OF TRADEMARKS

Division 1 – Initial registration

42. Obligation to register

(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.

43. Registration

(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.

44. Colours in registered trademarks

(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.

45. Notification of registration

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.

46. Date and term of registration

(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.

47. Ceasing of registration

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

48. Request for renewal

(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.

49. Renewal before registration expires

(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.

(2) The Registrar must give notice of the renewal to the registered owner of the trademark.

50. Failure to renew

If the registration of a trademark is not renewed, then:

(a) subject to section 51, the registration ceases to have effect when it expires; and

(b) the Registrar must remove the trademark from the Register 12 months after the day on which the registration expired.

51. Renewal within 3 months after registration expires

(1) If, within 3 months after the registration of a trademark has expired, a person asks the Registrar to renew the registration of the trademark, the Registrar must renew the registration of the trademark for 10 years from the day on which the registration expired.

(2) The request must be in the approved form and be filed with the Registrar.

PART 7 – AMENDMENT AND CANCELLATION OF REGISTRATION

52. Correction of Register

(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.

53. Cancellation of registration by Registrar

(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.

54. Amendment or cancellation because of contravention of condition

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.

55. Amendment or cancellation — loss of exclusive rights to use trademark

(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.

56. Amendment or cancellation – other grounds

(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 application for rectification is filed, the use of the trademark is likely to deceive or cause confusion for a reason other than one for which:

(i) the application for the registration of the trademark could have been rejected under section 28 or 29; or

(ii) the registration of the trademark could have been opposed under section 35; or

(d) that the following circumstances apply:

(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 made, or has been previously amended, as a result of fraud or misrepresentation.

57. No rectification in certain cases if registered owner not at fault

(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.

58. Duties and powers of Registrar

(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

59. Application for removal for non-use

(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) has not used the trade mark in Vanuatu; or

(v) has not used the trade mark in good faith in Vanuatu;

for those goods and/or services at any time before the period of one month ending on the day on which the non use application is filed;

(b) that the trade mark has remained registered for a continuous period of 3 years ending one month before the day on which the non-use application is filed, and, at no time during that period, the person who was then the registered owner used the trade mark in Vanuatu for the goods and/or services to which the application relates.

(6) A non-use application may not be made if an action about the trademark is pending in the Court, but the person aggrieved may apply to the Court for an order directing the Registrar to remove the trademark from the Register.

(7) If the right or interest on which the person relied to make the application becomes vested in another person, the other person may, on giving notice of the relevant facts to the Registrar or the Court (as the case requires), be substituted for the first-mentioned person as the applicant.

60. Referral to Court

If:

(a) an application to remove a trademark for non-use has been made to the Registrar; and

(b) the Registrar is of the opinion that the matter should be decided by the Court;

the Registrar may refer the matter to the Court and the Court may hear and determine the matter as if the application had been made to it.

61. Notice of opposition

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.

62. Removal of trademark if application unopposed

(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.

63. Proceedings before Registrar

If an application to the Registrar is opposed, the Registrar must:

(a) give both parties an opportunity to be heard; and

(b) make a decision whether to remove the trademark.

64. Decision on opposed application

(1) Subject to subsection (3), if:

(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 satisfied that the grounds on which the application was made have been established, the Court may order the Registrar to remove the trademark from the Register for any or all of the relevant goods and/or services.

(3) If satisfied that it is reasonable to do so, the Registrar or the Court may decide that the trademark should not be removed from the Register even if the grounds on which the application was made have been established.

(4) The Court must cause a copy of the order to be served on the Registrar and the Registrar must comply with the order.

65. Certificate – use of trademark

(1) If in proceedings about an opposed application the Registrar or the Court has found that:

(a) a trademark has been used in good faith during a particular period; or

(b) a trademark has not been used during a particular period solely because of circumstances that were an obstacle to its use;

the Registrar or the Court must, if so requested by the registered owner of the trademark, give the registered owner a certificate of those findings.

(2) In any subsequent proceedings in which non-use of the trademark is alleged the certificate is evidence of the facts stated in it.

PART 9 – ASSIGNMENT AND TRANSMISSION OF TRADEMARKS

66. Assignment and transmission of trademark

(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.

67. Recording assignment of trademark whose registration is sought

(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 assigned or transmitted is taken, for the purposes of this Act, to be the applicant for the registration of the trademark.

68. Recording assignment of registered trademark in Register

(1) If a registered trademark is assigned or transmitted:

(a) the person registered as the owner of the trademark; or

(b) the person to whom the trademark has been assigned or transmitted;

must apply to the Registrar for a record of the assignment or transmission to be entered in the Register.

(2) The application must be in the approved form and filed with the Registrar.

(3) If the application complies with this Act, the Registrar must, within 3 working days:

(a) enter the particulars of the assignment or transmission in the Register; and

(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 assignment or transmission; and

(b) the registration of the beneficiary as the owner of the trademark.

69. Notice of application to be given to person recorded as claiming interest in trademark

If an application for the assignment or transmission of a trademark complies with this Act, the Registrar must notify in writing any person recorded under Part 10 as claiming an interest in, or a right in respect of, the trademark.

PART 10 – VOLUNTARY RECORDING OF CLAIMS TO INTERESTS IN TRADEMARKS

70. Recording claims to interest – registered trademarks

(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.

71. Record not proof of existence of right

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.

72. Recording claims to interest – unregistered trademarks

(1) If:

(a) a person has applied for the registration of a trademark; and

(b) another person claims to have an interest in, or a right to, the trademark;

they may together apply to the Registrar for a record to be kept of the other person's claim.

(2) The application must be in an approved form and must be filed with the Registrar.

(3) If the application has been made in accordance with this section, the Registrar must record, in the papers dealing with the application for registration, the particulars of the claim set out in the application.

PART 11 – INFRINGEMENT OF TRADEMARKS

73. When is a registered trademark infringed?

(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.

74. Infringement of trademark by breach of restrictions

(1) This section applies to a registered trademark if the registered owner, or an authorised user of the trademark having power to do so, has caused a notice ("notice of prohibition") prohibiting any act that is a prohibited act in relation to the goods ("registered goods") for which the trademark is registered to be displayed:

(a) on the registered goods; or

(b) on their package; or

(c) on the container in which they are offered to the public.

(2) Each of the following is a prohibited act:

(a) applying the trademark to registered goods, or using the trademark in physical relation to them, after the state, condition, get-up or packaging in which they were originally offered to the public has been altered;

(b) altering, or partially removing or obliterating, any representation of the trademark applied to registered goods or used in physical relation to them;

(c) if the trademark has been applied to registered goods, or used in physical relation to them, together with other matter indicating that the registered owner or authorised user has dealt with the goods—removing or obliterating, totally or in part, any representation of the trademark without totally removing or obliterating the other matter;

(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 section applies if the person:

(a) is the owner of registered goods; and

(b) in the course of trade, or with a view to a dealing with the goods in the course of trade:

(i) does an act that is prohibited under the notice of prohibition; or

(ii) authorises that act to be done.

(4) The trademark is not infringed if the owner of the goods:

(a) acquired them in good faith and without being aware of the notice of prohibition; or

(b) became the owner of the goods because of a title derived from a person who had so acquired them.

75. When is a trademark not infringed?

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 person under this Act; or

(f) the Court is of the opinion that the person would obtain registration of the trademark in his or her name if the person were to apply for it; or

(g) the person, in using a sign referred to in subsection 73(1), (2) or (3) in a manner referred to in that subsection, does not (because of a condition or limitation subject to which the trademark is registered) infringe the exclusive right of the registered owner to use the trademark.

76. Goods to which registered trademark has been applied by, or with consent of, registered owner

(1) In spite of section 73, a person who uses a registered trademark for goods that are similar to goods for which the trademark is registered does not infringe the trademark if the trademark has been applied to, or in relation to, the goods by, or with the consent of, the registered owner of the trademark.

(2) In spite of section 73, a person who uses a registered trademark for services that are similar to services for which the trademark is registered does not infringe the trademark if the trademark has been applied in relation to the services by, or with the consent of, the registered owner of the trademark.

77. Prior use of identical trademark

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.

78. Action for infringement

(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.

79. Special case – plaintiff not entitled to damages

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 defendant has applied to the Court under section 59 for an order directing the Registrar to remove the trademark from the Register for those goods or services; and

(c) the Court finds that, because the trademark has not during a particular period ("critical period") been used in good faith by its registered owner for those goods or services, there are grounds (under subsection 59(4)) for so removing the trademark from the Register;

the Court may not grant relief to the plaintiff by way of damages or an account of profits for any infringement of the trademark that happened during the critical period.

PART 12 – OFFENCES

80. Falsifying a registered trademark

(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 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 falsifies a registered trademark if the person:

(a) alters or defaces it; or

(b) makes any addition to it; or

(c) partly removes, erases or obliterates it;

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

(3) A person unlawfully removes a registered trademark if the person wholly removes, erases or obliterates it:

(a) without the permission of the registered owner, or 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 the Court.

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.

81. Falsely applying a registered trademark

(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 substantially identical with it to the goods or in relation to the goods or services:

(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

(c) both a fine and a term of imprisonment.

82. Selling goods with false marks

A person must not:

(a) sell goods; or

(b) expose goods for sale; or

(c) have goods in his or her possession for the purpose of trade or manufacture; or

(d) import goods into Vanuatu for the purpose of trade or manufacture;

(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.

83. False representations about trademarks

(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 registered for goods or services unless the person knows, or has reasonable grounds to believe, that the trademark is registered in Vanuatu for those goods or services.

Penalty: 200,000 Vatu.

(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.

84. False entries in register

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.

PART 13 – COLLECTIVE TRADEMARKS

85. What is a collective trademark?

A "collective trademark" is a sign used, or intended to be used, for goods or services dealt with or provided in the course of trade by members of an association, to distinguish those goods or services from goods or services so dealt with or provided by people who are not members of the association.

86. Act applies to collective trademarks

(1) Subject to this Part, the provisions of this Act relating to trademarks (other than Part 9—Assignment and Transmission of Trademarks) apply to collective trademarks as if:

(a) a reference to a trademark included a reference to a collective trademark; and

(b) a reference to a person doing something for the registration of a trademark included a reference to an association doing that thing for the registration of the collective trademark; and

(c) a reference to a trademark registered by a person included a reference to a collective trademark registered by an association.

(2) For the purposes of this Act:

(a) the use of a collective trademark by a member of the association that is the applicant for the registration of the collective trademark is taken to be a use of the collective trademark by the applicant; and

(b) the use of a registered collective trademark by a member of the association that is the registered owner of the collective trademark is taken to be a use of the collective trademark by the registered owner.

(3) Section 26 (trademark not distinguishing applicant's goods or services) applies to a collective trademark as if a reference to the applicant were a reference to the members of the association that applied for registration of the collective trademark.

87. Application for registration

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

88. Limitation on rights given by registered collective trademark

(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.

89. Infringement of collective trademark

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

90. Jurisdiction of the Supreme Court

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

91. Appeal

(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;

(c) order an issue of fact to be tried as it directs;

(d) affirm, reverse or vary the Registrar's decision or direction;

(e) give any judgment, or make any order, that, in all the circumstances, it thinks fit;

(f) order a party to pay costs to another party.

92. Registrar may appear in appeals

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

93. Appeal to Court of appeal

A person aggrieved by a decision of the Supreme Court may appeal to the Court of Appeal against the decision.

PART 15 – INDIGENOUS KNOWLEDGE

94. Registration of trademark involving indigenous culture

(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 agreement on the payment by the applicant to the National Council of Chiefs of an equitable share of the benefits derived from the use of the trademark.

(4) If an agreement mentioned in subsection (2) or (3) has not been entered into within 12 months after the trademark application has been lodged:

(a) the Registrar may register the trademark; and

(b) the registered owner may use the trademark; and

(c) the Registrar is to determine the amount payable to the custom owners or the National Council of Chiefs by the registered owner of the trademark, being

payment of an equitable share of the benefits derived from the use of the trademark.

(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).

PART 16 – ADMINISTRATION

95. Registrar of trademarks

(1) There is to be a Registrar of Trademarks to be appointed by the Minister with the prior approval of the Council of Ministers.

(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 first giving that person a reasonable opportunity of being heard.

(4) If:

(a) the Registrar is required under this Act to do any act or thing; and

(b) no time or period is provided within which the act or thing is to be done;

the Registrar is to do the act or thing as soon as practicable.

96. The Register

(1) The Registrar is to keep a Register of Trademarks.

(2) The Registrar must enter in the Register in accordance with this Act:

(a) all particulars of registered trademarks, that were on the old register when the old Act was repealed; and

(b) particulars of trademarks, collective trademarks and all other matters required to be registered under this Act.

(3) The Register may be kept in whole or in part by using a computer.

(4) Any record made by using a computer for the purpose of keeping the Register is taken to be an entry in the Register.

97. Inspection of Register

(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.

98. Evidence

(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;

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 17 – MISCELLANEOUS

99. Making and signing applications

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.

100. Filing documents

A document may be filed with the Registrar by being delivered to him or her:

(a) personally; or

(b) by post or courier.

101. Withdrawing application

(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).

102. Address for service

(1) An applicant must ensure that the address for service provided in an application must be:

(a) in the case where the applicant operates from outside of Vanuatu – the address of an approved agent, authorised by the applicant to act on the applicant's behalf; or

(b) in the case where the applicant operates from Vanuatu:

(i) the residential address of the applicant in Vanuatu; or

(ii) the address of the place of operations of the applicant in Vanuatu; or

(iii) the address of an approved agent authorised by the applicant to act on the applicant's behalf.

(2) For the purposes of paragraph (1)(a) and subparagraph (b)(iii), an "approved agent" means a person approved by the Registrar as an approved agent under subsection 102A(1).

(3) The applicant must ensure that the Registrar is informed of any changes to the address of service.

(4) The Registrar is to register the address of service of the applicant in the Register of Trademarks.

102A. Approved agents

(1) The Registrar may approve persons as approved agents to be engaged by a person who intends to register a trademark.

(2) An applicant must not authorise any person to act on his or her behalf unless that person is an approved agent.

(3) The Register may by Regulations set out the process and criteria for the selection of approved agents.

103. Change of name

(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.

104. Death of applicant

(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.

105. Fees

(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.

(1A) Without limiting subsection (1), the Regulations may prescribe the requirements for the annual maintenance fees for registration of trademarks.

(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.

106. Extension of time

(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).

107. Convention countries

(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.

108. Use of trademark for export trade

(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.

109. Passing off actions

(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.

110. Regulations

(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.

111. Repeal and transitional

(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.

Table of Amendments

18	*Amended by Act 2 of 2021*
102	*Substituted by Act 1 of 2020*
102A	*Inserted by Act 1 of 2020*
105(1A)	*Inserted by Act 5 of 2019*