

# BRUNEI

## INTELLECTUAL PROPERTY HANDBOOK

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## Legislation

Trade Marks Act (Cap 98– Revised edition 2000), Trademark (Importation of Infringing Goods) Regulations (Revised Edition 2000), Trademark Rules (Revised Edition 2000).

## Definition

A trademark is defined as any visually perceptible sign capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, or the shape of goods or their packaging.

Since 2017, Brunei Darussalam can now accept registration for non-traditional marks: smell, sound and taste - so long as an applicant can visually represent the product's mark in writing.

## Criteria

- To be registrable, a trademark must be new (ie: there is no identical or confusingly similar mark in the same class by another applicant) and distinctive.
- Shape, colour and aspects of packaging are registrable in Brunei. There is also provision for the protection of well-known trademarks.
- Service marks are registrable. Multi-class applications, divisional applications, merger of applications and registrations are also available in Brunei.

## Membership

- ✓ - Paris Convention
- ✓ - Madrid Protocol

## Rule of Priority

The first user of a mark is entitled to its registration in Brunei. Classification is identical with international classification.

## Duration and Renewal

Under the old law, trademark are viable for an initial period of seven years and renewable for a further period of fourteen years. After the amendment to Brunei's trademarks law on 1 June 2000, a 10-year term of renewal will be granted where the renewal falls due on or after 1 June 2000. The old 14-year term will be granted only if the renewal fell due before 1 June 2000.

## Procedures

### Application

Every applicant is required to submit an application with the Brunei Trademark Office.

### Examination

On submission of the application, the Trademarks office will examine the application for statutory compliances. Such examinations could lead to office actions. Applicants will be informed and also given an opportunity to reply to such office actions.

### Publication

A trademark which passes through examination be published in the government gazette subject to the satisfaction of the registrar.

### Opposition

Third parties can oppose the application within three months of publication.

### Registration

On completion of objections and opposition a Certificate of Registration will be issued by the trademarks office subject to the payment of a fee. A trademark once registered is valid for a term of 10 years and can be renewed every 10 years.

## Filing Requirements

**The following information and/or documents are required to file an application for a trademark application in Brunei:-**

- Application form.
- A clear representation of the trademark.
- The full name, nationality and registered address of the applicant.
- A list of goods or services (which closely follow the Nice International Classification).
- Description of claim if colour or a combination of colour or a combination of colours is claimed as Trademark.
- For marks that contain non-English words, a certified transliteration and translation.
- If convention priority is claimed, a certified copy of the priority.

## Documents To Be Furnished For Filing Trade / Service Mark Application

| Basic Requirements                                                                           |                                               |                                               |
|----------------------------------------------------------------------------------------------|-----------------------------------------------|-----------------------------------------------|
| Documents                                                                                    | Remarks                                       | Time of Filing                                |
| Power of Attorney and statement of mark owner                                                | Power of Attorney and statement of mark owner | Power of Attorney and statement of mark owner |
| Mark in the form of foreign characters has to be accompanied with transliteration in English | Certified by Translator                       | 2 months from filing                          |

| Additional Documents for Claiming a Convention Priority |                                                                                                                           |                      |
|---------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------|----------------------|
| Documents                                               | Remarks                                                                                                                   | Time of Filing       |
| Priority documents                                      | Certified copy of the basic application. Documents in any other language has to be provided with its English translation. | 2 months from filing |

| Documents for Filing a Request of Records of Assignments & Changes                          |                                               |                            |
|---------------------------------------------------------------------------------------------|-----------------------------------------------|----------------------------|
| Documents                                                                                   | Remarks                                       | Time of Filing             |
| Copy of:-<br>• Assignment deed<br>• Document of name change<br>• Document of address change | • Notarized<br>• Certified<br><br>• Certified | Anytime after registration |

| Documents for Filing an Opposition of Counter-Opposition<br>(Deadline for Applying is during 3 Months Publication Period of the Trade Mark Application to be Opposed) |                                                         |                |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------|----------------|
| Documents                                                                                                                                                             | Remarks                                                 | Time of Filing |
| Copy of registrations in various countries                                                                                                                            | no legalization                                         | On filing date |
| Copy of advertisements / brochures of the products bearing the mark                                                                                                   | no legalization;<br>as many and<br>as early as possible | On filing date |

On 1 January 2012, the Patents Order 2011 and Patents Rules 2012 came into effect. The Brunei's Patent Order 2011 replaces the previous re-registration system of Singapore, Malaysia, UK and EP (designating UK) patents and establishes an independent patent system.

### Legislation

Patents Order 2011 and Patents Rules 2012

### Patentability Criteria

- A patent should satisfy the following criteria to claim protection:
  - Δ new
  - Δ involves an inventive step
  - Δ capable of industrial application
- An invention of a method of treatment on the human and/or animal body involving surgery, therapy, or diagnosis is not patentable as they cannot be applied industrially.
- An invention that encourages offensive, immoral or anti-social behavior is not patentable – even if it satisfies the criteria of patentability.

### Utility Innovations

N/A in Brunei

### Membership

- √ - Paris Convention
- √ - PCT

### Rule of Priority

Convention priority cannot be claimed in Brunei. The application system in Brunei Darussalam operates on a 'first-to-file' basis, that is, the first person to file an application will have priority over others for the same invention.

### Duration

The term of a patent granted under the Order shall be 20 years from its filing date. Annual fees shall be payable in respect of the fifth year onwards.

## Procedures

### ▼ Application

Every applicant is required to submit an application to the registrar of patents within 12 months of priority date.

### ▼ Publication

The application will be published after 18 months after the date of filing of the application.

### ▼ Preliminary Examination

A formalities examination for forms will be carried out to ensure statutory compliance within 21 months from the filing date.

### ▼ Examination

There are 4 ways of examination, details of which can be found in the following page.

### ▼ Registration

Upon the receipt of a search and examination report, the applicant would have to assess if it is worthwhile to proceed to obtain a grant of a patent and maintain the patent. If the applicant chooses to do so, he would then submit a request for grant within 42 months from filing date. The grant of a patent will take approximately 5 years depending on the complexity of the invention. On grant, a certificate of grant would be issued, and this fact and date of grant will be published in the Patents Journal.

#### Examination Option 1:

##### Request For Local Search and Examination (Non-PCT)

The applicant may request a search within 13 months from the priority date to be followed by a request for examination within 21 months from the priority date or a combined search and examination within 21 months from the priority date.

#### Examination Option 2.1:

##### Notification To Rely on Prescribed Information From a Prescribed Patent Office (Non-PCT) or International Preliminary Report on Patentability (For PCT National Entry)

The applicant can furnish prescribed information (ie, search, examination results and claims in English) of corresponding foreign application from a prescribed patent office (namely, from either Europe, USA, Japan, Australia, Canada, United Kingdom, New Zealand or South Korea) (for non-PCT filing) or IPRP (for PCT national entry) to meet local grant requirements within 42 months from the priority date. Please be informed that under this option, the claims must either be the same or narrow in scope as compared to the claims in the corresponding application that have been examined for novelty, inventive step and industrial applicability.

#### Examination Option 2.2:

##### Notification To Rely on Prescribed Information Under the Slow Track (Non-PCT)

If the applicant is unable to produce prescribed information showing final results or grant of foreign application from a prescribed patent office, the applicant can opt to proceed under the slow track by filing a block extension of time by 39 months and extend the deadline for filing the notification or prescribed information to 60 months.

#### Examination Option 3:

##### Request For Local Search and Examination Under the Slow Track (PCT National Entry)

The applicant can file a block extension of time by 39 months and request local examination based on the International Search Report or request combined search and examination at time of requesting the block extension, similar to the slow track option of a non-PCT application.

## Filing Requirements

**The following information and/or documents are required to file an application for a patent application in Brunei:-**

### **Direct National Application:-**

- Request for the grant of a patent:-
  - Δ the name and address of the applicant;
  - Δ the name and address of the inventor;
  - Δ a specification comprising a description, claims and any necessary drawings; and
  - Δ the country and filing particulars of basic application whose priority is claimed.
- Appointment of Patent Agent.
- A statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.
- There is no requirement for the filing of an assignment from inventor to applicant.

### **PCT National Phase Application:-**

- Request for the grant of a patent;
- A copy of the PCT application in English language (i.e. request form PCT/RO/101);
- The details of the PCT application (suitably, the bibliographic page as published by WIPO);
- One copy of the PCT specification as originally filed (in or translated to English);
- One copy of any amendments filed in the international phase (in or translated to English);
- An Appointment of Agent form signed by the applicant; and
- A statement explaining how the applicant derives its right to the patent from the inventor, normally by virtue of assignment or employment.

## Documents To Be Furnished For Filing A Patent Application in Brunei

| Basic Requirements                                   |                          |                |
|------------------------------------------------------|--------------------------|----------------|
| Documents                                            | Remarks                  | Time of Filing |
| Patent specification, claims and abstract in English | No legalization required | On filing date |
| Drawings                                             | (If Any)                 | On filing date |

| Additional Documents for Convention Patent Application |                                                |                              |
|--------------------------------------------------------|------------------------------------------------|------------------------------|
| Documents                                              | Remarks                                        | Time of Filing               |
| Priority documents                                     | Certified copy of the basic patent application | Within 2 months after filing |
| Appointment of Agent (PF41)                            |                                                | Within 2 months after filing |

| Additional Documents for Entry of PCT National Phase in Brunei                                                       |                |
|----------------------------------------------------------------------------------------------------------------------|----------------|
| Documents                                                                                                            | Time of Filing |
| International Preliminary Report on Patentability based on International Preliminary Search Report (Chapter I); or   | On filing date |
| International Preliminary Report on Patentability based on International Preliminary Examination Report (Chapter II) | On filing date |

## Legislation

The Emergency (Industrial Designs) Order 1999, Industrial Design (International Registration) Rules, 2014.

Effective 01 October 2012, the Registry of Industrial Designs in Brunei has been transferred from the Attorney General's Chambers to the Patent Registry Office (PRO).

## Definition

“Industrial Design” is defined “as features of shape, configuration, pattern or ornament applied to an article by any industrial process, being features which in the finished article appeal to and are judged by the eye, but does not include -

- method or principle of construction; or
- features of shape or configuration of an article which –
  - △ are dictated solely by the function which the article has to perform; or
  - △ are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part.”

## Criteria

To claim protection, a design has to fulfill the following conditions:-

- design must be new, that is, it has not been registered, published, used or sold in Brunei Darussalam or elsewhere before the date on which the application of registration was logged appearance of article must be material;
- design must be applied industrially, that is, it has been applied to more than fifty articles which altogether do not constitute a single article or to articles manufactured in lengths and pieces except hand-made articles.

## Rule of Priority

A claim to priority right must be applied for within six (6) months from the filing date of the first application in a Paris Convention Country or WTO member or successor in title, subject to compliance with any prescribed conditions.

## Duration and Renewal

A Registered Design can last for an initial period of 5 years from the filing date of the application for registration. Thereafter, the registration may be renewed up to a maximum of 15 years, subject to the payment of renewal fees.

## Procedures

### ▼ Application

Every design application has to be filed with the Registry.

### ▼ Examination

The Registrar on receipt will accord a filing date; and will proceed to examine the application on the "formal requirements". If there are deficiencies with regards to the formal requirements, the applicant will be notified and given the opportunity to correct the deficiencies within a prescribed period.

### ▼ Registration

If the formal requirements are satisfied then as soon as practicable after such examination, but subject to Section 27, the Registrar shall on payment of the prescribed fees register the industrial design by entering the prescribed particulars in the Register.

## Filing Requirements

**The following information and/or documents are required to file an application for an industrial design application in Brunei:-**

- The name and address of the applicant.
- Where the applicant is not the industrial designer, a statement explaining the applicant's rights in relation to the industrial design.
- An address in Brunei Darussalam for the services of documents.
- A transliteration of the name of the application, if it is not in Roman letters.
- A statement identifying the article or articles to which the industrial design is intended to be applied.
- A statement identifying the classification of the article or articles to which the industrial design is intended to be applied, according to the class and sub-class of the classification established by the Lacarno Agreement.
- Six additional representations of the industrial design.

## Documents To Be Furnished For Filing An Industrial Design Application in Brunei

| Basic Requirements    |                                                                                                                                               |                |
|-----------------------|-----------------------------------------------------------------------------------------------------------------------------------------------|----------------|
| Documents             | Remarks                                                                                                                                       | Time of Filing |
| Drawing / Photographs | The size shall be not more than 160 millimeters by 160 millimeters, and one side of the representation shall not be less than 30 millimeters. | On filing date |

### Note:

Where any document or part of a document is not in the English Language, it shall be accompanied by a translation into the English Language and such translation shall be verified to the satisfaction of the Registrar as corresponding to the original text. No notarization is required. This also applies to documents supporting any Statements.

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