

INTELLECTUAL PROPERTY AMENDMENT BILL 2019

SAMOA

Explanatory Memorandum

1.0 Object and reasons:

- 1.1 The Bill seeks to amend the Intellectual Property Act 2011 (“principal Act”) to domesticate and give effect to Samoa’s international obligations under the Hague Agreement, Lisbon Agreement and the Patent Cooperation Treaty.

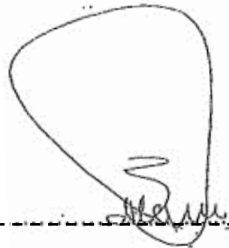
Clauses:

- Clause 1:** - provides for the short title and commencement.
- Clause 2:** - amends the arrangement of provision of the principal Act, to insert the term “trade” before “mark” to ensure provisions refer to “trade mark” at the commencement of the Bill.
- Clause 3:** - amends section 2 of the principal Act to insert the following new definitions, “Geneva Act of the Lisbon Agreement”, “Patent Cooperation Treaty” and “1999 Act”. This clause also amends the following definitions “basic registration”, “collective mark”, “international registration” and “mark” to insert the term “trade” before “mark”.
- Clause 4:** - inserts a new section 3A providing for new definitions to be used in Part 2.

- Clause 5:** - inserts a new section 18A to provide that a person may file an international application for the protection of his or patent under the Patent Cooperation Treaty.
- Clause 6:** - substitutes section 31 to include new definitions to be used in Part 4.
- Clause 7:** - section 44(5) is substituted include reference to a decision of the “International Bureau”.
- Clause 8:** - inserts new sections 44A, 44B, 44C and 44D to provide that a person may file an international application and registration for the protection of his or her designs under the Hague Agreement, the effects of the international registration, the initial term and renewal of the international registration and duration of the protection and the maximum period in which an industrial design can be deferred its publication.
- Clause 9:** - amends Part 5 heading and sections 45 - 48 of the principal Act to insert the term “trade” before “mark” wherever occurring.
- Clause 10:** - amends section 49 of the principal Act to insert the term “trade” before “mark” where first and third occurring.
- Clause 11:** - amends section 50 of the principal Act to insert the term “trade” before “mark” where second and third occurring.
- Clause 12:** - amends sections 52 to 54 of the principal Act to insert the term “trade” before “mark” wherever occurring.
- Clause 13:** - amends section 55 of the principal Act to insert the term “trade” before “mark” where it third occurs.

- Clause 14:** - amends sections 56 to 59 of the principal Act to insert the term “trade” before “mark” wherever occurring.
- Clause 15:** - amends section 60 of the principal Act to insert the term “trade” before “mark” wherever occurring.
- Clause 16:** - substitutes current section 83 principal Act with a new section 83 to provide new definitions.
- Clause 17:** - repeals section 84.
- Clause 18:** - substitutes current section 86 of the principal Act with a new section 86.
- Clause 19:** - substitutes current section 87 of the principal Act with a new section 87.
- Clause 20:** - amends section 88 of the principal Act to reflect changes made to section 86.
- Clause 21:** - amends section 89 of the principal Act to reflect changes made to section 86 and remove references to the term “foreign”.
- Clause 22:** - amends section 93 of the principal Act to substitute paragraph (f) and insert new paragraph (g) and removing of the term “foreign”.
- Clause 23:** - amends section 97 of the principal Act to remove reference to “foreign”.
- Clause 24:** - amends section 101 of the principal Act to insert the term “trade” before “mark”.
- Clause 25:** - inserts new sections 102A to 102G to provide for international registration of appellation of origin and geographical indication under the Geneva Act of the Lisbon Agreement. To also provide for protection of the international registration only when an administrative fee is paid and other procedural requirements as Samoa is obligated to comply under the Lisbon Agreement.

- Clause 26:** - amends sections 113, 116, 118, 124 and 126 of principal Act to insert the term “trade” before “mark”.
- Clause 27:** - amends section 137 of the principal Act to insert new paragraph (kc).
- Clause 28:** - amends section 140 of the principal Act to insert “trade” before “mark”.
- Clause 29:** - repeals Schedule 3 of the principal Act.
- Clause 30:** - makes general amendments to the principal Act to insert “appellation of origin” after “geographical indication”.
- Clause 31:** - makes consequential amendments to the Customs Act 2014 to insert the term “trade” before “mark” in sections 306, 307 and 314.



(Hon LAUTAFI Fio Selafi Joseph Purcell)

MINISTER FOR COMMERCE, INDUSTRY AND LABOUR

INTELLECTUAL PROPERTY AMENDMENT BILL 2019

SAMOA

Arrangement of Provisions

1. Short title and commencement
2. Arrangement of provisions and long title amended
3. Section 2 amended
4. New Section 3A inserted
5. New Section 18A inserted
6. Section 31 substituted
7. Section 44 amended
8. New Sections 44A, 44B, 44C and 44D inserted
9. Part 5 heading, sections 45 - 48 amended
10. Section 49 amended
11. Section 50 amended
12. Sections 52 to 54 amended
13. Section 55 amended
14. Sections 56 to 59 amended
15. Section 60 amended
16. Section 83 substituted
17. Section 84 repealed
18. Section 86 substituted
19. Section 87 substituted

20. Section 88 amended
21. Section 89 amended
22. Section 93 amended
23. Section 97 amended
24. Section 101 amended
25. New Sections 102A-102G inserted
26. Sections 113, 116, 118, 124 and 126 amended
27. Section 137 amended
28. Section 140 amended
29. Schedule 3 repealed
30. General amendments to the Act
31. Consequential amendments to the Customs Act 2014

2019, No.

A BILL INTITULED

AN ACT to amend the Intellectual Property Act 2011 (“Principal Act”) in order to give effect to the Patent Cooperation Treaty, The Geneva Act (1999) of the Hague Agreement Concerning the International Registration of Industrial Designs and Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

BE IT ENACTED by the Legislative Assembly of Samoa in Parliament assembled as follows:

1. Short title and commencement:

This Act may be cited as the Intellectual Property Amendment Act 2019 and commences on the date of assent by the Head of State.

2. Arrangement of provisions and long title amended:

In the arrangement of provisions and long title of the Principal Act before the words “marks” or “mark” wherever occurring, insert “trade”.

3. Section 2 amended:

Section 2 of the Principal Act is amended as follows:

(a) insert in its alphabetical order the following new definitions:

““Geneva Act of the Lisbon Agreement” means the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications and Regulations under the Geneva Act of the Lisbon Agreement;

“Patent Cooperation Treaty” means the Patent Cooperation Treaty done at Washington on June 19, 1970;

“1999 Act” means the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs, which was adopted on July 2, 1999, and entered into force on December 23, 2003;”;

(b) in the following definitions, insert the word “trade”, before the word “mark” -

(i) “basic application”;

(ii) “basic registration”;

(iii) “collective mark”;

(iv) “international registration”; and

(v) “mark”.

4. New section 3A inserted:

Before section 4 of the Principal insert:

“3A. Definitions:

In this Part:

“Administrative Instructions” means the Administrative Instructions made under the Patent Cooperation Treaty as revised from time to time;

“Contracting State(s)” means a State(s) party to the Patent Cooperation Treaty;

“international application” means an application made under the Patent Cooperation Treaty;

“receiving Office” means the national Office or the intergovernmental organization with which the international application for a patent has been filed under the Patent Cooperation Treaty;

“Regulations” means the Regulations under the Patent Cooperation Treaty as in force from July 1, 2019.”.

5. New Section 18A inserted:

After section 18 of the Principal Act insert:

“18A. International application:

- (1) A person may file an international application for a patent with the Ministry through the Registrar.
- (2) An application made under subsection (1) is made pursuant to requirements and procedures under the Act, Patent Cooperation Treaty, Regulations, Administrative Instructions and as prescribed.
- (3) A person referred to under subsection (1) includes any of the following:
 - (a) a citizen of Samoa;
 - (b) a permanent resident of Samoa;
 - (c) a resident of a Contracting State;
 - (d) a national of a Contracting State;

- (e) a temporary resident of Samoa or a Contracting State.
- (4) The Ministry shall be the receiving office for the purposes of an international application under the Patent Cooperation Treaty.”.

6. Section 31 substituted:

Section 31 of the Principal Act is substituted as follows:

“31. Definitions:

In this part:

“Administrative Instructions” means the Administrative Instructions made under the 1999 Act as revised from time to time;

“Common Regulations” means the Common Regulations under the 1999 Act and the 1960 Act of the Hague Agreement, as last revised;

“Contracting Party” means any State or intergovernmental organization party to the 1999 Act;

“creator”, in relation to a design, means the person who created it;

“design” means the design of any aspect of the shape, pattern or configuration (whether internal or external) of the whole or part of an article, but does not include:

- (a) a method or principle of construction; or
- (b) features of shape or configuration of an article which -
 - (i) are dictated solely by the function which the article has to perform; or
 - (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part.

“international application” means an application for international registration;

“international registration” means the international registration of an industrial design effected according to the 1999 Act.”.

7. Section 44 amended:

Section 44(5) of the Principal Act is substituted with the following:

“(5) A person affected by the invalidation of a registered design may appeal to the Court of Appeal for a review of the International Bureau’s decision or the Supreme Court’s decision.”.

8. New Sections 44A, 44B, 44C and 44D inserted:

After section 44 of the Principal Act insert:

“44A. International application and registration of designs:

- (1) A person may file an international application for the international registration of a design under the 1999 Act to the International Bureau through the Ministry.
- (2) An application made under subsection (1) is made pursuant to requirements and procedures under the Act, 1999 Act, Common Regulations, Administrative Instructions.
- (3) A person referred to under subsection (1) includes any of the following:
 - (a) a citizen of Samoa;
 - (b) a permanent resident of Samoa;
 - (c) a national of a State that is a Contracting Party or of a State member of an intergovernmental organization that is a Contracting Party;
 - (d) a person that has a domicile, a habitual residence or a real and effective industrial or commercial establishment in the territory of a Contracting Party.

- (4) Where the applicant files his or her application through the Ministry, the Ministry may charge a prescribed transmittal fee for such application.
- (5) An international application may contain a request that the publication of the design, upon registration, be deferred for a period not exceeding 12 months from the date of filing or, if priority is claimed, from the date of priority, of the application.

44B. Effects of International Registration:

- (1) The international registrations shall, from the filing date of the international application, have the same effect in Samoa as a regularly-filed application for the grant of protection of the industrial design under this Act.
- (2) If the Registrar has not communicated a refusal in accordance with Article 12 of the 1999 Act, the international registration shall have the same effect as a grant of protection for the industrial design under this Act from the filing date of the international application.
- (3) Where the Registrar has communicated a refusal and has subsequently withdrawn, in part or in whole that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in Samoa as a grant of protection for the industrial design under this Act from the filing date of the international application.

44C. Initial Term and renewal of the international Registration and duration of protection:

The initial term and renewal of the international registration and duration of protection shall be in accordance with the 1999 Act.

44D. Deferment of publication:

The maximum period for the deferment of publication of an industrial design under this Act is 12 months from the date of filing of the application or, if priority is claimed, from the date of priority.”.

9. Part 5 heading, sections 45 - 48 amended:

In Part 5 heading and section 45 to 48 of the Principal Act before “marks” or “mark” wherever occurring, insert “trade”.

10. Section 49 amended:

In section 49 of the Principal Act before “mark” where first and third occurring, insert “trade”.

11. Section 50 amended:

In section 50 of the Principal Act before “mark” where second and third occurring, insert “trade”.

12. Sections 52 to 54 amended:

In sections 52 to 54 of the Principal Act before “mark” wherever occurring, insert “trade”.

13. Section 55 amended:

In section 55 of the Principal Act before “mark” wherever occurring, except where it third occurs, insert “trade”.

14. Sections 56 to 59 amended:

In sections 56 to 59 of the Principal Act before “mark” wherever occurring, insert “trade”.

15. Section 60 amended:

In section 60 of the Principal Act before “mark” or “marks” wherever occurring, insert “trade”.

16. Section 83 substituted:

For Section 83 of the Principal Act substitute:

“83. Definitions:

In this part:

“appellation of origin” means a denomination as referred to in Article 2(1)(ii) of the Geneva Act of the Lisbon Agreement;

“Administrative Instructions” means the Administrative Instructions made under the Geneva Act of the Lisbon Agreement as revised from time to time;

“area” includes a country, region, trans-border geographical areas, locality or place;

“Common Regulations” means the Common Regulations under the Geneva Act of the Lisbon Agreement, as last revised;

“Contracting Party” means any State or intergovernmental organization party to the 1999 Act;

“geographical indication” means an indication, however expressed, which identifies a product as originating in a particular area, if some quality, reputation or other characteristic of the product is essentially attributable to its geographical origin;

“international application” means an application for international registration;

“International Register” means the International Register maintained by the International Bureau in accordance with Article 4 of the Geneva Act of the Lisbon Agreement as the official collection of data concerning international registrations of appellations of origin and geographical indications, regardless of the medium in which such data are maintained;

“international registration” means the international registration recorded in the International Register;

“Regulations” means the Regulations made under the Geneva Act of the Lisbon Agreement;

“good(s)” means:

- (a) any natural or agricultural good(s); or
- (b) any good(s) of handicraft or industry; and
- (c) includes wines and spirits.”.

17. Section 84 repealed:

Section 84 of the Principal Act is repealed.

18. Section 86 substituted:

For section 86 of the Principal Act substitute:

“86. Protection in respect of registered appellations or origin and geographical indications:

- (1) A person is prohibited from:
 - (a) using an appellation of origin or a geographical indication -
 - (i) in respect of goods of the same kind as those to which the appellation of origin or the geographical indication applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication;
 - (ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and

would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation;

- (b) conducting or doing any other practice that misleads consumers as to the true origin, provenance or nature of the goods.
- (2) Subsection (1)(a) also applies to the use of the appellation or origin or geographical indication:
- (a) amounting to its imitation, even if the true origin of the goods is indicated; or
 - (b) if the appellation of origin or the geographical indication is used in translated form or is accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar” or the like.
- (3) Despite provisions of this Act and Article 13(1) of the Geneva Act of the Lisbon Agreement, the Registrar may refuse or invalidated ex officio or at the request of an interested party, the registration of a later trade mark or collective trade mark if the use of the trade mark or collective trade mark would result in or of the situations covered under subsections (1) and (2).
- (4) No person shall if such good falls within prohibition under subsections (1) and (2) do any of the following:
- (a) sell any good; or
 - (b) import any good for sale in Samoa; or

- (c) export any good for sale outside Samoa; or
- (d) manufacture any good for sale.
- (5) A person who contravenes subsection (1) or (2) or (4) commits an offence.

19. Section 87 substituted:

For section 87 of the Principal Act, substitute:

“87. Institution of proceedings in relation to contravention of section 86:

An interested person may initiate proceedings in the Supreme Court in order to:

- (a) prevent a contravention of section 86; or
- (b) seek any other remedy arising out of a contravention of section 86.”.

20. Section 88 amended:

- (1) For section heading of section 88 of the Principal Act substitute, “use of misleading geographical indication” with “contravention of section 86”.
- (2) For section 88(4) and (5) of the Principal Act, substitute “84” with “86”.

21. Section 89 amended:

In section 89 of the Principal Act:

- (a) for section heading substitute, “use of misleading geographical indication” with “contravention of section 86”;
- (b) omit “foreign” where first and second occurring.

22. Section 93 amended:

In section 93 of the Principal Act:

- (a) for subsection (3)(f) substitute:

“(f) the application is for the registration of a geographical indication that is not identical with a term customary in common language as the common name for such products in Samoa; and”;

(b) after subsection (3)(f) insert:

“(g) the application is for the registration of a geographical indication that does not prejudice a prior trade mark applied for or registered in good faith, or acquired through use in good faith.”; and

(c) omit “foreign” where first occurring.

23. Section 97 amended:

In section 97 of the Principal Act, omit “foreign” where first occurring.

24. Section 101 amended:

In section 101 of the Principal Act before “mark”, “marks” or “mark’s” wherever occurring, insert “trade”.

25. New Sections 102A-102G inserted:

After section 102 of the Principal Act insert:

“102A. International registration of appellation of origin and geographical indications:

- (1) A person may file an international application for the international registration of an appellation of origin or a geographical indication under the Geneva Act of the Lisbon Agreement, to the International Bureau through the Ministry.
- (2) An application made under subsection (1) is made pursuant to requirements and procedures under the Act, Geneva Act of the Lisbon Agreement, Common Regulations, Regulations, Administrative Instructions and as prescribed.

- (3) An application made under subsection (1) is accompanied by a fee as provided under the Geneva Act of the Lisbon Agreement, Common Regulations, Regulations, Administrative Instructions or as prescribed.

102B. Protection of international registration to extend to Samoa on payment of an administration fee:

- (1) The protection resulting from international registration of each appellation of origin and each geographical indication shall extend to the Government of the Independent State of Samoa only when an administrative fee is paid to cover its cost of substantive examination of the international registration.
- (2) There shall also be paid by beneficiaries of the appellation of origin or the geographical indication registered internationally an administrative fee for every 10 year period relating to the use by the beneficiaries of the appellation of origin or the geographical indication in the Independent State of Samoa.
- (3) The administration fees under subsections (1) and (2) are to be prescribed by Regulations.

102C. Ministry may request for cancellation of international registration:

The Ministry may request the International Bureau to cancel an international registration of a geographical indication or appellation of origin.

102D. Protection against becoming generic:

Subject to provisions of this Act and the Geneva Act of the Lisbon Agreement, registered appellations of origin and registered geographical indications cannot be considered to have become generic.

102E. Withdrawn of refusal:

A refusal may be withdrawn in accordance with the procedures specified in the Regulations made under the Geneva Act of the Lisbon Agreement of as prescribed.

102F. Transitional period:

- (1) The Ministry may grant a transitional period for termination of use of an international registration in relation to circumstances where the Ministry has not refused the effects of an international registration on the ground of prior use by a third party or has withdrawn such refusal or has notified a grant of protection.
- (2) The grant of a transitional period is subject to procedures provided under the Regulations or as prescribed.

102G. Notification of Grant of Protection:

The Ministry may notify International Bureau of the grant of protection to a registered appellation of origin or geographical indication.

102H. Invalidation of the effects of international registration:

- (1) The Ministry must notify the International Bureau of the invalidation of the effects of an international registration.
- (2) The Invalidation of the effects of international registration, in part or in whole, of any international registration may only be pronounced only after having given the beneficiaries or person an opportunity to defend their rights.”.

26. Sections 113, 116, 118, 124 and 126 amended:

In sections 113, 116 and 118 of the Principal Act before “mark” or “marks” wherever occurring insert “trade”.

27. Section 137 amended:

After section 137(2)(kb)(vii) of the Principal Act, insert:

“(kc) for the purpose of giving effect in Samoa of the Geneva Act of the Lisbon Agreement, Patent Cooperation Treaty and 1999 Act and any related matter;”.

28. Section 140 amended:

In section 140 of the Principal Act before “marks” where first and second occurring, insert “trade”.

29. Schedule 3 repealed:

Schedule 3 of the Principal Act is repealed.

30. General amendments to the Act:

In the Principal Act after “geographical indication(s)”, wherever occurring, insert “or appellation of origin(s)”.

31. Consequential amendments to the Customs Act 2014:

(1) In section 306 of the Customs Act 2014:

- (a) for the definition of “infringing sign”, before “mark” where second occurring, insert “trade”;
- (b) for the definition of “mark”, before “mark” insert “trade”;
- (c) for the definition of “registered trade mark” before “mark” where second occurring, insert “trade”.

- (2) In sections 307 and 314 of the Customs Act 2014 before “mark” wherever occurring, insert “trade”.
