

*Subsection (3)* states that the grounds for invalidation may be proved in respect of only some of the claims or some parts of a claim. When invalidation is declared, it has retroactive effect since the patent should not have been granted (such grant being contrary to the law) or should not have been granted to the person to whom it was granted. The consequences of the retroactive character of invalidation will be governed by the general rules of law of the country.

*Subsection (4)* states that when the decision pronouncing invalidation becomes final, in other words, when all remedies of appeal have been exhausted or can no longer be availed of, the public should be informed as soon as possible of the termination (whether total or partial) of the rights conferred by the patent.

(3) Any invalidated patent, or claim or part of a claim, shall be regarded as null and void from the date of the grant of the patent.

(4) The final decision of the court shall be notified to the Registrar who shall record it and publish a reference thereto as soon as possible.

## PART II

### INDUSTRIAL DESIGNS

#### *Section 15*

The definition in *subsection (1)* must be understood in a broad sense. Everything which gives rise, in the appearance of a product, to an esthetic impression (i.e., an impression received by the sense of sight) can be an industrial design. This would comprise any material including so-called "textile designs." The definition also comprises external effects resulting from the use of certain processes such as oxidization, enameling, etc. A concrete aspect must always be involved; a manufacturing method is not protected as an industrial design.

*Subsection (2)* excludes, from protection, elements in a design which, although within the definition of *subsection (1)*, are in the design only for the purpose of obtaining a technical result and to the extent that it thus cannot be claimed that the elements are the result of personal creativity. Such elements are within the domain of patent law and are outside the protection conferred under industrial design law. An example of such an element, in the design of a new ball-point pen, would be the part the purpose of which is to expose and retract the writing tip. Here, the ball-point pen as a whole would be protected as an industrial design, but the mechanism for exposing or retracting the writing tip would not be so protected; it may be the subject of a patent.

## PART II

### INDUSTRIAL DESIGNS

#### Definition of "Industrial Design"

15.(1) For the purposes of this Act, any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors, is deemed to be an industrial design, provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

(2) The protection under this Act does not extend to anything in an industrial design which serves solely to obtain a technical result and to the extent that it leaves no freedom as regards arbitrary features of appearance.

## Section 16

*Subsection (1)* provides that, in order to be registrable, an industrial design must be new.

*Subsection (2)* provides for a requirement for universal novelty so far as publications in tangible form and so far as other forms of disclosure are concerned. It also allows, as in the case of patents (see comments on *Section 2(2)(c)*, above), a “grace period” of twelve months for filing an application after the public disclosure of an industrial design.

*Subsection (3)* provides that designs contrary to morality (e.g., obscene forms) or public order (e.g., the emblem of a public authority) are excluded from protection.

## Section 17

The provisions of this Act which apply to patents are made applicable, with due alterations, to industrial designs with regard to: the right to registration of an industrial design; industrial designs created jointly by two or more persons; the right to assign a registered industrial design; and the right of the creator of an industrial design to be named in the registration (see comments on *Section 3*, above).

## Section 18

This Section deals with the requirements of an application for registration of an industrial design and is to be supplemented by the Implementing Regulations.

*Subsection (2):* (See second paragraph of comments on *Section 4*, above.)

*Subsection (3):* (See comments on *Section 6*, above.)

*Subsection (4)* does not impose a limit on the maximum number of industrial designs that may be the subject of an application. However, the industrial designs that may be included in the same application are restricted to those designs which belong to the same class of the International Classification or to the same set or composition of articles.

The Regulations can provide that such so-called “multiple applications” shall be subject to the payment of an additional fee which would correspond to a percentage of the basic fee for each additional industrial design.

*Subsection (5)* introduces the possibility of keeping a registered design secret for a period not exceeding 12 months. This responds to the need of some sectors of industry to defer the publication of their designs before the corresponding products reach the market. Particularly in the field of fashion, but also in other sectors, letting competitors know in advance the general line of a design or designs could jeopardize the success of a commercial operation. Deferment of publication for a limited period attempts to strike a balance between the need for secrecy and the need for legal certainty and transparency. Deferment of publication must be requested at the moment of filing the application, since the registration procedure is too short to permit that the request be filed at a later date.



Registrable Industrial Designs

16.(1) An industrial design is registrable if it is new.

(2) An industrial design shall be new if it has not been disclosed to the public, anywhere in the world, by publication in tangible form or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration. Section 2(2)(c) shall apply *mutatis mutandis*.

(3) Industrial designs that are contrary to public order or morality shall not be registrable.

Right to Registration of Industrial Design; Naming of Creator

17. Section 3 shall apply *mutatis mutandis*.

Application

18.(1) The application for registration of an industrial design shall be filed with the Registrar and shall contain a request, drawings, photographs or other adequate graphic representations of the article embodying the industrial design and an indication of the kind of products for which the industrial design is to be used. It may be accompanied by a specimen of the article embodying the industrial design, where the industrial design is two-dimensional. The application shall be subject to the payment of the prescribed application fee.

(2) Where the applicant is not the creator, the request shall be accompanied by a statement justifying the applicant's right to the registration of the industrial design.

(3) Section 6 shall apply *mutatis mutandis*.

(4) Two or more industrial designs may be the subject of the same application, provided they relate to the same class of the International Classification or to the same set or composition of articles.

(5) The application, at the time of filing, may contain a request that the publication of the industrial 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.

(6) The applicant may withdraw the application at any time during its pendency.

*Section 19*

This draft Act provides only for a formal, but not a substantive (in particular as regards novelty), examination of industrial design applications. A substantive examination would require a large collection of industrial designs published anywhere in the world and could not be exhaustive. A system providing only for formal examination is considered appropriate, since registered industrial designs may be subject to proceedings for their invalidation where appropriate.

The procedure is that industrial designs are registered after the positive result of a formal examination, an examination as regards the right of the applicant, where he is not the creator, to the registration of the industrial design and an examination for compliance with the definition of "industrial design" and with the requirements of public order and morality, without any opposition proceedings being entertained. Invalidation proceedings may be instituted under *Section 21*.

*Subsection (1)*: This provision deals with the filing date to be accorded to the application and is similar, in all material respects, to the provisions of *Section 8(1)* which applies to patents (see comments on *Section 8(1)*, above).

*Subsection (2)*: Under this provision, the application is examined for compliance with the prescribed formal requirements and as regards the right of the applicant, where he is not the creator, to the registration of the industrial design. In addition, the application is also examined as to whether the industrial design is an industrial design within the definition provided in *Section 15* and meets the requirements of public order and morality.

*Subsection (3)*: Under this provision the application, if found in order, is registered and published and a certificate issued to the applicant.

*Subsection (4)*: The registered owner, in case of deferment of publication, enjoys a right which can be enforced against infringers. However, since infringers cannot be considered to be aware of the design, in view of its secret nature, the action for enforcement of the rights is, as long as no publication has taken place, subject to a prior communication to the alleged infringer of the whole file, including the representation of the design. This does not imply that the information should also be brought to the knowledge of the public at large.

Examination;  
Registration  
and Publication  
of Industrial Design

19.(1) The Registrar shall accord as the filing date the date of receipt of the application, provided that, at the time of receipt, the application contains indications allowing the identity of the applicant to be established and the required graphic representation of the article embodying the industrial design.

Section 8(1)(b) shall apply *mutatis mutandis*.

(2) After according a filing date, the Registrar shall examine whether the application complies with the requirements of Section 18(1) and (2) and the Regulations pertaining thereto, whether the application fee has been paid and whether the industrial design complies with the requirements of Sections 15 and 16(3) [and the Regulations pertaining thereto].

(3) Where the Registrar finds that the conditions referred to in subsection (2) hereof are fulfilled, he shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design; otherwise, he shall refuse the application.

(4)(a) Notwithstanding subsection (3), where a request has been made under Section 18(5) for deferment of publication, upon registration of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection. In this case, the Registrar shall publish a mention of the deferment of the publication of the industrial design and information identifying the registered owner, and indicating the filing date of the application, the length of the period for which deferment has been requested and any other prescribed particulars.

(b) At the expiry of the period of deferment, the Registrar shall publish the registered industrial design.



*Section 20*

The provisions of this Section, regarding the rights conferred by the registration of an industrial design, are similar, in all material respects, to those of *Section 10* concerning patents (see comments on *Section 10*, above).

*Subsection (3)* applies, to registered industrial designs, the limitation with regard to the "exhaustion of rights" (see comments on *Section 10(4)(a)(i)*, above).

*Subsection (5)*: Once registered, an industrial design is protected for a period of five 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. If, nevertheless, the date of registration is chosen as the starting point, it would be appropriate to reduce the five year duration by the average period that elapses between the filing date and the date of registration (e.g., one year).

The owner of the registered industrial design, by merely paying the fee prescribed (in the Implementing Regulations), can renew the registration for two further consecutive periods of five years each. As in the case of patents, and for the same reasons (see comments on *Section 11(2)*, above), the fees for the first and second renewals would increase progressively and a grace period is allowed for the late payment of the renewal fee.

(c) The institution of legal proceedings on the basis of a registered industrial design during the period of deferment of publication shall be subject to the condition that the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

Rights Conferred by  
Registration; Duration  
Renewal

20.(1) The exploitation of a registered industrial design in Samoa by persons other than the registered owner shall require the agreement of the latter.

(2) For the purposes of this Act, "exploitation" of a registered industrial design means the making, selling or importation of articles incorporating the industrial design.

(3) The rights conferred by registration of an industrial design 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 registered owner of an industrial design 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 industrial design by performing, without his agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

(5) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration. The registration may be renewed for two further consecutive periods of five years through the payment of the prescribed fee. 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 21*

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

Invalidation

21.(1) Any interested person may request the court to invalidate the registration of an industrial design.

(2) The court shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of Sections 15 and 16 is not fulfilled or if the registered owner of the industrial design is not the creator or his successor in title.

(3) Section 14(3) and (4) shall apply *mutatis mutandis*.



### PART III

## MARKS, COLLECTIVE MARKS- AND TRADE NAMES

### Section 22

The definitions provided in *paragraphs (i) and (ii)* of this Section distinguish between three categories of marks: trademarks, service marks and collective marks.

A mark belonging to any of these categories is always a visible distinctive sign, serving to distinguish the goods or services of one or more enterprises from the goods or services of another enterprise. Within this function of distinguishing goods or services, marks of the three categories have different objectives.

The "trademark" is the classic mark, serving to distinguish the goods of one enterprise (or of several enterprises working under license from the owner of the mark) from the goods of other enterprises. The goods may be manufactured products or natural products; they may be produced or merely sold by the owner of the mark or may be distributed by him without charge, as in the case of wrappings or advertising material.

The "service mark" is the fruit of a more modern notion. This mark fulfills the same function of distinguishing but it distinguishes the services of an enterprise (or of licensed enterprises), and not the goods, from those of other enterprises. These services may be of almost any kind, e.g., publicity, transport, insurance, laundry, treatment of materials.

The "collective mark" serves also to distinguish goods or services. However, it does not distinguish the goods or services of an individual enterprise from those of other enterprises, but goods or services which are produced by different enterprises but have a common origin or other common characteristics. The registered owner of such a mark can be one of those enterprises but may also be a third party--generally a cooperative or an association of enterprises or a public institute--charged with controlling the use of the mark. A collective mark must be designated as such when an application is filed for its registration. The purpose of this is to distinguish collective marks from trademarks and service marks in order to process and register them accordingly.

It would be possible to provide for the protection of "certification marks" in addition to collective marks. In this context, it is understood that the collective mark is used by members of an association, or group or of an entity, whereas the certification mark is used by persons or entities other than the owner of the mark and guarantees a particular characteristic or quality of the goods or services for which it is used.

PART III

MARKS, COLLECTIVE MARKS AND TRADE NAMES

Definition of "Mark,"  
of "Collective Mark"  
and of "Trade Name"

22. For the purposes of this Act:

- (i) "mark" means any visible sign capable of distinguishing the goods ("trademark") or services ("service mark") of an enterprise;
- (ii) "collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;
- (iii) "trade name" means the name or designation identifying and distinguishing an enterprise.

## Section 23

*Subsection (1)* makes it clear that the statutory exclusive right to a mark is secured by registration obtained through fulfillment of the conditions for registration contained in this Act.

*Subsection (2)* sets out the criteria for registrability by listing circumstances under which a mark cannot be validly registered.

*Subsection (2)(i)* mentions the essential requirement for registration--that a mark must be capable of distinguishing the applicant's goods or services from those of others (see comments on *Section 22(i)*, above). A mark that is only descriptive would not satisfy this requirement.

*Subsection (2)(ii)* prohibits marks which are contrary to public order or morality (e.g., obscene pictures or words) and *subsection (2)(iii)* marks that are likely to mislead consumers or trade circles as regards the source or other characteristics of the goods or services concerned. For example, a component in the mark may suggest that the goods concerned have a particular country of origin, whereas, in fact, the goods emanate from a different country; the component may suggest that the goods are made of natural products (e.g., cotton) whereas they are made of synthetic material.

*Subsection (2)(iv)* excludes marks which, without authorization, reproduce or imitate armorial bearings, etc., of States or intergovernmental international organizations. This prohibition is in conformity with the provisions of Article 6<sup>ter</sup> of the Paris Convention.

*Subsection (2)(v)* excludes marks which, in effect, reproduce well-known marks belonging to other persons. There would undoubtedly be confusion in the minds of the public if such marks were registered and used by persons who were not their owners. By excluding, subject to the conditions set out in this subsection, the registration of marks for goods and services other than those similar or identical to those for which the well-known mark has gained its reputation, the provisions seek to prevent the dilution of the reputation of the well-known mark and to prevent damage to the interests of its owner. In determining whether a mark is well known in a country, knowledge of the mark, in the relevant sector of the public, acquired not only as a result of the use of the mark but also by other means, including as a result of its promotion, must be taken into account (Article 16.2 of the TRIPS Agreement).



Acquisition of the  
Exclusive Right to a  
Mark; Registrability

23.(1) The exclusive right to a mark, as conferred by this Act, shall be acquired by registration in accordance with the provisions thereof.

(2) A mark cannot be validly registered:

- (i) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (ii) if it is contrary to public order or morality;
- (iii) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (iv) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organization or organization created by an international convention, unless authorized by the competent authority of that State or organization;
- (v) if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Samoa for identical or similar goods or services of another enterprise, or if it is well-known and registered in Samoa for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use;



*Subsection (2)(vi)* provides for the protection of third-party prior rights on the register. It is mandatory for an application to be refused, in opposition or invalidation proceedings, if the mark is identical to, or confusingly similar to, a mark already recorded on the register in the name of a different person in respect of the same or closely related goods or services.

It should be noted that Article 7 of the Paris Convention provides that the nature of the goods to which a trademark is to be applied shall, in no case, form an obstacle to the registration of the mark. A similar obligation is included in Article 15(4) of the TRIPS Agreement where it is extended to also apply to service marks.

#### *Section 24*

This Section deals with the requirement of an application for registration of a mark and is to be supplemented by the Implementing Regulations. The international classification mentioned in *subsection (1)* is the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. This classification is applied in an ever-growing number of countries and ensures consistency of treatment in classification matters. The subsection envisages that an application may be made in respect of more than one class of goods or services subject, naturally, to a corresponding increase in the application fee. This system is in conformity with the modern trend and minimizes the work without any loss of fees.

As regards the right of priority, reference is made to the comments on *Section 6*, above.

- (vi) if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Application for  
Registration

24.(1) The application for registration of a mark shall be filed with the Registrar and shall contain a request, a reproduction of the mark and a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification. It shall be subject to the payment of the prescribed application fee.

(2)(a) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title [in or for any State party to the said Convention or any Member of the World Trade Organization], in which case, the Registrar may require that the applicant furnish, within the prescribed time limit, a copy of the earlier application, certified as correct by the Office with which it was filed.

(b) The effect of the said declaration shall be as provided in the Paris Convention; if the Registrar finds that the requirements under this subsection and the Regulations pertaining thereto have not been fulfilled, the said declaration shall be considered not to have been made.

(3) The applicant may withdraw the application at any time during its pendency.

*Section 25*

*Subsection (1)(b)* requires the Registrar to examine the applications as to compliance with the requirements of *Sections 22(i)* and *23(2)*. The examination procedure set out in this subsection includes, like the procedure under the existing law of Samoa, an examination as regards conflict with existing registrations or pending applications.

*Subsection (2)* This subsection provides for a procedure under which, after the positive result of an examination for compliance with the requirements of *Section 23(2)*, applications are advertised under *subsection (2)(a)* so that interested persons may file opposition to the registration. Oppositions are decided upon by the Industrial Property Registry, and the registration effected or refused as the case may be.

*Subsection (2)(d)* requires the Registrar, in considering the merits of the case, to hear the parties if either or both wish to be heard. In view of the importance of the decision regarding an opposition it would be undesirable for the decision to be taken only on the basis of the written submissions of the parties particularly if either or both parties wish to be heard.

Some countries may, for reasons of administrative convenience, prefer to have the issue of opposition heard and determined by a Board or by the Court. In that case, the procedure set out in this Section would remain unchanged except that the Registrar, after receipt of a request for a hearing, would transmit all the relevant documentation to the Board, or to the Court, and notify the parties in writing that he has done so.



Examination;  
Opposition;  
Registration of Mark

25.(1)(a) The Registrar shall examine whether the application complies with the requirements of Section 24(1) and the Regulations pertaining thereto.

(b) The Registrar shall examine and determine whether the mark is a mark as defined in Section 22(i) and is registrable under Section 23(2).

(2)(a) Where the Registrar finds that the conditions referred to in subsection (1) hereof are fulfilled, he shall forthwith cause the application, as accepted, to be published in the prescribed manner.

(b) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on the grounds that one or more of the requirements of Section 22(i) and 23(2) and the Regulations pertaining thereto are not fulfilled.

(c) The Registrar shall send forthwith a copy of such a notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counter-statement of the grounds on which he relies for his application; if he does not do so, he shall be deemed to have abandoned the application.

(d) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

(e) After an application is published and until the registration of the mark, the applicant has the same privileges and rights as he would have if the mark had been registered; however, it shall be a valid defense to an action brought hereunder in respect of an act done after the application was published, if the defendant establishes that the mark could not validly have been registered at the time the act was done.