

REPUBLIC OF KIRIBATI



(No. 24 of 2022)



I assent,

A handwritten signature in black ink, appearing to be 'Beretitenti', written over a horizontal line.

Beretitenti

25/11/2022

AN ACT

entitled

**An Act to make provisions for the management of registration and enforcement of patent and other connected purposes**

Commencement date:

\_\_\_\_\_ 2022

MADE by the Maneaba ni Maungatabu and assented to by the Beretitenti

**Part I – Preliminary Matters**

**1. Short title**

This Act shall be cited as the *Patent Act 2022*.

**2. Interpretations**

For the purposes of this Act unless the context otherwise provides—

- (a) “Agent” means a legal practitioner resident and practising in Kiribati, representing the applicant;
- (b) “Applicant” means the person entitled to apply for a patent, and/or utility model certificate according to the provisions contained in this Act;
- (c) “Budapest Treaty” means the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, done at Budapest on April 28, 1977, as last amended on September 26, 1980;
- (d) “Certificate” means the title granted to protect a utility model. It establishes a presumption of the validity and enforceability of the right to prevent others from exploiting the registered right in Kiribati. Certificates shall be issued by the Registrar without any responsibility of the Government of Kiribati as to the conditions of registrability and to the right to the titles;
- (e) “Compulsory licence” means an authorization given by the competent authority to a person, firm or a private or state-owned or state-controlled entity, to exploit a patent or a utility model in Kiribati without the approval of the right holder;
- (f) “Convention country” means any country party to the Paris Convention;
- (g) “Court” means the High Court of Kiribati. Appeals of the Court’s decision and appeals involving the decisions of the Registrar, as well as of the Minister under this Act are to be heard by the Court of Appeal.
- (h) “European Patent Convention” means the Convention on the Grant of European Patents (European Patent Convention) adopted in Munich on October 5, 1973, as last revised on November 29, 2000;
- (i) “Gazette” means a printed or electronic official bulletin, referred to in section 49(4);
- (j) “Regulations” means the regulations implementing this Act;
- (k) “International Classification” means, as regards patents and utility models, the classification for patents for invention and utility models, known as the “International Patent Classification”, as established by the Strasbourg Agreement Concerning the International Patent Classification, of March 24, 1971, as last amended on September 28, 1979;
- (l) “Invention” means an idea of an inventor, which permits in practice the solution to a specific problem in a field of technology. Subject to sections 3 and 30(4), an invention may be, or may relate to, a product or a process;

- (m) "Minister" means the Minister in charge of patent;
- (n) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last amended on September 28, 1979;
- (o) "Patent" means the title granted to protect an invention;
- (p) "Priority Date" means the date of an earlier application that serves as the basis for the right of priority provided for in the Paris Convention;
- (q) "Registrar" means the person holding office pursuant to section 48;
- (r) "Registrar's Office" means the Registrar's Office of Kiribati as established under section 48(1);
- (s) "Utility model" means a technical creation that consists of a new shape or configuration of an object or of a component of an object that increases its functionality or utility; and
- (t) "World Intellectual Property Organization" means the World Intellectual Property Organization (WIPO) established by the WIPO Convention signed at Stockholm on July 14, 1967 and as amended on September 28, 1979.

## **PART II - Patent**

### **3. Matters Excluded from Patent Protection**

The following shall be excluded from patent protection—

- (a) discoveries, scientific theories and mathematical methods;
- (b) plant varieties and animals, including their parts, other than micro-organisms, and essentially biological processes for the production of plants or animals and their parts, other than non-biological and microbiological processes;
- (c) schemes, rules and methods for doing business, performing purely mental acts or playing games, and computer programs as such;
- (d) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced on the human or animal body; this provision shall not apply to products for use in any of those methods;
- (e) natural substances, even if purified, synthesized or otherwise isolated from nature; this provision shall not apply to the processes of isolating those natural substances from their original environment;

- (f) known substances for which a new use has been discovered; this provision shall not apply to the use itself, where it constitutes an invention under section 4(1); and
- (g) inventions, the prevention within the territory of Kiribati of the commercial exploitation of which is necessary to protect *ordre public* and morality, including the production of human beings, and the biological processes for their generation; such exclusion shall not be made merely because the exploitation of those inventions is prohibited by law.

#### **4. Patentable Inventions**

- (1) An invention is patentable if it is new, involves an inventive step and is industrially applicable.
- (2) An invention is new if it is not anticipated by prior art.
- (3) Prior art shall consist of everything disclosed to the public, anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where applicable, the priority date, of the application claiming the invention. Prior art shall also comprise the content of a national patent application having an earlier filing or, where applicable, priority date than a patent application filed later, to the extent that such content is included in the patent granted on the basis of the said national application.
- (4) For the purposes of subsection (3), disclosure to the public of the invention shall not be taken into consideration if—
  - (a) it occurred within twelve (12) months preceding the filing date or, where applicable, the priority date of the application; and
  - (b) if it was—
    - (i) due to an abuse committed by a third party with regard to the inventor, the original applicant or the original applicant's predecessor in title; or
    - (ii) by reason or in consequence of acts committed by the inventor, the original applicant or the original applicant's predecessor in title.
- (5) In the case of an invention consisting of a use of a substance or composition in any method, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.
- (6) An invention shall be considered as involving an inventive step if, having regard to the differences and similarities between the claimed invention and the prior art as defined in subsection (3), the claimed invention as a whole would not have been

obvious to a person skilled in the art at the filing date or, if applicable, at priority date of the claimed invention.

- (7) An invention shall be considered industrially applicable if it can be made or used in any kind of industry. The term "industry" shall be understood in its broadest sense, as any human economic activity leading to the production of goods and services; it shall cover, in particular, handicraft, agriculture, fishery and services.

## **5. Right to Patent**

- (1) The right to a patent shall belong to the inventor.
- (2) If two or more persons have jointly made an invention, the right to the patent shall belong to them jointly.
- (3) If two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date shall have the right to the patent, as long as the said application is not withdrawn, abandoned or rejected. In order to establish the right of preference, the Registrar shall take into account the matter claimed in the applications.
- (4) The right to a patent may be assigned or may be transferred by succession.
- (5) The inventor shall be named as such in the patent unless in a special written declaration addressed to the Registrar, the inventor indicates that he or she wishes not to be named. Any promise or undertaking by the inventor made to any person to the effect that the inventor will make such a declaration shall be without legal effect.

## **6. Inventions Made by an Employee**

- (1) In the absence of an agreement to the contrary, where an invention is made during the normal course of an employee's work—
  - (a) the invention belongs to the employer; and
  - (b) the employee shall be entitled to reasonable remuneration when the economic gain extracted by the employer from the invention are disproportionately high as compared to—
    - (i) the employee's salary; and
    - (ii) the reasonable expectations of gain that the employer had from the employee's inventive output at the time the employer was hired or promoted to a position held at the time the invention was made.

- (2) In the absence of an agreement to the contrary, where an invention is made by an employee outside the normal course of an employee's work, or by using materials, data or know-how of the employer—
  - (a) the right to the patent shall belong to the employer; and
  - (b) the employee shall be entitled to reasonable remuneration for the invention.
- (3) Any invention claimed in a patent application, filed by the employee within one year after the end of employment, that falls within the scope of the former employer's main business, shall be presumed to have been made during the normal course of an employee's work in terms of subsection (1), unless the employee produces evidence to the contrary.
- (4) Any anticipated promise or undertaking by the inventor made to the employer, to the effect that the inventor will waive any remuneration to which the inventor is entitled to under this section, shall be without legal effect.
- (5) This section shall apply to public civil servants as well as to persons whose services are hired in accordance with the *Employment and Industrial Relations Code 2015* as amended.
- (6) If the employer and the employee do not come up with an agreement on the amount of the reasonable remuneration under subsections (1)(b) and (2)(b), such amount will be determined by the Arbitrator as established under the *Employment and Industrial Relations Code 2015* as amended.

## **7. Application**

- (1) The application for a patent shall be filed with the Registrar in the prescribed manner and shall be accompanied by the prescribed fee.
- (2) An application for a patent shall contain—
  - (a) a request for the grant of a patent;
  - (b) a description of the invention;
  - (c) one or more claims;
  - (d) any drawings referred to in the description; and
  - (e) an abstract.
- (3) The request shall contain—
  - (a) a petition to the effect that a patent be granted;
  - (b) the name of and other prescribed data concerning the applicant, the inventor and the agent, if any; and
  - (c) the title of the invention.

- (4) The application shall also contain—
  - (a) where the applicant is not the inventor, a statement justifying the applicant's right to the patent; and
  - (b) where the applicant is acting before the Registrar through a legal representative, a power of attorney stating the corresponding mandate.
- (5) The description shall disclose the invention in a manner sufficiently clear and complete for the invention to be evaluated, and to be carried out by a person having ordinary skill in the art at the time of the filing date or, where priority is claimed, at the priority date of the application, and shall, in particular, indicate the best mode known to the applicant for carrying out the invention.
- (6) The description shall contain a clear identification of the origin of genetic or biological resources collected and that were directly or indirectly used in the making of the claimed invention as well as of any element of traditional knowledge associated or not with those resources and that was directly or indirectly used in the making of the claimed invention without the prior informed consent of its individual or collective creators.
- (7) For the purposes of this section, a person having ordinary skill in the art is understood as a skilled practitioner in the relevant field of technology, who has average knowledge and ability and is aware of what was common general knowledge in the art at the date when the patent application was filed.
- (8) For purposes of sufficiency of description under subsection (5), if an application for a patent claims a microorganism or involves the use, modification or cultivation of a microorganism which is not reasonably available to a person skilled in the art on the date of filing of the application and cannot be made or obtained on the basis of the description, the following is required—
  - (a) a deposit of a culture of a microorganism made on or before the filing date of the patent application or the claimed priority application, effected with a recognized international depositary authority under the Budapest Treaty, or with another institution recognized by the Registrar ;
  - (b) the indication of the name of the international depositary authority or another institution, the date of the deposit and the accession number within the description of the application; and
  - (c) the filing before the Registrar of a certification of the deposit, issued by the international depositary authority no later than twelve (12) months from the filing date of the patent application.
- (9) The claim(s) shall—

- (a) define the matter for which protection is sought;
  - (b) be clear and concise; and
  - (c) be supported by the description.
- (10) Drawings shall be required when they are necessary for the understanding of the invention.
- (11) The abstract, must be concise and precise, and shall merely serve the purpose of technical information. The abstract shall not be taken into account for the purpose of interpreting the scope of the protection.
- (12) The applicant may withdraw the application at any time during its pendency.
- (13) Where the application has been withdrawn under subsection (12) without having being opened to public inspection and:
- (a) no priority rights have been claimed by virtue of such application; and
  - (b) no rights are outstanding in Kiribati in connection with such application, a subsequent application can be filed in Kiribati in respect of the same invention. Such subsequent application shall be regarded as the first application in Kiribati in respect of that invention. No priority rights shall be claimed on the withdrawn application after the lodging of the subsequent application.

## **8. Unity of Invention**

- (1) The application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.
- (2) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under subsection (1) shall not be a ground for the invalidation of the patent.

## **9. Amendment and Division of Application**

- (1) The applicant may amend the application, provided that the amendment shall not go beyond the matter disclosed in the initial application as filed.
- (2) The applicant may, upon payment of the prescribed fee, at any time before the patent is granted, divide the application into two or more applications (“divisional applications”), provided that each divisional application shall not go beyond the matter disclosed in the initial application.
- (3) Each divisional application under subsection (2) shall be entitled to the filing date and, where applicable, the priority date of the initial application.

## **10. Right of Priority**

- (1) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, from one or more earlier applications filed by the applicant or the applicant's predecessor in title in one or more convention country.
- (2) An application filed in Kiribati before the expiration of the period of priority referred to in subsection (3), shall not be invalidated by reason of any acts accomplished in the interval, in particular, another initial filing, the publication or exploitation of the invention, and those acts cannot give rise to any third-party right or any right of personal possession.
- (3) The period of priority under subsection (1) is of twelve (12) months and shall be counted in accordance with the provisions of Article 4 of the Paris Convention.
- (4) For purposes of subsection (1), an earlier application filed in a convention country includes an application filed in accordance with the terms of a treaty subsisting between any two convention countries.
- (5) An applicant shall file a declaration of priority within two (2) months from the filing date to benefit from the right of priority in subsection (1).
- (6) Where the application contains a declaration under subsection (5),
  - (a) the Registrar may request that the applicant furnish, within a prescribed time limit, a copy of the earlier application certified as correct by the authority with which it was filed;
  - (b) where the earlier application is not in English, the applicant shall furnish together with the certified copy, a translation thereof in English, verified by the translator, that the translation is to the best of his or her knowledge complete and true.
- (7) The Registrar shall accept the form and the content of the certification mentioned in subsection (6) as determined by the certifying authority.
- (8) If the Registrar finds that the requirements under this section and the Regulations pertaining thereto have not been fulfilled, the declaration shall be considered not to have been made.

## **11. Information Concerning Corresponding Foreign Applications for Patents**

- (1) The applicant shall, at the request of the Registrar , furnish the date and number of any application for a patent filed by the applicant, or by the applicant's predecessor, abroad ("foreign application") relating to the same, or essentially the same, invention as that claimed in the application filed in Kiribati.
- (2) The applicant shall, at the request of the Registrar , furnish the Registrar with the following documents relating to one of the foreign applications referred to in subsection (1):
  - (a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
  - (b) a copy of the patent granted on the basis of the foreign application;
  - (c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application; and
  - (d) a copy of any final decision invalidating the patent granted on the basis of the foreign application.

## **12. Filing Date**

- (1) The Registrar shall accord, as a filing date, the date of receipt of the application, provided that, at the time of receipt, the application contains all of the following elements—
  - (a) an express or implicit indication to the effect that the elements are intended to be an application;
  - (b) indications allowing the identity of the applicant to be established or information allowing the applicant to be contacted by the Registrar; and
  - (c) a part which, on the face of it, appears to be a description of an invention.
- (2) A reference, made upon the filing of the application to a previously filed application shall, for the purposes of the filing date of the application, replace the description of the invention referred to in subsection (1)(c) and, if drawings are included in the referenced application, shall also replace any drawings.

- (3) The elements referred to in subsection (1)(a) and (1)(b) shall be submitted in English. The element referred to in subsection (1)(c) may, for the purposes of establishing the filing date, be filed in any language.
- (4) If the Registrar finds that the application did not, at the time of receipt, fulfil the requirements referred to in subsection (1), the Registrar shall invite the applicant to file the required correction within two (2) months counted from the date of notification and shall accord as filing date the date of receipt of the required correction.
- (5) Subject to section 28, if no correction is made within the prescribed period in subsection (4), the application shall be treated as if it had not been filed.
- (6) Where, in establishing the filing date, the Registrar notices that the application refers to drawings that are not included in the application, the Registrar shall promptly invite the applicant to furnish the missing drawings within two (2) months counted from the date of notification.
- (7) If the applicant complies with the said invitation within the prescribed period in subsection (6), the Registrar shall accord as filing date, the date of receipt of the missing drawings. Otherwise, the Registrar shall accord as filing date, the date of receipt of the application and shall treat any reference to the said drawings as non-existent.
- (8) Where, in establishing the filing date, the Registrar notices that a part of the description appears to be missing, the Registrar shall promptly invite the applicant to furnish the missing part of the description. If the applicant complies with the said invitation, the Registrar shall accord as filing date, the date of receipt of the missing part, unless subsection (1)(b) applies. Otherwise, the Registrar shall accord as filing date, the date of receipt of the application and shall treat any reference to the said part as non-existent.

### **13. Classification and Formal Examination**

- (1) After according a filing date, the Registrar shall—
  - (a) classify the invention according to the International Classification; and
  - (b) determine whether the application complies with the requirements of section 7 and any formal requirements contained in the Regulations.
- (2) Where the Registrar determines that the application did not fulfil the requirements referred to in subsection (1)(b), the Registrar shall invite the applicant to correct the application's defects within a period prescribed counted from the date of notification by the Registrar.

- (3) Subject to section 28, if the applicant fails to correct any deficiencies referred to in the notification under subsection (2) within the prescribed term, the application shall be deemed abandoned.

#### **14. Public Inspection and Publication**

- (1) Subject to subsection (2), the Registrar shall open the patent application for public inspection, eighteen (18) months after the filing date or, if priority is claimed, from the filing date of the earlier application whose priority is so claimed.
- (2) A patent application shall not be open to public inspection under subsection (1) if the application for a patent is withdrawn prior to the period prescribed in subsection (1).
- (3) Where an application has been opened for public inspection under subsection (1), and the application meets the formal requirements according to section 13, the Registrar shall publish notice of the patent application in the Gazette. At least the following elements of the patent application shall be included in the publication—
  - (a) the number and the filing date of the application;
  - (b) the title of the invention;
  - (c) the name of the applicant(s) and of the inventor(s);
  - (d) the priority date(s);
  - (e) the international classification;
  - (f) one drawing, if any, that depicts the main element(s) of the invention; and
  - (g) the abstract.
- (4) Any interested person shall receive a copy of the full contents of patent applications opened for public inspection, provided the prescribed fees are paid.
- (5) The Registrar shall not give access to, or information about, the contents of the patent application to third persons until the application has been opened for public inspection under subsection (1).
- (6) The applicant may request the Registrar to open an application for public inspection under subsection (1) and to publish the notice under subsection (3) upon payment of the prescribed fee, at any time between the filing date and the end of the eighteen-month period.

#### **15. Request for Search and Substantive Examination**

- (1) Within three (3) years from the date of filing of the application, the applicant may file, if the invention falls within one of the categories under section 16 a request for search

and substantive examination in the prescribed manner, accompanied by the prescribed fee.

- (2) If the request and fee referred to in subsection (1) is not submitted within the prescribed time, the application shall be deemed abandoned.

#### **16. Categories for Substantive Examination**

- (1) The Registrar may issue a practice note or an instruction indicating the specific technical categories of inventions that will undergo the examination of the requirements under sections 3 and 4.
- (2) Following the publication of the application under section 14, the Registrar shall notify the applicant if the application will undergo substantive examination.

#### **17. Search**

- (1) If the applicant files the request for search and substantive examination under section 15 within the prescribed time and pays the prescribed fee, the Registrar shall cause a search to be conducted on the invention object of the patent application in the prescribed manner.
- (2) The Registrar shall review the unity of invention of the application according to section 8. If the Registrar considers that the application lacks unity of invention, the search under subsection (1) will only be conducted on the first invention presented in the claims of the application for a patent.

#### **18. Substantive Examination**

- (1) The Registrar shall examine whether the conditions under sections 3 and 4 are met.
- (2) For the purposes of the examination of the patent application under subsection (1), the Registrar shall take into account—
  - (a) any search conducted under section 17; and
  - (b) any information submitted related to foreign applications submitted under section 11(2).
- (3) Subject to the provisions of section 28, when the Registrar is of the opinion that the conditions referred to in subsection (1) are not fulfilled, the Registrar shall invite the applicant within the following three (3) months to submit observations and amend the application. Additional invitations based on the submitted observations and amendments, if any, may be made. If the applicant fails to file any response within the prescribed term, the patent application shall be deemed abandoned.

- (4) In performing the task of substantive examination under this section, the Registrar may ask the assistance of other patent offices or entities having such capacity.

#### **19. Objection to application**

- (1) Within three (3) months from the publication under section 14 any interested party may file a notice of objection to the Registrar in the prescribed manner.
- (2) The notice of objection indicating that the patent shall not be granted, shall include—
  - (a) the opposed patent application number; and
  - (b) the grounds that the opponent deems relevant.
- (3) The grounds for objection under subsection (2)(b) may be any of the following—
  - (a) the invention is not patentable under section 3, as claimed in the patent application, has been disclosed before the priority date of the claim in Kiribati or elsewhere in the world;
  - (b) the subject-matter of any claim of the patent application is not patentable under section 4; and
  - (c) the patent application does not disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art under section 7(5).
- (4) If a notice of objection is filed under subsection (1), the Registrar shall notify the applicant of the opposition, providing a copy of the notice.
- (5) The applicant may contest the objection, providing observations and/or amendments within the term of three (3) months from the notification in subsection (4).
- (6) If the applicant fails to contest the objection within the prescribed period, the application shall be refused.
- (7) The notice of objection and any response shall be considered by the Registrar during the substantive examination under section 18.

#### **20. Grant and Refusal of a Patent**

- (1) If, after the examination under sections 13, 18 and 19, the conditions for granting a patent are not fulfilled, the Registrar shall refuse the grant of a patent. Any decision refusing the grant of a patent shall be in writing and state the reasons for the refusal. The Registrar shall notify the applicant of the decision.
- (2) If, after the examination under sections 13, 18 and 19, the conditions for granting a patent are fulfilled, the Registrar shall issue a decision to grant a patent.
- (3) Following the issuance of the decision to grant a patent under subsection (2), the Registrar shall—
  - (a) publish a reference to the grant of the patent in the Gazette;

- (b) issue a certificate of the grant of the patent and a copy of the patent to the applicant;
- (c) record the patent in the Register; and
- (d) make copies of the patent available to the public, on payment of the prescribed fee.

## **21. Validation of Patents Granted in the United Kingdom**

- (1) The owner of a patent granted in the United Kingdom can apply to the Registrar in the prescribed manner and fee, for its validation in Kiribati within three (3) years of the date of issue in the United Kingdom.
- (2) The privileges and rights of a patent granted under this section will continue in force only as long as the patent remains in force in the United Kingdom.
- (3) The owner of a patent granted in the United Kingdom in accordance with the terms of the European Patent Convention (EPC), or any other international agreement to which the United Kingdom is party, can apply to the Registrar in the prescribed manner, for its validation in Kiribati within three (3) years of the date of issue of the European Patent for the jurisdiction of the United Kingdom.

## **22. Amendment of a Patent**

- (1) The Registrar shall, upon request of the patent owner and payment of the prescribed fee, amend the patent to—
  - (a) correct an obvious clerical error;
  - (b) reflect a change in the name, address, domicile or other particulars of the owner or inventor; or
  - (c) make a change to the text or drawings to limit the extent of protection conferred by the patent.
- (2) Any amendment under subsection (1)(c) shall—
  - (a) not exceed the scope of the initial application; and
  - (b) have effect and be deemed always to have had effect from the date of grant of the patent.

## **23. Rights Conferred by the Patent**

- (1) A patent shall confer on its owner the right to prevent third parties from exploiting the patented invention in Kiribati. The scope of the right of the patent owner is defined by the claims.

- (2) For the purposes of this Act, “exploiting” a patented invention means any of the following acts–
- (a) when the patent has been granted in respect of a product–
    - (i) making, importing, offering for sale, selling and using the product; and
    - (ii) stocking such product for the purposes of offering for sale, selling or using;
  - (b) when the patent has been granted in respect of a process–
    - (i) using the process; and
    - (ii) doing any of the acts referred to in paragraph (a) in respect of a product obtained directly by means of the process.
- (3) The patent owner shall, in addition to any other rights, remedies or actions available, have the right, subject to sections 24 and 35 and in accordance with the provisions of PART V, VI, VII and VIII to institute court proceedings against any person who infringes the patent by performing, without the patent owner’s agreement, any of the acts referred to in subsection (2) or who performs acts which make it likely that infringement will occur.

#### **24. Limitations of Rights Conferred by a Patent**

- (1) The rights under the patent shall not extend–
- (a) to acts in respect of articles which have been put on the market in any country by the patent owner or with the patent owner’s consent, consequently exhausting the patent owner’s rights;
  - (b) to the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Kiribati;
  - (c) to acts done privately and on a non-commercial scale or for non-commercial purpose, provided that it does not significantly prejudice the economic interests of the patent owner;
  - (d) to acts of extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner;
  - (e) to acts done only for experimental purposes relating to a patented invention;
  - (f) to the acts of making, constructing, using, or selling the patented invention solely for uses reasonably related to the development and submission of information required under any law of Kiribati or another country that regulates the manufacture, construction, use or sale of any product, provided

that any product produced under such authority shall not be made, used, or sold in this country other than for purposes related to generating such information, and that the product shall only be exported for purposes of meeting marketing approval requirements;

- (g) to acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted, was using the invention or was making effective and serious preparations for such use in Kiribati (the “prior user”); it is understood that this exception does not apply to acts that are different in nature or purpose from the actual or contemplated earlier use; and
  - (h) to the use by a farmer of the product of the farmer’s harvest for propagation or multiplication by the farmer on the farmer’s holding, where the farmer has acquired for agricultural use plant propagating material that was put on the market in accordance with subsection (1)(a), or to the use by a farmer of animals on his own holdings for reproduction or selective breeding, when those animals were obtained or put on the market in accordance with subsection (1)(a).
- (2) The right of the prior user referred to in subsection (1)(g) may be transferred or devolved only together with the enterprise or business, or with that part of the enterprise or business, in which the use or preparations for use have been made.

## **25. Duration and Fees**

- (1) Subject to subsection (2), a patent shall expire twenty (20) years after the filing date of the application for the patent.
- (2) In order to maintain the patent or patent application, a prescribed annual fee shall be paid in advance to the Registrar, starting the first year after the filing date of the application for a patent.
- (3) Subject to section 28, a grace period of six (6) months shall be allowed for the late payment of the annual fee on payment of the prescribed surcharge. If a renewal fee is not paid in accordance with the provisions of this subsection, the patent application shall be deemed to have been withdrawn or the patent shall lapse.

## **26. Compulsory Licences**

- (1) The Registrar may grant a compulsory licence that authorizes a third party to exercise the rights conferred by the patent in section 23, without the authorization of the patent owner.

- (2) The grounds for granting a compulsory licence under subsection (1) are any of the following—
- (a) when the public interest so requires;
  - (b) when a judicial or administrative body has determined that the manner of exploitation, by the patent owner or the patent owner's licensee, is—
    - (i) abusive including excessive price; or
    - (ii) anti-competitive,and the Registrar is satisfied that the exploitation of the patented invention by a third party would remedy such practice;
  - (c) when a patent (the “second patent”) claiming an invention that involves an important technical advance of considerable economic significance in relation to an invention claimed in another patent (the “first patent”) cannot be exploited without infringing the first patent;
  - (d) when a patented invention is not worked in the territory of Kiribati, provided that—
    - (i) it is more than four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever is later; and
    - (ii) the inaction is not justified by legitimate reasons.
- (3) A request for a compulsory licence may be made by any person or by a government agency.
- (4) The request for the compulsory licence shall be addressed to the Registrar.
- (5) The request shall include—
- (a) the name of the requestor;
  - (b) the number of the patent in respect to which the compulsory licence is requested;
  - (c) the potential licensee, if different than the requestor;
  - (d) a statement of the grounds on which the request is based; and
  - (e) if the request is made on the grounds of subsection (2)(c), the number of the second patent owned by the requestor.
- (6) The request for a compulsory licence shall be accompanied by evidence that the requestor has attempted to obtain a licence from the patent owner on reasonable commercial terms and conditions and within a reasonable time for the same patent.
- (a) For purposes of this subsection, six (6) months is considered a reasonable time, unless the circumstances indicate otherwise.
  - (b) The requirement of this subsection may be waived in the following cases—

- (i) national emergency and other cases of extreme urgency;
  - (ii) when the requested compulsory licence is for public non-commercial use; or
  - (iii) when the grounds for requesting the compulsory licence are those contained in subsection (2)(b)(ii).
  
- (7) Upon receipt of a request for a compulsory licence that meets the requirements of subsections (5) and (6), the Registrar shall—
  - (a) promptly notify the patent owner;
  - (b) invite the patent owner and the potential licensee to make observations regarding the requested compulsory licence;
  - (c) allow an exclusive licensee make observations regarding the requested compulsory licence; and
  - (d) the Registrar shall publish the request for a compulsory licence in the Gazette and invite the public to make observations regarding the request.
  
- (8) Each request for a compulsory licence shall be considered by the Registrar on its individual merits.
  
- (9) The Registrar shall hold a hearing before deciding whether to grant the compulsory licence and the terms of any such compulsory licence. The requirement of this subsection shall be waived in the cases described under subsection (6)(b).
  
- (10) If the Registrar finds that the conditions are satisfied, a compulsory licence shall be granted. The Registrar shall—
  - (a) issue an order regarding the terms of the compulsory licence; and
  - (b) publish the order in the Gazette.
  
- (11) The order shall contain—
  - (a) the patent number;
  - (b) the name of the licensee;
  - (c) scope of the compulsory licence;
  - (d) duration of the compulsory licence;
  - (e) a statement of the grounds on which the compulsory licence is based; and
  - (f) remuneration to be paid to the patent owner and the party responsible for paying such remuneration.
  
- (12) The remuneration paid to the patent owner shall be adequate. Adequate remuneration shall be determined by taking into account—

- (a) the economic value of the granted compulsory licence and the circumstances that led to the grant of the compulsory licence; and
  - (b) when the compulsory licence is granted under the ground in subsection (2)(b)(ii), the need to correct the anticompetitive practices.
- (13) A patent owner or exclusive licensee may request to terminate a compulsory licence if–
- (a) the circumstances that led to the grant of the compulsory licence have ceased to exist and are unlikely to recur; or
  - (b) the terms of the compulsory licence have been violated.
- (14) Upon a request to terminate the licence, the Registrar shall invite interested parties to make observations regarding the request. If the Registrar is satisfied that the conditions under subsection (13) are satisfied, the compulsory licence shall be terminated.
- (15) The compulsory licence may only be assigned with the enterprise or goodwill of its licensee.
- (16) Granting a compulsory licence shall not prevent the patent owner from exercising the rights conferred under section 23.
- (17) The compulsory licence shall be predominately for the supply of Kiribati's market. The requirement of this subsection shall be waived when the compulsory licence is granted on the grounds according to subsection (2)(b)(ii).
- (18) When a compulsory licence is granted on the grounds of subsection (2)(c)–
- (a) the patent owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the invention claimed in the second patent; and
  - (b) the licence of the first patent shall be non-assignable except with the assignment of the second patent.

## **27. Invalidation**

- (1) Any interested person may request the Registrar to invalidate a patent or any claim therein.
- (2) The grounds for invalidation may be any of the following–
  - (a) the invention as claimed in the patent is not patentable under section 4;
  - (b) the subject-matter of any claim of the patent is not patentable under section 3;
  - (c) the applicant is not a person entitled under section 5 to make an application; or that the applicant did not obtain the right to patent or register the invention from the right holder, or obtain it in a fraudulent manner;

- (d) the patent does not disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art under section 7(5);
  - (e) the description does not clearly identify the origin of genetic or biological resources under section 7(6); and
  - (f) the patent application contains a material misrepresentation or a false statement or representation and which the applicant or patent owner knew to be false at the time when the declaration was made.
- (3) A request for invalidation under subsection (1) shall state the grounds on which it is based.
  - (4) The Registrar shall determine whether to invalidate one or more claims of the patent. When the grounds for invalidation are established with respect only to a part of the invention, only the corresponding claim or claims shall be invalidated.
  - (5) Any invalidated patent or only the corresponding claim therein shall be regarded as null and void from the date of the grant of the patent and shall be deemed as if it had never been granted.
  - (6) In the event of a dispute over the right to the patent, the interested person may ask the Registrar to transfer the title to the interested person instead of invalidating it.
  - (7) The Registrar shall publish the decision in the Gazette and record it in the Register.

### **PART III - COMMON PROVISIONS**

#### **28. Extensions of time**

- (1) Subject to subsections (2) and (3), the time limits under this Act in respect of an application or a patent may be extended for a period of two (2) months counted from the date of the expiration of the unobserved time limit, if a request to that effect is filed with the Registrar and the request is filed within that extended period according to the Regulations.
- (2) All of the requirements in respect of which the time limit for the action concerned applied shall be complied with at the same time as the request is filed.
- (3) The Registrar may prescribe that specific time limits under this Act may not be extended.

#### **29. Reinstatement of rights**

- (1) Subject to subsections (2) to (5), if the applicant or patent owner has failed to comply with a time limit for an action in a procedure before the Registrar's Office, the direct

consequence of which is a loss of rights with respect to an application or patent, and the Registrar's Office finds that the failure to comply with such time limit as unintentional, the Registrar's Office shall reinstate the rights of the applicant or patent owner with respect to the application or patent concerned.

- (2) The person requesting the reinstatement of rights shall—
  - (a) file a request for the reinstatement of rights, stating reasons for the failure to comply with the time limit;
  - (b) comply with all of the requirements with respect of which the time limit for the said action applied, within the time limit prescribed in subsection (3); and
  - (c) pay the prescribed fee and any surcharges as prescribed.
- (3) A request for reinstatement of rights shall be filed, and all of the requirements in respect of which the time limit for the said action applied shall be complied with, within the earlier of the following—
  - (a) two (2) months from the date of the removal of the cause of failure to comply with the time limit for the action in question;
  - (b) two (2) months from the date when the applicant has later learned of failure; and
  - (c) one year from the date of failing to comply with the requirement.
- (4) Notwithstanding subsection (5), the Registrar may request a declaration or other evidence regarding the reasons for failure to comply with the time limit. Failure to respond to the request within the prescribed term shall result in a refusal of the reinstatement.
- (5) If the Registrar determines that reinstatement of rights referred to in subsection (1) is unjustified, and intends to refuse it in its entirety or in part, the Registrar shall—
  - (a) prior to the refusal, inform the person filing the request for reinstatement of the reasons for the refusal; and
  - (b) shall invite the requestor to file observations on such reasons within one month from the day of receipt of the invitation.
- (6) The Registrar shall issue a decision in writing regarding the reinstatement of rights. The decision shall be provided to the requestor.
- (7) No reinstatement of rights under subsection (1) shall be granted with respect to complying with the time limits for the following acts—
  - (a) filing of the proposal referred to in subsection (1);
  - (b) filing of a request for the extension of a time limit under subsection (3);
  - (c) for performing all the acts in the appeal procedure; and

- (d) for actions in *inter partes* proceeding.
- (8) Any person who has exploited in good faith an invention or has made real and serious preparations for exploiting the invention, which is the subject matter of a published application or granted patent, may, in the period between the loss of rights referred to in subsection (1) and the publication of data on the acceptance of a proposal for the reinstatement of rights, continue such exploitation, without payment of compensation for damages, for the purposes of the third party's business and needs related to it.

#### **PART IV - UTILITY MODEL CERTIFICATES**

##### **30. Registrable Utility Models**

- (1) Without prejudice to the following provisions, the provisions of Part II and III as well as other provisions that apply to patents and patent applications, shall apply *mutatis mutandis* to utility model applications and utility model certificates.
- (2) An invention is registrable as a utility model if it is new and is industrially applicable.
- (3) The description of the utility model shall disclose the invention in a manner sufficiently clear and complete for the utility model to be carried out by a person having ordinary skill in the art, and shall indicate how the claimed invention in the utility model enhances the utility or functionality of the relevant object.
- (4) The following are excluded from utility model protection—
- (a) procedures;
  - (b) chemical, metallurgical or any other kind of substances or compounds; and
  - (c) items excluded from protection by patents for inventions pursuant to section 4 of this Act.

##### **31. Rights Conferred by Utility Model Certificates**

- (1) The owner of the utility model certificate shall, in addition to any other rights, remedies or actions available, have the right to institute court proceedings, in accordance with Part V, VI, VII and VIII, against any person who infringes the certificate by performing, without the owner's agreement, any of the acts referred to in section 23(2) or who performs acts which make it likely that infringement will occur.
- (2) Upon receipt of the action, the Court shall order the utility model certificate to be examined as to compliance with the provisions of section 3, 4 and 7(5). The Registrar shall transmit the result of such examination to the Court in no more than one

hundred and twenty (120) days. That result shall have the value of a rebuttable presumption as regards the validity or invalidity of the certificate.

- (3) During the period in which the Registrar examines the utility model, the Court may order provisional measures to prevent an infringement from occurring and/or to preserve relevant evidence in regard to the alleged infringement.

### **32. Duration**

Subject to section 25(2), a utility model certificate shall expire ten (10) years after the filing date of the application for the certificate.

### **33. Grounds for invalidation of a utility model**

- (1) The grounds for invalidation of a utility model may be any of the following—
  - (a) the invention is not registrable under section 30(2) as claimed in the utility model certificate, when it has been disclosed before the priority date of the claim in Kiribati or elsewhere in the world;
  - (b) the subject-matter of any claim of the utility model is not registrable under sections 4 or 30(4);
  - (c) a judicial decision ascertained that the applicant is not a person entitled under section 5 to make an application; or that the applicant did not obtain the right to patent the invention from the right holder, or obtained it in a fraudulent manner;
  - (d) the utility model certificate does not disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person having ordinary skill in the art under section 30(3) for the applicant did not disclose the best mode known at the time of filing the application for a utility model; and
  - (e) the utility model application contains a material misrepresentation or a false statement or representation and which the applicant or patent owner knew to be false at the time when the declaration was made.

### **34. Conversion of Patent Applications or Applications for Utility Model Certificates**

- (1) At any time before the examination of a patent application or in any case before the grant or refusal of a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.
- (2) At any time before the grant or refusal of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert the utility

model application into a patent application, which shall be accorded the filing date of the initial application.

- (3) An application shall not be converted under subsection (1) and (2) more than once.

## **PART V - ENFORCEMENT OF RIGHTS**

### **35. Infringement of Patents and Utility Models; Remedies**

- (1) Subject to section 23 and 26 of Part II and section 31 of part IV, an infringement of a patent or a utility model, shall consist of the performance of any act referred to in section 23(2) in Kiribati by a person other than the patent or utility model owner and without the agreement of the latter.
- (2) On the request of the patent or utility model owner, an exclusive licensee, or a compulsory licensee, or of a non-exclusive licensee if the non-exclusive licensee has requested the patent owner to institute court proceedings for a specific relief and the patent owner has refused or failed to do so within ninety (90) days, the Court may grant an injunction to prevent infringement or an imminent infringement or to desist from an infringement, award damages where the infringer acted knowingly or with reasonable grounds to know, and grant any other remedy provided for in the general law.

### **36. Time Limits**

- (1) Civil proceedings under section 35 can be initiated within five (5) years from the date on which the right holder knew or had reasons to know the infringing acts.
- (2) Except as otherwise provided by this Act, no recovery shall be had for any infringement committed more than five (5) years prior to the filing of an action under subsection (1).

### **37. Cumulative Remedies**

When they find that an infringement of a patent or utility model protected by this Act has taken place, Courts shall order injunctions so that the infringer ceases, provisionally and/or definitively, to infringe, and the payment of damages, and any other remedies available, in accordance with this Act as well as general procedural law.

## PART VI - PROVISIONAL MEASURES

### 38. Provisional Measures

- (1) On request, the Court shall order, in accordance with the procedure prescribed in the High Court Civil Procedure Rules or similar statutes prompt and effective provisional measures to prevent an infringement or unlawful use referred to in Part V from occurring or to preserve relevant evidence in regard to an alleged infringement. The request for provisional measures can be made only by the owner of a patent or utility model certificate, or the exclusive licensee, or the non-exclusive licensee if the non-exclusive licensee has requested the owner to make such a request for provisional measures and the owner has refused or failed to do so within twenty (20) days.
- (2) Where appropriate, any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed, the Court shall order provisional measures without giving the other party an opportunity of being heard provided that the applicant has furnished—
  - (a) any reasonably available evidence satisfying the Court that the applicant is the right holder and that the applicant's rights are being infringed or that such infringement is imminent, and
  - (b) any security or equivalent assurance required by the Court to protect the defendant and to prevent abuse; such security or equivalent assurance shall be reasonable in view of the circumstances and shall be set so as not to unreasonably deter recourse to such procedures.
- (3) Where provisional measures have been ordered without having given the other party an opportunity of being heard, the Court shall give the parties affected notice of the decision, at the earliest after the execution of the measures.
- (4) Requests for provisional measures without giving the other party an opportunity of being heard shall be acted upon expeditiously and shall, except in exceptional cases, generally be executed within ten (10) days.
- (5) Where provisional measures have been ordered under subsections (2) and (3), the defendant may file a request for review with the Court within two (2) weeks from the notification of the decision. In the review proceedings, the Court shall give the parties concerned an opportunity of being heard and shall confirm, modify or invalidate the decision within a reasonable period after the notification of the decision.
- (6) Where the applicant does not initiate Court proceedings leading to a decision on the merits of the case within twenty (20) working days or thirty-one (31) calendar days, whichever is the longer, from the notification of the decision ordering provisional

measures or within any other reasonable period determined by the Court in the decision, the Court shall invalidate the provisional measures upon the request of the defendant.

- (7) Where the provisional measures are invalidated or where the Court decides on the merits of the case in proceedings under subsection (6) initiated by the applicant that there has been no infringement or threat of an infringement, the Court shall order the applicant, upon the request of the defendant, to provide the defendant appropriate compensation for any injury caused by the execution of the provisional measures.
- (8) The measures of this section aiming at preserving relevant evidence shall also be available before the granting of the pending registration if the Court so deems necessary. In that event, the applicant shall initiate Court proceedings leading to a decision on the merits of the case twenty (20) working days or thirty-one (31) calendar days, whichever is the longer, from the publication of the grant of the pending registration.

## **PART VII - EVIDENCE; BURDEN OF PROOF**

### **39. Evidence; Reversal of Burden of Proof**

- (1) The Court may, where a party has presented reasonably available evidence sufficient to support the claims and has specified evidence relevant to substantiation of the claims, which lies in the control of the opposing party, order that this evidence be produced by the opposing party, subject, in appropriate cases, to conditions that ensure the protection of confidential information.
- (2) In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide, necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, the Court may make preliminary and final determinations, affirmative or negative, on the basis of the information presented to it, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.
- (3) For the purposes of civil proceedings in respect of the infringement of rights of the patent owner, if the subject matter of a patent is a process for obtaining a product, the Court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.

- (4) Any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process in either of the following circumstances—
  - (a) If the product obtained by the patented process is new; or
  - (b) If there is substantial likelihood that the identical product was made by the process and the patent owner has been unable through reasonable efforts to determine the process used.
- (5) In requiring the production of evidence, the Court before which the proceedings referred to in this subsection take place shall consider the legitimate interests of the alleged infringer in not disclosing the alleged infringer's manufacturing and business secrets.
- (6) In the event that the Court appoints technical or other experts in civil proceedings concerning the enforcement of intellectual property rights and require that the parties to the litigation bear the costs of such experts, the Court shall seek to ensure that such costs are closely related, *inter alia*, to the quantity and nature of work to be performed and do not unreasonably deter recourse to such proceedings.

## **PART VIII - DAMAGES AND OTHER REMEDIES**

### **40. Damages**

- (1) Where damages are awarded in accordance with section 35, the Court shall order the infringer to pay the right holder adequate compensation for the infringement of his or her rights. Where appropriate, the Court shall order the infringer to pay the right holder expenses, including the Court costs or fees and appropriate attorney's fees.
- (2) In determining damages for infringement of the rights established in this Act, the Court shall consider, *inter alia*, the value of the infringed good or service, measured by the suggested retail price or other legitimate measure of value submitted by the right holder.
- (3) The Court may order the infringer to pay for damages relating to acts of infringement practiced—
  - (a) on the date, or subsequent to the date, on which public notice, if any, of the application of the registration was given through the Gazette;
  - (b) on the date, or subsequent to the date, on which the applicant of the registration gave notice to the alleged infringer of the contents of the application; or

- (c) on the date, or subsequent to the date, on which the alleged infringer acquired knowledge of the contents of the application.
- (4) The request for the Court to order the payment of damages under subsection (3) may be filed only after the patent or utility model in question is granted.

#### **41. Other Remedies**

- (1) Where goods have been found to be infringing, the Court may order on the application of the right holder, without compensation of any sort, that these goods be destroyed or disposed of outside the channels of commerce.
- (2) The Court may order on the application of the right holder that materials or implements the predominant use of which has been the creation of infringing goods be destroyed or, in exceptional circumstances, be disposed of outside the channels of commerce without compensation of any sort in such a manner as to minimize the risks of further infringement.
- (3) In exercising its discretion in terms of subsections (1) and (2), the Court shall take into account—
  - (a) the deterrent effect of the order;
  - (b) that destruction or disposal outside the channels of commerce must be proportional to the seriousness of the infringement;
  - (c) the effect on the environment of the manner of destruction or disposal; and
  - (d) the legitimate interests of third parties.

#### **42. Information to Right Holder**

In civil judicial proceedings concerning the enforcement of the rights protected by this Act, the Court shall have the authority to order the infringer to provide any information that the infringer possesses regarding any person or persons involved in any aspect of the infringement and regarding the means of production or distribution channel of such goods or services, including the identification of third persons involved in the production and distribution of the infringing goods or services or in their channels of distribution, and to provide this information to the right holder. The Court shall order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution.

#### **43. Indemnification of the Defendant**

The Court shall order an applicant, at whose request measures were taken and who has abused enforcement procedures, to provide to a defendant wrongfully enjoined or

restrained adequate compensation for the injury suffered by virtue of such abuse. Where this is considered adequate in view of the seriousness of the abuse, the Court shall also order the person having abused enforcement procedures to pay the other party's expenses including appropriate attorney's fees.

#### **44. Appeals**

- (1) Any decision by the Court in infringement proceedings shall be subject to an appeal to the Court of Appeal.
- (2) The appeal shall be filed within sixty (60) days from the notification of the decision.

### **PART IX - MISCELLANEOUS**

#### **45. Power of Minister to make regulations**

- (1) The Minister may make regulations for the purpose of carrying out or giving effects to the principles and provisions of this Act.
- (2) In particular and without prejudice to the generality of the powers conferred by subsection (1), the Minister may make regulations for or in respect of all or any of the following matters:-
  - (a) the amount of fees and surcharges;
  - (b) the forms to be used in applications;
  - (c) the registration procedure for agent;
  - (d) the procedures for applications; and
  - (e) the time limits or term required in the Act.

#### **46. Changes in Ownership (Assignments)**

Any change in the ownership of a patent, or a utility model certificate, or in the ownership of an application thereof, shall be in writing and shall, at the request of any interested party, to the Registrar be recorded and, except in the case of an application, published by the Registrar in the Gazette. Such change shall have no effect against third parties until such recording is effectuated.

#### **47. Agents**

- (1) Where an applicant's ordinary residence or principal place of business is outside of Kiribati, the applicant shall be represented by an agent. That agent shall receive power to receive communications and service as regards any process or proceeding, either judicial or other, in Kiribati, under this Act, relating to the application or title in question.

- (2) Any decision taken by the Registrar under this Act, in particular the grant of a patent or a utility model certificate or the refusal of an application for such a grant or registration, the grant of a compulsory licence, and his decision relating to the remuneration provided in respect of a compulsory licence under section 26, may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within sixty (60) days of the date of the decision.

#### **54. Sanctions against Abuses of Judicial Procedures**

The Court shall have the authority to—

- (a) fine or imprison, in appropriate cases, a party to a litigation who fails to abide by valid orders issued by such authorities; and
- (b) impose sanctions on parties to a litigation, their counsel, experts, or other persons subject to the Court's jurisdiction, for violation of judicial orders regarding the protection of confidential information produced or exchanged in a proceeding.

#### **55. Publicity and Transparency**

- (1) Final judicial decisions and administrative rulings of general application pertaining to the enforcement of industrial property rights shall be in writing and shall state any relevant findings of fact and the reasoning or the legal basis on which the decisions or rulings are based.
- (2) Such decisions or rulings shall be published in the Gazette.

#### **56. Application of International Treaties**

The provisions of any international treaties in respect of patents, and utility models certificates, including regional and bilateral agreements, to which Kiribati is party, shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, shall prevail over the latter.

#### **57. Savings**

Despite the repeal of the *Registration of UK Patent Ordinance Cap 87* and subject to this Act, any registrations certificates executed under it and in force at the date of commencement of this Act continues to be in force as if it has been under this Act.

#### **58. Repeal**

*The Registration of UK Patent Ordinance Cap 87* is hereby repealed.

## EXPLANATORY MEMORANDUM

The Patent Act 2022 was established to repeal the outdated patent system installed by the United Kingdom law titled *Registration of UK Patents Ordinance*. The British introduced the ancient patent system during the colonial period and have never been amended or updated. The new Patent Act shall place a modern patent system in Kiribati that will help boost economic development by promoting and enabling the protection of local inventions and foreign registrations. That said, the following details shall provide a summary of the Patent Act 2022.

The Patent Act 2022 has nine parts and consist of 55 sections.

Part I is on preliminary matters and consists of 2 sections. First, it contains the title of the Act followed by Interpretations.

Part II is on Patents. This part contains 24 sections and talks mostly on all Patent matters. For instance, section 3 and 4 provides a list of issues that are not considered patentable. This part also provides a procedure or process of applications amendment when filing for patent protection. The method includes the following: filing, formal examination, classification, publication, substantive examination, objection to the application and final decision whether to grant or reject the application. The rights of a patent owner are also stipulated in this part, including the duration of protection.

Part III on Common Provisions provides a process in applying for the extension of time regarding applications or patents and the reinstatement of rights.

Part IV talks about the Utility Model Certificate, another kind of patent protection but lacks inventive steps. It is provided in this provision that Utility Model Certificate have a protection life of 10 years which is shorter than patent. The patent can also be converted to Utility Model but must follow the process provided in this provision.

Part V provides how patent owners can enforce their rights if infringed. There is also a time limit for the patent owner to pursue their case before it lapses. Finally, the last part of this provision provides power for the court to award cumulative remedies.

Part VI is about Provisional Measures. That said, this part gives power to the court to order or initiate measures to prevent an infringement of rights from happening.

Part VII on Evidence and Burden of Proof consist of section 39, which provides court powers to call evidence from both parties to prove their case. For instance, for the complainant to prove that there was an infringement, the respondent must prove otherwise.

Part VIII provides Court powers to award damages against infringement, which can be in monies or in other forms that shall compensate the patent owner's damage.

Part IX is on Miscellaneous. This last provision touches on relevant matters that are crucial for implementing and enforcing this Act. One of those issues is the establishment of the Registrar's office to keep the record of registered patent. Another essential matter is the power of the Minister to make regulations on issues that are not stipulated in this Act but prescribed. For foreign registrations they can only be dealt with by an Agent who should be a local legal practitioner. Other matters under this part deal with the following matters: the establishment of the patent register, the use of the gazette, and the appeal against the Registrar's decision. The final section deals with repeal and savings.

**Honourable Booti Nauan**

Minister of Tourism, Commerce, Industry and Cooperatives

**LEGAL REPORT**

I hereby certify that in my opinion none of the provisions of the above Act are in conflict with the Constitution and that His Excellency the Beretitenti may properly assent to the Act

**Tetiro Maate Semilota**

Attorney General

**CERTIFICATE OF THE CLERK OF THE MANEABA NI  
MAUNGATABU**

This printed impression of the Patent Act 2022 has been carefully examined by me with the Bill which passed the Maneaba ni Maungatabu on the 6<sup>th</sup> September 2022 and is found by me to be a true and correctly printed copy of the said Bill.



**Eni Tekanene**  
**Clerk of the Maneaba ni Maungatabu**

Published by exhibition at the Maneaba ni Maungatabu this ..... day  
of ..... 2022.



**Eni Tekanene**  
**Clerk of the Maneaba ni Maungatabu**