

**BRUNEI DARUSSALAM**

**Industrial Designs Order**

Emergency (Industrial Designs) Order 1999

As on 13th February 2020

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## **PART I PRELIMINARY, INTERPRETATION AND APPLICATION**

### **1. Citation, commencement, long title and application**

(1) This Order may be cited as the Emergency [Industrial Designs) Order, 1999 and shall commence on the day or days to be appointed by the Attorney General, with the approval of His Majesty the Sultan and Yang Di-Pertuan, by notification in the Gazette.

(2) Different days may be appointed under subsection (1) for different provisions of this Order or for different purposes of the same provision.

(3) The long title of this Order is "An Order in respect of industrial design rights and related matters".

(4) This Order applies to-

(a) things done in or on the continental shelf (being the area proclaimed by His Highness the Sultan on 30th. June, 1954 by the Continental Shelf Proclamation 1954) and the waters above the continental shelf on a structure or vessel which is present there for purposes directly connected with the exploration of the seabed and its subsoil or with the exploitation of their natural resources: and

(b) the airspace above Brunei Darussalam and the continental shelf, as it applies to things done in Brunei Darussalam.

### **2. Interpretation**

(1) In this Order, unless the context otherwise requires-  
"application for registration" means an application for registration of an industrial design made under section 15;

"article" means any article of manufacture and includes any part of an article if that part is made and sold separately;

"artistic work" shall be construed in accordance with section 6 of the Emergency (Copyright) Order, 1999, but does not include a layout design or an integrated circuit as respectively defined in section 2 of the Emergency [Layout Designs) Order, 1999;

"assignment" means assignment by act of the parties concerned:

"business" includes any trade or profession;

"commencement" means the day appointed for the commencement of the main substantive provisions of this Order;

"corresponding industrial design", in relation to an artistic work, means an industrial design which if applied to an article would produce something which would be treated for the purposes of Part I of the Emergency (Copyright)

Order, 1999 as a copy of that work;

"court" means the High Court or an Intermediate Court;

"designer", in relation to an industrial design, means the person who creates it or, if there are two or more such persons, each of those persons;

"employee" means a person who works or, where the employment has ceased, worked under a contract of employment;

"employer", in relation to an employee, means the person by whom the employee is or was employed;

"exclusive licence" means a licence (whether general or limited) signed by or on behalf of the owner of an industrial design, authorising the licensee to the exclusion of all other persons, including the person granting the licence, to exercise in the manner authorised by that licence, any right which, under this Order, would otherwise be exercisable by such owner;

"filing date", in relation to an application for registration, means the date determined under section 16 as the filing date of the application;

"formal requirements" means such requirements of section 15 and of any rules designating requirements as formal requirements for the purposes of this Order;

"Geneva Act of the Hague Agreement" means the Act, signed at Geneva on 2nd July 1999, of the Hague Agreement Concerning the International Registration of Industrial Designs;

"Government use" of an industrial design means any act done in relation to that industrial design under section 36;

"industrial design" means 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-

- (a) a method or principle of construction; or
- (b) features of shape or configuration of an article which-
  - (i) are dictated solely by the function which the article has to perform;

or

- (ii) are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part;

"International Bureau" means the International Bureau of the World Intellectual Property Organisation;

"international registration" means the international registration of an industrial design effected according to the Geneva Act of the Hague Agreement.

"Journal" means Industrial Designs Journal referred to in section 78A(1);

"owner" has the meaning assigned by section 8;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of 20th. March, 1883, as revised or amended;

"Paris Convention country" means a country, other than Brunei Darussalam, which is a party to the Paris Convention;

"priority date", in relation to an application for registration, means the date regarded as being the filing date of the application pursuant to section 19;

"Register" means the Register of Industrial Designs maintained by the Registrar under subsection (1) of section 64;

"registered industrial design" means an industrial design registered under section 26;

"registered owner", in relation to a registered industrial design, means the person whose name is entered in the Register as the owner of the industrial design or, if there are two or more such persons, each of those persons;

"Registrar" means the Registrar of Industrial Designs appointed under subsection (4) of section 4;

"registration" means, unless the context otherwise requires, registration in the Register;

"Registry" means the Registry of Industrial Designs administered by the Registrar;

"set of articles" means two or more articles of the same general character that are ordinarily on sale together or intended to be used together, to each of which the same industrial design, or the same industrial design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied;

"transmission" means transfer by operation of law, devolution on the personal representative of a deceased person, or any other mode of transfer other than an assignment;

"World Trade Organization Agreement" means the Agreement Establishing the World Trade Organization done at Marrakesh in 1994, as revised or amended;

"WTO member" means any country, territory or area, other than Brunei Darussalam, which is a party to the World Trade Organization Agreement.

(2) Unless the context otherwise requires, any reference in this Order-  
(a) to the filing of a document shall be construed as a reference to the filing of the document with the Registrar;

(b) to an article in respect of which an industrial design is registered shall, in the case of an industrial design registered in respect of a set of articles, be construed as a reference to any article of that set:

(c) to the infringement of a design or registered industrial design shall be construed as a reference to the infringement of any right in the design conferred by this Order.

### **3. Non-application**

(1) This Order does not apply to computer programs and layout designs.

(2) Provision may be made by rules under section 77 for excluding from registration under this Order industrial designs for such articles of a primarily literary or artistic character as may be specified therein.

(3) In subsection (1)-

“computer program” means an expression, in any language, code or notation, of a set of instructions (whether with or without related information) intended, either directly or after either or both of the following-

(a) the conversion to another language, code or notation;

(b) the reproduction in a different material form, to cause a device having information-processing capabilities to perform a particular function;

“layout design” means the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections, of an integrated circuit (as defined in section 2 of the Emergency (Layout Designs) Order, 1999); and includes such a three-dimensional disposition prepared for an integrated circuit intended for manufacture.

### **4. Registrar of Industrial Designs and other officers**

(1) There shall be a Registrar of Industrial Designs who shall have the chief control of the Registry of Industrial Designs.

(2) There shall be one or more Deputy Registrars of Industrial Designs who shall, subject to the control of the Registrar, have all the powers and functions of the Registrar under this Order, other than the powers of the Registrar under section 5.

(3) There shall be one or more Assistant Registrars of Industrial Designs.

(4) The Registrar and all the other officers under this section shall be appointed by His Majesty the Sultan and Yang Di-Pertuan.

### **5. Delegation by Registrar**

(1) The Registrar may, in relation to a particular matter or class of

matters, by writing under his hand, delegate all or any of his powers or functions under this Order (except this power of delegation) to an Assistant Registrar of Industrial Designs or any public officer so that the delegated powers and functions may be exercised by the delegate with respect to the matter or class of matters specified in the instrument of delegation.

(2) A delegation under this section is revocable at will and no delegation shall prevent the exercise of a power or function by the Registrar or by any Deputy Registrar of Industrial Designs.

#### **6. Registry of Industrial Designs**

For the purposes of this Order, there shall be an office which shall be known as the Registry of Industrial Designs.

#### **7. Seal of Registry**

(1) There shall be a seal of the Registry of Industrial Designs and the seal shall be of such device as may be approved by the Attorney General.

(2) Impressions of the seal shall be judicially noticed and admitted in evidence.

#### **8. Ownership of industrial designs**

(1) Subject to this section, the designer of an industrial design is for the purposes of this Order the original owner of that industrial designs.

(2) Where an industrial design is made by a person in the course of his employment or apprenticeship, his employer is the original owner of that industrial design, subject to any agreement to the contrary.

(3) Where a person commissions the making of an industrial design and the industrial design is made in carrying out that commission, the person who commissioned the work is the original owner of the industrial design, subject to any agreement to the contrary.

(4) Where an industrial design, or the right to apply an industrial design to any article, becomes vested, whether by assignment or transmission, in any person other than the original owner, either alone or jointly with the original owner, that other person or, as the case may be, the original owner and that other person, shall be treated for the purposes of this Order as the owner of the industrial design or as the owner of the industrial



design in relation to that article.

(5) In the case of an industrial design generated by computer in circumstances such that there is no human designer, the person by whom the arrangements necessary for the creation of the industrial design are made shall be deemed to be the designer.

## **PART II REGISTRATION OF INDUSTRIAL DESIGNS**

### **9. New industrial designs are registrable**

(1) Subject to this Order, an industrial design which is new may, upon application by the person claiming to be the owner, be registered in respect of any article or set of articles specified in the application.

(2) An industrial design for which an application for registration is made shall not be regarded as new if it is the same as -

(a) an industrial design that has been registered in pursuance of a prior application filed or having effect in Brunei Darussalam, whether or not that industrial design has been registered in respect of the same article for which the application is made or in respect of any other article; or

(b) an industrial design that has been disclosed in Brunei Darussalam or elsewhere before the filing date, whether or not it has been published in respect of the same article for which the application is made or in respect of any other article, or if it differs from such an industrial design only in immaterial details or in features which are variants commonly used in the trade.

(3) The Registrar may, in such cases as may be prescribed, direct that for the purpose of deciding whether an industrial design is new an application for registration shall be treated as made on a date earlier or later than that on which it was in fact made.

### **10. Industrial designs not registrable if appearance of article not material**

An industrial design is not registrable in respect of an article if aesthetic considerations are not normally taken into account to a material extent by persons acquiring or using articles of that description, and would not be so taken into account if the industrial design were to be applied to the article.

### **11. Industrial designs contrary to public order or morality not registrable**

(1) Subject to subsection (2), an industrial design the publication or use of which would be contrary to public order or morality is not registrable.

(2) The publication or use of an industrial design shall not be considered to be contrary to public order merely because it is prohibited by any law in force in Brunei Darussalam.

## **12. Provisions as to confidential disclosure, etc.**

(1) An application for the registration of an industrial design shall not be refused, and the registration of an industrial design shall not be invalidated by reason only of-

- (a) the disclosure of the industrial design by the owner within twelve months to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the industrial design;
- (b) the disclosure of the industrial design in breach of good faith within twelve months by any person other than the owner of the industrial design;
- (c) in the case of a new or original textile industrial design intended for registration, the acceptance of a first and confidential order for goods bearing the industrial design; or
- (d) the communication of the industrial design by the owner within twelve months to a government department or to any person authorised by a government department to consider the merits of the industrial design, or of anything done in consequence of such a communication.

(2) An application for the registration of an industrial design shall not be refused, and the registration of an industrial design shall not be invalidated by reason only-

- (a) that a representation of the industrial design, or any article to which the industrial design has been applied, has been displayed, with the consent of the owner of the industrial design at an official international exhibition;
- (b) that after any such display as is mentioned in paragraph (a), and during the period of the exhibition, a representation of the industrial design, or any article to which the industrial design has been applied, has been displayed by any person without the consent of the owner; or
- (c) that a representation of the industrial design has been published in consequence of any such display as is mentioned in paragraph (a), if the application for registration of the industrial design is made not later than six months after the opening of the exhibition.

(3) In this section, "official international exhibition" means an official, or officially recognised, international exhibition falling within the terms of the Convention on International Exhibitions of 22nd. November, 1928 and any protocols to that Convention, or falling within the terms of any treaty replacing that Convention, as respectively revised or amended.

### **13. Provisions as to artistic works**

(1) Subject to subsection (2), where an application is made by or with the consent of the owner of copyright in an artistic work for the registration of a corresponding industrial design, the industrial design shall not be treated for the purposes of this Order as being other than new by reason only of any use previously made of the artistic work.

(2) Subsection (1) does not apply if the previous use consisted of or included the sale, letting for hire, or offer or exposure for sale or hire, of articles to which had been applied industrially-

- (a) the industrial design in question; or
  - (b) an industrial design differing from it only in immaterial details or in features which are variants commonly used in the trade,
- and that previous use was made by or with the consent of the copyright owner.

(3) Provision may be made by rules as to the circumstances in which an industrial design is to be regarded for the purpose of this section as applied industrially to articles or any description of articles.

### **14. Provisions as to registration of same design in respect of other articles, etc.**

(1) Where the registered owner of a design registered in respect of any article makes an application-

- (a) for registration in respect of one or more other articles, of the registered design; or
- (b) for registration in respect of the same or one or more other articles, of a design consisting of the registered design with modifications or variations not sufficient to alter the character or substantially affect the identity thereof,

the application shall not be refused, and the registration made on the application shall not be invalidated, by reason only of the previous registration or publication of the registered design:

Provided that the right in a design registered by virtue of this section shall not extend beyond the end of the period and any extended period for which the right subsists in the original registered design.

(2) Where any person makes an application for the registration of a design in respect of any article and either-

- (a) the design has been previously registered by another person in respect of some other article; or

(b) the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially affect the identity thereof, then, if at any time while the application is pending the applicant becomes the registered owner of the design previously registered, subsection (1) shall apply as if at the time of making the application the applicant had been the registered owner of that design.

#### **15. Applications for registration**

(1) An application for registration of an industrial design shall be filed with the Registrar in the prescribed manner.

(2) The application shall include-

- (a) a request for registration of the industrial design;
- (b) a representation of the industrial design suitable for reproduction;
- (c) a statement that the industrial design is new;
- (d) the name and address of the applicant;
- (e) where the applicant is not the designer, a statement explaining the applicant's rights in relation to the industrial design;
- (f) an address in Brunei Darussalam for service of documents; and
- (g) such other information, documents or matter as may be required by the rules.

(3) The application may include such other information, documents or matter as may be authorised by the rules.

(4) The application shall be accompanied by the prescribed filing fee.

(5) Every application for an industrial design shall be examined on filing to determine whether-

- (a) the prescribed filing fee has been paid; and
- (b) the application has satisfied the requirements of section 16 for the accordance of a filing date.

(6) Two or more industrial designs may be the subject of the same application for registration if the industrial designs-

- (a) relate to the same prescribed class of industrial designs or to the same set of articles; and
- (b) comply with any prescribed conditions.

## **16. Filing date**

(1) Subject to this Order, the filing date of an application for registration of an industrial design is the latest of the dates on which-

(a) documents containing everything required by paragraphs (a) to (c) of subsection (2) of section 15 have been filed; and

(b) the prescribed filing fee has been paid.

(2) If the prescribed filing fee has not been paid in accordance with subsection (4) of section 15, the application shall be deemed to have been abandoned.

(3) If a date of filing cannot be accorded under subsection (1), the Registrar shall give the applicant an opportunity to remedy the deficiencies and if they are not remedied within the prescribed period the application shall be deemed to have been abandoned.

## **17. Claim to priority right**

(1) A person who has filed an application for registration of an industrial design in, or in respect of, a Paris Convention country or WTO member or his successor in title, has a right of priority, for the purposes of registering the same industrial design under this Order in respect of any or all of the same articles, for a period of six months from the filing date of the first application, subject to compliance with any prescribed conditions.

(2) Any filing of an application for registration of an industrial design in, or in respect of, a Paris Convention country or WTO member which is equivalent to a regular national filing under the law of that Paris Convention country or WTO member, or under any agreement to which it is a party, shall be recognised as giving rise to a right of priority.

(3) A subsequent application for the registration of an industrial design that was the subject of a previous application, and that was filed in or in respect of the same Paris Convention country or WTO member, shall be considered as the first application for the purpose of determining priority if on the filing date of the subsequent application-

(a) the previous application has been withdrawn, abandoned or refused, without having been open to public inspection and without leaving any rights outstanding; and

(b) has not served as a basis for claiming a right of priority.

(4) In this section, "regular national filing" means any filing of an application for registration of an industrial design in, or in respect of, a Paris Convention country or WTO member which is adequate to establish the date on which such application was filed, whatever the result of that application.

(5) An application for the registration of an industrial design filed in, or in respect of, Brunei Darussalam shall give rise to a right of priority with the same effect provided in subsections (1), (2) and (3). Upon filing a subsequent application in, or in respect of, Brunei Darussalam claiming the priority of an earlier application filed in, or in respect of, Brunei Darussalam, the latter shall be deemed to be abandoned and replaced by the former.

#### **18. Claiming priority**

(1) An applicant who desires to take advantage of the priority of a previous application shall file with the Registrar in the prescribed manner a statement of priority.

(2) Where a statement of priority is filed in accordance with this section, the applicant shall for the purposes of proceedings before the Registrar be deemed to be entitled to enjoy the right of priority shown in the statement.

(3) Where a declaration claiming priority from an earlier application has been made and where the Registrar is of the opinion that the validity of the claim to priority is relevant to the determination of whether the industrial design is new or involves an inventive step, the applicant or the proprietor of an industrial design granted on the application shall, if requested by the Registrar, furnish in respect of every application specified in the declaration-

(a) its file number; and

(b) either-

(i) a copy of that application duly certified by the authority with which it was filed; or

(ii) a copy of that application accompanied by a statutory declaration or affidavit or otherwise verified to the satisfaction of the Registrar, that the copy corresponds to the original of that application.

#### **19. Effect of priority right**

(1) The right of priority shall have the effect that the filing date of

the previous application claimed under section 18 shall be regarded as being the filing date of the application for registration under this Order for the purpose of determining whether the industrial design is new.

(2) Subsection (1) shall not be construed as excluding the power to give directions under subsection (3) of section 9 in relation to the application for registration under this Order.

(3) Where an application for registration of an industrial design is filed under this Order and the priority of a previous application is claimed under section 18, then, notwithstanding anything contained in this Order, the application shall not be refused and the registration of the industrial design under this Order shall not be invalidated by reason only of the fact that the previous application has been published at any time after the filing date of the previous application.

## **20. Withdrawal of applications**

(1) An applicant may withdraw his application for registration of an industrial design by filing a notice of withdrawal with the Registrar before the date on which preparations for publication under section 26 have been completed, as determined by the Registrar.

(2) A notice under this section shall be made in writing and filed in the prescribed manner.

(3) Where a notice is filed in accordance with this section, the application shall be deemed to have been abandoned.

(4) A notice filed in accordance with this section is irrevocable.

## **21. Effect of deemed abandonment**

Where an application for registration of an industrial design is deemed by any provision of this Order to have been abandoned-

(a) the applicant shall continue to enjoy the right of priority under section 19 which he enjoyed immediately before the abandonment: and

(b) no other right may be claimed under this Order in relation to the application.

## **22. Extensions of time**

(1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make regulations to provide for extension of time



for any period of time specified for the doing of any act in relation to an application for registration or in proceedings under this Order or any rules or regulations made thereunder, not being proceedings in court.

(2) The regulations may contain such provision as the Attorney General thinks fit regulating the circumstances in which such an extension may be granted and may also provide for the protection and compensation of persons affected by the grant of extension of time and may authorise the Registrar to grant an extension of time notwithstanding that the period has already expired.

### **23. Amendment of applications**

(1) The Registrar may amend an application for registration of an industrial design on request made to him by the applicant in the prescribed manner.

(2) An application for registration of an industrial design shall not be amended under subsection (1) if, as a result of the amendment, the scope of the application would be increased by the inclusion of any matter that was not in substance disclosed in the application initially filed or if, as a result of the amendment, the initial design was or, if there is more than one, any of the initial designs were altered.

(3) Where a request for amendment of an application for registration of an industrial design has been granted under subsection (1), and the amendment has the effect of excluding one or more industrial designs from the application initially filed, the applicant may at any time while the initial application is pending make a further application for registration of the industrial design or industrial designs so excluded.

(4) Where, after an application for registration has been filed and before the industrial design is registered, a further application is filed by the original applicant or his successor in title in accordance with the regulations in respect of any part of the matter contained in the earlier application and the conditions mentioned in section 15 are satisfied in relation to the new application (without the new application contravening the provisions of subsection (2)), the new application shall be treated as having, as its date of filing, the date of filing the earlier application.

### **24. Rights in applications**

(1) Sections 32, 33 and 34 apply, with necessary modification, in relation

to an application for registration of an industrial design as they apply in relation to a registered industrial design.

(2) In section 33, as it applies in relation to an application for registration of an industrial design, the reference in subsection (1) to the registration of an industrial design shall be construed as a reference to the making of the application.

(3) In section 34, as it applies in relation to a transaction, instrument or event affecting an application for registration of an industrial design, the references to the registration of particulars, and to the making of an application for the registration of particulars, shall be construed as a reference to the giving of written notice to the Registrar of those particulars.

## **25. Examination of applications**

(1) If an application for registration of an industrial design has been accorded a filing date under section 16 and has not been withdrawn, the Registrar shall examine the application to determine whether it complies with the requirements of this Order and with the formal requirements.

(2) Where the Registrar determines that there are deficiencies as regards the formal requirements, he shall notify the applicant and give him an opportunity to correct the deficiencies within the prescribed period.

(3) Where after an examination under subsection (1) it is determined that not all the formal requirements have been complied with, the Registrar shall give the applicant an opportunity to make representations and to amend the application within such period as the Registrar may specify so as to comply with those requirements (subject however to subsection (2) of section 23) and, if the applicant fails to do so, the Registrar may refuse the application.

## **26. Registration and publication**

(1) If on an examination by the Registrar under section 25 an application for registration of an industrial design is found to have satisfied the formal requirements, then as soon as practicable after such examination but subject to section 27, the Registrar shall on payment of the prescribed fee-

(a) register the industrial design by entering the prescribed particulars in the Register;

(b) enter the name of the applicant, or the successor in title to the application, in the Register as the owner of the industrial design;  
(c) issue a certificate of registration to the person who is the registered owner of the industrial design at the time the industrial design is registered; and  
(d) advertise the fact of such registration and publish a representation of the industrial design by notice in the Journal.

(2) Notwithstanding paragraph (d) of subsection (1), advertisement of the registration and publication of the industrial design shall, upon request by the applicant at the time of filing of the application or at any time before the date on which preparations for publication have been completed, be deferred for a period not exceeding twelve months from the date of filing or, if priority is claimed, from the date of priority of the application.

(3) Where a request has been made under subsection (2) for deferment of publication, upon registration of the industrial design, neither the representation of the design nor any file relating to the application shall be open to public inspection. In this case, the Registrar shall publish a mention of the deferment and information identifying the registered owner, indicating the filing date of the application, the length of the period for which deferment has been requested and any other prescribed particulars.

(4) At the expiry of the period of deferment, the Registrar shall publish the registered industrial design.

(5) The institution of legal proceedings on the basis of a registered industrial design during the period of deferment of publication shall be subject to the condition that the information contained in the Register and in the file relating to the application has been communicated to the person against whom the action is brought.

## **27. Refusal of applications**

(1) The Registrar may by notice in the prescribed manner, stating the reason for his refusal, refuse an application for registration of an industrial design if, after an examination by him under section 25 and after giving the applicant the opportunity to correct any deficiencies as provided for in that section, he determines-

(a) that the application does not satisfy the formal requirements;

- (b) that, on the face of the application, the industrial design is not new or is not registrable for any other reason; or
- (c) the prescribed fee for the registration of the industrial design has not been paid.

(2) Where the Registrar refuses an application for registration of an industrial design under this section-

- (a) the applicant shall continue to enjoy the right of priority under section 18 which he enjoyed immediately before such refusal; and
- (b) no other right may be claimed under this Order in relation to the application.

#### **28. Formality examination**

Except as expressly provided to the contrary, nothing in this Order shall be construed as imposing any obligation upon the Registrar to consider or have regard to, for the purpose of determining whether to accept an application for registration of an industrial design, any question as to-

- (a) the registrability of the industrial design;
- (b) whether the applicant is entitled to any priority claimed in the application; or
- (c) whether the industrial design is properly represented in the application.

#### **29. Period of registration**

(1) The initial period of registration of an industrial design is five years beginning on the filing date of the application for registration.

(2) The period of registration of an industrial design may be extended for additional periods of five years each but the total period of registration may not exceed fifteen years beginning on the filing date of the application for registration.

(3) If the owner of a registered industrial design wishes to renew the period of registration for a further period of five years, the prescribed renewal fee shall not be paid earlier than three months immediately preceding the end of the current period of registration.

(4) If the renewal fee is not paid in accordance with subsection (3), the registration of the industrial design shall cease to have effect at the end of the current period of registration.

(5) If, during the period of six months immediately following the end of the period specified in subsection (4), the renewal fee and any prescribed additional fee are paid, the registration of the industrial design shall be treated as if it had never ceased to have effect and accordingly-

- (a) anything done under or in relation to any rights in or under the industrial design by or with the consent of the owner during that period shall be deemed to be valid;
- (b) any act which would have constituted an infringement of the industrial design if the registration had not ceased to have effect shall be deemed to constitute such an infringement; and
- (c) any act which would have constituted Government use of the industrial design if the registration had not ceased to have effect shall be deemed to constitute Government use.

### **30. Surrender of registration**

(1) The registration of an industrial design may be surrendered by the registered owner in respect of all or any of the articles for which the industrial design is registered.

(2) Provision may be made by rules-

- (a) as to the manner and effect of a surrender; and
- (b) for protecting the interest of other persons having a right in the industrial design.

## **PART III RIGHTS IN INDUSTRIAL DESIGNS**

### **31. Rights conferred by registration**

(1) Subject to this Order, the registration of an industrial design under this Order gives to the registered owner the exclusive right-

(a) to make in Brunei Darussalam or import-

(i) for sale or hire; or

(ii) for use for the purpose of trade or business; or

(b) to sell, hire, or offer or expose for sale or hire, in Brunei Darussalam, any article in respect of which the industrial design is registered and to which that industrial design or an industrial design not substantially different from it has been applied.

(2) The right in an industrial design is infringed by any person who, without the licence of the registered owner-

(a) does, or authorises another person to do, anything which under subsection (1) is the exclusive right of the registered owner;

(b) makes, or authorises another person to make, anything for enabling any article referred to in subsection (1) to be made in Brunei Darussalam or elsewhere;

(c) does, or authorises another person to do, anything in relation to a kit that would constitute an infringement of the industrial design if it had been done in relation to the assembled article; or

(d) makes, or authorises another person to make, anything for enabling a kit to be made or assembled, in Brunei Darussalam or elsewhere, if the assembled article would be such an article as is referred to in subsection (1).

(3) The right in an industrial design is not infringed by any act done by any person-

(a) solely for the purpose of research or for private and domestic use;

(b) for teaching purposes, in the course of instruction or of preparation for instruction, provided it was done by a person giving or receiving the instruction;

(c) for the purpose of evaluation or analysis;

(d) that consists of the importation, use or disposal of, or of the offer to dispose of, any registered industrial design or any product obtained by means of a registered industrial design, which was produced by or with the consent (conditional or otherwise) of the registered owner of the industrial design or any person licensed by him; and for this purpose "registered industrial design" includes an industrial design registered

in any country or territory outside Brunei Darussalam in respect of the same or substantially the same industrial design as that for which an industrial design has been registered under this Order.

(4) The right in an industrial design is not infringed by the reproduction of a feature of the industrial design which, under paragraph (b) of the definition of "industrial design" in subsection (1) of section 2, is not taken into account for the purpose of determining whether the industrial design is registrable.

(5) In this section, "kit" means a complete or substantially complete set of components intended to be assembled into an article.

### **32. Nature of industrial design**

(1) An industrial design and any right in or under it is property within the meaning of paragraph (a) of the definition of "property" in subsection (1) of section 3 of the Interpretation and General Clauses Act and, subject to this Order, is transferable by assignment or transmission in the same way as any other property, in accordance with subsections (2) to (6). It is so transferable either in connection with the goodwill of a business or independently.

(2) Subject to this Order, any industrial design, and any right in or under it, may be assigned or mortgaged.

(3) Subject to this Order, a licence may be granted under any industrial design for the use of the industrial design and-

(a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and

(b) any such licence or sub-licence shall legally vest in the same way as any other property.

(4) Any assignment or mortgage of an industrial design or any right in or under it, whether total or partial, is not effective unless it is in writing and signed by or on behalf of the assignor or, in the case of a body corporate, so signed or under the seal of that body.

(5) An assignment of an industrial design or of a share in it, and an exclusive licence granted under any industrial design, may confer on the assignee or licensee the right of the assignor or licensor to bring

proceedings for a previous infringement.

(6) A licence granted in respect of industrial design rights by the owner of the rights is binding on every successor in title to the interest in the rights of such owner, except-

(a) a purchaser in good faith for valuable consideration and without notice, actual or constructive, of the licence; and

(b) a person deriving title from such a purchaser, to the same extent as the licence was binding on the grantor.

### **33. Co-ownership of industrial designs**

(1) Subject to any agreement to the contrary, where there is more than one registered owner of an industrial design, each of them shall be entitled to an undivided share in the industrial design.

(2) Subject to this section and to any agreement to the contrary, where there is more than one registered owner of an industrial design, each of them shall be entitled, by himself or his agent, to do in respect of the industrial design, for his own benefit and without the consent of or the need to account to any other registered owner, any act which would apart from this subsection and section 36 constitute an infringement of that industrial design; and any such act shall be deemed not to constitute an infringement of that industrial design.

(3) Subject to section 41 and to any agreement to the contrary, where there is more than one registered owner of an industrial design, no registered owner shall, without the consent of each of the others, grant a licence under the industrial design or assign or mortgage a share in it.

(4) Nothing in subsections (1) or (2) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

### **34. Transactions affecting rights in industrial designs**

(1) Any person who claims to have acquired any right in or under an industrial design by virtue of any transaction, instrument or event to which this section applies is entitled as against any other person who claims to have acquired that right by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event-



- (a) application has not been made for the registration of particulars concerning the earlier transaction, instrument or event; and
- (b) the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event.

(2) Subsection (1) also applies to the case where any person claims to have acquired any right in or under an industrial design by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section applies to the following transactions, instruments and events-

- (a) the assignment of an industrial design or a right in or under it;
- (b) the mortgage of an industrial design or the granting of security over it;
- (c) the grant, assignment or mortgage of a licence or sub-licence under an industrial design;
- (d) the death of the registered owner or one of the registered owners of an industrial design or any person having a right in or under an industrial design and the vesting by an assent of personal representatives of an industrial design or any such right; and
- (e) any order or directions of a court or other competent authority transferring an industrial design or any right in or under it to any person and the event by virtue of which the court or authority had power to make any such order or give any such directions.

### **35. Rights of third parties to continue use of industrial designs**

(1) A person who in Brunei Darussalam before the filing date of an application for registration of an industrial design-

- (a) does in good faith an act which would have constituted an infringement of the industrial design if it had been registered at the time the act was done; or

- (b) makes in good faith effective and serious preparations to do such an act,

has the rights specified in subsection (2).

(2) The rights referred to in subsection (1) are-

- (a) the right to continue to do or, as the case may be, to do the act referred to in subsection (1);

- (b) if such act was done, or such preparations had been made, by an individual

in the course of a business-

(i) the right to assign the right to do the act or to transfer such right on death; and

(ii) the right to authorise the doing of the act by any of his partners for the time being in the business in the course of which the act was done or the preparations had been made; and

(c) if such act was done, or such preparations had been made, by a body corporate in the course of a business, the right to assign the right to do the act or to transmit such right on the body's dissolution, and the doing of such act by virtue of this subsection shall not constitute an infringement of the industrial design concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

(4) Where an article is disposed of to another person in exercise of a right conferred by subsection (2), that other person and any person claiming through him may deal with the article in the same way as if it had been disposed of by the owner of the industrial design concerned.

## **PART IV USE BY GOVERNMENT OF INDUSTRIAL DESIGNS**

### **36. Use by Government for security, defence, etc.**

(1) An act done by or on behalf of the Government, in relation to an industrial design, is not an infringement of the rights in that industrial design if it appears to the Government necessary or expedient that the act was done-

(a) to avoid prejudice to the security or defence of Brunei Darussalam or for the efficient prosecution of any war in which Brunei Darussalam may be engaged;

(b) to assist in the exercise of powers and the implementation of measures during a period of national emergency or other circumstances of extreme urgency; or

(c) for public non-commercial purposes, and before doing that act, the Government, having taken all reasonable steps to do so, has been unable to obtain the licence of the owner of the industrial design, on reasonable terms, to do the act.

(2) A person may be authorised to act on behalf of the Government under subsection (1) before or after the act in respect of which he was authorised has been done.

(3) In this section, "period of national emergency" means any period beginning with such date as may be declared by the Attorney General by order published in the Gazette to be the commencement, and ending with such date as may be so declared to be the termination, of a period of national emergency for the purpose of this section.

### **37. Nature and scope of rights under section 36**

(1) The right to use an industrial design under section 36-

(a) is both non-exclusive and non-assignable;

(b) is limited to the purposes specified in that section;

(c) is subject to the terms of any authorisation under that section;

(d) does not permit the sale of the industrial design to the public; and

(e) is limited to use of the industrial design predominantly in Brunei Darussalam.

(2) An act done under section 36 in relation to an industrial design shall not be taken into account in calculating the protection period of that industrial design.

(3) Where an exclusive licence is in force in relation to any industrial design, sections 36, 38 and 39 shall have effect as if for references to the owner of the industrial design there were references to the exclusive licensee.

#### **38. Duty to inform owner**

(1) Where an act has been done under section 36 in relation to an industrial design, the Government shall, as soon as practicable, inform the owner of the rights in that industrial design that it has been done and give him such information about it as he may require.

(2) Nothing in subsection (1) requires the Government to inform or disclose information to the owner if doing so would, or might reasonably be expected to, prejudice the security or defence of Brunei Darussalam.

#### **39. Owner of industrial design entitled to remuneration**

Where an act has been done under section 36 in relation to an industrial design, the Government shall pay to the owner of the industrial design such remuneration as may be agreed or determined by a method agreed between them.

#### **40. Appeal to High Court**

(1) Any person aggrieved by any act done by or on behalf of the Government under section 36 may appeal to the High Court which may make such order as it thinks fit.

(2) On any such appeal-

(a) the Government; and

(b) with the leave of the High Court, any other person,

is entitled to appear and to be heard.

## **PART V LEGAL PROCEEDINGS**

### **41. Determination of rights after registration**

(1) After an industrial design has been registered, any person having or claiming a proprietary interest in or under it may refer to the court the question-

- (a) who is or are the true owner or owners of the industrial design;
  - (b) whether the industrial design should have been registered in the name of the person or persons in whose name or names it was registered; or
  - (c) whether any right in or under the industrial design should be transferred or granted to any other person or persons,
- and the court shall determine the question and make such order as it thinks fit to give effect to the determination.

(2) Without prejudice to the generality of subsection (1), an order under that subsection may contain provision-

- (a) directing that the name of the person by whom the reference is made shall be entered in the Register as the owner or one of the owners of the industrial design (whether or not to the exclusion of any other person);
- (b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the industrial design;
- (c) granting any licence or other right in or under the industrial design; or
- (d) directing any person registered as the owner of the industrial design or any person having any right in or under it to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom a direction has been given under paragraph (d) of subsection (2) fails to do anything necessary for carrying out any such direction within fourteen days after the date of the order containing the direction, the court may, on application made to it by any person in whose favour or on whose reference the order was made, authorise him to do that thing on behalf of the person to whom the direction was given.

(4) If a reference under this section is made after the end of the period of two years beginning with the date of registration of the industrial design to which the reference relates, no order shall be made under subsection (1) transferring any right in or under the industrial design from the person registered as the owner of the industrial design to any other person on the ground that the person so registered was not entitled

to be registered as the owner unless it is shown that he knew at the time of the registration or, as the case may be, of the transfer of the industrial design to him, that he was not entitled to be registered as the owner.

(5) Where a question is referred to the court under this section, no order shall be made under subsections (2) or (4) unless notice of the reference is given to all persons registered as owner of the industrial design or as having a right in or under the registered industrial design except those who are parties to the reference.

#### **42. Effect of transfer of registered industrial design under section 41**

(1) Where an order is made under section 41 that a registered industrial design shall be transferred from any person or persons (the old owner or owners) to one or more persons (whether or not including an old owner), then, except in a case falling within subsection (2), any licences or other rights granted or created by the old owner or owners shall, subject to section 32 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the industrial design was ordered to be transferred (the new owner or owners).

(2) Where an order is so made that a registered industrial design shall be transferred from the old owner or owners to one or more persons (none of whom was an old owner) on the ground that the industrial design was registered in the name of a person not entitled to be registered as an owner, any licences or other rights in or, under the industrial design shall, subject to subsection (3) and to the provisions of the order, lapse on the registration of that person or those persons as the new owner or owners of the industrial design.

(3) Where an order is so made that a registered industrial design shall be transferred as mentioned in subsection (2) and, before particulars of the reference resulting in the making of the order are entered in the Register, the old owner or owners or a licensee-

(a) does in good faith an act which would have constituted an infringement of the industrial design if particulars of the reference had been registered at the time the act was done; or

(b) makes in good faith effective and serious preparations to do such an act,

the old owner or owners or the licensee shall on making a request to the new owner or owners within the prescribed period be entitled to be granted a licence, but not an exclusive licence, to continue to do the act or,

as the case may be, to do the act.

(4) Any such licence shall be granted for a reasonable period and on reasonable terms.

(5) The new owner or owners of the industrial design or any person claiming that he is entitled to be granted any such licence may refer to the court the question whether that person is so entitled and whether any such period is, or any such terms are, reasonable, and the court shall determine the question and may, if it considers it appropriate, order the grant of such a licence.

#### **43. Licences granted by order of court**

Any order made under subsection (2) of section 41 or subsection (5) of section 42 for the grant of a licence shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the owner of the industrial design and all other necessary parties, granting a licence in accordance with the order.

#### **44. Revocation on ground of public order or morality**

(1) Any person may at any time after an industrial design has been registered under this Order refer to the court for determination the question of whether, having regard to section 11, the industrial design is a registrable industrial design.

(2) Without prejudice to the jurisdiction of the court apart from this subsection to determine any such question, the court shall have jurisdiction to do so.

(3) If the court determines that the industrial design is not a registrable industrial design under section 11, it shall order the registration of the industrial design to be revoked.

(4) Any person may oppose a reference made under subsection (1).

#### **45. Revocation on ground that industrial design not registrable**

The court may, on application by any person, order the registration of an industrial design to be revoked on the ground that, at the time of its registration, the industrial design was not new or was not registrable for any other reason.

**46. Revocation on ground that person not entitled to be registered as owner**

(1) Subject to subsections (2) and (3), the court may, on application by any person, order the registration of an industrial design to be revoked on the ground that the person whose name is entered in the Register as the owner of the industrial design is not entitled to be registered as the owner.

(2) An application under subsection (1) may be made only by a person found by the court on a reference under section 41 to be entitled to be registered as the owner of the industrial design.

(3) Where the reference under section 41 was commenced after the end of the period of two years beginning with the date of registration of the industrial design, the court may not order the revocation of the registration of the industrial design under this section unless the applicant shows that the person whose name is entered in the Register as the owner of the industrial design knew at the time of its registration or of the registration of the transfer of the industrial design to him that he was not entitled to be registered as the owner.

**47. Effect of revocation**

Without affecting transactions past and closed, where an order is made under sections 44, 45 or 46 that the registration of an industrial design be revoked, the Registrar shall rectify the Register accordingly and the registration of the industrial design shall be deemed never to have been made.

**48. Infringement proceedings**

(1) An infringement of the right in an industrial design is actionable by the registered owner and in any action in respect of such an infringement all such relief, by way of damages, injunction, account of profits or otherwise, shall be available as is available in proceedings in respect of the infringement of other proprietary rights.

(2) The court shall not, in respect of the same infringement, both award damages and order an account of profits.

(3) No proceedings shall be taken in respect of an infringement of an industrial design committed before the date on which the certificate of registration of the industrial design was issued under section 26.



(4) Subject to this section and to any agreement to the contrary, where there is more than one registered owner of an industrial design, each of them shall be entitled to bring proceedings in respect of any infringement of the industrial design.

(5) In the application of section 31 to an industrial design of which there is more than one registered owner, the reference to the registered owner shall be construed-

(a) in relation to any act, as a reference to that registered owner or those registered owners who, by virtue of section 33 or any agreement referred to in that section, is or are entitled to do that act without its constituting an infringement; and

(b) in relation to any consent, as a reference to that registered owner or those registered owners who, by virtue of section 33 or any such agreement, is or are the proper person or persons to give such consent.

(6) Infringement proceedings may be brought by any co-owner, but he may not, without the leave of the court, proceed with the action unless the other of them, or each of the others, has either been joined as a plaintiff or added as a defendant. A co-owner who has been added as a defendant shall not be made liable for any costs in the action unless he has taken part in the proceedings. Nothing in this subsection affects the granting of interlocutory relief on the application of a single co-owner alone.

#### **49. Exercise of concurrent rights**

(1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights in respect of matters occurring after the grant of the licence as if the licence had been an assignment. Where or to the extent that such provision is made, the licensee is entitled, subject to the provisions of the licence and to subsections (2) to (8), to bring infringement proceedings in his own name, against any person other than the owner.

(2) Any such rights of an exclusive licensee are concurrent with those of the owner; and references in this Order to the owner which relate to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee under this section, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the owner.

(4) Where infringement proceedings brought by the owner or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the owner or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other of them has either been joined as a plaintiff or added as a defendant. Nothing in this subsection affects the granting of interlocutory relief on the application of an owner or exclusive licensee alone.

(5) A person who has been added as a defendant under subsection (4) shall not be made liable for any costs in the action unless he has taken part in the proceedings.

(6) Where infringement proceedings are brought which relate wholly or partly to an infringement in respect of which the owner and an exclusive licensee have or had concurrent rights of action-

(a) the court shall in assessing damages take into account-

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the court shall, if an account of profits is directed, apportion the profits between them as the court considers just, subject to any agreement between them.

This subsection applies whether or not the owner and the exclusive licensee are both parties to the action; and if they are not both parties the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(7) The owner of the industrial design shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 53; and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(8) Subsections (4) to (7) have effect subject to any agreement to the contrary between the owner and the exclusive licensee.

**50. Application of section 49 to exclusive licensee**

Section 49 applies to an exclusive licensee of the right in an industrial design under a licence that was in force at the time the conduct constituting an infringement of those rights took place.

**51. General restriction on recovery of damages or profits**

(1) In proceedings for the infringement of an industrial design damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for believing, that the industrial design was registered.

(2) For the purpose of subsection (1), a person shall not be taken to have been so aware or to have had reasonable grounds for so believing by reason only of the application to an article, or to any printed matter accompanying an article, of the word "registered", or any word or words or abbreviation expressing or implying that an industrial design has been registered, unless the registration number of the industrial design accompanied such word, words or abbreviation.

(3) In proceedings for infringement of an industrial design the court may, if it thinks fit, refuse to award any damages or make any such order in respect of an infringement committed during any further period specified under subsection (5) of section 29, but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

**52. Further restriction on recovery of damages or profits for certain infringements**

Where a person becomes the registered owner or one of the registered owners or an exclusive licensee of an industrial design under a transaction, instrument or event to which section 34 applies, then unless-

(a) an application to register the prescribed particulars of such transaction, instrument or event is made before the end of the period of six months beginning with its date; or

(b) the court is satisfied that it was not practicable to make such an application before the end of that period and that it was made as soon as practicable after the end of that period,

he is not entitled to damages or an account of profits in respect of any infringement occurring after the date of the transaction, instrument or event and before the prescribed particulars of the transaction, instrument

or event are registered.

**53. Order for delivery up of infringing articles, etc.**

(1) The proprietor of an industrial design may apply to the court for an order for the delivery up to him or such other person as the court may direct of-

(a) any infringing article; or  
(b) anything specifically designed or adapted for the making of any infringing article, knowing or having reason to believe that the thing has been or is to be used to make any infringing article, which that person has in his possession, custody, or control in the course of a business.

(2) An application under subsection (1) may not be made after the end of the period of six years from the date on which the article or thing was made unless, during the whole or part of that period, the registered owner was under a disability or was prevented by fraud or concealment from discovering the facts entitling him to make the application, in which case an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(3) No such order shall be made unless the court also makes, or it appears to the court that there are grounds for making, an order under section 54.

(4) A person to whom any infringing article or thing is delivered up in pursuance of an order under this section shall, if an order under section 54 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(5) Nothing in this section affects any other power of the court.

(6) In subsection (2), "disability" has the same meaning as in subsection (2) of section 4 of the Limitation Act (Chapter 14).

**54. Order for disposal**

(1) Where any infringing article or thing has been delivered up in pursuance of an order under section 53, an application may be made to the court-

(a) for an order that they be destroyed or forfeited to such person as

the court may think fit; or

(b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement would be adequate to compensate the registered owner and any licensee and protect their interests.

(3) Provision may be made by rules of court as to the service of notice on persons having an interest in the articles or thing, and any such person is entitled-

(a) to appear in proceedings for an order under this section, whether or not he was served with notice; and

(b) to appeal against any order made, whether or not he appeared, and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal has been given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the article or thing, the court shall make such order as it thinks just.

(5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the article or thing was before being delivered up is entitled to its return.

(6) References in this section to a person having an interest in any article or thing include any person in whose favour an order could be made under this section or under any law which makes similar provision in relation to the infringement of trade marks, copyright, rights in performances or industrial design rights.

#### **55. Declaration as to non-infringement**

Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or that a proposed act would not, constitute an infringement of an industrial design may be made by the court in any proceedings between the person doing or proposing to do the act and the registered owner, notwithstanding that no assertion to the contrary has been made by the registered owner, if it is shown that-

(a) such person has applied in writing to the registered owner for a written

acknowledgement to the effect of the declaration claimed, and has furnished him with full written particulars of that act or proposed act; and  
(b) the registered owner has refused or failed to give any such acknowledgement.

#### **56. Certificate of contested validity of registration**

(1) If in any proceedings before the court the validity of the registration of an industrial design is contested and that registration is found by the court to be valid, the court may certify the finding and the fact that the validity of the registration was so contested.

(2) Where a certificate has been granted under this section, then if, in any subsequent proceedings before the court for infringement of the industrial design or for revocation of the registration, a final order or judgment is made or given in favour of the party relying on the validity of the registration, that party shall, unless the court otherwise directs, be entitled to his costs on the indemnity basis within the meaning of that term as appearing in Order 59 rule 27 of the Rules of the Supreme Court, other than the costs of any appeal in the subsequent proceedings.

#### **57. Groundless legal proceedings**

(1) Subject to subsection (2), where a person has commenced proceedings alleging an infringement of the right in an industrial design, the court may, on the application of any person against whom such proceedings are brought, if it is satisfied that they were unjustified-

- (a) make an order striking out the proceedings; and
- (b) make an order for the payment of damages for any loss suffered by the person against whom the proceedings were brought.

(2) The court shall not grant relief under this section if the defendant proves that the act in respect of which the proceedings were brought constituted, or if done, would have constituted, an infringement of the right in the industrial design.

#### **57A. Remedy for groundless threats of infringement proceedings.**

(1) Where a person (whether or not entitled to or interested in a registered design or an application for registration of a design) threatens any other person with proceedings for infringement of a registered design, any person aggrieved thereby may bring proceedings against the person making the threats for relief under this section.

(2) The relief which may be applied for are

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) damages, in respect of any loss he has sustained by the threats, and the plaintiff is entitled to such relief unless
  - (i) the defendant proves that the acts in respect of which the proceedings were threatened constitute, or if done would constitute, an infringement of the design; and
  - (ii) the plaintiff fails to show that the registration of the design concerned is invalid.

(3) Proceedings may not be brought under this section as regards a threat to bring proceedings for an infringement alleged to consist of the making or importing of anything.

(4) For the purposes of this section, a notification that a design is registered does not of itself constitute a threat of proceedings within the meaning of this section.

(5) Nothing in this section shall render an advocate or solicitor liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

#### **58. Appeal from Registrar**

(1) An appeal to the court lies from any decision of the Registrar under this Order, except as otherwise expressly provided by rules or regulations made under this Order.

(2) Any appeal under this Order which concerns an application for registration of an industrial design shall be heard in Chambers unless the court otherwise directs.

(3) In any appeal under this Order -

- (a) the Registrar shall be entitled to appear and be heard; and
- (b) the Registrar shall appear if so directed by the court.

(4) In addition to its powers under any other law, in any appeal the court has the same discretionary powers as have been conferred upon the Registrar by this Order.

(5) In this section, "decision" includes any act of the Registrar made

in the exercise of a discretion vested in him by or under this Order.

**59. Registrar's appearance in proceedings involving Register**

(1) In any proceedings before the court which concerns an application for the alteration or rectification of the Register-

- (a) the Registrar shall be entitled to appear and be heard; and
- (b) the Registrar shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the Registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of-

- (a) any proceedings before him in relation to the matter in issue;
  - (b) the grounds of any decision given by him;
  - (c) the practice of the Registrar or the Registry in like cases, if any; and
  - (d) such matters within his knowledge as he thinks fit,
- and the statement shall be deemed to form part of the evidence in the proceedings.

**60. General powers of court**

The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Order, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

**61. Procedure in case of option to apply to court or Registrar**

(1) Where under this Order a person has an option to make an application either to the court or to the Registrar on a question concerning an industrial design, or an application for registration of an industrial design, then-

- (a) if any proceeding concerning the industrial design or application for registration is pending before the court, the application shall be made to the court; and
- (b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question, subject to appeal to the court.

(2) Subsection (1) is without prejudice to the powers of the court, apart from this section, to determine any question referred to in that subsection.



**62. Costs and expenses in proceedings before court**

(1) In all proceedings before the court under this Order, the court may award to any party such costs as it may consider reasonable and the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

(2) If in any such proceedings the court directs that any costs of one party shall be paid by another party, the court may settle the amount of the costs by fixing a lump sum or may direct that the costs be taxed on a scale specified by the court, being a scale of costs prescribed by rules of court.

**63. Costs and expenses in proceedings before Registrar**

(1) The Registrar may, in proceedings before him under this Order, by order award to any party such costs as he may consider reasonable and direct how and by what parties they are to be paid.

(2) Any costs awarded under this section shall, if the court so orders, be recoverable by execution issued from the court as if they were payable under an order of that court.

## **PART VI ADMINISTRATIVE AND MISCELLANEOUS PROVISIONS**

### **64. Register of Industrial Designs**

(1) The Registrar shall maintain at the Registry a register known as the Register of Industrial Designs.

(2) There shall be entered in the Register in accordance with this Order and the rules-

- (a) particulars as to applications for registration of industrial designs, including the filing dates and priority dates;
- (b) the names of owners of industrial designs;
- (c) particulars as to transactions, instruments or events affecting rights in or under industrial designs and applications for registration; and
- (d) such other matters as the Registrar may think fit.

(3) No notice of any trust (express, implied or constructive) shall be entered in the Register, and the Registrar shall not be affected by any such notice.

(4) The Register need not be kept in documentary form.

### **65. Register is prima facie evidence**

(1) Subject to subsection (4), the Register shall be prima facie evidence of anything required or authorised to be registered by this Order or the rules.

(2) A certificate purporting to be signed by the Registrar and certifying that any entry in the Register which he is authorised by this Order or the rules to make has or has not been made, or that any other thing which he is so authorised to do has or has not been done, shall be prima facie evidence of the matters so certified.

(3) A copy of-

- (a) an entry in the Register or an extract from the Register, which is supplied under subsection (1) of section 68;
  - (b) any document kept in the Registry or an extract from any such document;
  - (c) any model or specification of an industrial design; or
  - (d) any application for registration of an industrial design,
- which purports to be a certified copy or a certified extract shall, subject to subsection (4), be admitted in evidence without further proof and without production of any original.

(4) This section is without prejudice to sections 35A and 35B of the Evidence Act.

(5) In this section, "certified copy" and "certified extract" means a copy and extract certified by the Registrar and sealed with the seal of the Registrar.

#### **66. Rectification of Register**

(1) Any person having a sufficient interest may apply for the rectification of an error in or omission from the Register: Provided that an application for rectification may not be made in respect of a matter affecting the validity of an industrial design.

(2) An application for rectification may be made either to the Registrar or to the court, except that-

(a) if any proceeding concerning the industrial design is pending before the court, the application shall be made to the court; and

(b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the Registrar or the court directs otherwise, the effect of rectification of the Register is that the error or omission shall be deemed never to have been made.

(4) The Registrar may, on request made in the prescribed manner by the owner of an industrial design, or a licensee, enter any change in his name or address as recorded in the Register.

(5) The Registrar may remove from the Register matters appearing to him to have ceased to have effect-

(a) on an application made to him by any person having a sufficient interest; or

(b) on his own motion.

#### **67. Right to inspect Register**

(1) Subject to any rules, any person shall have the right to inspect the Register during the business hours of the Registry.

(2) In relation to any portion of the Register kept otherwise than in documentary form the right of inspection conferred by subsection (1) is

a right to inspect the material on the Register.

#### **68. Right to copies of entries**

(1) Any person who applies for a certified copy of an entry in the Register or a certified extract from the Register shall be entitled to obtain such a copy or extract on payment of the prescribed fee.

(2) Any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of the prescribed fee.

(3) Application under this section shall be made in the prescribed manner.

(4) In relation to any portion of the Register kept otherwise than in documentary form, the right to a copy or extract conferred by subsections (1) and (2) is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

#### **69. Right to information**

(1) After the registration of an industrial design and upon the filing of a written request by any person in the prescribed manner, the Registrar shall give the person making the request such information, and permit him to inspect such documents, relating to the application for registration or to the industrial design, including any representation, sample or specimen of the industrial design, as may be specified in the request, subject to any prescribed conditions.

(2) Subject to this section, until notice of registration of an industrial design has been published under section 26, information or documents constituting or relating to the application shall not, without the consent of the owner or the applicant, as the case may be, be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent the Registrar from publishing or communicating to other persons any prescribed information relating to an application for registration of an industrial design.

(4) Where a person is notified that an application for registration of an industrial design has been made and that the applicant will, if the industrial design is registered, bring proceedings against that person in the event of his doing any act specified in the notification, that person may make a request under subsection (1) and that subsection shall

apply accordingly.

#### **70. Hours of business of Registry and excluded days**

(1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules specifying the hour at which the Registry shall be taken to be closed on any day for purposes of the transaction by the public of business under this Order or of any class of such business, and may specify days as excluded days for any such purposes.

(2) Any business done under this Order on any day after the hour so specified in relation to business of that class, or on a day which is an excluded day in relation to business of that class, shall be taken to have been done on the next following day not being an excluded day; and where the time for doing anything under this Order expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

(3) Rules under this section may make different provision for different classes of business.

#### **71. Exercise of Registrar's discretionary powers**

Without prejudice to any rule of law, the Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretion vested in the Registrar by this Order.

#### **72. Immunity of Registrar as regards official acts**

Neither the Registrar nor any public officer-

(a) shall be taken to warrant the validity of the registration of any industrial design registered under this Order; or

(b) shall incur any liability by reason of, or in connection with, any examination required or authorised by this Order, or any report or other proceedings consequent on any such examination or investigation.

#### **73. Recognition of agents**

(1) Subject to this section, where under this Order any act has to be done by or to any person in connection with an industrial design or any procedure relating to an industrial design or the registration of an industrial design, the act may be done by or to an agent of such person duly authorised by him on the prescribed form.

(2) A person duly authorised by another person under subsection (1) to act as his agent may, subject to any provision to the contrary in any agreement between the agent and that person, on giving notice to the Registrar and to such other person, on the prescribed form, cease to act as agent for the other person.

(3) The Registrar may refuse to recognise as agent in respect of any business under this Order any person specified for the purpose in the rules.

(4) The Registrar may refuse to recognise as an agent a person who neither resides nor has a place of business in Brunei Darussalam.

#### **74. Correction of errors in filed documents**

(1) Subject to the rules, the Registrar may upon written request by any person interested correct any error of translation or transcription, clerical error or mistake made in-

(a) any application for registration of an industrial design or document filed in connection with such an application;

(b) any representation of an industrial design; or

(c) any document filed in connection with an industrial design.

(2) Any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

#### **75. Industrial designs relevant for defence purposes**

(1) Where, either before or after commencement, an application for registration of an industrial design has been made and it appears to the Registrar that the industrial design is one of a class notified to him by the Attorney General as relevant for defence purposes, the Registrar may give directions for prohibiting or restricting the publication of information with respect to the industrial design, or the communication of such information to any person or class of persons specified in the directions.

(2) Rules may be made for securing that where such directions are given-

(a) the representation of the industrial design; and

(b) any evidence filed in support of the applicant's application for registration that the industrial design is registrable, shall not be open to public inspection in the Registry during the continuance in force of the directions.

(3) Where the Registrar gives such directions, he shall give notice of the application of the directions to the Attorney General, and thereupon the following provisions shall have effect-

(a) the Attorney General shall consider whether the publication of the industrial design would be prejudicial to the defence of Brunei Darussalam;

(b) the Attorney General may at any time after the industrial design has been registered or, with the consent of the applicant, at any time before the industrial design has been registered, inspect the representation of the industrial design and any such evidence as to its registrability;

(c) if upon the consideration of the industrial design at any time it appears to the Attorney General that the publication of the industrial design would not, or would no longer, be prejudicial to the defence of Brunei Darussalam, notice may be given to the Registrar to that effect; and

(d) on the receipt of any such notice the Registrar shall revoke the directions and may, subject to any such conditions as he may think fit, extend the time for doing anything required or authorised to be done by or under this Order in connection with the application for registration, whether or not that time has previously expired.

#### **76. Government's right to sell forfeited articles**

Nothing in this Order affects the right of the Government or any person deriving title directly or indirectly from the Government to dispose of or use articles forfeited under any law relating to customs or excise.

**PART VIA GENEVA ACT OF THE HAGUE AGREEMENT ETC.**

**76A. Power to make provision giving effect to Geneva Act of the Hague Agreement etc.**

(1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules to give effect in Brunei Darussalam to the provisions of the Geneva Act of the Hague Agreement or of any other treaty, convention, arrangement or engagement relating to designs to which Brunei Darussalam is a party.

(2) Without prejudice to the generality of subsection (1), rules may, in particular, be made to provide for

(a) the procedures to be followed for the filing of applications for international registrations through the Registry;

(b) the procedures to be followed where an application for international registration fails or the international registration ceases to be in force;

(c) the effects of a successful application for international registration designating Brunei Darussalam as a country in which the design is to be registered;

(d) the communication of information to the International Bureau; and

(e) the payment of fees (including transmittal fees) and amounts prescribed in respect of applications for international registrations, corrections and renewals.

(3) Provision may also be made in the rules to apply, in relation to an international design (Brunei Darussalam), the provisions of section 57A and Parts IV and VIII.

(4) For the purposes of subsection (3), "international design (Brunei Darussalam)" means

(a) a design which is entitled to protection in Brunei Darussalam under the Geneva Act of the Hague Agreement; or

(b) a design prescribed by the Attorney General as an international design (Brunei Darussalam).



## **PART VII RULES AND REGULATIONS**

### **77. Rules**

(1) The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules prescribing all matters which are required or convenient to be prescribed, including the prescription of the forms to be used in connection with the registration of any industrial design or any other proceeding before him under this Order, and of fees, and generally for giving effect to the objects and purposes of this Order and for the due administration thereof.

(2) Such rules may make different provision as respects different classes of case to which they apply, and may include such incidental and supplementary provisions as the Attorney General considers expedient.

### **78. Regulations**

The Attorney General may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make regulations-

- (a) amending the period within which a notice under section 20 shall be filed;
- (b) amending the number of years specified in subsection (2) of section 29;
- (c) amending the number of months specified in subsection (5) of section 29;
- (d) providing that no appeal shall lie under section 58 from a decision or order of the Registrar that is of a class of decisions or orders specified therein;
- (e) designating requirements as formal requirements for the purposes of this Order.

### **78A. Power of Registrar to publish journal.**

(1) The Registrar may publish or cause to be published a journal to be called the Industrial Designs Journal in which there may be published such documents and information relating to a registered industrial design or an application for registration as the Registrar thinks fit.

(2) For the avoidance of doubt, the Journal shall be the official journal of record.

(3) A publication specified under the Journal need not be in a documentary form.

## **PART VIII OFFENCES**

### **79. Falsification of Register, etc.**

(1) It is an offence for a person to make, or cause to be made, a false entry in the Register, knowing or having reason to believe that it is false.

(2) It is an offence for a person-

(a) to make or cause to be made anything falsely purporting to be a copy of an entry in the Register; or

(b) to produce or tender, or cause to be produced or tendered, in evidence any such thing,

knowing or having reason to believe that it is false.

(3) Any person guilty of an offence under this section is liable on conviction to imprisonment for a term not exceeding five years, a fine not exceeding fifty thousand dollars or both.

### **80. False representation that industrial design is registered**

(1) Subject to this section, any person who makes a representation that an industrial design applied to any article disposed of by him for value is registered in respect of that article is guilty of an offence and liable on conviction to a fine not exceeding ten thousand dollars.

(2) For the purpose of subsection (1), a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word "registered" or anything expressing or implying that an industrial design applied to the article is registered in respect of that article, shall be taken to have made a representation that the industrial design applied to the article is registered in respect of the article.

(3) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

### **81. Misuse of title "Registry of Industrial Designs", etc.**

Any person who uses on his place of business, or on any document issued by him, or otherwise, the words "Registry of Industrial Designs" or any other words suggesting that his place of business is, or is officially connected with, the Registry, is guilty of an offence and liable on

conviction to a fine not exceeding fifty thousand dollars.

**82. Contravention of directions given under section 75**

Any person who contravenes a direction given by the Registrar under section 75 is guilty of an offence and liable on conviction to imprisonment for a term not exceeding two years and a fine not exceeding fifty thousand dollars.

**83. Offences committed by bodies corporate and partnerships**

(1) Where an offence under this Order committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any act or default on the part of, a director, manager, secretary or other similar officer of that body, or of a person purporting to act in any such capacity, he, as well as the body corporate, is also guilty of that offence and liable to be proceeded against and punished accordingly.

(2) Where a partnership is guilty of an offence under this Order, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(3) In relation to a body corporate whose affairs are managed by its members, "director", in subsection (1), means any member of the body corporate.

## **PART IX GENERAL**

### **84. Enabling powers**

His Majesty the Sultan and Yang Di-Pertuan may by order make such provision as appears to him to be necessary or expedient-

- (a) for giving effect to the objects and purposes of this Order; and
- (b) for the purpose of bringing any other written law into accord with this Order.

### **85. Order binding on Government**

This Order is binding on the Government.