

**SAMOA**

**INTELLECTUAL PROPERTY REGULATIONS 2015**

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**PURSUANT** to section 137 of the Intellectual Property Act 2011, **I, TUI ATUA TUPUA TAMASESE EFI**, Head of State, acting on the advice of Cabinet, **MAKE** the following Regulations:

**DATED** this 27<sup>th</sup> day of October 2015.

signed: (Tui Atua Tupua Tamasese Efi)  
**HEAD OF STATE**

## REGULATIONS

### PART I PRELIMINARY

**1. Citation and commencement-**(1) These Regulations may be cited as the Intellectual Property Regulations 2015.

(2) These Regulations commence on the date they are signed by the Head of State.

**2. Interpretation** - In these Regulations, unless the context otherwise requires:

“Act” means the Intellectual Property Act 2011;

“agent” means a person:

(a) who is authorised by the agent’s principal to act for the principal for any proceeding or application under these Regulations;

(b) who is a practicing barrister or solicitor of the Supreme Court of Samoa; and

(c) for whom recognition has not been refused by the Registrar under regulation 18.

“approved form” means a form approved by the Minister under section 131 of the Act;

“Locarno Classification” means the International Classification for Designs under the Locarno Agreement as set out in Schedule 1 of the Act;

“Ministry” means the Ministry responsible for Commerce, Industry and Labour;

“Nice Classification” means the International Classification of Goods and Services for the Purposes of the Registration of Marks as set out in Schedule 2 of the Act;

“non-compliance report” means a report issued by the Registrar giving notice to an applicant that the application does not comply with a requirement under the Act or these Regulations;

“fee” means a fee prescribed under section 128 of the Act;

“Registry” means the Intellectual Property Registry established under section 118 of the Act;

“right or protection” means any right or protection pertaining to patents, innovation patents, registered designs, marks, collective marks, plant breeder’s rights, geographical indications and circuit layouts as are duly accorded under the Act.

## **PART II APPLICATION FOR REGISTRATION**

**3. Use of approved forms-**(1) Any person making an application for the registration of a right or protection must use the approved form.

(2) Any material that is intended by the applicant to form part of the application for a right or protection:

- (a) must be attached to the application; and
- (b) is taken to be part of the application.

**4. Requirements for filing-**(1) If an application does not meet a requirement under the provisions of the Act, the Registrar must give the applicant written notice of the requirement.

(2) If the applicant meets the requirement referred to in sub-regulation (1) within a period of three (3) months from the date of the notice, the application is taken to be filed on the day on which all the requirements are met.

(3) If the applicant does not meet the requirement referred to in sub-regulation (1) within the period referred to under sub-regulation (2), the application is taken not to have been filed.

**5. Representation of trademarks-**(1) In an application for the registration of a trade mark that contains, or consists of, a 3 dimensional shape:

- (a) if practicable, the representation of the trade mark in the application must be illustrated in a perspective that shows each feature of the trade mark; or

(b) the representation of the trade mark in the application must include views of the trade mark that are necessary to show each feature of the trade mark.

(2) If the Registrar reasonably believes that the views of a trade mark to which sub-regulation (1)(a) or (b) applies are not sufficient to allow all features of the trade mark to be properly examined, the Registrar may, by notice in writing, require the applicant to give to the Registrar up to 6 additional views of the trade mark that show the features sufficiently to permit proper examination of the trade mark.

(3) If a trade mark for which registration is sought contains or consists of a sign that is a colour, shape, or an aspect of packaging, or any combination of those features, the application for registration of the trade mark must include a concise and accurate description of the trade mark that is acceptable to the Registrar.

(4) If the Registrar reasonably believes that the description or representation of a trade mark in an application for registration of the trade mark does not:

(a) demonstrate the nature of the trade mark sufficiently;  
or

(b) show each feature of the trade mark sufficiently,  
to permit proper examination of the trade mark, the Registrar may require the applicant to give to the Registrar a description, or further description, of the trade mark and a specimen of the trade mark.

**6. Representation of a design-**(1) In an application for the registration of a design, the application must:

(a) be accompanied by a representation of the design;  
and

(b) if the design is to be applied to a set of articles, the representation must show the design as applied to each different article included in the set.

(2) The Registrar may at any time before registration require further representation from the applicant.

- (3) Representations must be given to the Registrar:
  - (a) as one (1) or more digital images in an electronic file format acceptable to the Registrar; or
  - (b) in any other format acceptable to the Registrar.
- (4) Each representation must clearly and unambiguously show the novel design features of the design as applied to the article.
- (5) Each digital image may be in black and white, grey scale, or colour.
- (6) Each digital image must be:
  - (a) able to be readily printed on a single-sided A4 international size sheet of paper; and
  - (b) clearly labelled stating the perspective, front, side or any other view of the article.

**7. Specification of goods or services or both for trademarks and products for registered designs-**(1) For the purposes of section 48(2)(d) of the Act, the following sub-regulations set out the manner of specifying, in an application for the registration of a trademark, the goods or services or both in respect of which registration is sought:

- (a) the expression “all goods”, “all services”, “all other goods”, or “all other services” must not be used in an application for registration of a trade mark to specify the goods or services or both in respect of which registration is sought; and
  - (b) the goods or services or both must be grouped according to the appropriate classes as detailed in the Nice Classification; and
  - (c) the applicant must nominate the class number that is appropriate to the goods or services in each group; and
  - (d) the groups must be listed in the order of their class numbers.
- (2) For the purposes of section 39(2)(e) of the Act, the following sub-regulations set out the manner of specifying, in an application for the registration of a registered design, the products in respect of which registration is sought:

- (a) the expression “all products” must not be used in an application for registration of a registered design to specify the products in respect of which registration is sought; and
- (b) the products must be grouped according to the appropriate classes as detailed in the Locarno Classification; and
- (c) the applicant must nominate the class number that is appropriate to the products in each group; and
- (d) the groups must be listed in the order of their class numbers.

**8. Convention priority claims-**(1) An applicant must claim a right of priority for an application by filing notice of that claim when filing the application.

(2) The Registrar must not extend the time for making a claim for convention priority.

**9. Allocation of number to application** - On receipt of an application for any right or protection under the Act, the Registrar must allocate a number to each application.

**10. Publication of particulars of application** - The Registrar must, upon payment of the fee, publish the following particulars of the application:

- (a) the number allocated to the application by the Registrar;
- (b) the applicant’s name and the applicant’s agent’s name and address;
- (c) the date of filing the application;
- (d) particulars of any claim for a right of priority for the application;
- (e) where the application is for a trade mark, the class number or numbers for the goods or services or both in respect of which registration of the trade mark is sought; and

- (f) where the application is for a registered design, the class number or numbers for the products in respect of which registration of the design is sought.

**11. Report to applicant-**(1) A non-compliance report to an applicant must include notice of the date on which the application will lapse if it is not accepted earlier.

(2) Subject to sub-regulation (3), the applicant must write to the Registrar in response to the non-compliance report within three (3) months of the date the Registrar delivered the report to the applicant.

(3) Where the applicant is ordinarily resident outside Samoa, the applicant must respond within six (6) months from the date the Registrar delivered the non-compliance report to the applicant.

(4) As proof of receipt of the non-compliance report, the applicant must sign the delivery notice issued by the Registrar.

**12. Applicant's response to report-**(1) An applicant must respond in writing to the Registrar's report under regulation 11.

(2) The response may be made in relation to any or all of the following:

- (a) contest a belief of the Registrar that is expressed in the report; or
- (b) contest another matter that is mentioned in the report; or
- (c) provide further documents or evidence in support of the application; or
- (d) request that the application be amended in order for the application to comply with the provisions of the Act.

**13. Further report to applicant-**(1) On receipt of a response provided by an applicant under regulation 12, the Registrar must consider the response.

(2) If the Registrar continues to believe that:

- (a) the application has not been made in accordance with the Act or these Regulations; or

(b) there are grounds under the Act for rejecting it, the Registrar must report that belief in writing to the applicant.

(3) Unless acceptance of an application is deferred, a report under sub-regulation (2) in relation to that application must include notice of the date on which the application will lapse if it is not accepted earlier.

**14. Merger or division of applications-**(1) The Registrar may approve the merger of two (2) or more applications upon:

(a) receiving a written request from the applicant; and

(b) being satisfied that the applications -

(i) are for the same trade mark or registered design; and

(ii) have the same filing dates and, if applicable, the same convention priority dates; and

(iii) are in the name of the same applicant; and

(iv) are classified according to the same classification system prescribed in the Act; or

(c) being satisfied that the merger of the applications will address issues in a non-compliance report issued for one (1) or more of the applications.

(2) The Registrar may approve the division of an application upon:

(a) receiving a written request from the applicant that sufficiently identifies the part of a series, classes, goods, services or products to be divided from the application; and

(b) being satisfied that the division of the application will address issues in a non-compliance report issued for the application.

### **PART III AGENTS**

**15. Use of agent for filing of applications-**(1) An application must be filed to the Registrar by an agent whose ordinary residence or principal place of business is in Samoa.

(2) In this regulation, “application” includes an application for any right, proceeding, process or record.

**16. Authorisation of agent-**(1) The appointment of an agent must be by an authorisation of agent using the approved form and must be signed by the applicant.

(2) The original authorisation of an agent form may be filed together with the application or within one (1) month from its filing date.

(3) If the appointment of an agent is not made in accordance with section 117 of the Act and sub-regulation (1), any procedural steps taken by the agent shall be considered not to have been taken.

**17. Rejection of non-complying application** - The Registrar may not accept or register any application that does not comply with this Part.

**18. Registrar may refuse to recognize person as agent-**(1) The Registrar must refuse to recognise a person as an agent:

- (a) whose name has been removed from or struck off the roll of barristers and solicitors under the provisions of the Lawyers and Legal Practice Act 2014, and has not been restored to the roll; or
- (b) who is suspended from practice as a barrister or solicitor; or
- (c) who has been convicted of an offence specified in Part XIV of the Crimes Act 2013 or who has been convicted of an equivalent offence in another country.

(2) Where the Registrar refuses to recognise a person as an agent, the Registrar must, as soon as practicable, notify that person and that person’s principal in writing.

**19. Revocation of appointment of agent-**(1) Any person being the principal of an agent who wishes to revoke the appointment of an agent may do so by applying in writing to the Registrar.

(2) The Registrar must accept any application made under sub-regulation (1) and provide written notice of the application to the affected agent.

#### **PART IV OPPOSITION TO REGISTRATION**

**20. Filing notice of opposition-**(1) A person may in writing file with the Registrar a notice of opposition accompanied by the prescribed fee.

(2) In this Regulation a “person” means:

- (a) a creator, owner or licensee of an intellectual property;
- (b) an agent of the persons mentioned in paragraph (a);
- (c) for trademarks, a person who consider that a trademark is offensive;
- (d) any other person who has any other interest in the intellectual property.

**21. Grounds for extension of time for filing-**(1) A person may apply to the Registrar for an extension of time in which to file a notice of opposition.

(2) An application for an extension of time may be made within the period for filing a notice of opposition on the following grounds:

- (a) an error or omission by a member of staff of the Ministry;
- (b) an error or omission by the person applying for the extension of time, or by the person’s agent;
- (c) circumstances beyond the control of the person applying for the extension of time;
- (d) the conduct of genuine negotiations between that person and the applicant for registration; or
- (e) the undertaking of genuine research to decide -
  - (i) whether opposition is justified; or
  - (ii) on the grounds of opposition.

**22. Application for extension of time for filing** - An application for an extension of time in which to file a notice of opposition must be:

- (a) in writing; and
- (b) accompanied by a declaration stating the facts on which the grounds specified in the application are based.

**23. Grant of extension of time for filing**-(1) Subject to sub-regulations (2) and (4), if the Registrar is reasonably satisfied as to the grounds set out in an application for an extension of time to file a notice of opposition, the Registrar must grant the extension of time.

(2) The Registrar must not grant the extension of time, unless the Registrar:

- (a) is reasonably satisfied that the person applying for the extension of time has served a copy of the application, and the accompanying declaration, on the agent for the applicant for registration of the trade mark; and
- (b) has given to both the person applying for the extension of time and the applicant for registration of the trade mark a reasonable opportunity to make representations concerning the application for extension of time.

(3) For the purposes of sub-regulation (2)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar considers appropriate.

(4) An extension of time must:

- (a) last 60 days at any one (1) time; and
- (b) not be granted more than three (3) times.

**24. Opposition proceedings**-(1) A person may file a notice of opposition to the Registrar relating to any application for the grant of a right or protection under the provisions of the Act.

(2) A notice of opposition must be made in writing.

(3) The Registrar must provide notice of the opposition to the applicant within 10 working days from receipt of the notice.

**25. Evidence in support-**(1) If the person opposing intends to rely on evidence in support of the opposition, the person opposing must file with the Registrar the original evidence in support within two (2) months from the day the notice of opposition is filed by the person opposing.

(2) The Registrar must provide a copy of the evidence in support to the applicant as soon as practicable.

**26. Notice that person opposing will not rely on evidence in support-**(1) If the person opposing does not intend to rely on evidence in support of the opposition, that person must file with the Registrar the original notice stating that that person will not rely on evidence in support of the opposition.

(2) The original notice must be filed within two (2) months from the day that the notice of opposition is filed by the person opposing.

(3) The Registrar must provide a copy of the original notice under sub-regulation (1) to the applicant as soon as practicable.

**27. Failure to file** - If the person opposing does not file evidence in support under regulation 25 or the notice under regulation 26 or apply for extension, the person opposing is taken to have abandoned his or her opposition.

**28. Evidence in answer-**(1) If the applicant intends to rely on evidence in answer to the opposition, the applicant must file with the Registrar the original evidence in answer within the period for service of a copy of that evidence under regulation 29.

(2) The Registrar must provide a copy of the evidence in answer to the person opposing within seven (7) days from the receipt of evidence in answer.

**29. Period for service of a copy of the evidence in answer** - If the person opposing complies with regulation 25 or 26, the period for service of a copy of the evidence in answer to the opposition is two (2) months from the day on which the Registrar serves on the applicant:

- (a) the copy of the evidence in support referred to in regulation 25(2); or
- (b) the copy of the notice referred to in regulation 26(2).

**30. Notice that applicant will not rely on evidence in answer-**(1) If an applicant does not intend to rely on evidence in answer to the opposition, the applicant must file with the Registrar the original notice stating that the applicant will not rely on evidence in answer.

(2) The applicant must file the notice not to rely on evidence in answer within two (2) months from the day the notice of opposition is filed.

(3) The Registrar must provide a copy of the notice to the person opposing not more than seven (7) days from the receipt of the notice.

**31. Failure to file evidence in answer** - If the applicant does not file evidence in answer under regulation 28 or the notice under regulation 30 or apply for extension of time, the applicant is taken to have abandoned his or her application.

**32. Evidence in reply to evidence in answer-**(1) If a person opposing intends to rely on evidence in reply to the evidence in answer, that person must file with the Registrar the original evidence in reply within two (2) months from the day the evidence in answer is filed.

(2) The Registrar must provide a copy of the evidence received under sub-regulation (1) not more than seven (7) days from the receipt of such evidence.

(3) The evidence must be confined to matters strictly in reply.

**33. Notice that persons opposing will not rely on evidence in reply to evidence in answer and failure to file-**(1) If a person opposing does not intend to rely on evidence in reply to the evidence in answer, the person opposing must file with the Registrar, the original notice that he will not rely on the evidence in reply within two (2) months from the day that the evidence in answer is filed.

(2) The Registrar must provide a copy of the notice received under sub-regulation (1) upon the applicant not more than seven (7) days from the receipt of such notice.

(3) If the person opposing does not file evidence in reply to evidence in answer under regulation 32 or the notice under regulation 33 or apply for extension, the evidence is taken to be closed and opposition proceedings must continue.

**34. Hearing of opposition-**(1) Upon completion of the evidence, the applicant or person opposing may request in writing to the Registrar to hear the parties to the opposition proceedings.

(2) The Registrar must conduct a hearing requested under sub-regulation (1) at a venue determined by the Registrar.

(3) If an applicant or person opposing in opposition proceedings does not make a request to the Registrar under sub-regulation (1), the Registrar may, give an opportunity to the parties to the opposition proceedings to be heard in relation to those proceedings.

(4) The Registrar must give notice to the parties of a date when he or she will hear arguments in the opposition proceedings.

(5) The date under sub-regulation (4) must be a date at least 15 working days after the date of the notice unless the parties consent to a shorter notice.

(6) Any party who intends to appear must notify the Registrar in writing by notice within 10 working days from the receipt of the notice.

(7) A party who receives notice and who does not notify the Registrar in accordance with sub-regulation (6) may be treated as not desiring to be heard.

**35. Extension of period to serve evidence and service of further evidence-**(1) A party to the opposition proceedings may apply to the Registrar:

- (a) for an extension of the period for serving a copy of the evidence under regulation 25, 29 or 32; or
- (b) for permission to serve a copy of further evidence on the other party.

(2) The Registrar may grant an application on such conditions as may be determined by the Registrar.

(3) The Registrar must not grant an application unless the Registrar:

(a) is satisfied that a copy of the application, and of any documents accompanying the application has been served on the other party; and

(b) has given the parties a reasonable opportunity to make representations concerning the application; and

(c) is satisfied that -

(i) in the case of an application to which sub-regulation (1)(a) applies, the extension of the period for serving a copy of the evidence; and

(ii) in the case of an application to which sub-regulation (1)(b) applies, permission to serve a copy of further evidence,

is appropriate.

(4) For the purposes of sub-regulation (3)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar considers appropriate.

(5) If the Registrar grants an application under sub-regulation (1)(b) on terms that include service of a copy of the further evidence within a specified period, a party to the opposition proceedings may apply to the Registrar for an extension of that period.

(6) Sub-regulations (2), (3) and (4) apply to an application under sub-regulation (5).

**36. Conduct of opposition proceedings generally-**(1) The Registrar may, give a direction in relation to the procedure in the proceedings.

(2) A direction given under sub-regulation (1) must be consistent with these Regulations.

(3) The Registrar must not give a direction unless the Registrar:

(a) is satisfied that parties to the proceedings have been notified of the proposed direction; and

(b) has given the parties a reasonable opportunity to make representations concerning the proposed direction; and

(c) is satisfied that the proposed direction is appropriate.

(4) For the purposes of sub-regulation (3)(b), the representations may be made in writing or at a hearing or by such other means as the Registrar reasonably allows.

**37. Registrar to give notice of dismissal of proceedings-**

(1) If opposition proceedings are dismissed or discontinued, the Registrar must notify the parties in writing that the opposition proceedings have been dismissed or discontinued.

(2) A notice under sub-regulation (1) must be made within seven (7) working days of the matter being made known to the Registrar.

**PART V**  
**AMENDMENT OF APPLICATION FOR**  
**REGISTRATION AND OTHER DOCUMENTS**

**38. Amendment of applications by Registrar-**(1) Subject

to sub-regulation (2), if the Registrar proposes to amend an application, the Registrar must give notice in writing to the applicant:

(a) setting out the proposed amendment and the reason for making the amendment; and

(b) stating the fee if the proposed amendment is for additional classes proposed by the Registrar provided that the additional classes does not materially alter the scope of the application; and

(c) stating that the proposed amendment will be made at the end of a period stated in the notice.

(2) The applicant may object in writing to the amendment within the period stated by the Registrar by stating grounds for the objection.

(3) If an applicant objects to an amendment proposed by the Registrar within the period mentioned in sub-regulation (1)(b), the Registrar must not make the amendment unless the objection is withdrawn.

(4) Where it appears to the Registrar that the objection is untenable and intended to delay proceedings, the Registrar may inform the applicant that his or her objection is declined and shall proceed to deal with the application accordingly.

**39. Amendment of applications by applicant-**(1) An applicant may, at any time prescribed, withdraw an application or limit any specification.

(2) An application may also be altered, at the request of the applicant and upon the payment of a fee, by correcting only:

- (a) the name or address of the applicant; or
- (b) an error or omission if, in the Registrar's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.

## **PART VI REGISTRATION OF RIGHTS OR PROTECTIONS**

**40. Particulars to be entered in the Register-**(1) The following information relating to a right or protection must be entered into the respective Register:

- (a) the date of the registration;
- (b) the particulars of any right of priority claimed under the relevant provisions of the Act;
- (c) the filing date of the initial application;
- (d) the number allocated to the initial application for registration of the right or protection which must also be the registration number of the right or protection;
- (e) in relation to trade marks, the class numbers of the goods or services or both in respect of which the trade mark is registered;
- (f) in relation to registered designs, the class numbers of the products in respect of which the registered design is registered;
- (g) the name and address of the owner of the right or protection;

- (h) the name and address of the authorised agent;
  - (i) if the right or protection is a trade mark registered as a collective trade mark, an indication to that effect;
  - (j) any other particulars relating to the right or protection that the Registrar reasonably believes to be appropriate in the circumstances.
- (2) The Register may be kept in a manual or electronic form.

**41. Certificate of registration-**(1) The certificate of registration of a right or protection issued by the Registrar must contain the following information:

- (a) the number that the Registrar has assigned to the right or protection;
- (b) the name and address of the owner of the right or protection;
- (c) a description or representation of the right or protection;
- (d) the date of filing and the date of registration;
- (e) where the registration is based on a convention priority claim, details of the corresponding application;
- (f) where the right or protection is a trade mark, the class or classes in which the trade mark is registered and the goods and services for which the trade mark is registered;
- (g) where the right or protection is a registered design, the class or classes in which the registered design is registered and the products for which the registered design is registered.

(2) The certificate of registration may contain any other information that the Registrar thinks appropriate in the circumstances.

**42. Certified copy of entry in register-**(1) The Registrar must, on the request of any person, provide that person with any of the following documents:

- (a) a certified copy of any entry in any register;

(b) a certified copy of, or an extract from, any register, public document, or record that must be kept under the Act or these Regulations.

(2) A request for a document referred to in sub-regulation (1) must:

- (a) be in writing; and
- (b) contain the name and communication address of the person making the request; and
- (c) be accompanied by the fee.

**43. Request for renewal-**(1) Subject to section 57 of the Act, the owner or the owner's agent may request for renewal of the registration of a mark:

- (a) in the approved form; and
- (b) accompanied by the renewal fee.

(2) The request under sub-regulation (1) must include:

- (a) a statement of the date on which the registration of the mark will expire; and
- (b) any other document or information that the Registrar may require the applicant to provide.

**44. Grant of renewal** - The Registrar must on receipt of a request under regulation 43 notify the owner or the owner's agent:

- (a) if the registration is renewed; or
- (b) if the registration is not renewed, including the reasons for non-renewal.

**45. Factors for grant of grace period** - The Registrar may take into account the following matters when considering whether to grant a grace period for the late payment of any fee:

- (a) an error or omission by a member of staff of the Ministry; or
- (b) an error or omission by the person applying for the grace period, or by the person's agent; or
- (c) circumstances beyond the control of the person, or by the person's agent, applying for the extension of time.

**PART VII  
AMENDMENT AND ASSIGNMENT  
OF REGISTRATION**

**46. Request for entry, alteration, or removal of memorandum on register** - A request under section 113 of the Act for the entry, alteration, or removal of any information on the register must:

- (a) be in writing; and
- (b) be signed by the owner or the owner's agent; and
- (c) contain the following information -
  - (i) the right or protection's registration number;
  - (ii) the owner's name;
  - (iii) if the owner has an agent, the agent's name;
  - (iv) the information to be entered, the alteration to be made to the information, or the information to be removed; and
- (d) be accompanied by the fee.

**47. Application to register change in title to trademark** - An application under section 113(1) of the Act for registration of title to a right or protection or to change the name of the applicant on an application for registration must:

- (a) be in writing; and
- (b) contain the information specified in regulation 48; and
- (c) accompanied by the fee.

**48. Information required for application to register change in title**-(1) An application under section 113(1) of the Act must contain the following information:

- (a) the name of the person who assigned or transmitted the right or protection;
- (b) if the person under paragraph (a), has an agent, the agent's name;

- (c) the name and address for service of the person to whom the person under paragraph (a) is assigning or transmitting the right or protection;
- (d) if the person who is being assigned or transmitted the right or protection has an agent, the agent's name;
- (e) whether the assignment or transmission was full or partial;
- (f) the date on which the assignment or transmission became effective;
- (g) where applicable, the class or classes that were assigned or transmitted;
- (h) in the case of the assignment or transmission of some of the goods or services within a classification, a statement of the goods or services or products assigned or transmitted;
- (i) the application or registration number of the right or protection;
- (j) an original or certified true copy of the document of assignment or transmission or other documents acceptable to the Registrar that are proof of the person's title to the trade mark as named under paragraph (c).

(2) The Registrar may require the applicant to provide further information if the Registrar has reason to doubt the veracity of any information contained in the application or in any document submitted with the application.

### **PART VIII REMOVAL OF TRADE MARK FROM REGISTER FOR NON-USE**

**49. Applications for removal** - An application for the removal of a trade mark from the Register must be accompanied by a declaration made by, or on behalf of, the applicant:

- (a) stating that an inquiry into the use of the trade mark has been conducted by, or on behalf of, the applicant; and

- (b) setting out the findings of that inquiry that support the grounds for the application referred to in section 59(2) of the Act.

**50. Notification of application-**(1) The Registrar must give notice of an application under section 59(1) of the Act within 20 working days after the application is filed in accordance with these Regulations.

(2) The notice must be given by sending a copy of the application, and the accompanying declaration:

- (a) to the registered owner;
- (b) the registered owner's agent, if any; and
- (c) the licensee or authorised person, in the opinion of the Registrar, needs to know that the application has been filed.

**51. Notice of opposition to removal-**(1) The registered owner of the trade mark may, within three (3) months from the day on which an application for removal is notified under regulation 50(2), file with the Registrar a notice of opposition to the application for removal.

(2) A notice of opposition must address the matters specified in section 59(3) of the Act.

(3) The person opposing must serve a copy of the notice of opposition on the applicant as soon as practicable after the notice is filed.

**52. Opposition proceedings before the Registrar-**(1) Regulations 25 to 36 apply, subject to sub-regulations (2) and (3), to an opposition to an application under section 59 of the Act.

(2) The Registrar must, if asked to do so by the person opposing within the period for filing:

- (a) an original of the evidence in support under regulation 25(1); or
  - (b) an original of the notice under regulation 26(1),
- hear the parties to the opposition proceedings.

- (3) If the person opposing does not file:
- (a) an original of the evidence in support in accordance with regulation 25(1); or
  - (b) an original notice under regulation 26(1); or
  - (c) an original notice within the time allowed in sub-regulation 25(1) or 26(1) as the case may be,
- and the person opposing does not request a hearing under sub-regulation (2), the opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed.
- (4) If:
- (a) under sub-regulation (3), opposition proceedings are taken to have ended, but are not taken to have been discontinued or dismissed; and
  - (b) the Registrar is satisfied that the grounds on which the opposed application was made have been established,
- the Registrar must determine the application in accordance with section 59 of the Act.

## **PART IX SEARCHES**

**53. Request for extracts and copies of documents -** Requests for certified copies of extracts from the Register or for copies of documents must be made to the Registrar in a manner authorised by the Registrar and must be accompanied by the fee.

**54. Searches - who conducted by-**(1) An interested party may on payment of the fee, search the Register or files relating to intellectual property.

(2) An interested party may request the Registrar to conduct a search of the Register and the Registrar may carry out the search upon the payment of the fee by that party.

(3) The Register may not allow an interested party to search unless the interested party provides proper identification.

## **PART X LICENCES**

**55. Application for registration of license contract-**(1) An application for the registration of a licence contract must be made in writing.

(2) The Registrar shall make a notation on the Register of each licence contract recorded in respect of each right or protection to which the licence relates.

## **PART XI ADMINISTRATION**

**56. Compliance with instructions on approved forms -** If an application or request under the Act or these Regulations:

- (a) is required to be made in an approved form to be supplied by the Registrar; and
- (b) the form contains directions on how it is to be completed,

a person completing the form must comply with the directions in the form.

**57. Filing of original or certified copies of documents-**(1) A document to be filed at the Registry must be an original document or certified as a true copy of the original document by a person who is duly authorized to certify copies in Samoa or in another country.

(2) Subject to sub-regulation (3), if a document is filed as a copy of the document, but not a certified true copy of the document, the Registrar may still accept the document.

(3) The Registrar may accept a document under sub-regulation (2) on the condition that the person files the original document or certified true copy of the original document within three (3) months of the documents being submitted to the Registrar.

**58. Common requirements for filing of documents-**(1) A document filed under the Act or these Regulations may include the following information:

- (a) the name and address for service of the person filing the document; and
- (b) if that person has an agent, the agent's name and address for service.

(2) If an address recorded in the Register or included in an application, notice or request that is filed changes, the person whose address changes, or a person acting on behalf of that person, must notify the Registrar of the new address.

(3) If the Registrar is notified of a new address, the Registrar must amend the Register, application, notice or request accordingly.

(4) A document that is to be filed must be signed and dated by the applicant or his or her agent.

**59. Treatment of non-complying documents-**(1) If a document received for filing at the Registry fails to comply with the Act or these Regulations, the Registrar may:

- (a) treat the document as not having been filed at the Registry; or
- (b) treat the document as having been filed, but require the person who filed the document to make, or cause to be made, any alterations to the document that are necessary to enable the document to comply within a specified period.

(2) Where the Registrar decides to treat the document in accordance with sub-regulation (1), the Registrar must return the document to the person from whom it was received with a statement:

- (a) setting out the requirements that have not been complied with; and
- (b) stating the specified period within which the requirements must be complied with.

(3) The specified period for the purposes of sub-regulations (1) and (2) is not to exceed three (3) months.

**60. Filing of documents: date of receipt to be marked-**(1) A document that is received for filing must be marked by the Registrar with the date on which it is received.

(2) Except as otherwise provided by the Act or these Regulations, a document is taken to be filed at the Registry on the date on which it is received by the Registry.

**61. Notice of withdrawal of applications-**(1) A notice of withdrawal of any application, notice or request required under the Act may be made by:

- (a) a person who has filed an application, notice or request; or
- (b) another person in whom the right or interest in reliance on which the application, notice or request was filed has become vested.

(2) The notice must be made in writing to the Registrar.

(3) The notification of withdrawal must contain the following information:

- (a) the applicant's name;
- (b) if the applicant has an agent, the agent's name; and
- (c) the application number.

(4) The notification must be signed by the applicant or the applicant's agent.

(5) Where the Registrar withdraws an application, notice or request in accordance with this regulation, the Registrar must notify in writing the person or his or her agent of the withdrawal and record the fact of the withdrawal in a manner the Registrar considers appropriate.

**62. Change of address for service: notice to interested persons** - A person:

- (a) who has filed an application, notice or request stating an address; and

(b) who notifies the Registrar of another address, must give a copy of the notification to any party to proceedings relating to the application, notice or request and to any other person as directed by the Registrar.

**PART XII**  
**PROCEEDINGS BEFORE THE REGISTRAR**

**63. Applications for costs-**(1) A party to proceedings before the Registrar may apply to the Registrar for an award of costs in relation to the proceedings.

(2) An application must be made:

(a) during the proceedings; or

(b) within three (3) months from -

(i) the date on which the Registrar makes a decision in the proceedings that ends those proceedings; or

(ii) the date of the Registrar's notice to the party that the proceedings have been discontinued or dismissed.

(3) Before awarding costs in respect of the proceedings, the Registrar must give each party to the proceedings a reasonable opportunity to be heard in relation to the award of costs.

(4) If a bill of costs is filed in relation to the proceedings, the bill of costs must be filed within three (3) months from the date on which the decision on costs are awarded.

**64. Conduct of proceedings generally-**(1) The Registrar may, at the request of a party to proceedings before the Registrar, other than opposition proceedings, give directions in relation to the procedure in the proceedings.

(2) Directions given under sub-regulation (1) must not be inconsistent with these Regulations.

(3) The Registrar must not give directions under sub-regulation (1) unless the Registrar:

(a) is satisfied that any person affected by the proposed directions has been notified of the proposed directions;

(b) has given any person affected a reasonable opportunity to make representations concerning the proposed directions; and

(c) is satisfied that the proposed directions are appropriate.

(4) For the purposes of sub-regulation (3)(b), representations may be made in writing or at a hearing or by such other means as the Registrar considers appropriate.

(5) Subject to these Regulations, the Registrar may determine the procedure to be followed in proceedings before the Registrar.

**65. Hearings by Registrar-**(1) This regulation applies if the Act or these Regulations provide for a person to be heard by the Registrar.

(2) A request for a hearing by the Registrar must be in writing.

(3) On request, or on his or her own initiative, the Registrar may:

- (a) fix a time, date and place for the hearing; and
- (b) give the parties to the hearing at least 10 working days' notice in writing of the hearing and of the time, date and place fixed for the hearing.

(4) A party must, as soon as practicable after being notified of the hearing, inform the Registrar in writing as to whether the party wants to be heard.

(5) A party may attend a hearing in person or by such means as the Registrar considers appropriate.

(6) A party may make representations in writing before or during a hearing.

(7) A hearing must be conducted with as little formality and technicality, and with as much expedition, as the requirements of the Act and these Regulations and a proper consideration of the matters before the Registrar, allow.

(8) The Registrar is not bound by the rules of evidence but may inform himself or herself on any matter that is before him or her in any way that the Registrar considers appropriate.

(9) The Registrar may adjourn a hearing by notifying each party to the hearing accordingly.

(10) Subject to these Regulations, the Registrar may give a direction that is necessary for the conduct of the hearing.

**66. Registrar not required to hold hearings-**(1) The Registrar is not required to proceed to hear a matter if:

- (a) the Registrar believes that no party wishes to be heard in the matter; or
  - (b) at least one of the following circumstances applies in relation to a party notified of the hearing -
    - (i) the party has not indicated to the Registrar that the party wishes to be heard; or
    - (ii) the party has informed the Registrar that the party does not wish to be heard; or
    - (iii) a party does not attend the hearing.
- (2) The Registrar may decide a matter to which sub-regulation (1) refers:
- (a) without a hearing; and
  - (b) by reference to relevant information about the matter that is held by the Ministry.

**67. Evidence in proceedings-**(1) Evidence that is given in writing in any proceedings before the Registrar must be in the form of a declaration in accordance with the form of declaration provided for under the Oaths, Affidavits and Declarations Act 1963.

(2) The Registrar may require a person who has made a declaration that is filed in the proceedings to attend before the Registrar to give evidence orally on oath or affirmation instead of, or in addition to, the evidence contained in the declaration.

(3) The Registrar may permit a party to cross-examine a person who attends under sub-regulation (2).

**68. Documents not in English** - If a document that is filed as evidence in proceedings before the Registrar is not in English, the party filing the document must also file with it:

- (a) a translation of the document into English; and
- (b) a certificate of verification in relation to the translation.

**69. Registrar may use information available-**(1) Subject to sub-regulation (2), if:

- (a) information that is available to the Registrar is relevant to proceedings before the Registrar; and

(b) the Registrar has reason to believe that the information is not known to a party to the proceedings; and

(c) the Registrar proposes to take the information into account in making a decision in the proceedings, the Registrar cannot make a decision unless he or she has attended to the matters set out under sub-regulation (2).

(2) Before making a decision on a matter where circumstances under sub-regulation (1) apply, the Registrar must:

- (a) provide the information to the party; and
- (b) give the party a reasonable opportunity to make representations about the information.

(3) For the purposes of sub-regulation (2)(b) the representations may be made in writing or at a hearing or by such other means as the Registrar considers appropriate.

**70. Statements of reason for decision - If:**

- (a) the Registrar notifies a party to proceedings before the Registrar of a decision of the Registrar in the proceedings; and
  - (b) the party requests the Registrar in writing for the reasons for the decision,
- the Registrar must comply with the request.

**PART XIII  
FEES**

**71. Registrar may refuse to take step before fee is paid-**

(1) The Registrar may refuse to take any step under the Act or Regulations in respect of which a fee is payable unless the fee is first paid.

(2) The Registrar may refuse to accept any application, notice, or request under the Act or these Regulations in respect of which a fee is payable unless the fee is first paid.

**72. How determined fees are to be paid -** All determined fees must be paid in a manner approved by and to the Registrar.

**73. Notice of non-payment of fee** - If a fee that is required to be paid under the Act has not been paid, the Registrar must notify in writing the person concerned, or his or her agent, that the fee has not been paid, within 15 working days after the filing of the document, for which the fee is payable.

**74. Refunds etc, of fees**-(1) Fees are non-refundable.

(2) If an applicant's agent makes an overpayment of fees, the Registrar may hold the overpayment as a credit towards the account of the applicant or agent.

(3) The Registrar may give notice to the applicant of any amount on hold as credit towards the account of the applicant or the applicant's agent.

#### **PART XIV MISCELLANEOUS**

**75. Translation into English**-(1) Subject to sub-regulation (3), an English translation of an application must be certified as a true and correct translation in the English language by a person qualified to translate documents in the country where the translation is made.

(2) If the right or protection, which is the subject of an application includes characters constituting words, being characters that are not roman letters, the applicant must file in support of the application:

- (a) a transliteration of the characters into roman letters, using the recognised system of romanisation of the characters, if any; and
- (b) a translation of the words into English.

(3) A person qualified to translate documents must be a person that the Registrar considers fit for this purpose and in so doing, the Registrar may require that the applicant provide evidence of qualifications of their nominated translator or any other document that the Registrar may require to determine the accuracy of the translation work.

**76. Signatures-**(1) In the following cases, a document must be signed for the purposes of these Regulations as follows:

- (a) in the case of a partnership, the document must -
  - (i) contain the full names of all partners, unless a list of the current members of the partnership has been filed with the Registrar; and
  - (ii) be signed by a qualified partner or any other person who has, to the Registrar's satisfaction, authority to sign;
- (b) in the case of a body corporate, the document must be signed by a director or other principal officer, or any other person who has, to the satisfaction of the Registrar, authority to sign;
- (c) in the case of an unincorporated association, the document may be signed by any person who appears to the Registrar to be duly qualified and authorized in writing by the association.

(2) An application made in accordance with these Regulations by two (2) or more joint applicants, and any document required to be signed that is part of the application, must be signed by each applicant.

**77. Electronic Documents** - Any requirement in these Regulations that a document must be in writing is satisfied if the document complies with section 7 of the Electronic Transactions Act 2008.

**78. Direction not otherwise provided for** - If the Registrar reasonably believes that it is necessary for the proper conduct of proceedings for a person to perform an act, file a document or produce evidence that the person is not required by the Act or these Regulations to perform, file or produce, the Registrar may give notice in writing to the person requiring him or her:

- (a) to perform the act; or
- (b) file the document; or
- (c) to produce the evidence,

that is specified in the notice.

**79. Requirements cannot be complied with for reasonable cause - If:**

- (a) under these Regulations, a person is required to do an act or thing, sign a document, make a declaration or file or give to the Registrar a document or evidence; and
  - (b) the Registrar is reasonably satisfied that the person cannot comply with the requirement,
- subject to any condition that the Registrar may reasonably impose, the Registrar may dispense with the requirement.

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**Copies of these Regulations can be purchased from the Office of the Clerk of the Legislative Assembly.**

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