

(3) Where the Registrar finds that the conditions referred to in subsection (1) are fulfilled, and either:

- (i) the registration of the mark has not been opposed within the prescribed time limit; or
- (ii) the registration of the mark has been opposed and the opposition has been decided in the applicant's favor,

he shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration. Otherwise, he shall refuse the application.

## Section 26

*Subsection (1)* establishes the exclusive right that registration of a mark confers upon its owner.

*Subsection (2)*: The right to institute proceedings against any person who infringes or threatens to infringe the rights of the owner of a registered mark is the owner's most important right. This right, where confusion could arise in the public, extends to the use of a mark which, though not identical to the registered mark or not used in relation to the same goods or services, is similar to the registered mark and is used in relation to goods or services similar or related to those for which the mark was registered. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed (TRIPS Art. 16.1).

*Subsection (3)* applies the "exhaustion" of rights principle to registered marks (see above comments on *Section 10(4)(a)(i)* relating to patents, and on *Section 20(3)* relating to industrial designs).

*Subsection (4)*: This provision fulfills the obligations contained in Article 6bis of the Paris Convention, as it would give an express right of action against the *use* of well-known marks, as opposed to their *registration*.

*Subsection (5)*: Once registered, a mark is protected for a period of ten years. The duration is computed from the filing date of the application. This does not mean that the protection commences from the filing date. It only means that the starting point for calculating the duration is the filing date. The protection commences from the date of registration. As an alternative method of calculation, the date of registration could be the starting point for calculating. This, however, is a method of calculation which is used only in a few countries and is therefore not recommended.

Unlike patents and industrial designs, marks may be protected indefinitely for consecutive ten-year periods provided that the owner pays the renewal fee, as required by *subsection (5)(b)*. The renewal is effected upon request by the registered owner without checking whether the mark is actually used. It would be too much of a burden if the Industrial Property Registry would be obliged to check whether the mark actually had been used since this would require an investigation into the facts. It has been suggested that the registered owner be required to file a statement confirming bona fide use of the mark. However, such a statement cannot serve as proof of use and it would be even difficult to provide for sanctions if the statement is not in conformity with the legal requirement of use since those requirements are subject to interpretation. The sanctions for non-use are dealt with in a special procedure provided for in *Section 27(2)* and with the possibility of a final decision by the Court. As in the case of patents and industrial designs, a grace period is allowed for the late payment of the renewal fee (see comments on *Section 11(2)*, above).

Rights Conferred  
by Registration;  
Duration

26.(1) The use of a registered mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner shall require the agreement of the latter.

(2) The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using, without his agreement, the mark as aforesaid or who performs acts which make it likely that infringement will occur. The right shall extend to the use of a sign similar to the registered mark and use in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(3) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in Samoa [any country] by the registered owner or with his consent.

(4) The provisions of Section 23(2)(v) shall apply, *mutatis mutandis*, in any action instituted by the owner of a well-known mark against any person in respect of the unlawful use of the well-known mark.

(5)(a) The registration of a mark shall be for a period of ten years from the filing date of the application for registration.

(b) The registration of a mark may, upon request, be renewed for consecutive periods of ten years, provided that the registered owner pays the prescribed renewal fee.

(c) A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.



*Section 27*

*Subsection (1):* The provisions of this subsection are similar in all material respects to those relating to patents (see comments on *Section 14*, above) and industrial designs (see comments on *Section 20*, above) and establish the possibility of invalidating registered marks which do not satisfy the specific fundamental requirements of the law.

*Subsection (2)* provides that an interested person may apply for the removal of a mark from the register, in respect of any of the goods or services for which it is registered, on the ground that up to one month prior to the filing of the application it had not been used at any time during a continuous period of three years or longer. The one month period before the filing of the application for removal is to enable the interested person to approach the registered proprietor, in advance, to seek his voluntary cancellation of the mark without the risk of the proprietor commencing to use his mark immediately upon learning that his registration is likely to be attacked on the ground of non-use. Under the proviso to this subsection, failure to use a registered mark is excused where such failure is attributable solely to circumstances which are beyond the control of the registered proprietor, and not to any intention to abandon or not to use the mark. This Section provides for proceedings for invalidation, or for removal on the ground of non-use, to be dealt with by the Industrial Property Registry. Some countries may, for reasons of administrative convenience, prefer to have applications under this Section determined by the court and may so provide.

Invalidation;  
Removal on Grounds  
of Non-Use

27.(1)(a) Any interested person may request the Registrar to invalidate the registration of a mark.

(b) The Registrar shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Sections 22(i) and 23(2) is not fulfilled.

(c) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published as soon as possible.

(2) Any interested person may request the Registrar to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of three years or longer, provided that a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

## Section 28

*Subsection (1):* Under this subsection the provisions relating to marks are made applicable to collective marks subject to the special provisions, set out in *subsections (2) and (3)*, that apply only to collective marks.

*Subsection (2):* The designation of a collective mark as such, in an application for its registration, enables it to be distinguished from a trademark or service mark (see comments on *Section 22* regarding the definition of "collective mark"). The requirement that an application for registration of a collective mark be accompanied by a copy of the regulations governing its use and that changes in the said regulations be notified to the Industrial Property Registry ensures that the Office has on record, and available to the public, information on the conditions under which the collective mark can be used.

*Subsection (3)* provides for additional grounds upon which collective marks can be invalidated. Where the collective mark is used only by the registered owner, it, in effect, ceases to be a collective mark as defined in *Section 22(ii)*.

## Section 29

*Subsection (1):* The purpose of this provision is to protect consumers by ensuring effective quality control when marks are used under license.

*Subsection (2):* Since a collective mark may be used only by persons who fulfill the requirements of the regulations governing its use, this subsection does not allow collective marks to be licensed.

## Section 30

*Subsection (1):* According to the definition contained in *Section 22(iii)*, a trade name is a name or designation identifying and distinguishing an enterprise. It may consist of the name of the owner of the enterprise or of his pseudonym, or of an invented name, or of an abbreviation, or of a description of the enterprise or of any other designation. The choice of a trade name is more restricted than that of a mark: many of the examples of types of marks, such as devices, reliefs and labels, cannot be used as a trade name because the latter must be a name or designation. This Section places still further limits upon the choice of a trade name. A trade name, and the use to which it may be put, must, in the first place, not be contrary to public order or morality. An obscene name or a name identical or similar to the name of a public authority would be examples in point. Furthermore, a trade name must not be liable to deceive trade circles, or the public, as to the nature of the enterprise identified by it. It should not, for example, indicate that an enterprise is a local enterprise when, in actual fact, it is foreign or give the impression that the enterprise which it identifies has a scope of activities different from that which it actually has. In order not to deceive trade circles or the public, a trade name should also not be identical or similar to another trade name which is no longer used but is well known to the public.



Collective Marks

28.(1) Subject to subsections (2) and (3), Sections 23 to 27 shall apply to collective marks, except that references therein to Section 22(i) shall be read as 22(ii).

(2)(a) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.

(b) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in paragraph (a).

(3) In addition to the grounds provided in Section 27(1), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in subsection (2)(a) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Licensing of Marks  
and Collective Marks

29.(1) Any license contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the license contract does not provide for such quality control or if such quality control is not effectively carried out, the license contract shall not be valid.

(2) The registration of a collective mark, or an application therefor, may not be the subject of a license contract.

Trade Names

30.(1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

*Subsection (2)(a)* provides for the protection of trade names independently of registration, even if such registration is otherwise mandatory under other laws or regulations of the country. Such laws and regulations would probably provide for sanctions for failure to register a trade name. Such sanctions could not, however, consist of a denial of protection of the unregistered trade name against acts likely to cause confusion as provided in this Act. Protection of this kind is clearly in the interest of the public.

*Subsection (2)(b)* specifies what, in particular, constitutes an unlawful act against which trade names are protected, i.e., any subsequent use by a third party of the name itself, whether as a trade name or as a mark, and any such use of a similar trade name or mark, if likely to mislead the public. A trade name does not have to be distinctive; it can consist of a very common surname or of a description of the enterprise. In such cases, the same surname or description may be used by others, provided the likelihood of confusion to the public is avoided.



(2)(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful.

## PART IV

### GENERAL PROVISIONS

#### *Section 31*

*Subsection (1):* The requirement that changes in ownership in respect of patents and registrations of industrial designs and marks, or applications therefor, must be in writing and must be submitted to the Industrial Property Registry for recording ensures that the Office has on record, and available to the public, particulars regarding changes in ownership.

*Subsection (2):* Collective marks are placed in a special category. The transfer of ownership of a collective mark should be allowed less freely than that of an individual mark because collective marks imply, more than ordinary marks, a guarantee of origin, quality, or other characteristics, so that a change in ownership may be more likely to mislead or confuse consumers. For this reason, changes of ownership in respect of collective marks require the prior approval of the Minister responsible for the Industrial Property Registry.

*Subsection (3):* Since a trade name (unlike a mark) identifies an enterprise, or part of it, a change in ownership in respect of a trade name is allowed only if it occurs together with a change of ownership of the enterprise or of the part of it identified with the trade name.

*Subsection (5)* imposes an obligation on the parties to a license contract to submit the contract to the Registrar for recordal and for a publication of a reference thereto.

## PART IV

### GENERAL PROVISIONS

#### Changes in Ownership; License Contracts

31 (1) Any change in the ownership of a patent, the registration of an industrial design or the registration of a mark or collective mark, or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party, to the Registrar, be recorded and, except in the case of an application, published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

(2) Any change in the ownership of the registration of a collective mark, or in the ownership of an application therefor, shall require previous approval by the Minister.

(3) Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name and shall be in writing.

(4) A change in ownership of the registration of a mark or a collective mark shall, however, be invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

(5) Any license contract concerning a patent, a registered industrial design or a registered mark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto. The license contract shall have no effect against third parties until such submission has been made.



*Section 32*

The purpose of this provision is to ensure that applicants resident outside the territory of Samoa are represented by a local attorney or agent admitted to represent clients before the Industrial Property Registry.

*Section 33*

The structure will be determined in accordance with the administrative convenience of the Government and this Section should be amended accordingly if necessary.

Agents

32. Where an applicant's ordinary residence or principal place of business is outside Samoa, he shall be represented by a legal practitioner resident and practicing in Samoa.

Organization of the  
Industrial Property Registry

33.(1)(a) The Industrial Property Registry shall be established within the Ministry of [...].

(b) The Industrial Property Registry shall be entrusted with all functions relating to the procedure for the grant of patents and the registration of industrial designs, marks and collective marks and for the administration of granted patents and registered industrial designs, marks and collective marks as specified in this Act and the Regulations.

(2)(a) The Registrar shall be appointed by the [...].

(b) The Registrar shall be assisted by a Deputy and such Assistant as may be appointed and shall superintend and perform all duties required by this Act and the Regulations and shall have the authority to carry out studies, programs or exchanges of items or services regarding domestic and international industrial property law.

(c) Decisions shall be signed by the Registrar or an official designated by him.

(3) The Minister shall determine the organizational structure and regulate all questions concerning the financial and budgetary system of the Industrial Property Registry.

*Section 34*

*Subsection (2):* The publications required under this Act may be effected either as part of a gazette or part of an official journal, depending on the administrative convenience of the Government.

*Section 35*

*Subsection (1):* The Registrar may correct any obvious errors, as opposed to making amendments, in any document filed or registered with his Office.



Registers;  
Official Bulletin

34.(1)(a) The Industrial Property Registry shall maintain separate Registers for patents, industrial designs and marks. Collective marks shall be registered in a special section of the Register of Marks. All the recordings provided for in this Act shall be effected in the said Registers.

(b) The Registers may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the Regulations.

(2) The Industrial Property Registry shall publish in the Official Bulletin all the publications provided for in this Act.

Corrections of Errors;  
Extension of Time

35.(1) The Registrar may, subject to any provision in the Regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Industrial Property Registry or in any recording effected pursuant to this Act or the Regulations.

(2) If the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the Regulations, upon notice to the parties concerned and upon such terms as he may direct. The extension may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of  
Discretionary  
Powers

36. The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Act or the Regulations.

Competence of  
Court; Appeals

37.(1) The [...] Court shall have jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which under this Act [and the Regulations] are to be referred to the court.

(2) Any decision taken by the Registrar under this Act, in particular the grant of a patent or the registration of an industrial design or of a mark or collective mark, or the refusal of an application for such a grant or registration, may be the subject of an appeal by any interested party before the [...] Court and such appeal shall be filed within [two] months of the date of the decision.

Infringement;  
Unlawful Acts;  
Offenses

38.(1) Subject to Sections 10(4), 12, 13, 20(3) and 26(3), an infringement shall consist of the performance of any act referred to in Sections 10, 20 and 26 in Samoa by a person other than the owner of the title of protection and without the agreement of the latter.

(2) On the request of the owner of the title of protection, or of a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, the court may grant an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in Sections 30(2), award damages and grant any other remedy provided for in the general law.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) hereof or an unlawful act as defined in Sections 30(2) shall be guilty of an offense punishable by a fine not exceeding ..... or by imprisonment for a term not exceeding ....., or by both.

(4)(a) For the purposes of civil proceedings in respect of the infringement of rights of the owner, if the subject matter of a patent is a process for obtaining a product, the court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.

It is to be noted that *subsection (4)(b)* provides for the reversal of the burden of proof and the presumption of infringement in respect of a product identical to the product obtained from a patented process in the case where the product is new or where a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used. The TRIPS Agreement allows, in its Article 34, to provide for the reversal of the burden of proof and the presumption of infringement if the conditions set out in *paragraph (i)* or, alternatively, the conditions set out in *paragraph (ii)* are fulfilled.

*Subsection (5)* seeks to strike a balance between the interests of the owner of the patent for a process and the interests of the alleged infringer (defendant). The alleged infringer may well have obtained the identical product in question by using a different process which he has kept secret. The Court before which the infringement proceedings take place is, therefore, required to take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.



(b) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process in [either of] the following circumstances:

[alternative]\*

[(i)] if the product obtained by the patented process is new, [or]

[(ii)] if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(5) In requiring the production of evidence, the Court before which the proceedings referred to in subsection (4) take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Application of  
International  
Treaties

39. The provisions of any international treaties in respect of industrial property to which Samoa is a party shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, shall prevail over the latter.

Regulations;  
Administrative  
Instructions

40.(1) The Minister shall issue Regulations prescribing details for the implementation of this Act. The Regulations may, in particular, provide for the payment of fees in connection with applications for the grant of patents and for the registration of industrial designs, marks and collective marks and matters related thereto.

(2) The Registrar may issue Administrative Instructions relating to the procedures under this Act and the Regulations as well as to the other functions of the Industrial Property Registry.

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Article 34 of the TRIPS Agreement states that countries shall be free to provide that the burden of proof indicated in subsection (4) shall be on the alleged infringer only if the condition referred to in subparagraph (b)(i) is fulfilled or only if the condition referred to in subparagraph (b)(ii) is fulfilled.

*Section 42*

*Subsection (3):* expressly provides that patents granted and trade marks registered under the existing legislation shall remain in force but shall be subject to this Act.

*Subsection (4):* This subsection states the period for which patents granted under the existing law will remain in force, taking due account of Article 70.2 of the TRIPS Agreement which requires that the term of protection of patents granted under the existing law be extended, for a period of altogether 20 years (provided that the protection has not yet expired at the said date) and makes them subject to payment of the maintenance fees required under this Act.

Interpretation

41. In this Act, unless the context otherwise requires:

“Court” means the court referred to in Section 37;

“International Classification” means, as regards industrial designs, the classification according to the Locarno Agreement Establishing an International Classification for Industrial Designs and, as regards marks, the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as last revised;

“Minister” means the Minister of [...];

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March, 20, 1883, as last revised;

“Priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“Registers” means the Registers referred to in Section 34(1);

“Regulations” means the Regulations referred to in Section 40(1).

Entry Into Force; Repeals;  
Transitional Provisions

42.(1) This Act shall enter into force on [.....]

(2) The following are hereby repealed:

[list of existing Laws]

(3) Notwithstanding the repeal of [...], patents granted and trademarks registered thereunder shall remain in force but shall, subject to subsections (4) and (5), be deemed to have been registered under this Act.

(4) Patents thus granted shall remain in force for the unexpired portion of the period of protection provided under this Act, subject to the payment of annual maintenance fees provided for in this Act.

*Subsection (5):* This subsection states the period for which trade marks registered under the existing law will remain in force, makes them subject to payment of the renewal fees required under this Act and provides for their reclassification at the time of renewal.

*Subsection (6)* takes due account of the fact that industrial designs registered in the United Kingdom are automatically protected in Samoa under the existing legislation.

*Subsection (7):* taking into account the existing legislation in Samoa (according to which the confirmation of United Kingdom patents and of European patents designating the United Kingdom and the (re-)registration of marks registered in the UK may be obtained and UK designs are automatically protected in Samoa), and in order to avoid loss of rights which existed thereunder, would give holders of titles in the United Kingdom, or applicants therefor, a time limit of 12 months within which they can file applications under the Act and maintain their United Kingdom or other filing date. *Paragraph (b)* does not contain a reference to proprietors of industrial designs already registered in the United Kingdom at the date of entry into force of this Act since the existing legislation provided for their automatic protection in Samoa. The reference to European patents with effect in the United Kingdom (EU/UK patents) has been placed in square brackets since the WIPO Secretariat has no sufficient information as to whether the confirmation of EU/UK patents is possible in Samoa.



(5) Trademarks thus registered shall be due for renewal within the same period as under [...] and, upon renewal, shall be reclassified in accordance with the International Classification.

(6) Notwithstanding the repeal of [...], industrial designs protected thereunder shall remain in force for the unexpired period of protection provided for under the United Kingdom Registered Designs Act.

(7) A person who on the date of entry into force of this Act

(a) is the owner of a patent granted in the United Kingdom [or a European patent designating the United Kingdom] or has filed an application for the grant of a patent in the United Kingdom [or an application for a European patent designating the United Kingdom];

(b) has filed an application for registration of an industrial design in the United Kingdom; or

(c) is the proprietor of a trademark registered in the United Kingdom [or a (European) Community trademark] or an international registration of a trademark designating the United Kingdom or has filed an application for registration of a trademark in the United Kingdom [or of a (European) Community trademark].

may, within 12 months of the entry into force of this Act, file an application for the grant of a patent for the same invention or for the registration of the same industrial design or trademark under this Act. Such application shall be accorded the filing date or, where priority has been claimed, any priority date accorded to the application, grant or registration in the United Kingdom [or the filing date or priority date accorded to the patent application designating the United Kingdom or the grant by the European Patent Office] [or the filing date or priority date accorded to the application for a (European) Community trademark or the registration of a (European) Community trademark. Where a trademark has been registered internationally, the date of application shall be the date referred to in Article 3(4) of the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks].

*Subsection (8)* contains corresponding provisions for international applications for patents under the PCT.

*Subsection (9)*: It may not be possible to foresee all the cases that need to be covered during the transitional period. *Subsection (9)* therefore allows the Minister to supplement the present section, if necessary or desirable, by subsidiary legislation.

(8) A person who on the date of entry into force of this Act has filed an international application under the Patent Cooperation Treaty designating the United Kingdom for a national patent or for a European patent may, subject to subsection (9), file an application for the grant of a patent for the same invention under this Act, and such application shall be accorded the filing date and any priority date accorded to the international application designating the United Kingdom.

(9)(a) Where the designation is for a national patent, the application under this Act must be filed within 12 months of the entry into force of this Act, or within 12 months of the date on which the international application enters into the national phase before the patent Office of the United Kingdom, whichever expires later.

(b) Where the designation is for a European patent, the application under this Act must be filed within 12 months of the entry into force of this Act, or within 12 months of the date on which the international application enters into the regional phase before the European Patent Office, whichever expires later.

(10) The Minister may by [Order] [Statutory Instrument] make any further transitional or saving provisions which appear to him to be necessary or desirable.

[End]