

No. S 46

INDUSTRIAL DESIGNS ORDER, 1999
(S 7/2000)

INDUSTRIAL DESIGNS (INTERNATIONAL REGISTRATION) RULES, 2014

ARRANGEMENT OF RULES

Rule

PART I

PRELIMINARY

1. Citation.
2. Interpretation.
3. Forms.

PART II

INTERNATIONAL REGISTRATION DESIGNATING BRUNEI DARUSSALAM

4. Entitlement to protection.
5. Effects of protected international design (Brunei Darussalam).
6. Protected international design (Brunei Darussalam) as object of property.
7. Notifiable transactions and relevant transactions.
8. Priority.
9. Examination.
10. Notice of refusal.
11. Protection.
12. Revocation.
13. False representation that design is protected.
14. Government use.

PART III

INTERNATIONAL APPLICATION THROUGH REGISTRY

15. International application.

PART IV

GENERAL

16. Evidence of certain matters relating to international registration.
17. Agents.
18. Burden of proving use of protected international design (Brunei Darussalam).
19. Communication of information to International Bureau.
20. Application of S 23/2000.
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In exercise of the power conferred by sections 76A and 77(1) of the Emergency (Industrial Designs) Order, 1999, the Minister of Energy in the Office of the Prime Minister may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, hereby makes the following Rules —

PART I

PRELIMINARY

Citation.

1. These Rules may be cited as the Industrial Designs (International Registration) Rules, 2014.

Interpretation.

2. In these Rules, unless the context otherwise requires —

“Common Regulations” means the Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement, adopted by the Assembly of the Hague Union with effect from 1st April 2004, as amended or revised from time to time;

“international application” means an application to the International Bureau for international registration;

“International Register” means the official collection of data concerning international registrations maintained by the International Bureau for the purposes of the Geneva Act of the Hague Agreement;

“international registration designating Brunei Darussalam” means an international registration in respect of which a request has been made (whether in the relevant international application or subsequently) for extension of protection to Brunei Darussalam under the Geneva Act of the Hague Agreement;

“protected international design (Brunei Darussalam)” has the meaning given by rule 11, and references to “protected” and “protection” shall be construed accordingly.

Forms.

3. (1) Any reference in these Rules to a numbered form is construed as a reference to the current version of the form bearing the corresponding number which is —

(a) described in the First Schedule to the Industrial Designs Rules, 2000 (S 23/2000); and

(b) published in the Journal.

(2) Any form may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

PART II

INTERNATIONAL REGISTRATION DESIGNATING BRUNEI DARUSSALAM

Entitlement to protection.

4. (1) Subject to rule 9, an international registration designating Brunei Darussalam is entitled to become protected in Brunei Darussalam if, had the particulars of the international registration been comprised in an application for registration of a design under the Order, that application would have satisfied the requirements for registration of a design under the Order and the Industrial Designs Rules, 2000 (S 23/2000).

(2) For the purposes of subrule (1), section 15 and rules 3, 6 to 11, 15, 17, 19, 21, 22, 24, 27 and 62 of the Industrial Designs Rules, 2000 (S 23/2000) are to be disregarded.

Effects of protected international design (Brunei Darussalam).

5. (1) Subject to the provisions of these Rules, the holder of the international registration relating to a protected international design (Brunei Darussalam), has the same rights and remedies as the registered owner of an industrial design under sections 31, 35, 41, 48, 48(1), 49, 53 and 54.

(2) Subrule (1) applies subject to section 31(3) and (4) relating to acts not amounting to infringement of an industrial design.

(3) For the purposes of the application of section 31(1), the rights of the holder have effect from the date on which the protected international design (Brunei Darussalam) is to be treated as registered under rule 11(2).

(4) The remedy for groundless threats of infringement proceedings under section 57A applies to a protected international design (Brunei Darussalam) as it applies in relation to an industrial design under the Order.

(5) For the purposes of subrule (4) —

(a) the reference in section 57(1) to an application for registration of a design must be treated as a reference to an international application relating to a protected international design (Brunei Darussalam);

(b) the reference in section 57(2) to the registration of the design must be treated as a reference to the protection of the protected international design (Brunei Darussalam); and

(c) the reference in section 57(4) to the notification that a design is registered must be treated as a reference to a notification that a design is a protected international design (Brunei Darussalam).

Protected international design (Brunei Darussalam) as object of property.

6. Sections 32 and 33 apply with the necessary modifications, in relation to a protected international design (Brunei Darussalam), as they apply in relation to an industrial design under the Order.

Notifiable transactions and relevant transactions.

7. (1) The following are notifiable transactions for the purposes of this rule —

(a) the grant of a licence or sub-licence for the use of a protected international design (Brunei Darussalam);

(b) the grant of any security interest (whether fixed or floating) over a protected international design (Brunei Darussalam) or any right in it.

(2) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a protected international design (Brunei Darussalam) by virtue of a notifiable transaction; or

(b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the Register.

(3) An application for registration of the relevant particulars of a notifiable transaction must —

- (a) be made in Form D7;
- (b) where the transaction is the grant of a licence or sub-licence for the use of a protected international design (Brunei Darussalam) —
 - (i) be signed by the grantor of the licence or sub-licence, as the case may be; or
 - (ii) be accompanied by such evidence as the Registrar considers to be sufficient proof of the transaction;
- (c) where the transaction is the grant of any security interest (whether fixed or floating) over a protected international design (Brunei Darussalam) or any right in it —
 - (i) be signed by the mortgagor of the security interest; or
 - (ii) be accompanied by such evidence as the Registrar considers to be sufficient proof of the transaction; and
- (d) be accompanied by the prescribed fee for the filing of Form D7.

(4) The following are relevant transactions for the purposes of this rule —

- (a) an assignment of a protected international design (Brunei Darussalam) or any right in it;
- (b) the making by personal representatives of an assent in relation to a protected international design (Brunei Darussalam) or any right in it;
- (c) an order of the Court or other competent authority transferring a protected international design (Brunei Darussalam) or any right in it.

(5) Until —

- (a) in the case of a notifiable transaction, an application has been made for registration of the relevant particulars of the transaction; or
- (b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in the protected international design (Brunei Darussalam) in ignorance of it.

(6) A person claiming to be entitled to an interest in or under a protected international design (Brunei Darussalam) by virtue of a notifiable transaction is not entitled to —

(a) damages or an account of profits in respect of any infringement of the protected international design (Brunei Darussalam) occurring after the date of the transaction and before the date of the application for registration of the relevant particulars of the transaction; and

(b) remuneration under section 39 in respect of the use of the design for the services of the Government occurring after the date of the transaction and before the date of the application for registration of the relevant particulars of the transaction.

(7) A person who becomes the holder of the international registration relating to a protected international design (Brunei Darussalam) by virtue of a relevant transaction is not entitled to —

(a) damages or an account of profits in respect of any infringement of the protected international design (Brunei Darussalam) occurring after the date of the transaction and before the transaction is recorded in the International Register; and

(b) remuneration under section 39 in respect of the use of the design for the services of the Government occurring after the date of the transaction and before the transaction is recorded in the International Register.

(8) In this rule, “relevant particulars” means —

(a) in the case of the grant of a licence for the use of a protected international design (Brunei Darussalam) —

- (i) the name and address of the licensee;
- (ii) where the licence is an exclusive licence, that fact;
- (iii) where the licence is limited, a description of the limitation; and
- (iv) the duration of the licence if the duration is, or is ascertainable as, a definite period;

(b) in the case of the grant of a sub-licence for the use of a protected international design (Brunei Darussalam) —

- (i) the name and address of the grantor of the sub-licence and of each person from whom he derived his ability to grant the sub-licence;
- (ii) the name and address of the sub-licensee;

- (iii) where the sub-licence is an exclusive sub-licence, that fact;
 - (iv) where the sub-licence is limited, a description of the limitation; and
 - (v) the duration of the sub-licence if the duration is, or is ascertainable as, a definite period; and
- (c) in the case of the grant of any security interest over a protected international design (Brunei Darussalam) or any right in it —
- (i) the name and address of the grantee;
 - (ii) the nature of the interest (whether fixed or floating); and
 - (iii) the extent of the security or right in the protected international design (Brunei Darussalam) secured.

Priority.

8. (1) Subject to subrule (2), section 17 applies so as to confer a right of priority in relation to the protection of an international registration designating Brunei Darussalam, as it applies in relation to the registration of a design under the Order.

(2) The manner of claiming priority is determined in accordance with the Geneva Act of the Hague Agreement and the Common Regulations.

Examination.

9. (1) Upon receiving a notification of an international registration designating Brunei Darussalam from the International Bureau, the Registrar must examine whether the international registration satisfies the requirements for protection in Brunei Darussalam set out in rule 4(1).

(2) If it appears to the Registrar that the requirements for protection in Brunei Darussalam set out in rule 4(1) are not met, he must give a notice of refusal of protection to the International Bureau.

(3) The notice of refusal must specify the period within which the holder of the international registration may make representations against the refusal.

(4) The Registrar may extend the period within which the holder of the international registration may make representations upon receiving an application for an extension of time before the expiry of the current period specified in the notice of refusal.

(5) If the holder requires an extension of time to make representations, he must file with the Registrar his request for an extension of time on Form D11 before the expiry of —

- (a) the period specified in the notice of refusal; or
- (b) any extended period previously granted by the Registrar.

(6) A holder of an international registration making representations must file with the Registrar an address for service in Brunei Darussalam in Form D1.

Notice of refusal.

10. (1) A notice of refusal under rule 9(3) must not be given after the expiry of 6 months from the date of the publication of the international registration in accordance with Rule 26(3) of the Common Regulations.

(2) A notice of refusal under rule 9(3) must set out the matters required under Article 12 of the Geneva Act of the Hague Agreement and Rule 18 of the Common Regulations.

(3) Where, after a notice of refusal has been given under rule 9(2), the holder makes representations within the period specified in rule 9(3) or any extended period granted by the Registrar, the Registrar must, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(4) For the purposes of subrule (3), a final decision is regarded as being made where —

- (a) the Registrar or the Court on appeal from the Registrar decides whether the refusal shall be upheld or withdrawn, and any right of appeal against that decision expires or is exhausted; or
- (b) the proceedings relating to the refusal are discontinued or abandoned.

Protection.

11. (1) A design which is the subject of an international registration designating Brunei Darussalam shall be protected as a protected international design (Brunei Darussalam) —

- (a) in a case where no notice of refusal has been given to the International Bureau within the period of 6 months referred to in rule 10(1), upon the expiry of that period; or

(b) in any other case, upon the Registrar notifying the International Bureau under rule 10(3) that a final decision has been made to withdraw the refusal of protection.

(2) For the purposes of the application by these Rules of the provisions of the Order, a design which is the subject of an international registration designating Brunei Darussalam shall be —

(a) treated as if it was registered under the Order;

(b) protected as a protected international design (Brunei Darussalam),

from the filing date of the corresponding international application.

Revocation.

12. (1) The protection conferred under rule 11 on a protected international design (Brunei Darussalam) may be revoked on the application of an interested person.

(2) Subject to subrules (3), (4) and (5), section 45 applies, with the necessary modifications, in relation to the revocation of the protection conferred on a protected international design (Brunei Darussalam) as it applies in relation to the revocation of the registration of an industrial design under the Order.

(3) For the purposes of section 45 —

(a) the references in section 45 to the time of its registration shall be treated as references to the time after a design has become protected as a protected international design (Brunei Darussalam) under rule 1;

(b) the references in section 45 to the order the registration of an industrial design to be revoked shall be treated as references to the revocation of the protection conferred on a protected international design (Brunei Darussalam);

(c) the references in sections 45 and 46(3) to the time of its registration shall be treated as references to the date a design became protected as a protected international design (Brunei Darussalam);

(d) the reference in section 46(3) to the time of its registration shall be treated as a reference to the time a design became protected as a protected international design (Brunei Darussalam).

(4) Where the protection conferred on a protected international design (Brunei Darussalam) is revoked to any extent —

(a) the Registrar shall notify the International Bureau; and

(b) the rights of the holder of the international registration relating to the protected international design (Brunei Darussalam) is regarded to have ceased to exist as from —

(i) the date of the application for revocation; or

(ii) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

False representation that design is protected.

13. (1) Section 80 applies, with the necessary modifications, in relation to a protected international design (Brunei Darussalam) as it applies in relation to an industrial design under the Order.

(2) For the purposes of section 80 —

(a) the references in section 80(1) and (2) to a person representing that a design applied to an article is registered in respect of that article shall be treated as references to a person representing that a design applied to an article is protected as a protected international design (Brunei Darussalam); and

(b) the references in section 80(3) to a right in a registered design shall be treated as references to protection conferred on a protected international design (Brunei Darussalam).

Government use.

14. Part IV of the Order applies, with the necessary modifications, in relation to a protected international design (Brunei Darussalam) as it applies in relation to an industrial design under the Order.

PART III

INTERNATIONAL APPLICATION THROUGH REGISTRY

International application.

15. (1) Subject to the provisions of these Rules, an international application may be made through the Registry.

(2) The international application may be made only by any of the following persons —

(a) a person who is a national of a State that is a Contracting Party;

(b) a person who is a national of a State member of an inter-governmental organisation that is a Contracting Party;

(c) a person who is domiciled in or has a habitual residence in the territory of a Contracting Party; or

(d) a person who has a real and effective industrial or commercial establishment in the territory of a Contracting Party.

(3) The Registrar shall not be required to transmit the international application to the International Bureau unless the international application is —

(a) made in such form as may be required under the Common Regulations;

(b) accompanied by payment of such fee as may be required under the Common Regulations for the filing of the international application; and

(c) accompanied by payment to the Registry of a transmittal fee of \$150.

(4) The payment referred to in subrule (3)(b) must comply with —

(a) such general requirements as may be specified in the practice directions issued by the Registrar; and

(b) such other requirements as the Registrar may, in any particular case, specify in a written notice to the applicant.

(5) In this rule —

“Contracting Party” means any State or inter-governmental organisation which is a party to the Geneva Act of the Hague Agreement;

“territory of a Contracting Party” means —

(a) where the Contracting Party is a State, the territory of that State; or

(b) where the Contracting Party is an inter-governmental organisation, the territory in which the constituent treaty of that inter-governmental organisation applies.

PART IV

GENERAL

Evidence of certain matters relating to international registration.

16. (1) In all legal proceedings relating to a protected international design (Brunei Darussalam), the registration of a person as the holder of the international registration relating to a protected international design (Brunei Darussalam) is *prima facie* evidence of the validity of that international registration and of any subsequent assignment or other transmission of it.

(2) Judicial notice shall be taken of —

(a) the Geneva Act of the Hague Agreement and the Common Regulations;

(b) a copy of an entry in the International Register issued by the International Bureau; and

(c) a copy of the Bulletin published by the International Bureau.

(3) Any document referred to in subrule (2)(b) or (c) shall be admissible as evidence of any instrument or act of the International Bureau referred to in the document.

(4) Evidence of any document issued by the International Bureau, or of any entry in or extract from such a document, may be given in any legal proceedings by the production of a copy thereof, and such a copy shall be received in evidence.

(5) In this rule, “legal proceedings” include proceedings before the Registrar.

Agents.

17. Any act required or authorised under these Rules to be done by or to a person in connection with —

(a) a request for protection of a design as a protected international design (Brunei Darussalam); or

(b) any procedure relating to a protected international design (Brunei Darussalam),

may be done by or to an agent authorised by that person orally or in writing.

Burden of proving use of protected international design (Brunei Darussalam).

18. If in any civil proceedings relating to a protected international design (Brunei Darussalam), a question arises as to the use to which the design has been put, the holder of the international registration relating to the design bears the burden of showing what use has been made of it.

Communication of information to International Bureau.

19. Notwithstanding any written law or rule of law, the Registrar may communicate to the International Bureau any information which Brunei Darussalam is required to communicate under these Rules, the Geneva Act of the Hague Agreement or the Common Regulations.

Application of S 23/2000.

20. (1) Except as otherwise provided in these Rules, the Industrial Designs Rules, 2000 (S 23/2000) apply, with the necessary modifications, in relation to an international registration designating Brunei Darussalam and to a protected international design (Brunei Darussalam) as they apply in relation to an application for registration of a design and to a registered design.

(2) The provisions of the Order and the Industrial Designs Rules, 2000 (S 23/2000) relating to costs and security for costs and to evidence before the Registrar apply in relation to proceedings under these Rules in the same manner as they apply in relation to proceedings relating to a registered design or an application for registration of a design.

(3) For the avoidance of doubt, rules 3, 6 to 11, 15, 17, 19, 21, 22, 24, 25, 27, 28, 29, 30, 31, 32, 50, 51, 52, 59, 62 and 69 of the Industrial Designs Rules, 2000 (S 23/2000) do not apply to an international registration designating Brunei Darussalam or a protected international design (Brunei Darussalam).

Made this 29th. day of Syawal, 1435 Hijriah corresponding to the 25th. day of August, 2014.

PEHIN DATU SINGAMANTERI COLONEL (R)
DATO SERI SETIA (DR.) AWANG HAJI MOHAMMAD YASMIN
BIN HAJI UMAR
Minister of Energy in the Office of the Prime Minister,
Minister responsible for Industrial Designs.