

Changes to Samoa's IP Laws

Samoa's new Intellectual Property Act 2011 comes into law on 1 October 2012. This Act makes sweeping changes to Samoa's IP regime following the country's recent WTO accession and implements the WTO TRIPS Agreement. The changes are most significant for foreign trade marks filings, which make up over 90% of all IP filings in Samoa.

Trade marks

Key changes for trade marks practitioners and rights owners include:

- Availability of Nice Classification (9th edition) for goods and services (extending the previous regime which recognized only goods classes)
- New requirement to use a local agent for all filings
- Collective marks and non-traditional marks are available
- Optional recording of licences with presumption of notice to third parties

Priority provisions instead of re-registration: the legislation removes the previous re-registration scheme based on foreign registrations. Instead, applicants can now claim priority based on applications filed in Paris Convention member states. Convention priority applications must be made within 12 months of foreign filing. Samoa is not a member of the Madrid Protocol.

Duration: trade mark protection will now apply for a period of 10 years from filing date, renewable for further 10 year periods. This replaces the previous 14 year duration.

Multiclass applications: the Registrar has indicated that multiclass applications will be available, however new forms and fees have yet to be provided.



Patents and designs

The Act modernizes the design and patent regimes and introduces a new unregistered design right and innovation patent.

Priority provisions instead of re-registration:

As for trade marks, the new Act removes the previous re-registration provisions. It introduces convention priority applications made within 12 months of filings in Paris Convention member states. Samoa is not a member of the PCT.

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Patents and designs continued

Traditional knowledge:

Patent applications must now include a statement about whether the invention is based on indigenous or community knowledge (whether from Samoa or elsewhere). The source and geographical origin of any biological material must also be disclosed. The applicant may be required to submit supporting evidence about such information, including consent to use.

Pharmaceutical patents:

The Act includes compulsory licencing for pharmaceutical patents using the Doha Declaration scheme for least developed countries, on notification to the WTO TRIPS Council.

Duration and renewals:

Patent duration is 20 years from filing, with renewal fees to be paid every 5 years. Innovation patents are valid for 7 years with no renewal requirements. Registered designs are valid for 15 years from filing, with renewal fees to be paid every 5 years. Unregistered design rights are valid for 15 years with no renewal requirements. There is a grace period of 6 months to pay any fees.

Plant breeder's rights, geographical indications and circuit layouts:

The new regime also provides for registration of geographical indications, plant breeders' rights and layout designs of integrated circuits.



Clarke Ey Lawyers

Clarke Ey Lawyers can assist with all your IP needs in Samoa. Our partner responsible for IP matters, Fiona Ey, has over 15 years legal practice experience in Samoa and Australia. Fiona is a qualified trade marks attorney and has extensive experience in IP advising, searching, filing and dispute resolution in Samoa and the Pacific region. She was consultant to the Government of Samoa on the drafting of the new IP Act and National IP Strategy. Contact Fiona Ey: ey@clarkelawyers.net

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