

No. S 57

CONSTITUTION OF BRUNEI DARUSSALAM
(Order made under Article 83(3))

PATENTS ORDER, 2011

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CONSTITUTION OF BRUNEI DARUSSALAM
{Order made under Article 83(3)}

PATENTS ORDER, 2011

In exercise of the power conferred by Article 83(3) of the Constitution of Brunei Darussalam, His Majesty the Sultan and Yang Di-Pertuan hereby makes the following Order —

PART I

PRELIMINARY

Citation, commencement and long title.

1. (1) This Order may be cited as the Patents Order, 2011 and shall commence (with the exception of Part XIX) on the 1st. day of January, 2012.

(2) The Minister may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, appoint different dates for the commencement of the different Parts or provisions of this Order or for the different purposes of the same provision.

(3) The long title of this Order is "An Order to make provision for patents for inventions, to give effect to certain international conventions on patents and to repeal the Inventions Act (Chapter 72) and the Emergency (Patents) Order, 1999 (S 42/1999) and for matters connected therewith".

Interpretation.

2. (1) In this Order, unless the context otherwise requires —

"Convention on International Exhibitions" means the Convention relating to International Exhibitions signed in Paris on 22nd. November, 1928, as amended or supplemented by any protocol to that convention which is for the time being in force;

"corresponding application", in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed, or treated as filed, with any prescribed patent office that —

(a) forms the basis for a priority claim under section 17 in the application in suit; or

(b) is subject to a priority claim based on —

- (i) the application in suit; or
- (ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

"Council for TRIPS" means the Council for Trade-Related Aspects of Intellectual Property Rights established under the TRIPS Agreement;

"corresponding international application", in relation to an application for a patent (referred to in this definition as the application in suit), means an application for protection filed under the Patent Co-operation Treaty that —

(a) forms the basis for a priority claim under section 17 in the application in suit; or

(b) is subject to a priority claim based on —

- (i) the application in suit; or
- (ii) an application which is also the basis for a priority claim under section 17 in the application in suit;

"corresponding patent", in relation to a corresponding application, means a patent granted in respect of the corresponding application by the prescribed patent office in which the corresponding application was filed or treated as filed;

"country" includes —

(a) a colony, protectorate or territory subject to the authority or under the suzerainty of another country; or

(b) a territory administered by another country under the trusteeship of the United Nations;

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

"date of filing", in relation to —

(a) an application for a patent made under this Order, means the date of filing that application by virtue of section 26; and

(b) any other application, means the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing that application in that country or is equivalent to the date of

filing an application in that country (whatever the outcome of the application);

"designate", in relation to an application or a patent, means designate the country or countries (in pursuance of the Patent Co-operation Treaty) in which protection is sought for the invention which is the subject of the application or patent;

"Doha Declaration Implementation Decision" means the Decision adopted by the General Council of the World Trade Organisation on 30th. August, 2003 on the implementation of paragraph 6 of the Declaration on the TRIPS Agreement and Public Health adopted in Doha on 14th. November, 2001;

"employee" means a person who works or (where the employment has ceased) worked under a contract of employment or in employment under or for the purposes of a Government department;

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

"European Patent Convention" means the Convention on the Grant of European Patents;

"European Patent Office" means the office of that name established by the European Patent Convention;

"Examiner" means such person, organisation or foreign or international patent office or organisation as may be prescribed to whom the Registrar may refer questions relating to patents, including search and examination of applications for patents;

"exclusive licence" means a licence from the proprietor of or applicant for a patent conferring on the licensee, or on him and persons authorised by him, to the exclusion of all other persons (including the proprietor or applicant), any right in respect of the invention to which the patent or application relates, and

"exclusive licensee" and "non-exclusive licence" shall be construed accordingly;

"filing fee" means the fee prescribed for the purposes of section 25;

"formal requirements" means those requirements of this Order and the rules which are designated by the rules as formal requirements for the purposes of this Order;

"international application for a patent" means an application made under the Patent Co-operation Treaty;

"international application for a patent (Brunei Darussalam)" means an application of that description which, on its date of filing, designates Brunei Darussalam;

"International Bureau" means the secretariat of the World Intellectual Property Organisation established by a convention signed at Stockholm on 14th. July, 1967;

"international exhibition" means an official or officially recognised international exhibition falling within the terms of the Convention on International Exhibitions or falling within the terms of any subsequent treaty or convention replacing that convention;

"international preliminary report on patentability" means —

(a) an international preliminary report on patentability (Chapter I of the Patent Co-operation Treaty); or

(b) an international preliminary report on patentability (Chapter II of the Patent Co-operation Treaty),

referred to in the Regulations under the Patent Co-operation Treaty;

"inventor", in relation to an invention, means the actual deviser of the invention and "joint inventor" shall be construed accordingly;

"journal" has the same meaning as in section 112(4);

"legal officer" means a qualified person in the judicial or legal service of Brunei Darussalam;

"marketing approval", in relation to a pharmaceutical product, means a product licence under section 10 of the Medicines Order, 2007 (S 79/2007);

"medicinal product" has the same meaning as in the Medicines Order, 2007 (S 79/2007);

"missing part", in relation to an application for a patent, means —

(a) any drawing; or

(b) any part of the description of the invention for which the patent is sought,

which was missing from the application at the date of filing of the application;

"mortgage", when used as a noun, includes a charge for securing money or money's worth and, when used as a verb, shall be construed accordingly;

"Paris Convention" means the Convention for the Protection of Industrial Property signed at Paris on 20th. March, 1883;

"patent" means a patent under this Order and includes a patent in force by virtue of section 115(4);

"Patent Co-operation Treaty" means the treaty of that name signed at Washington on 19th. June, 1970;

"patented invention" means an invention for which a patent is granted and "patented process" shall be construed accordingly;

"patented product" means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

"person" includes the Government;

"pharmaceutical product" means a medicinal product which is a substance used wholly or mainly by being administered to a human being for the purpose of treating or preventing disease, but does not include —

(a) any substance which is used solely —

(i) for diagnosis or testing; or

(ii) as a device or mechanism, or an instrument, apparatus or appliance; or

(b) any substance or class of substances specified in paragraph 2 or 3 of the Schedule;

"prescribed form" means a form published by the Registrar under section 113;

"priority date" means the date determined as such under section 17;

"published" means made available to the public (whether in Brunei Darussalam or elsewhere) and a document shall be taken to be published under any provision of this Order if it can be inspected as of right at any

place in Brunei Darussalam by members of the public, whether on payment of a fee or not, and "republished" shall be construed accordingly;

"register", when used as a noun, means the register of patents maintained under section 43 and, when used as a verb, means, in relation to any thing, to register or register particulars, or enter notice, of that thing in the register and, when used in relation to a person, means to enter his name in the register;

"registered patent agent" means a person whose name is entered in the register of patent agents kept in accordance with the rules made under section 101;

"Registrar" means the Registrar of Patents and includes any Deputy Registrar of Patents holding office under this Order;

"Registry" means the Registry of Patents established by section 6 of this Order;

"relevant authority", in relation to a pharmaceutical product, means the Brunei Darussalam Medicines Control Authority;

"relevant health product" means a patented invention which is a product referred to in —

(a) paragraph 1(a) of the Doha Declaration Implementation Decision;
or

(b) paragraph 1(a) of the Annex to the TRIPS Agreement;

"right", in relation to any patent or application, includes an interest in the patent or application and, without prejudice to the foregoing, any reference to a right in a patent includes a reference to a share in the patent;

"scientific adviser" means any person with any scientific qualification, any medical practitioner, engineer, architect, surveyor, accountant, actuary and any other specially skilled person;

"TRIPS Agreement" means the Agreement on Trade-Related Aspects of Intellectual Property Rights, set out in Annex 1C to the WTO Agreement, as revised or amended from time to time;

"WTO Agreement" means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

(2) Rules may provide for stating in the journal that an exhibition falls within the definition of "international exhibition" in subsection (1) and any such

statement shall be conclusive evidence that the exhibition falls within that definition.

(3) For the purposes of this Order, a matter shall be taken to have been disclosed in any relevant application within the meaning of section 17 or in the specification of a patent if it was either claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or specification.

(4) For the purposes of this Order —

(a) a claim is related to another claim if —

(i) the 2 claims are identical; or

(ii) each limitation in the second claim —

(A) is identical to a limitation in the first claim; or

(B) differs from a limitation in the first claim only in expression but not in content; and

(b) more than one claim may be related to a single claim.

(5) References in this Order to an application for a patent, as filed, are references to such an application in the state it was on the date of filing.

(6) References in this Order to an application for a patent being published are references to its being published under section 27.

(7) References in this Order to the Paris Convention or the Patent Co-operation Treaty are references to that Convention or Treaty or any other international convention or agreement replacing it, as amended or supplemented by any convention or international agreement (including in either case any protocol or annex) to which Brunei Darussalam is a party, or in accordance with the terms of any such convention or agreement and include references to any instrument made under any such convention or agreement.

(8) The Arbitration Order, 2009 [S 34/2009] shall not apply to any proceedings before the Registrar under this Order.

Order to bind Government.

3. This Order shall bind the Government.

PART II

ADMINISTRATION

Registrar of Patents and other officers.

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

(2) There shall be one or more Deputy Registrars of Patents 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 Patents.

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

Delegation by Registrar.

5. (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 Patents 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 Patents.

Registry of Patents.

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

Seal of Registry.

7. There shall be a seal of the Registry and impressions of the seal shall be judicially noticed.

Powers of Registrar.

8. The Registrar may, for the purposes of this Order —

- (a) summon witnesses;
- (b) receive evidence on oath, whether orally or otherwise;
- (c) require the production of documents or articles; and
- (d) award costs against a party to proceedings before him.

Disobedience to summons an offence.

9. (1) A person who has been summoned to appear as a witness before the Registrar shall not, without lawful excuse, fail to appear in obedience to the summons.

(2) A person who has been required by the Registrar to produce a document or article shall not, without lawful excuse, fail to produce the document or article.

(3) Any person who contravenes subsection (1) or (2) is guilty of an offence and liable on conviction to a fine not exceeding \$2,000, imprisonment for a term not exceeding 3 months or both.

Refusal to give evidence an offence.

10. (1) A person who appears before the Registrar shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

(2) Any person who contravenes subsection (1) is guilty of an offence and liable on conviction to a fine not exceeding \$2,000, imprisonment for a term not exceeding 3 months or both.

Officers not to traffic in inventions.

11. (1) An officer or person employed in the Registry shall not buy, sell, acquire or traffic in an invention or patent, whether granted in Brunei Darussalam or elsewhere, or in a right to, or licence under, a patent, whether granted in Brunei Darussalam or elsewhere.

(2) Any person who contravenes subsection (1) is guilty of an offence and liable on conviction to a fine not exceeding \$2,000, imprisonment for a term not exceeding 3 months or both.

(3) A purchase, sale, acquisition, assignment or transfer made or entered into in contravention of this section is void.

(4) This section does not apply to the actual inventor or to an acquisition by bequest or devolution in law.

Officers not to furnish information.

12. (1) An officer or person employed in the Registry shall not, except when required or authorised by this Order, or under a direction in writing of the Registrar or by order of a court —

(a) furnish information on a matter which is being, or has been, dealt with under this Order;

(b) prepare, or assist in the preparation of, a document required or permitted by or under this Order to be lodged in the Registry; or

(c) conduct a search in the records of the Registry.

(2) Any person who contravenes subsection (1) is guilty of an offence and liable on conviction to a fine not exceeding \$2,000, imprisonment for a term not exceeding 3 months or both.

PART III

PATENTABILITY

Patentable inventions.

13. (1) Subject to subsection (2), a patentable invention is one that satisfies the following conditions —

(a) the invention is new;

(b) it involves an inventive step; and

(c) is capable of industrial application.

(2) An invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour is not a patentable invention.

(3) For the purposes of subsection (2), behaviour shall not be regarded as offensive, immoral or anti-social only because it is prohibited by any law in force in Brunei Darussalam.

Novelty.

14. (1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Brunei Darussalam or elsewhere) by written or oral description, by use or in any other way.

(3) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken also to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if the following conditions are satisfied —

(a) that matter was contained in the application for that other patent both as filed and as published; and

(b) the priority date of that matter is earlier than that of the invention.

(4) For the purposes of this section, the disclosure of matter constituting an invention shall be disregarded in the case of a patent or an application for a patent if occurring later than the beginning of the period of 12 months immediately preceding the date of filing the application for the patent and either —

(a) the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by any person —

(i) from the inventor or from any other person to whom the matter was made available in confidence by the inventor or who obtained it from the inventor because he or the inventor believed that he was entitled to obtain it; or

(ii) from any other person to whom the matter was made available in confidence by any person mentioned in sub-paragraph (i) or in this sub-paragraph or who obtained it from any person so mentioned because he or the person from whom he obtained it believed that he was entitled to obtain it;

(b) the disclosure was made in breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor;

(c) the disclosure was due to, or made in consequence of, the inventor displaying the invention at an international exhibition and the applicant

states, on filing the application, that the invention has been so displayed and also, within the prescribed period, files written evidence in support of the statement complying with any prescribed condition; or

(d) the disclosure was due to, or made in consequence of, the inventor describing the invention in a paper read by him or another person with his consent or on his behalf before any learned society or published with his consent in the transactions of any learned society.

(5) In subsection (4)(d), "learned society" includes any club or association constituted in Brunei Darussalam or elsewhere whose main object is the promotion of any branch of learning or science.

(6) In this section, references to the inventor include references to any proprietor of the invention for the time being.

(7) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.

Inventive step.

15. An invention shall be taken to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the state of the art by virtue only of section 14(2) and without having regard to section 14(3).

Industrial application.

16. (1) Subject to subsection (2), an invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry, including agriculture.

(2) An invention of a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body shall not be taken to be capable of industrial application.

(3) Subsection (2) shall not prevent a product consisting of a substance or composition from being treated as capable of industrial application merely because it is invented for use in any such method.

Priority date.

17. (1) For the purposes of this Order, the priority date of an invention to which an application for a patent relates and also of any matter (whether or not the same as the invention) contained in the application is, except as provided by the provisions of this Order, the date of filing the application.

(2) Where in, or in connection with, an application for a patent (referred to in this section as the application in suit) a declaration is made, whether by the applicant or any predecessor in title of his, complying with the relevant requirements of the rules and specifying one or more earlier relevant applications for the purposes of this section made by the applicant or a predecessor in title of his, and the application in suit has a date of filing, within the period referred to in subsection (3)(a) or (b), then —

(a) if an invention to which the application in suit relates is supported by matter disclosed in the earlier relevant application or applications, the priority date of that invention shall, instead of being the date of filing the application in suit, be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them; and

(b) the priority date of any matter contained in the application in suit which was also disclosed in the earlier relevant application or applications shall be the date of filing the relevant application in which that matter was disclosed or, if it was disclosed in more than one relevant application, the earliest of them.

(3) For the purposes of subsection (2), the period is —

(a) the period of 12 months immediately following the date of filing of the specified earlier relevant application or, if there is more than one relevant application, the earliest of them; or

(b) where the Registrar has granted a request under subsection (4), the period commencing immediately after the period referred to in paragraph (a) and ending at the end of such period as may be prescribed.

(4) The applicant may make a request to the Registrar for the declaration referred to in subsection (2) to be made after the period referred to in subsection (3)(a).

(5) Where the applicant makes a request under subsection (4), he shall, if he has failed to file the application in suit within the period referred to in subsection (3)(a), indicate in the request whether his failure to file the application in suit within the period referred to in subsection (3)(a) —

(a) occurred in spite of due care required by the circumstances having been taken; or

(b) was unintentional.

(6) The Registrar shall grant a request under subsection (4) if and only if —

(a) the request is made within such period and in such manner, and complies with such requirements, as may be prescribed; and

(b) where the applicant has failed to file the application in suit within the period referred to in subsection (3)(a), the Registrar is satisfied that the applicant's failure to file the application in suit within the period referred to in subsection (3)(a) —

(i) occurred in spite of due care required by the circumstances having been taken; or

(ii) was unintentional.

(7) Where an invention or other matter contained in the application in suit was also disclosed in earlier relevant applications filed by the same applicant as in the case of the application in suit or a predecessor in title of his and the latter of those relevant applications was specified in or in connection with the application in suit, the latter of those relevant applications shall, so far as it concerns that invention or matter, be disregarded unless —

(a) it was filed in or in respect of the same country as the first; and

(b) not later than the date of filing the latter, the earlier (whether or not so specified) was unconditionally withdrawn, or was abandoned or refused, without —

(i) having been made available to the public whether in Brunei Darussalam or elsewhere;

(ii) leaving any right outstanding; and

(iii) having served to establish a priority date in relation to another application, wherever made.

(8) This section shall apply for determining the priority date of an invention for which a patent has been granted as it applies for determining the priority date of an invention to which an application for that patent relates.

(9) In this section and section 18, "relevant application" means any of the following applications which has a date of filing —

(a) an application for a patent under this Order; or

(b) an application in or for a convention country for protection in respect of an invention or an application which, in accordance with the law of a convention country or a treaty or international convention to which a convention country is a party, is equivalent to such an application.

(10) In subsection (9), "convention country" means —

(a) a country other than Brunei Darussalam that is a party to the Paris Convention or a member of the World Trade Organisation; or

(b) any other country with which Brunei Darussalam has entered into a treaty, convention, arrangement or engagement and which is declared by the Minister, by order published in the *Gazette*, as a convention country.

Disclosure of matter etc. between earlier and later applications.

18. (1) It is hereby declared for the avoidance of doubt that where an application (the application in suit) is made for a patent and a declaration is made in accordance with section 17(2) in or in connection with that application specifying an earlier relevant application, the application in suit and any patent granted in pursuance of it shall not be invalidated by reason only of the relevant intervening acts.

(2) In subsection (1), "relevant intervening acts" means acts done in relation to matter disclosed in an earlier relevant application between the dates of the earlier relevant application and the application in suit, as for example, filing another application for the invention for which the earlier relevant application was made, making information available to the public about that invention or that matter or working that invention, but disregarding any application, or the disclosure to the public of matter contained in any application, which is itself to be disregarded for the purposes of section 17(7).

PART IV

RIGHT TO APPLY FOR AND OBTAIN PATENT

Right to apply for and obtain patent.

19. (1) Any person may make an application for a patent either alone or jointly with another.

(2) A patent for an invention may be granted —

(a) primarily to the inventor or joint inventors;

(b) in preference to paragraph (a), to any person or persons who, by virtue of any written law or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in Brunei Darussalam; or

(c) in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) or any person so mentioned and the successor or successors in title of another person so mentioned,

and to no other person.

(3) Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) to be granted a patent and 2 or more persons who make such an application jointly shall be taken to be the persons so entitled.

Determination before grant of questions about entitlement to patents etc.

20. (1) At any time before a patent has been granted for an invention —

(a) any person may refer to the Registrar the question whether he is entitled to be granted (alone or with any other persons) a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent; or

(b) any of 2 or more co-proprietors of an application for a patent for that invention may so refer the question whether any right in or under application should be transferred or granted to any other person,

and the Registrar shall determine the question and may make such order as he thinks fit to give effect to the determination.

(2) Where a person refers a question relating to an invention under subsection (1)(a) to the Registrar after an application for a patent for the invention has been filed and before a patent is granted in pursuance of the application, then, unless the application is refused or withdrawn before the reference is disposed of by the Registrar, the Registrar may, without prejudice to the generality of subsection (1) and subject to subsection (6) —

(a) order that the application shall proceed in the name of that person, either solely or jointly with that of any other applicant or any specified applicant;

(b) where the reference was made by 2 or more persons, order that the application shall proceed in all their names jointly;

(c) refuse to grant a patent in pursuance of the application or order the application to be amended so as to exclude any of the matter in respect of which the question was referred; or

(d) make an order transferring or granting any licence or other right in or under the application and give directions to any person for carrying out the provisions of any such order.

(3) Where a question is referred to the Registrar under subsection (1)(a) and —

(a) the Registrar orders an application for a patent for the invention to which the question relates to be so amended;

(b) any such application is refused under subsection (2)(c) before the Registrar has disposed of the reference (whether the reference was made before or after the publication of the application); or

(c) any such application is refused under any other provision of this Order or is withdrawn before the Registrar has disposed of the reference, but after the publication of the application,

the Registrar may order that any person by whom the reference was made, may, within the prescribed period make a new application for a patent for the whole or part of any matter comprised in the earlier application or, as the case may be, for all or any of the matter excluded from the earlier application, subject in either case to section 81, and in either case that, if such a new application is made, it shall be treated as having been filed on the date of filing the earlier application.

(4) Where a person refers a question under subsection (1)(b) relating to an application, any order under subsection (1) may contain directions to any person for transferring or granting any right in or under the application.

(5) If any person to whom directions have been given under subsection (2)(d) or (4) fails to do anything necessary for carrying out any such directions within 14 days after the date of the directions, the Registrar may, on application made to him by any person in whose favour or on whose reference the directions were given, authorise him to do that thing on behalf of the person to whom the directions were given.

(6) Where on a reference under this section it is alleged that, by virtue of any transaction, instrument or event relating to an invention or an application for a patent, any person other than the inventor or the applicant for the patent has become entitled to be granted (whether alone or with any other persons) a patent for the invention or has or would have any right in or under any patent so granted

or any application for any such patent, an order shall not be made under subsection (2)(a), (b) or (d) on the reference unless notice of the reference is given to the applicant and any such person, except any of them who is a party to the reference.

(7) If it appears to the Registrar on a reference of a question under this section that the question involves matters which would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, the court shall have jurisdiction to do so.

(8) No direction shall be given under this section so as to affect the mutual rights or obligations of trustees or of the personal representatives of deceased persons, or their rights or obligations as such.

Determination after grant of questions referred before grant.

21. If a question with respect to a patent or application is referred by any person to the Registrar under section 20, and is not determined before the time when the application is first in order for a grant of a patent in pursuance of the application, that fact shall not prevent the grant of a patent, but on its grant that person shall be treated as having referred to the Registrar under section 48 any question mentioned in that section which the Registrar thinks fit.

Handling of application by joint applicants.

22. If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Registrar may, on a request made by any of the parties, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it shall be proceeded with, or for both those purposes, as the case may require.

Effect of transfer of application under section 20 or 22.

23. (1) Where an order is made or directions are given under section 20 or 22 that an application for a patent shall proceed in the name of one or some of the original applicants (whether or not it is also to proceed in the name of some other person), any licences or other rights in or under the application shall, subject to the provisions of the order and any directions under either of those sections, continue in force and be treated as granted by the persons in whose name the application is to proceed.

(2) Where an order is made or directions are given under section 20 that an application for a patent shall proceed in the name of one or more persons none of whom was an original applicant (on the ground that the original applicant or applicants was or were not entitled to be granted the patent), any licences or

other rights in or under the application shall, subject to the provisions of the order and any directions under that section and subject to subsection (3), lapse on the registration of the person or those persons as the applicant or applicants or, where the application has not been published, on the making of the order.

(3) If before registration of a reference under section 20 resulting in the making of any order mentioned in subsection (2) —

(a) the original applicant or any of the applicants, acting in good faith, worked the invention in question in Brunei Darussalam or made effective and serious preparations to do so; or

(b) a licensee of the applicant, acting in good faith, worked the invention in Brunei Darussalam or made effective and serious preparations to do so,

that or those original applicant or applicants or the licensee shall, on making a request within the prescribed period to the person in whose name the application is to proceed, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention.

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

(5) Where an order is made as mentioned in subsection (2), the person in whose name the application is to proceed or any person claiming that he is entitled to be granted any such licence, may refer to the Registrar the question whether the latter is so entitled and whether any such period is or terms are reasonable.

(6) The Registrar shall determine the question under subsection (5) and may, if he thinks fit, order the grant of such a licence.

v Mention of inventor.

24. (1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with the rules in a prescribed document.

(2) Unless he has already given the Registry the information mentioned in this subsection, an applicant for a patent shall, within the prescribed period, file with the Registry a statement —

(a) identifying the person or persons whom he believes to be the inventor or inventors; and

(b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent,

and, if he fails to do so, the application shall be treated as having been abandoned.

(3) Where a person has been mentioned as a sole or joint inventor under this section, any other person who alleges that the former ought not to have been mentioned may at any time apply to the Registrar for a certificate to that effect, and the Registrar may issue such a certificate.

PART V

APPLICATIONS FOR PATENTS

Manner of application.

25. (1) Every application for a patent —

(a) shall be made in the prescribed form and shall be filed at the Registry in the prescribed manner; and

(b) shall be accompanied by the fee prescribed for the purposes of this subsection.

(2) Where an application is not accompanied by the fee mentioned in subsection (1)(b), the fee shall be paid within the prescribed period.

(3) Every application for a patent shall contain —

(a) a request for the grant of a patent;

(b) a specification containing a description of the invention, a claim or claims and any drawing referred to in the description or any claim; and

(c) an abstract,

but this subsection shall not prevent an application being initiated by documents complying with section 26(1).

(4) The specification of an application shall disclose the invention in a manner which is clear and complete for the invention to be performed by a person skilled in the art.

(5) The claim or claims shall —

- (a) define the matter for which the applicant seeks protection;
- (b) be clear and concise;
- (c) be supported by the description; and
- (d) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

(6) Without prejudice to the generality of subsection (5)(d), the rules may provide for treating 2 or more inventions as being so linked as to form a single inventive concept for the purposes of this Order.

(7) The purpose of the abstract is to give technical information and on publication it shall not form part of the state of the art by virtue of section 14(3), and the Registrar may determine whether the abstract adequately fulfils its purpose and, if it does not, may reframe it so that it does.

(8) An application for a patent may be withdrawn at any time before the patent is granted and any withdrawal of such an application may not be revoked.

Date of filing application.

26. (1) Subject to the provisions of this Order, the date of filing an application for a patent shall be taken to be the earliest date on which the documents filed at the Registry to initiate the application satisfy the following conditions —

- (a) the documents indicate that a patent is sought;
- (b) the documents identify the applicant for the patent; and
- (c) the documents contain —
 - (i) something which is or appears to be a description of the invention for which the patent is sought; or
 - (ii) where a declaration under section 17(2) is made in or in connection with the application —
 - (A) a reference to an earlier relevant application specified in the declaration;
 - (B) such information on the earlier relevant application as may be prescribed; and
 - (C) a statement that the description of the invention for which the patent is sought is incorporated in the application by

reference to, and is completely contained in, the earlier relevant application, as filed.

(2) For the purposes of subsection (1)(c)(i), it is immaterial whether —

(a) the thing is in, or is accompanied by a translation into, a language accepted by the Registry in accordance with the rules; or

(b) the thing otherwise complies with the other provisions of this Order and with any relevant rules.

(3) Where the Registrar determines that the documents filed at the Registry to initiate an application for a patent do not satisfy the conditions in subsection (1)(a), (b) and (c)(i) or (ii) —

(a) the Registrar shall, as soon as practicable after the filing of those documents, notify the applicant of what else must be filed in order for the application to have a date of filing; and

(b) the applicant shall, within such period as may be prescribed, do either or both of the following —

(i) make observations on the Registrar's determination;

(ii) file every document which must be filed in order for the application to have a date of filing.

(4) Where subsection (3) applies, if the applicant fails to file every document which must be filed in order for the application to have a date of filing before the end of the period prescribed under subsection (3)(b), the application shall be treated as having been abandoned.

(5) Subsection (4) does not apply if —

(a) the applicant makes observations as mentioned in subsection (3)(b)(i) before the end of the period prescribed under subsection (3)(b); and

(b) as a result of the observations, the Registrar is satisfied that the documents filed at the Registry to initiate the application satisfy the conditions in subsection (1)(a), (b) and (c)(i) or (ii).

(6) Where the documents filed at the Registry to initiate an application for a patent satisfy the conditions in subsection (1)(a), (b) and (c)(i) or (ii), the Registrar shall, as soon as practicable after the filing of the last of those documents, notify the applicant of the date of filing of the application.

(7) Where an application for a patent has a date of filing under subsection (1) by reason only that the documents filed at the Registry to initiate the application satisfy the conditions in subsection (1)(a), (b) and (c)(ii), the applicant shall, within such period as may be prescribed, file at the Registry —

(a) a written notice confirming that the description of the invention for which the patent is sought is incorporated in the application by reference to the earlier relevant application referred to in subsection (1)(c)(ii)(C);

(b) the description of the invention for which the patent is sought; and

(c) such other documents as may be prescribed.

(8) If an application for a patent has a date of filing by virtue of subsection (1), the applicant files at the Registry any missing part of the application within such period and in such manner as may be prescribed, and the applicant does not withdraw that missing part before the end of that period, then —

(a) that missing part shall be treated as included in the application; and

(b) the date of filing of the application shall be the date on which that missing part is filed at the Registry.

(9) Subsection (8)(b) does not apply if —

(a) on or before the date which is the date of filing of the application for a patent by virtue of subsection (1), a declaration is made under section 17(2), in or in connection with the application, specifying an earlier relevant application; and

(b) within such period as may be prescribed, the applicant —

(i) makes a request to the Registrar for subsection (8)(b) not to apply to the application;

(ii) files a statement that the missing part referred to in subsection (8) is incorporated in the application by reference to, and is completely contained in, the earlier relevant application, as filed;

(iii) furnishes such information on the earlier relevant application as may be prescribed; and

(iv) files such other documents as may be prescribed.

(10) Subsections (8) and (9) do not affect the power of the Registrar under section 104(1) to correct an error or a mistake.

(11) Where, after an application for a patent has been filed and before the conditions in section 30(2) and (3) are satisfied —

(a) a new application is filed by the original applicant or his successor in title in accordance with the rules in respect of any part of the matter contained in the earlier application; and

(b) the conditions in subsection (1)*(a)*, *(b)* and *(c)(i)* or *(ii)* are satisfied in relation to the new application (without the new application contravening section 81),

the new application shall be treated as having, as its date of filing, the date of filing of the earlier application.

(12) Where an application has a date of filing by virtue of this section, the application shall be treated as having been abandoned unless —

(a) the applicant files at the Registry, before the end of such period as may be prescribed, one or more claims for the purposes of the application;

(b) the applicant pays the filing fee under section 25(1)*(b)* before the end of the period prescribed under section 25(2); and

(c) where the application has a date of filing under subsection (1) by reason only that the documents filed at the Registry to initiate the application satisfy the conditions in subsection (1)*(a)*, *(b)* and *(c)(ii)*, the applicant files at the Registry the documents referred to in subsection (7)*(a)*, *(b)* and *(c)* before the end of the period prescribed under subsection (7).

(13) In this section, "relevant application" has the same meaning as in section 17(9).

Publication of application.

27. (1) Subject to section 32, where an application has a date of filing, then, as soon as possible after the end of the prescribed period, the Registrar shall, unless the application is withdrawn in the prescribed manner, treated as having been abandoned or refused before preparations for its publication have been completed by the Registry, publish it as filed (including not only the original claims but also any amendment of those claims and new claims subsisting immediately before the completion of those preparations).

(2) The Registrar may, if so requested by the applicant, publish the application as mentioned in subsection (1) during the prescribed period, and in either event shall publish the fact and date of its publication in the journal.

(3) The Registrar may omit from the specification of a published application for a patent any matter —

(a) which in his opinion disparages any person in a way likely to damage him; or

(b) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour.

PART VI

PROCEDURE FOR GRANT OF PATENT

Preliminary examination.

28. (1) The Registrar shall conduct a preliminary examination of an application for a patent if —

(a) the application has a date of filing;

(b) the application has not been withdrawn or treated as abandoned;

(c) the filing fee under section 25(1)(b) has been paid;

(d) one or more claims for the purposes of the application have been filed under section 26(12)(a); and

(e) where the application has a date of filing under section 26(1) by reason only that the documents filed at the Registry to initiate the application satisfy the conditions in section 26(1)(a), (b) and (c)(ii), the documents referred to in section 26(7)(a), (b) and (c) have been filed at the Registry.

(2) If, after the Registrar has conducted a preliminary examination of an application for a patent under subsection (1), the applicant files at the Registry, and does not withdraw, any missing part of the application in accordance with section 26(8), then the Registrar shall conduct another preliminary examination of the application, with the missing part treated as included in the application.

(3) On a preliminary examination of an application, the Registrar shall determine —

(a) whether the application complies with all the formal requirements;
and

(b) whether —

- (i) any drawing referred to in the application; or
- (ii) any part of the description of the invention for which the patent is sought,

is missing from the application.

(4) If the Registrar determines under subsection (3)(a) that not all the formal requirements have been complied with, then the Registrar shall notify the applicant accordingly and shall specify in the notification a period during which the applicant shall have the opportunity —

- (a) to make observations on the Registrar's determination; and
- (b) subject to section 81, to amend the application so as to comply with all the formal requirements.

(5) Where subsection (4) applies, the Registrar may refuse the application if the applicant fails to amend the application as mentioned in paragraph (b) of that subsection before the end of the period specified by the Registrar under that subsection.

(6) Subsection (5) does not apply if —

- (a) the applicant makes observations as mentioned in subsection (4)(a) before the end of the period specified by the Registrar under subsection (4); and
- (b) as a result of the observations, the Registrar is satisfied that all the formal requirements have been complied with.

(7) If the Registrar determines under subsection (3)(b) that a drawing or part of the description of the invention is missing from the application, then the Registrar shall notify the applicant accordingly.

(8) Where subsection (7) applies, if the applicant files the drawing or part of the description of the invention that is missing from the application within such period and in such manner as may be prescribed, and the applicant does not withdraw that drawing or part of the description of the invention before the end of that period, then —

- (a) that drawing or part of the description of the invention shall be treated as included in the application; and
- (b) the date of filing of the application shall be the date on which that drawing or part of the description of the invention is filed at the Registry.

(9) Subsection (8)/b/ does not apply if —

(a) on or before the date which is the date of filing of the application by virtue of section 26(1), a declaration is made under section 17(2), in or in connection with the application, specifying an earlier relevant application; and

(b) within such period as may be prescribed, the applicant —

(i) makes a request to the Registrar for subsection (8)/b/ not to apply to the application; ✎

(ii) files a statement that the drawing or part of the description of the invention referred to in subsection (8) is incorporated in the application by reference to, and is completely contained in, the earlier relevant application, as filed;

(iii) furnishes such information on the earlier relevant application as may be prescribed; and

(iv) files such other documents as may be prescribed.

(10) In subsection (9), "relevant application" has the same meaning as in section 17(9).

Search and examination.

29. (1) Where an application for a patent complies with all the formal requirements, the Registrar shall send a notification to the applicant.

(2) The applicant shall comply with any of the following paragraphs which is applicable within the period prescribed for that paragraph —

(a) where the application is not an international application for a patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3), file a request in the prescribed form and pay the prescribed fee for a search report;

(b) file a request in the prescribed form and pay the prescribed fee for a search and examination report;

(c) where a corresponding application for a patent has been filed at any prescribed patent office —

(i) file —

- (A) a copy of the search report in respect of the corresponding application;
- (B) where the search report is not in the English language, an English translation of the search report;
- (C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in the English language; and
- (D) a request in the prescribed form for an examination report,

and pay the prescribed fee for an examination report; or

(ii) file —

- (A) in the prescribed form, the prescribed information relating to the corresponding application; and
- (B) where the prescribed information includes any document that is not in the English language, an English translation of such document;

(d) where a corresponding international application for a patent has been filed —

(i) file —

- (A) a copy of the international search report in respect of the corresponding international application;
- (B) where the international search report is not in the English language, an English translation of the international search report;
- (C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in the English language; and
- (D) a request in the prescribed form for an examination report,

and pay the prescribed fee for an examination report; or

(ii) file —

- (A) in the prescribed form, the prescribed information relating to the corresponding international application; and
- (B) where the prescribed information includes any document that is not in the English language, an English translation of such document;

(e) where the application is an international application for a patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3) —

(i) file —

- (A) a copy of the international search report issued in respect of the application;
- (B) where the international search report is not in the English language, an English translation of the international search report;
- (C) a copy of each prescribed document and, where required by the rules, an English translation of the document if it is not in the English language; and
- (D) a request in the prescribed form for an examination report,

and pay the prescribed fee for an examination report; or

(ii) file a notice in the prescribed form of the applicant's intention to rely on the international preliminary report on patentability in respect of that application.

(3) Where the applicant has filed a request and paid the prescribed fee for a search report under subsection (2)(a), the Registrar shall —

(a) cause the application to be subjected to a search by an Examiner to discover the relevant prior art contained in —

- (i) such documentation as may be prescribed; and
- (ii) any additional documentation that the Examiner is aware of and considers to be relevant; and

(b) upon receiving the search report prepared by the Examiner, send the applicant a notification and a copy of the search report.

(4) Upon receiving the search report under subsection (3)(b) from the Registrar, the applicant shall, within the prescribed period, file a request in the prescribed form and pay the prescribed fee for an examination report.

(5) Where the applicant has filed a request and paid the fee for an examination report under subsection (2)(c)(i), (d)(i) or (e)(i) or (4), the Registrar shall —

(a) cause the application to be subjected to an examination by an Examiner to determine —

- (i) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;
- (ii) whether the application discloses any additional matter referred to in section 81(1); and
- (iii) whether the application discloses any matter extending beyond that disclosed in the application as filed,

taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been referred to in the search report or international search report, as the case may be; and

(b) upon receiving the examination report prepared by the Examiner, send the applicant a notification and a copy of the examination report.

(6) Where the applicant has filed a request and paid the fee for a search and examination report under subsection (2)(b), the Registrar shall —

(a) cause the application to be subjected to —

- (i) a search by an Examiner to discover the relevant prior art contained in —
 - (A) such documentation as may be prescribed; and
 - (B) any additional documentation that the Examiner is aware of and considers to be relevant; and
- (ii) an examination by an Examiner to determine —
 - (A) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;
 - (B) whether the application discloses any additional matter referred to in section 81(1); and

- (C) whether the application discloses any matter extending beyond that disclosed in the application as filed,

taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been discovered in the search; and

(b) upon receiving the search and examination report prepared by the Examiner, send the applicant a notification and a copy of the search and examination report.

(7) If, within the prescribed period under —

(a) paragraph (b), (c)(i) or (ii), (d)(i) or (ii) or (e)(i) or (ii) of subsection (2);
or

(b) subsection (4),

an applicant files a request in the prescribed form and pays the prescribed fee for that period to be extended, the applicant shall perform the acts set out in that provision within the prescribed extended period for performing those acts.

Grant of patent.

30. (1) Subject to subsection (4), the Registrar shall grant the applicant a patent if —

(a) the conditions in subsection (2) are satisfied before the end of the prescribed period or any extension thereof; and

(b) the conditions in subsection (3) have been satisfied.

(2) The conditions referred to in subsection (1)(a) are —

(a) that all the formal requirements have been complied with;

(b) that the Registrar has received —

(i) the search report referred to in section 29(3) and the examination report referred to in section 29(5);

(ii) the search and examination report referred to in section 29(6);

(iii) the search report referred to in section 29(2)(c)(i), the examination report referred to in section 29(5) and, where the search report is not in the English language, an English translation of the search report;

- (iv) the prescribed information referred to in section 29(2)(c)(ii) or (d)(ii) and, where the prescribed information includes any document that is not in the English language, an English translation of such document;
 - (v) the international search report referred to in section 29(2)(d)(i) or (e)(i), the examination report referred to in section 29(5) and, where the international search report is not in the English language, an English translation of the international search report; or
 - (vi) in the case of an international application for a patent (Brunei Darussalam) which has entered the national phase in Brunei Darussalam under section 83(3), as an alternative to the document or documents referred to in any of sub-paragraphs (ii), (iii), (iv) and (v) —
 - (A) the notice referred to in section 29(2)(e)(ii);
 - (B) an international search report in respect of that application;
 - (C) an international preliminary report on patentability in respect of that application; and
 - (D) where any report referred to in sub-paragraph (B) or (C) is not in the English language, an English translation of that report;
- (c) that the prescribed documents for the grant of the patent have been filed; and
- (d) that the prescribed fee for the grant of the patent has been paid.
- (3) The conditions referred to in subsection (1)(b) are —
- (a) that —
 - (i) the document or documents received by the Registrar under subsection (2)(b) do not disclose any unresolved objection on the ground that the claim or claims in the application do not relate to one invention or to a group of inventions which are so linked as to form a single inventive concept; or
 - (ii) if any such objection is disclosed, the applicant has satisfied the Registrar that the objection has been resolved;

(b) where the applicant relies on any examination report referred to in section 29(5), any search and examination report referred to in section 29(6) or any international preliminary report on patentability referred to in subsection (2)(b)(vi), that each claim in the application at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid is related to at least one claim in the application at the time the report was issued —

(i) which has been examined; and

(ii) which is referred to in the report;

(c) where the applicant relies on the prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii) or the prescribed information relating to a corresponding international application referred to in section 29(2)(d)(ii), at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid, that each claim in the application is related to at least one claim —

(i) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and

(ii) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility);

(d) that the invention is not an invention referred to in section 13(2); and

(e) that there is —

(i) no other application for a patent for the same invention having the same priority date filed by the same applicant or his successor in title; and

(ii) no earlier grant of a patent for the same invention having the same priority date to the same applicant or his successor in title.

(4) If, within the prescribed period under subsection (1)(a) —

(a) an appeal is filed in court in respect of an application; and

(b) the applicant applies to the court to extend that period while the appeal is pending,

the court may extend that period to such date as the court may determine.

(5) Where the conditions in subsection (2) are not satisfied before the end of the prescribed period under subsection (1)(a) or any extension thereof, the applicant shall be deemed to have abandoned his application at the end of that period.

(6) If the Registrar is of the opinion that any condition in subsection (3) has not been satisfied —

(a) the Registrar shall send a notification to the applicant setting out the grounds for the Registrar's objection to granting a patent;

(b) the applicant shall have the right to respond to the Registrar's objection within a period specified by the Registrar;

(c) unless the Registrar withdraws his objection, the applicant shall, within a period specified by the Registrar and subject to section 81, amend the specification of his application in accordance with the prescribed conditions, with a view to satisfying the conditions in subsection (3); and

(d) if any condition in subsection (3) remains unsatisfied at the end of the period referred to in paragraph (c), the applicant shall be deemed to have abandoned his application at the end of that period.

General power to amend application before grant.

31. (1) If it appears to an Examiner during the examination of an application that —

(a) the conditions specified in sections 13 and 25(4) and (5) have not been complied with; or

(b) the application discloses —

(i) any additional matter referred to in section 81(1); or

(ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall give the applicant at least one written opinion to that effect, and the Registrar shall, upon receiving the written opinion, send the applicant a notification and a copy of the written opinion.

(2) The applicant shall, before the examination report is issued, have the right —

(a) to respond in the prescribed manner to the written opinion within any prescribed period; and

(b) subject to section 81, to amend in the prescribed manner the specification of the application in accordance with the prescribed conditions.

(3) Notwithstanding subsection (1), during any period prescribed for the purposes of this subsection, the applicant may, in accordance with the prescribed conditions and subject to section 81, amend the application of his own volition.

Information prejudicial to defence of Brunei Darussalam or safety of public.

32. (1) Where an application for a patent is filed in the Registry (whether under this Order or any treaty or international convention to which Brunei Darussalam is a party) and it appears to the Registrar that the application contains information of a description notified to him by the Minister as being information the publication of which might be prejudicial to the defence of Brunei Darussalam, the Registrar shall give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons.

(2) If it appears to the Registrar that any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give directions prohibiting or restricting the publication of that information or its communication to any specified person or description of persons until the end of a period not exceeding 3 months from the end of a period prescribed for the purposes of section 27.

(3) While directions are in force under this section with respect to an application —

(a) if the application is made under this Order, it will be held in abeyance after the formal requirements of this Order and the rules have been met and will not proceed to be processed in accordance with section 29 until the directions are revoked under subsection (4)(e); and

(b) if it is an international application for a patent, a copy of it shall not be sent to the International Bureau or any international searching authority appointed under the Patent Co-operation Treaty.

(4) Where the Registrar gives directions under this section with respect to any application, he shall give notice of the application and of the directions to the Minister, and the following provisions shall then have effect —

(a) the Minister shall, on receipt of the notice, consider whether the publication of the application or the publication or communication of the information in question would be prejudicial to the defence of Brunei Darussalam or the safety of the public;

(b) if the Minister determines under paragraph (a) that the publication or communication of that information would be prejudicial to the safety of the public, he shall notify the Registrar who shall continue his directions under subsection (2) until they are revoked under paragraph (e);

(c) if the Minister determines under paragraph (a) that the publication of the application or the publication or communication of that information would be prejudicial to the defence of Brunei Darussalam or the safety of the public, he shall (unless a notice under paragraph (d) has previously been given by the Minister to the Registrar) reconsider that question during the period of 9 months from the date of filing the application and at least once in every subsequent period of 12 months;

(d) if on consideration of an application at any time it appears to the Minister that the publication of the application or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the defence of Brunei Darussalam or the safety of the public, he shall give notice to the Registrar to that effect; and

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

(5) The Minister may at any time, for the purpose of enabling him to decide the question referred to in subsection (4)(c), do one or both of the following, that is to say, inspect or authorise any person to inspect the application and any document sent to the Registrar in connection with it and where a person is authorised to carry out such inspection, he shall as soon as practicable report on his inspection to the Minister.

(6) Where directions given under this section in respect of an application for a patent for an invention are revoked, and the application is brought in order for the grant of a patent and a patent is granted for the invention, then —

(a) if while the directions are in force the invention is worked by (or with the written authorisation of or to the order of) a Government department, the provisions of Part XII shall apply as if —

- (i) the working were use made by section 58;
- (ii) the application had been published at the end of the prescribed period or at the time the directions were revoked, whichever is earlier; and
- (iii) a patent had been granted for the invention at the time the application is brought in order for the grant of a patent (taking the terms of the patent to be those of the application as it stood at the time it was so brought in order); and

(b) if it appears to the Minister that the applicant for the patent has suffered hardship while the directions were in force, the Minister may make such payment (if any) by way of compensation to the applicant as appears to the Minister to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(7) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.

(8) Any person who fails to comply with any direction under this section is guilty of an offence and liable on conviction to a fine not exceeding \$5,000, imprisonment for a term not exceeding 2 years or both.

(9) Nothing in this section shall prevent the disclosure of information concerning an invention to a Government department or authority for the purpose of obtaining advice as to whether directions under this section with respect to an application for a patent for that invention should be made, amended or revoked.

Restrictions on applications abroad by Brunei Darussalam residents.

33. (1) Subject to this section, no person resident in Brunei Darussalam shall, without written authority granted by the Registrar, file or cause to be filed outside Brunei Darussalam an application for a patent for an invention unless —

(a) an application for a patent for the same invention has been filed in the Registry not less than 2 months before the application outside Brunei Darussalam; and

(b) no directions have been given under section 32 in relation to the application in Brunei Darussalam or all such directions have been revoked.

(2) Subsection (1) does not apply to an application for a patent for an invention for which an application for a patent has first been filed in a country outside Brunei Darussalam by a person resident outside Brunei Darussalam.

(3) Any person who files or causes to be filed an application for the grant of a patent in contravention of this section is guilty of an offence and liable on conviction to a fine not exceeding \$5,000, imprisonment for a term not exceeding 2 years or both.

(4) In this section —

(a) any reference to an application for a patent includes a reference to an application for other protection for an invention;

(b) any reference to either kind of application is a reference to an application under this Order, under the law of any country other than Brunei Darussalam or under any treaty or international convention to which Brunei Darussalam is a party; and

(c) "person resident in Brunei Darussalam" includes a person who, at the material time, is residing in Brunei Darussalam by virtue of a valid pass lawfully issued to him under the Immigration Act (Chapter 17) to enter and remain in Brunei Darussalam for any purpose.

PART VII

PROVISIONS AS TO PATENTS AFTER GRANT

Publication and certificate of grant.

34. (1) As soon as practicable after a patent has been granted under this Order, the Registrar shall —

(a) send to the proprietor of the patent a certificate in the prescribed form that the patent has been granted to the proprietor; and

(b) publish in the journal a notice that the patent has been granted.

(2) The Registrar shall, at the same time as he publishes a notice under subsection (1)(b) in relation to a patent, publish the specification of the patent, the names of the proprietor and (if different) the inventor and any other matters (including the prescribed information under sections 29 and 30) constituting or relating to the patent which in the Registrar's opinion it is desirable to publish.

Term of patent.

35. (1) A patent granted under this Order shall be treated for the purposes of this Order as having been granted, and shall take effect, on the date of issue of the certificate of grant and, subject to subsection (2) and section 36, shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent or with such other date as may be prescribed.

(2) A patent shall cease to have effect at the end of the prescribed period for the payment of any renewal fee if it is not paid within that period.

(3) If during the period of 6 months immediately following the end of the prescribed period the renewal fee and any prescribed additional fee are paid, the patent shall be treated for the purposes of this Order as if it had never expired, and accordingly —

(a) anything done under or in relation to it during that further period shall be valid;

(b) an act which would constitute an infringement of it if it had not expired shall constitute such an infringement; and

(c) an act which would constitute the use of the patented invention in accordance with section 58 if the patent had not expired shall constitute that use.

(4) Rules shall include provision requiring the Registrar to notify the registered proprietor of a patent that a renewal fee has not been received from him in the Registry before the end of the prescribed period and before the framing of the notification.

Extension of term of patent.

36. (1) The proprietor of a patent may apply to the Registrar to extend the term of the patent on any of the following grounds —

(a) that there was an unreasonable delay by the Registrar in granting the patent;

(b) where the patent was granted on the basis of prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii), that —

(i) there was an unreasonable delay in the issue of the corresponding patent; and

- (ii) the patent office that granted the corresponding patent has extended the term of the corresponding patent on the basis of such delay;

(c) where the subject of the patent includes any substance which is an active ingredient of any pharmaceutical product, that —

- (i) there was an unreasonable curtailment of the opportunity to exploit the patent caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient; and
- (ii) the term of the patent has not previously been extended on this ground.

(2) A delay by the Registrar in granting a patent shall not be treated as an unreasonable delay under subsection (1)(a) unless —

(a) the interval between the date of filing of the application for the patent and the date of issue of the certificate of grant, excluding any period attributable to an act or omission of the applicant, exceeds 4 years; or

(b) the interval between the date on which the applicant —

- (i) filed a request for a search and examination report in accordance with section 29(2)(b); or
- (ii) filed a request for an examination report in accordance with section 29(2)(c)(i), (d)(i) or (e)(i) or (4),

and the date of issue of the certificate of grant, excluding any period attributable to an act or omission of the applicant, exceeds 2 years.

(3) Where the proprietor of a patent has made an application under subsection (1)(a) and has satisfied the Registrar that there was in fact an unreasonable delay under subsection (1)(a), the Registrar shall extend the term of the patent —

(a) in a case to which subsection (2)(a) applies, by the period by which the interval referred to in subsection (2)(a) exceeds 4 years;

(b) in a case to which subsection (2)(b) applies, by the period by which the interval referred to in subsection (2)(b) exceeds 2 years; or

(c) in a case to which both paragraphs (a) and (b) of subsection (2) apply, by the period by which —

(i) the interval referred to in subsection (2)(a) exceeds 4 years; or

(ii) the interval referred to in subsection (2)(b) exceeds 2 years,

whichever is the longer period.

(4) Where the proprietor of a patent has made an application under subsection (1)(b) and has satisfied the Registrar of the matters referred to in sub-paragraphs (i) and (ii) of subsection (1)(b), the Registrar may, if the Registrar thinks fit, extend the term of the patent by such period, not exceeding 5 years, as the Registrar may determine.

(5) A curtailment of the opportunity to exploit a patent, the subject of which includes a substance which is an active ingredient of any pharmaceutical product, caused by the process of obtaining marketing approval for a pharmaceutical product, being the first pharmaceutical product to obtain marketing approval which uses the substance as an active ingredient, shall not be treated as an unreasonable curtailment under subsection (1)(c) unless —

(a) the marketing approval was obtained after the date of issue of the certificate of grant; and

(b) the interval between the date the application for marketing approval was filed and the date marketing approval was obtained, excluding any period attributable to an act or omission of the applicant for marketing approval, exceeds 2 years.

(6) Subject to subsections (7), (8) and (9), where the proprietor of a patent has made an application under subsection (1)(c) and has satisfied the Registrar that there was in fact an unreasonable curtailment of the opportunity to exploit the patent under subsection (1)(c), the Registrar shall extend the term of the patent by —

(a) a period equivalent to the interval between the date of issue of the certificate of grant and the date marketing approval was obtained;

(b) the period by which the interval referred to in subsection (5)(b) exceeds 2 years; or

(c) a period of 5 years,

whichever is the shortest period.

(7) The Registrar shall not extend the term of the patent under subsection (6) unless the applicant has procured and submitted to the Registrar a certificate from the relevant authority stating —

(a) the date the application for marketing approval was filed;

(b) the date marketing approval was obtained; and

(c) for each period attributable to an act or omission of the applicant for marketing approval, the dates on which the period started and ended.

(8) In determining the period by which to extend the term of the patent under subsection (6), the Registrar shall rely on, and shall not be concerned to inquire into the truth of, the statements contained in the certificate from the relevant authority under subsection (7).

(9) Where the term of a patent has been extended under subsection (6), the protection conferred by the patent during the term of the extension shall apply only to the substance referred to in subsection (1)(c).

(10) Every application to extend the term of a patent shall be —

(a) made by the proprietor of the patent in the prescribed form within the prescribed period;

(b) filed in the prescribed manner; and

(c) accompanied by the prescribed fee and any prescribed documents,

and the Registrar may reject any application that fails to comply with any requirement under this subsection.

(11) As soon as practicable after the Registrar has extended the term of a patent, he shall —

(a) send to the proprietor of the patent a certificate of extension of patent term in the prescribed form specifying —

(i) the period of the extension; and

(ii) any limitation on the protection conferred by the patent during the term of the extension; and

(b) publish in the journal a notice of the extension.

(12) The proprietor of a patent who has made an application under subsection (1) may withdraw the application by informing the Registrar in writing

of the withdrawal of the application, and any such withdrawal shall not be revocable.

[13] In subsection (2), "period attributable to an act or omission of the applicant" includes (without prejudice to the generality of the expression) any of the following periods which is applicable —

(a) the period taken by the applicant to pay the filing fee under section 25(1)(b), calculated from the date of filing of the application for the patent to the date on which the filing fee is paid;

(b) the period taken by the applicant to make observations under section 26(3)(b)(i) which satisfy the Registrar that the documents filed at the Registry to initiate the application satisfy all of the conditions in section 26(1)(a), (b) and (c)(i) or (ii), calculated from the date of the Registrar's notification to the applicant under section 26(3)(a) to the date on which the applicant makes the observations;

(c) the period taken by the applicant to file the documents referred to in section 26(7)(a), (b) and (c), calculated from the date of filing of the application for a patent to the date on which the applicant files the documents;

(d) the period taken by the applicant to comply with section 26(9)(b), if the applicant, after filing at the Registry any missing part of the application, makes a request to the Registrar for section 26(8)(b) not to apply to the application, calculated from the date on which the applicant filed at the Registry the missing part of the application to the date on which the applicant complies with section 26(9)(b);

(e) the period taken by the applicant to file one or more claims for the purposes of the application under section 26(12)(a), calculated from the date of filing of the application for the patent to the date on which the applicant files the claim or claims;

(f) the period taken by the applicant to —

(i) make observations under section 28(4)(a) which satisfy the Registrar that all the formal requirements have been complied with; or

(ii) amend his application under section 28(4)(b) to comply with all the formal requirements,

calculated from the date of the Registrar's notification under section 28(4) to the date on which the applicant makes the observations or the earliest date

on which the application, as amended by the applicant, complies with all the formal requirements;

(g) the period taken by the applicant to comply with section 28(9)(b), if the applicant, after filing any drawing or part of the description of the invention which is missing from the application, makes a request to the Registrar for section 28(8)(b) not to apply to the application, calculated from the date of the Registrar's notification under section 28(7) to the date on which the applicant complies with section 28(9)(b);

(h) the period taken by the applicant to —

- (i) file a request and pay the prescribed fee for a search report under section 29(2)(a); or
- (ii) file a request and pay the prescribed fee for a search and examination report under section 29(2)(b),

calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the request and pays the fee;

(i) the period taken by the applicant to file the documents referred to in section 29(2)(c)(i), (d)(i) or (e)(i) and pay the prescribed fee for an examination report, calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the documents and pays the fee;

(j) the period taken by the applicant to file the documents referred to in section 29(2)(c)(ii) or (d)(ii), calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the documents;

(k) the period taken by the applicant to file a notice under section 29(2)(e)(ii), calculated from the date of the Registrar's notification under section 29(1) to the date on which the applicant files the notice;

(l) the period taken by the applicant to file a request for an examination report under section 29(4), calculated from the date of the Registrar's notification under section 29(3)(b) to the date on which the applicant files the request;

(m) the period taken by the applicant to file the prescribed documents under section 30(2)(c) and pay the prescribed fee under section 30(2)(d) for the grant of the patent, calculated from —

- (i) in a case to which section 30(2)(b)(i), (iii) or (v) applies, the date of the Registrar's notification under section 29(5);

(ii) in a case to which section 30(2)(b)(ii) applies, the date of the Registrar's notification under section 29(6);

(iii) in a case to which section 30(2)(b)(iv) applies, the date on which the applicant files the documents referred to therein; or

(iv) in a case to which section 30(2)(b)(vi) applies, the date on which the applicant files the notice under section 29(2)(e)(ii),

to the date on which the prescribed documents under section 30(2)(c) are filed and the prescribed fee under section 30(2)(d) is paid;

(n) the period taken by the applicant to rectify any failure to satisfy any condition under section 30(3), calculated from the date of the Registrar's notification under section 30(6)(a) to the date on which every condition in section 30(3) is satisfied;

(o) the period taken by the applicant to respond to a written opinion under section 31(2)(a), calculated from the date of the Registrar's notification under section 31(1) to the date on which the applicant responds to the written opinion;

(p) the period taken by the applicant to amend the specification of his application under section 31(2)(b), calculated from the date of the written opinion given under section 31(1) to the date on which the applicant amends the specification of his application;

(q) where the application is an international application for a patent (Brunei Darussalam) that has entered the national phase in Brunei Darussalam under section 83(3), the period taken by the applicant to cause the application to enter the national phase in Brunei Darussalam, calculated from the date of the filing of the application in accordance with the Patent Co-operation Treaty to the date on which the national phase of the application begins under section 83(3);

(r) the period taken by the applicant to rectify any failure to comply with any requirement under this Order or the rules, such period —

(i) to be calculated from the date by which the applicant is required to comply with the requirement to the date on which the applicant rectifies the failure to comply with the requirement; and

(ii) to include any period taken by the Registrar or the Registry to detect or to notify the applicant of the applicant's failure to comply with the requirement;

(s) the period taken by the applicant to respond to any request by the Registrar for any document, information or evidence, calculated from the date of the Registrar's notification to the applicant of the request to the date on which the applicant responds to the request;

(t) any extension or alteration of any period to do any thing that is granted by the Registrar or the court at the request or on the application of the applicant.

(14) In subsections (5) and (7), "period attributable to an act or omission of the applicant for marketing approval" includes (without prejudice to the generality of the expression) —

(a) the period taken by the applicant for marketing approval to correct deficiencies in his application for marketing approval, calculated from the date of the relevant authority's notification to the applicant for marketing approval of the deficiencies to the date on which the applicant for marketing approval corrects the deficiencies;

(b) the period taken by the applicant for marketing approval to respond to any request by the relevant authority for clarification or information, calculated from the date of the relevant authority's request to the date on which the relevant authority receives the response of the applicant for marketing approval; and

(c) any extension of any period to do any thing that is granted by the relevant authority at the request or on the application of the applicant for marketing approval.

Patent not to be impugned for lack of unity.

37. No person may in any proceeding object to a patent or to an amendment of a specification of a patent on the ground that the claims contained in the specification of the patent, as they stand or, as the case may be, as proposed to be amended, relate —

(a) to more than one invention; or

(b) to a group of inventions which are not so linked as to form a single inventive concept.

General power to amend specification after grant.

38. (1) Subject to this section and section 81, the Registrar may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

(2) No such amendment shall be allowed under this section where there are pending before the court or the Registrar proceedings in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed to have had effect from the grant of the patent.

(4) A person may give notice to the Registrar of his opposition to an application under this section by the proprietor of a patent, and if he does so the Registrar shall notify the proprietor and consider the opposition in deciding whether to grant the application.

Search and examination after grant.

39. (1) Subject to subsection (2), any person may request for a search and examination report in respect of any claim or claims in the specification of a patent on any of the following grounds —

(a) where the patent was granted on the basis of any examination report or search and examination report referred to in section 29, any international preliminary report on patentability referred to in section 30(2)(b)(vi) or any international preliminary examination report, that —

(i) at least one claim in the application for the patent at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid was not related to any claim in the application at the time the report was issued —

(A) which has been examined; and

(B) which is referred to in the report; or

(ii) the Examiner of the application did not consider all the relevant prior art before preparing the report;

(b) where the patent was granted on the basis of any prescribed information relating to a corresponding application or corresponding international application referred to in section 29, that —

- (i) at the time the prescribed documents for the grant of the patent were filed and the prescribed fee for the grant of the patent was paid, at least one claim in the application for the patent did not relate to any claim —
 - (A) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and
 - (B) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility); or
 - (ii) the Examiner of the corresponding application or corresponding international application, as the case may be, did not consider all the relevant prior art before preparing his report on the examination of the corresponding application or corresponding international application, as the case may be.
- (2) The Registrar shall not grant a request under subsection (1) unless —
- (a) the request is filed in the prescribed manner;
 - (b) the prescribed fee for the search and examination report has been paid; and
 - (c) in a case to which subsections (3) and (4) apply, subsection (4) has been complied with.
- (3) Subject to subsection (4), any person who files a request under subsection (1) may, at the time he files the request, also file —
- (a) any observation which he wishes to make in relation to the patent; and
 - (b) any document which he considers to be relevant for the purposes of the examination.
- (4) Where any document referred to in subsection (3)(b) is not in the English language, the person who files the request under subsection (1) shall also file an English translation of the document.
- (5) The Registrar shall not grant a request under subsection (1) if he is of the view that the request is frivolous, vexatious or an abuse of the process.

(6) No request under subsection (1) shall be filed or granted where there are pending before the court or the Registrar proceedings in which the validity of the patent may be put in issue.

(7) Where the Registrar grants a request under subsection (1), the Registrar shall cause the claim or claims to be subjected to —

(a) a search by an Examiner to discover the relevant prior art contained in —

- (i) such documentation as may be prescribed; and
- (ii) any additional documentation that the Examiner is aware of and considers to be relevant; and

(b) an examination by an Examiner to determine —

- (i) whether the conditions specified in sections 13 and 25(4) and (5) have been complied with;
- (ii) whether the specification of the patent discloses any additional matter referred to in section 81(1); and
- (iii) whether the specification of the patent discloses any matter extending beyond that disclosed in the application for the patent as filed,

taking into consideration all the relevant prior art, if any, that the Examiner is aware of or that has been discovered in the search.

(8) If it appears to the Examiner during the examination of the specification of the patent that —

(a) the conditions specified in sections 13 and 25(4) and (5) have not been complied with; or

(b) the specification of the patent discloses —

- (i) any additional matter referred to in section 81(1); or
- (ii) any matter extending beyond that disclosed in the application for the patent as filed,

the Examiner shall give the proprietor of the patent a written opinion to that effect, and the proprietor of the patent shall, before the examination report is issued, have the right to respond in the prescribed manner to the written opinion within the prescribed period.

(9) Upon receiving the search and examination report prepared by the Examiner, the Registrar shall —

(a) send a copy of the report to the proprietor of the patent; and

(b) where the request under subsection (1) is not filed by the proprietor of the patent, send a copy each of —

(i) the report;

(ii) any written opinion given by the Examiner; and

(iii) any response given in the prescribed manner by the proprietor of the patent to any such written opinion,

to the person who filed the request.

Restoration of lapsed patents.

40. (1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee, an application for the restoration of the patent may be made to the Registrar within the prescribed period.

(2) An application under this section may be made by the person who was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect.

(3) Where the patent was held by 2 or more persons jointly, the application may, with the leave of the Registrar, be made by one or more of them without joining the others.

(4) Notice of the application shall be published by the Registrar in the prescribed manner.

(5) If the Registrar is satisfied that the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that that fee and any prescribed additional fee were paid within the 6 months immediately following the end of that period, the Registrar shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

(6) An order under this section may be made subject to such conditions as the Registrar thinks fit (including a condition requiring compliance with any provision of the rules relating to registration which have not been complied with), and if the proprietor of the patent does not comply with any such condition of the order, the Registrar may revoke the order and give such directions consequential on the revocation as he thinks fit.

(7) The effect of an order for the restoration of a patent shall be as provided in subsections (8) to (13).

(8) Anything done under or in relation to the patent during the period between expiry and restoration shall be treated as valid.

(9) Anything done during that period which would have constituted an infringement if the patent had not expired shall be treated as an infringement —

(a) if done at a time when it was possible for the patent to be renewed under section 36(3);

(b) if it was a continuation or repetition of an earlier infringing act.

(10) If after it was no longer possible for the patent to be so renewed, and before publication of notice of the application for restoration, a person —

(a) began in good faith to do an act which would have constituted an infringement of the patent if it had not expired; or

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

he has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the restoration of the patent.

(11) The right referred to in subsection (10) does not extend to granting a licence to another person to do the act.

(12) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (10) may —

(a) authorise the doing of that act by any partner of his for the time being in that business; and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(13) Where a product is disposed of to another in exercise of the rights conferred by subsection (10) or (12), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

(14) Subsections (8) to (13) shall apply in relation to the use of a patent in accordance with section 58 as they apply in relation to infringement of the patent.

Surrender of patents.

41. (1) The proprietor of a patent may at any time by notice given to the Registrar offer to surrender his patent.

(2) A person may give notice to the Registrar of his opposition to the surrender of a patent under this section, and if he does so the Registrar shall notify the proprietor of the patent and determine the question.

(3) If the Registrar is satisfied that the patent may properly be surrendered, he may accept the offer and, as from the date when notice of his acceptance is published in the journal, the patent shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date in accordance with section 58.

PART VIII

PROPERTY IN PATENTS AND APPLICATIONS FOR PATENTS AND REGISTRATION

Nature of, and transactions in, patents and applications for patents.

42. (1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with this section.

(2) Subject to section 47(3), any patent or any such application, or any right in it, may be assigned or mortgaged.

(3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(4) Subject to section 47(3), a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application; 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 vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.

(5) Subsections (2) to (4) shall have effect subject to the provisions of this Order.

(6) Any of the following transactions, that is to say —

(a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;

(b) any assent relating to any patent or any such application or right,

shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.

(7) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 65 or 74 for a previous infringement or to bring the proceedings under section 60 for a previous act.

Register of patents.

43. (1) The Registrar shall maintain a register of patents in accordance with the rules made by virtue of this section.

(2) Without prejudice to any other provisions of this Order or the rules, the rules may make provision with respect to the following matters, including provision imposing requirements as to any of those matters —

(a) the registration of patents and of published applications for patents;

(b) the registration of transactions, instruments or events affecting rights in or under patents and applications;

(c) the furnishing to the Registrar of any prescribed document or description of documents in connection with any matter which is required to be registered;

(d) the correction of errors in the register and in any document filed at the Registry in connection with registration; and

(e) the publication and advertisement of anything done under this Order or the rules in relation to the register.

(3) Notwithstanding anything in subsection (2)(b), no notice of any trust, whether 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.

(5) Subject to the rules, the public shall have a right to inspect the register at the Registry at all convenient times.

(6) 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 a fee prescribed in relation to certified copies and extracts.

(7) The rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(8) Applications under subsection (6) or the rules made by virtue of subsection (7) shall be made in such manner as may be prescribed.

(9) In relation to any portion of the register kept otherwise than in documentary form —

(a) the right of inspection conferred by subsection (5) is a right to inspect the material on the register; and

(b) the right to a copy or extract conferred by subsection (6) or the rules 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.

Effects of registration etc. on rights in patents.

44. (1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property 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) the earlier transaction, instrument or event was not registered;

(b) in the case of any application which has not been published, notice of the earlier transaction, instrument or event had not been given to the Registrar; and

(c) in any case, the person claiming under the later transaction, instrument or event did not know of the earlier transaction, instrument or event.

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent, 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 shall apply to the following transactions, instruments and events —

(a) the assignment of a patent or application for a patent, or a right in it;

(b) the mortgage of a patent or application;

(c) the grant or assignment of a licence or sub-licence, or mortgage of a licence or sub-licence, under a patent or application;

(d) the death of the proprietor or one of the proprietors of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right; and

(e) any order or directions of a court or other competent authority —

(i) transferring a patent or application or any right in or under it to any person; or

(ii) that an application should proceed in the name of any person,

and in either case the event by virtue of which the court or authority had power to make any such order or give any such directions.

(4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a), registration of the application shall be treated as registration of the transaction, instrument or event.

Rectification of register.

45. (1) The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.

(2) In proceedings under this section, the court may determine any question which may be necessary or expedient to decide in connection with the rectification of the register.

Evidence of register, documents etc.

46. (1) The register shall be *prima facie* evidence of anything required or authorised by this Order or the rules to be registered.

(2) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorised by this Order or 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 matter so certified.

(3) Each of the following, that is to say —

(a) a copy of an entry in the register or an extract from the register which is supplied under section 43(6);

(b) a copy of any document kept in the Registry or an extract from any such document; or

(c) any specification of a patent or any application for a patent which has been published,

which purports to be a certified copy or a certified extract shall be admitted in evidence without further proof and without production of the original.

(4) In this section, "certified copy" and "certified extract" mean a copy and an extract certified by the Registrar and sealed with the seal of the Registry.

Co-ownership of patents and applications for patents.

47. (1) Where a patent is granted to 2 or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Where 2 or more persons are proprietors of a patent, then, subject to this section and subject to any agreement to the contrary —

(a) each of them shall be entitled, by himself or his agents, to do in respect of the invention, for his own benefit and without the consent of or the need to account to the other or others, any act which would, apart from this subsection and section 58, amount to an infringement of the patent; and

(b) any such act shall not amount to an infringement of the patent.

(3) Subject to sections 20 and 48 and to any agreement for the time being in force, where 2 or more persons are proprietors of a patent, one of them shall not without the consent of the other or others grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to sections 20 and 48 where 2 or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the

supply of those means by virtue of this subsection shall not amount to an infringement of the patent.

(5) Where a patented product is disposed of by any of 2 or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) This section shall have effect in relation to an application for a patent which is filed as it has effect in relation to a patent and —

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) to a patented product shall be construed accordingly.

Determination of right to patent after grant.

48. (1) After a patent has been granted for an invention, any person having or claiming a proprietary interest in or under the patent may refer to the Registrar the question —

(a) who is or are the true proprietor or proprietors of the patent;

(b) whether the patent should have been granted to the person or persons to whom it was granted; or

(c) whether any right in or under the patent should be transferred or granted to any other person or persons,

and the Registrar shall determine the question and make such order as he 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 person by whom the reference is made under that subsection shall be included (whether or not to the exclusion of any other person) among the persons registered as proprietors of the patent;

(b) directing the registration of a transaction, instrument or event by virtue of which that person has acquired any right in or under the patent;

(c) granting any licence or other right in or under the patent; and

(d) directing the proprietor of the patent or any person having any right in or under the patent to do anything specified in the order as necessary to carry out the other provisions of the order.

(3) If any person to whom directions have been given under subsection (2)(d) fails to do anything necessary for carrying out any such directions within 14 days after the date of the order containing the directions, the Registrar may, on an application made to him by any person in whose favour or on whose reference the order containing the directions was made, authorise him to do that thing on behalf of the person to whom the directions were given.

(4) Where the Registrar finds on a reference under this section that the patent was granted to a person not entitled to be granted that patent (whether alone or with other persons) and on an application made under section 77 makes an order on that ground for the conditional or unconditional revocation of the patent, the Registrar may order that the person by whom the application was made or his successor in title may, subject to section 81, make a new application for a patent —

(a) in the case of unconditional revocation, for the whole of the matter comprised in the specification of that patent; and

(b) in the case of conditional revocation, for the matter which in the opinion of the Registrar should be excluded from that specification by amendment under section 80,

and where such a new application is made, it shall be treated as having been filed on the date of filing the application for the patent to which the reference relates.

(5) On any reference under subsection (1) —

(a) no order shall be made under this section transferring the patent to which the reference relates on the ground that the patent was granted to a person not so entitled; and

(b) no order shall be made under subsection (4) on that ground if the reference was made after the end of the period of 2 years beginning with the date of the grant, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

(6) An order under this section shall not be so made as to affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) Where a question is referred to the Registrar under this section, an order shall not be made by virtue of subsection (2) or under subsection (4) on the reference unless notice of the reference is given to all persons registered as proprietor of the patent or as having a right in or under the patent, except those who are parties to the reference.

(8) If it appears to the Registrar on a reference under this section that the question referred to him would more properly be determined by the court, he may decline to deal with it and, without prejudice to the court's jurisdiction to determine any such question and make a declaration, the court shall have jurisdiction to do so.

(9) The court shall not in the exercise of any such declaratory jurisdiction determine a question whether a patent was granted to a person not entitled to be granted the patent if the proceedings in which the jurisdiction is invoked were commenced after the end of the period of 2 years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent.

Effect of transfer of patent under section 48.

49. (1) Where an order is made under section 48 that a patent shall be transferred from any person or persons (the old proprietor or proprietors) to one or more persons (whether or not including an old proprietor) then, except in a case falling within subsection (2), any licences or other rights granted or created by the old proprietor or proprietors shall, subject to section 44 and to the provisions of the order, continue in force and be treated as granted by the person or persons to whom the patent is ordered to be transferred (the new proprietor or proprietors).

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

(3) Where an order is so made that —

(a) a patent shall be transferred as mentioned in subsection (2); or

(b) a person other than an old proprietor may make a new application for a patent,

and before the reference of the question under that section resulting in the making of any such order is registered, the old proprietor or proprietors or a licensee of the patent, acting in good faith —

(i) worked the invention in question in Brunei Darussalam; or

(ii) made effective and serious preparations to do so,

the old proprietor or proprietors or the licensee shall, on making a request to the new proprietor or proprietors within the prescribed period, be entitled to be granted a licence (but not an exclusive licence) to continue working or, as the case may be, to work the invention, so far as it is the subject of the new application.

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

(5) The new proprietor or proprietors of the patent or any person claiming that he is entitled to be granted any such licence may refer to the Registrar the question whether that person is so entitled and whether any such period is or terms are reasonable.

(6) The Registrar shall determine the question referred to in subsection (5) and may, if he thinks fit, order the grant of such a licence.

PART IX

EMPLOYEES' INVENTIONS

Right to employees' inventions.

50. (1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Order and all other purposes if —

(a) the invention was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or

(b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done —

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent; or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

(4) In subsection (3), the reference to application for a patent includes an application for other protection for an invention, and includes an application for a patent or any other protection under the law of a country other than Brunei Darussalam or under any treaty to which Brunei Darussalam is a party.

Supplementary provisions.

51. (1) This Part shall not apply to an invention made by an employee unless at the time he made the invention one of the following conditions was satisfied in his case —

(a) he was mainly employed in Brunei Darussalam; or

(b) he was not mainly employed anywhere or his place of employment could not be determined, but his employer had a place of business in Brunei Darussalam to which the employee was attached, whether or not he was also attached elsewhere.

(2) In this Part, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to his merely contributing advice or other assistance in the making of an invention by another employee.

(3) Any references in section 50 to a patent and to a patent being granted are respectively references to a patent or other protection and to its being granted whether under the law of Brunei Darussalam or the law in force in any other country or under any treaty or international convention.

(4) Nothing in this Part shall be construed as precluding the operation of an agreement or a contract in relation to the right to an invention.

PART X

CONTRACTS AS TO PATENTED PRODUCTS

Application of this Part.

52. This Part shall apply only to —

- (a) any contract for the supply of a patented product;
- (b) any licence to work a patented invention; and
- (c) any contract relating to any such supply or licence,

that was entered into or granted before the date of commencement of this Order.

Avoidance of certain restrictive conditions.

53. (1) Subject to this section, any condition or term of a contract for the supply of a patented product or of a licence to work a patented invention, or of a contract relating to any such supply or licence, shall be void in so far as it purports —

(a) in the case of a contract for supply, to require the person supplied to acquire from the supplier, or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the supplier or his nominee, anything other than the patented product;

(b) in the case of a licence to work a patented invention, to require the licensee to acquire from the licensor or his nominee, or prohibit him from acquiring from any specified person, or from acquiring except from the licensor or his nominee, anything other than the product which is the patented invention or (if it is a process) other than any product obtained directly by means of the process or to which the process has been applied; or

(c) in either case, to prohibit the person supplied or the licensee from using articles (whether patented products or not) which are not supplied by, or any patented process which does not belong to, the supplier or licensor, or his nominee, or to restrict the right of the person supplied or the licensee to use any such articles or process.

(2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.

(3) A condition or term of a contract or licence shall not be void by virtue of this section if —

(a) at the time of the making of the contract or granting of the licence, the supplier or licensor was willing to supply the product, or grant a licence to work the invention, as the case may be, to the person supplied or the licensee, on reasonable terms specified in the contract or licence and without any such condition or term as is mentioned in subsection (1); and

(b) the person supplied or the licensee is entitled under the contract or licence to relieve himself of his liability to observe the condition or term on giving to the other party 3 months' notice in writing, and subject to payment to that other party of such compensation (being, in the case of a contract to supply, a lump sum or rent for the residue of the term of the contract and, in the case of a licence, a royalty for the residue of the term of the licence) as may be determined by an arbitrator appointed by the Minister.

(4) If in any proceedings it is alleged that any condition or term of a contract or licence is void by virtue of this section, it shall lie on the supplier or licensor to prove the matters set out in subsection (3)(a).

(5) A condition or term of a contract or licence shall not be void by virtue of this section by reason only that it prohibits any person from selling goods other than those supplied by a specific person or, in the case of a contract for the hiring of or licence to use a patented product, that it reserves to the bailor or licensor, or his nominee, the right to supply such new parts of the patented product as may be required to put or keep it in repair.

Determination of parts of certain contracts.

54. (1) Any contract for the supply of a patented product or licence to work a patented invention, or contract relating to any such supply or licence, may at any time after the patent or all the patents by which the product or invention was protected at the time of the making of the contract or granting of the licence has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or licence or in any other contract, be determined, to the extent (and only to the extent) that the contract or licence relates to the product or invention, by either party on giving 3 months' notice in writing to the other party.

(2) In subsection (1), "patented product" and "patented invention" include respectively a product and an invention which is the subject of an application for a patent, and that subsection shall apply in relation to a patent by which any such product or invention was protected and which was granted after the time of the making of the contract or granting of the licence, on an application which had been filed before that time, as it applies to a patent in force at that time.

(3) If, on an application under this section made by either party to a contract or licence falling within subsection (1), the court is satisfied that, in consequence of the patent or patents ceasing to be in force, it would be unjust to require the applicant to continue to comply with all the terms and conditions of the contract or licence, the court may make such order varying those terms or conditions as, having regard to all the circumstances of the case, it thinks just as between the parties.

(4) Without prejudice to any other right of recovery, nothing in subsection (1) shall be taken to entitle any person to recover property let under a hire-purchase agreement within the meaning of the Hire-Purchase Order, 2006 (S 44/2006).

(5) This section shall be without prejudice to any rule of law relating to the frustration of contracts and any right of determining a contract or licence exercisable apart from this section.

PART XI

LICENCES OF RIGHT AND COMPULSORY LICENCES

Licences of right.

55. (1) At any time after the grant of a patent, its proprietor may apply to the Registrar for an entry to be made in the register to the effect that licences under the patent are to be available as of right.

(2) Where an application under subsection (1) is made, the Registrar shall give notice of the application to any person registered as having a right in or under the patent and, if satisfied that the proprietor of the patent is not precluded by contract from granting licences under the patent, the Registrar shall make that entry.

(3) Where an entry under subsection (2) is made in respect of a patent —

(a) any person shall, at any time after the entry is made, be entitled as of right to a licence under the patent on such terms as may be settled by agreement or, in default of agreement, by the Registrar on the application of the proprietor of the patent or the person requiring the licence;

(b) the Registrar may, on the application of the holder of any licence granted under the patent before the entry was made, order the licence to be exchanged for a licence of right on terms so settled;

(c) if, in proceedings for infringement of the patent, the defendant undertakes to take a licence on such terms, no injunction shall be granted against him and the amount (if any) recoverable against him by way of

damages shall not exceed twice the amount which would have been payable by him as licensee if such a licence on those terms had been granted before the earliest infringement; and

(d) the renewal fee payable in respect of the patent after the date of the entry shall be half the fee which would be payable if the entry had not been made.

(4) An undertaking under subsection (3)(c) may be given at any time before final order in the proceedings, without any admission of liability.

(5) The licensee under a licence of right may (unless, in the case of a licence the terms of which are settled by agreement, the licence otherwise expressly provides) request the proprietor of the patent to take proceedings to prevent any infringement of the patent.

(6) If the proprietor refuses or neglects to take proceedings under subsection (5) within 2 months after being so requested, the licensee may institute proceedings for the infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(7) A proprietor so added as defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Cancellation of entry made under section 55.

56. (1) At any time after an entry has been made under section 55 in respect of a patent, the proprietor of the patent may apply to the Registrar for cancellation of the entry.

(2) Where an application under subsection (1) is made and the balance paid of all renewal fees which would have been payable if the entry had not been made, the Registrar may cancel the entry if satisfied that there is no existing licence under the patent or that all licensees under the patent consent to the application.

(3) Within the prescribed period after an entry had been made under section 55 in respect of a patent, any person who claims that the proprietor of the patent is, and was at the time of the entry, precluded by a contract in which the claimant is interested from granting licences under the patent may apply to the Registrar for cancellation of the entry.

(4) Where the Registrar is satisfied, on an application under subsection (3), that the proprietor of the patent is and was so precluded, he shall cancel the entry.

(5) The proprietor shall be liable to pay, within a period specified by the Registrar, a sum equal to the balance of all renewal fees which would have been payable if the entry had not been made, and the patent shall cease to have effect at the expiration of that period if that sum is not so paid.

(6) Where an entry is cancelled under this section, the rights and liabilities of the proprietor of the patent shall after the cancellation be the same as if the entry had not been made.

(7) Where an application has been made under this section —

(a) in the case of an application under subsection (1), any person; and

(b) in the case of an application under subsection (3), the proprietor of the patent,

may, within the prescribed period, give notice to the Registrar of opposition to the cancellation.

(8) The Registrar shall, in considering the application made under this section, determine whether the opposition is justified.

Compulsory licences.

57. (1) Any interested person may apply to the court for the grant of a licence under a patent on the ground that the grant of the licence is necessary to remedy an anti-competitive practice.

(2) Without prejudice to the generality of subsection (1), the court may determine that the grant of a licence is necessary to remedy an anti-competitive practice if —

(a) there is a market for the patented invention in Brunei Darussalam;

(b) that market —

(i) is not being supplied; or

(ii) is not being supplied on reasonable terms; and

(c) the court is of the view that the proprietor of the patent has no valid reason for failing to supply that market with the patented invention, whether directly or through a licensee, on reasonable terms.

(3) Subject to this section, if the court is satisfied that the ground referred to in subsection (1) is established, the court may make an order for the grant of a

licence in accordance with the application upon such terms as the court thinks fit.

(4) A licence granted under this section —

(a) is not exclusive; and

(b) shall not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used.

(5) Any licence granted under this section may, on the application of any interested party, be terminated by the court where the court is satisfied that the ground upon which the licence was granted has ceased to exist and is unlikely to recur.

(6) Where a licence is granted under this section to any person, the person shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed between the person and the patentee or, in default of agreement, as is determined by the court on the application of the person or the patentee.

(7) The powers of the court on an application under this section shall be exercised with a view to securing that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the economic value of the licence.

(8) No order shall be made in pursuance of any application under this section which would be at variance with any treaty or international convention relating to patents to which Brunei Darussalam is a party.

PART XII

USE OF PATENTED INVENTIONS FOR SERVICES OF GOVERNMENT

Use of patented inventions by Government and authorised parties.

58. (1) Subject to sections 61, 62 and 63, but notwithstanding any other section of this Order, the Government and any party authorised in writing by the Government may do anything in relation to a patented invention —

(a) for a public non-commercial purpose; or

(b) for or during a national emergency or other circumstances of extreme urgency,

and anything done by virtue of this section shall not amount to an infringement of the patent.

(2) Without prejudice to the generality of subsection (1), subject to sections 61, 62 and 63, but notwithstanding any other section of this Order, the Government and any party authorised in writing by the Government may import any relevant health product, and do anything in relation to any relevant health product so imported, for or during a national emergency or other circumstances of extreme urgency, if the Government has given the Council for TRIPS a relevant notification in relation to the relevant health product.

(3) For the purposes of this section and section 59 —

(a) any use of an invention for the supply to the government of any country outside Brunei Darussalam, in pursuance of any agreement or arrangement between the Government of His Majesty the Sultan and Yang Di-Pertuan and the government of that country, of articles required for the defence of that country shall be deemed to be a use of the invention for a public non-commercial purpose; and

(b) the power of the Government or any party authorised by the Government to do anything in accordance with this section shall not, in the case of a patent relating to an integrated circuit, extend to sale of the invention to the public.

(4) The purchaser of any article sold in the exercise of the powers conferred by this section, and any person claiming through the purchaser, shall have power to deal with it in the same manner as if the patent were held on behalf of the Government.

(5) In this section —

"integrated circuit" means a product, in its final or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in and on, or in or on, a piece of material and which is intended to perform an electronic function;

"relevant notification" means a notification that satisfies the requirements of —

(a) paragraph 2(a) of the Doha Declaration Implementation Decision;
or

(b) paragraph 2(a) of the Annex to the TRIPS Agreement.

Rights of third parties in respect of Government use.

59. (1) In relation to —

(a) anything done in accordance with section 58 by the Government or any party authorised in writing by the Government; or

(b) anything done to the order of the Government —

(i) for a public non-commercial purpose; or

(ii) for or during a national emergency or other circumstances of extreme urgency,

by the proprietor of a patent in respect of the patented invention or by the proprietor of an application for a patent in respect of the invention for which the application has been filed and is still pending,

the provisions of any licence, assignment or agreement to which this subsection applies shall, subject to sections 61, 62 and 63, be of no effect so far as those provisions restrict or regulate the working of the invention, or the use of any model, document or information relating to it, or provide for the making of payments in respect of, or calculated by reference to, such working or use.

(2) The reproduction or publication of any model or document in connection with the said working or use shall not be deemed to be an infringement of any copyright or design right subsisting in the model or document.

(3) Subsection (1) shall apply to any licence, assignment or agreement which is made, whether before or after the date of commencement of this Order, between (on the one hand) any person who is a proprietor of or an applicant for the patent, or anyone who derives title from any such person or from whom such person derives title, and (on the other hand) any person other than the Government.

References of disputes as to Government use.

60. (1) Any dispute as to the exercise by the Government or a party authorised by the Government of the powers conferred by, or as to the terms for doing anything in accordance with, section 58 may be referred to the court by either party to the dispute after a patent has been granted for the invention.

(2) In determining any dispute referred to the court under this section, the court shall have regard to —

(a) any benefit or compensation that the patentee of the invention may have received, or may be entitled to receive, directly or indirectly, from the Government or any party authorised by the Government in respect of the patented invention; and

(b) the need to ensure that the patentee shall receive reasonable remuneration having regard to the economic value of the patented invention.

(3) If the validity of a patent is put in issue in proceedings under this section and it is found that the patent is only partially valid, the court may, subject to subsection (4), grant relief to the proprietor of the patent in respect of that part of the patent which is found to be valid and to have been used in accordance with section 58.

(4) Where in any such proceedings it is found that a patent is only partially valid, the court shall not grant relief by way of costs or expenses except where the proprietor of the patent proves that the specification of the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court may grant relief in respect of that part of the patent which is valid and has been so used, subject to the discretion of the court as to costs and expenses.

(5) As a condition of any such relief, the court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 80, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

(6) In any proceedings under this section, the court may at any time order the whole proceedings or any question or issue of fact arising in them to be referred, on such terms as the court may direct, to an arbitrator; and references to the court in this section shall be construed accordingly.

(7) One of the 2 or more joint proprietors of a patent or an application for a patent may, without the concurrence of the others, refer a dispute to the court under this section, but shall not do so unless the others are made parties to the proceedings; but any of the others if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Nature and scope of rights under section 58.

61. (1) The right to use a patented invention under section 58 —

(a) is not exclusive;

(b) shall not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) is, notwithstanding section 58(2)(a), limited to the supply of the patented invention predominantly in Brunei Darussalam by the Government or a party authorised by the Government under that section.

(2) The right under section 58 to use a relevant health product which is imported under section 58(2) does not include a right to export the relevant health product.

(3) The right to use a patented invention under section 58 may, on the application of any interested party, be terminated by the court, where the court is satisfied that the circumstances that gave rise to the right to use the patented invention have ceased to exist and are unlikely to recur.

(4) Where the court has terminated the right under section 58 to use a patented invention, the court may make such consequential orders as it thinks necessary.

Duty to inform patentee.

62. (1) Where any thing set out in section 64(1) is done in relation to a patented invention by the Government or a party authorised in writing by the Government for a public non-commercial purpose, the Government department that did or authorised the doing of the thing shall inform the patentee promptly of the doing of the thing.

(2) Where any thing set out in section 64(1) is done in relation to a patented invention by the Government or a party authorised in writing by the Government for or during a national emergency or other circumstances of extreme urgency, the Government department that did or authorised the doing of the thing shall, as soon as reasonably practicable, inform the patentee of the doing of the thing.

Patentee entitled to remuneration.

63. (1) Subject to subsection (2), where an act is done under section 58, the Government shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed, between the Government and the patentee having regard to the economic value of the patented invention or as may, in default of agreement, be determined by the court under section 60.

(2) No remuneration shall be payable under subsection (1) in respect of the import or subsequent use under section 58(2) of any relevant health product, if the patentee has received or will receive any other remuneration in respect of that relevant health product.

PART XIII

INFRINGEMENT OF PATENTS

Meaning of infringement.

64. (1) Subject to the provisions of this Order, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following

things in Brunei Darussalam in relation to the invention without the consent of the proprietor of the patent —

(a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;

(b) where the invention is a process, he uses the process or he offers it for use in Brunei Darussalam when he knows, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent;

(c) where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(2) An act which, apart from this subsection, would constitute an infringement of a patent for an invention shall not be so if —

(a) it is done privately and for purposes which are not commercial;

(b) it is done for experimental purposes relating to the subject-matter of the invention;

(c) it consists of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner or consists of dealing with a medicine so prepared;

(d) it consists of the use of a product or process in the body or operation of a relevant aircraft, hovercraft or vehicle which has temporarily or accidentally entered or is crossing Brunei Darussalam (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft, hovercraft or vehicle;

(e) it consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily or accidentally entered the territorial waters of Brunei Darussalam;

(f) subject to subsections (3) and (6), it consists of the import, use or disposal of, or the offer to dispose of, any patented product or any product obtained by means of a patented process or to which a patented process has been applied, which is produced by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by him, and for this purpose "patent" includes a patent granted in any country outside Brunei Darussalam in respect of the same or substantially the same invention as that for which a patent is granted under this Order and

"patented product", "patented process" and "licensed" shall be construed accordingly;

(g) it consists of the doing of any thing set out in subsection (1) in relation to the subject-matter of the patent to support any application for marketing approval for a pharmaceutical product, provided that any thing produced to support the application is not —

(i) made, used or sold in Brunei Darussalam; or

(ii) exported outside Brunei Darussalam,

other than for purposes related to meeting the requirements for marketing approval for that pharmaceutical product; or

(h) subject to subsection (6), it consists of the import, disposal or offer to dispose of a patented pharmaceutical product for use by or on a specific patient in Brunei Darussalam, or the use of that product by or on that patient, where —

(i) that product is required for use by or on that patient;

(ii) the relevant authority has granted approval specifically for the import of that product for use by or on that patient; and

(iii) that product was produced by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by him (and for this purpose "patent" includes a patent granted in any country outside Brunei Darussalam in respect of the same or substantially the same product and "licensed" shall be construed accordingly).

(3) Subsection (2)(f) shall not apply to the import of any patented pharmaceutical product by any person (referred to in this subsection and subsection (4) as the importer) if —

(a) the product has not previously been sold or distributed in Brunei Darussalam by or with the consent (conditional or otherwise) of the proprietor of the patent or any person licensed by the proprietor of the patent to sell or distribute the product in Brunei Darussalam;

(b) the import of the product by the importer would result in the product being distributed in breach of a contract between —

(i) the proprietor of the patent; and

(ii) any person licensed by the proprietor of the patent to distribute the product outside Brunei Darussalam; and

(c) the importer has actual or constructive knowledge of the matters referred to in paragraph (b).

(4) For the purposes of subsection (3), where the importer has received a written notice containing the prescribed particulars, he shall be deemed to have constructive knowledge of the matters referred to in subsection (3)(b).

(5) For the avoidance of doubt, in subsection (3), "patent" does not include a patent granted in any country outside Brunei Darussalam in respect of the same or substantially the same product and "licensed" shall be construed accordingly.

(6) Subsection (2)(f) and (h) shall not apply to the import or sale of, or the offer to sell, any relevant health product produced for export to any country, other than Brunei Darussalam, which is an eligible importing member of the World Trade Organisation.

(7) In this section —

"eligible importing member", in relation to the World Trade Organisation, means a member of the World Trade Organisation which —

(a) is a least-developed country; or

(b) has given the Council for TRIPS the notification referred to in —

(i) paragraph 1(b) of the Doha Declaration Implementation Decision; or

(ii) paragraph 1(b) of the Annex to the TRIPS Agreement;

"relevant ship" and "relevant aircraft, hovercraft or vehicle" mean, respectively, a ship and an aircraft, a hovercraft or a vehicle registered in, or belonging to, any country, other than Brunei Darussalam, which is —

(a) a party to the Paris Convention; or

(b) a member of the World Trade Organisation.

Proceedings for infringement of patent.

65. (1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made —

(a) for an injunction restraining the defendant from any apprehended act of infringement;

(b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised or any material and implement the predominant use of which has been in the creation of the infringing product;

(c) for damages in respect of the infringement;

(d) for an account of the profits derived by him from the infringement; and

(e) for a declaration that the patent is valid and has been infringed by him.

(2) The court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.

(3) The proprietor of a patent and any other person may, by agreement with each other, refer to the Registrar the question whether that other person has infringed the patent and on the reference, the proprietor of the patent may make any claim mentioned in subsection (1)(c) or (e).

(4) In this Order, unless the context otherwise requires —

(a) any reference to proceedings for infringement and the bringing of such proceedings includes a reference to a reference under subsection (3) and the making of such a reference;

(b) any reference to a plaintiff includes a reference to the proprietor of the patent; and

(c) any reference to a defendant includes a reference to any other party to the reference.

(5) If it appears to the Registrar on a reference under subsection (3) that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to determine the question as if the reference were proceedings brought in the court.

(6) Subject to this Part, in determining whether or not to grant any kind of relief claimed under the section and the extent of the relief granted, the court or the Registrar shall apply the principles applied by the court in relation to that kind of relief immediately before the date of commencement of this Order.

Reversal of burden of proof.

66. (1) In any proceedings for the infringement of a patent, where the subject-matter of the patent is a process for obtaining a new product, the burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the court shall not require him to disclose any manufacturing or commercial secret if it appears to the court that it would be unreasonable to do so.

Restrictions on relief for infringement.

67. (1) In proceedings for infringement of a patent, 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 supposing, that the patent existed.

(2) A person shall not be taken to have been aware or to have had reasonable grounds for supposing by reason only of the application to a product of the word "patent" or "patented", or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words.

(3) In proceedings for infringement of a patent, the court or the Registrar may, if it or he thinks fit, refuse to award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction) —

(a) in respect of an infringement committed during any further period specified under section 35(3), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection;

(b) where the patent was granted on the basis of any examination report referred to in section 29(5), any search and examination report referred to in section 29(6) or any international preliminary report on patentability referred to in section 30(2)(b)(vi), in respect of any infringement alleged to have been committed at any time when any claim (in the specification of the patent) that is alleged to have been infringed is not related to any claim in the application for the patent at the time the report was issued —

(i) which has been examined; and

(ii) which is referred to in the report; or

(c) where the patent was granted on the basis of the prescribed information relating to a corresponding application referred to in section 29(2)(c)(ii) or the prescribed information relating to a corresponding international application referred to in section 29(2)(d)(ii), in respect of any infringement alleged to have been committed at any time when any claim (in the specification of the patent) that is alleged to have been infringed is not related to any claim —

(i) which is set out in the prescribed information relating to the corresponding application or corresponding international application, as the case may be; and

(ii) which has been examined to determine whether the claim appears to satisfy the criteria of novelty, inventive step (or non-obviousness) and industrial applicability (or utility).

(4) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Order, the court or the Registrar shall not, in proceedings for an infringement of the patent committed before the decision to allow the amendment, award any damages, make an order for an account of profits or grant any other relief (including, in proceedings before the court, an injunction) unless the court or the Registrar is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

Relief for infringement of partially valid patent.

68. (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the Registrar may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the court or the Registrar shall not grant relief by way of damages, costs or expenses, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event the court or the Registrar may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the court or the Registrar as to costs or expenses and as to the date from which damages should be reckoned.

(3) As a condition of relief under this section, the court or the Registrar may direct that the specification of the patent shall be amended to its or his satisfaction upon an application made for that purpose under section 80, and an

application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

Right to continue use begun before priority date.

69. (1) Where a patent is granted for an invention, a person who in Brunei Darussalam before the priority date of the invention —

(a) does in good faith an act which would constitute an infringement of the patent if it were in force; or

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

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent.

(2) The right conferred by subsection (1) shall not extend to granting a licence to another person to do the act.

(3) If the act was done, or the preparations were made, in the course of a business, the person entitled to the right conferred by subsection (1) may —

(a) authorise the doing of that act by any partner of his for the time being in that business; and

(b) assign that right, or transmit it on death (or in the case of a body corporate on its dissolution) to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(4) Where a product is disposed of to another in exercise of the rights conferred by subsection (1) or (3), that other and any person claiming through him may deal with the product in the same way as if it had been disposed of by the registered proprietor of the patent.

Certificate of contested validity of patent.

70. (1) Where in any proceedings before the court or the Registrar the validity of a patent to any extent is contested and that patent is found by the court or the Registrar to be wholly or partially valid, the court or the Registrar may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the Registrar for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier

proceedings, that party shall, unless the court or the Registrar otherwise directs, be entitled to his costs or expenses as between solicitor and own client other than the costs or expenses of any appeal in the subsequent proceedings.

Proceedings for infringement by co-owner.

71. (1) In the application of section 64 to a patent of which there are 2 or more joint proprietors, the reference to the proprietor shall be construed —

(a) in relation to any act, as a reference to that proprietor or those proprietors who, by virtue of section 47 or any agreement referred to in that section, is or are entitled to do that act without its amounting to an infringement; and

(b) in relation to any consent, as a reference to that proprietor or those proprietors who, by virtue of section 47 or any such agreement, is or are the proper person or persons to give the requisite consent.

(2) One of 2 or more joint proprietors of a patent may without the concurrence of the others bring proceedings in respect of an act alleged to infringe the patent, but shall not do so unless the others are made parties to the proceedings; but any of the others if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Proceedings for infringement by exclusive licensee.

72. (1) The holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in this Order relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings, the court or the Registrar shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section, the proprietor of the patent need not be made a party to the proceedings, but if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Effect of non-registration on infringement proceedings.

73. Where by virtue of a transaction, instrument or event to which section 44 applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, the court or the Registrar shall not award him damages or order that he be given an account of the profits in respect of such a subsequent infringement occurring before the transaction, instrument or event is registered unless —

(a) the transaction, instrument or event is registered within the period of 6 months beginning with its date; or

(b) the court or the Registrar is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as practicable thereafter.

Infringement of rights conferred by publication of application.

74. (1) Where an application for a patent for an invention is published, then, subject to this section, the applicant shall have, as from the publication and until the grant of the patent, the same right as he would have had, if the patent had been granted on the date of the publication of the application, to bring proceedings in the court or before the Registrar for damages in respect of any act which would have infringed the patent.

(2) References in sections 64 to 67 and 71 to 73 to a patent and the proprietor of a patent shall be respectively construed as including references to any such application and the applicant, and references to a patent being in force, being granted, being valid or existing shall be construed accordingly.

(3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only —

(a) after the patent has been granted; and

(b) if the act would, if the patent had been granted on the date of the publication of the application, have infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were completed by the Registry.

(4) Section 67(3) and (4) shall not apply to an infringement of the rights conferred by this section but in considering the amount of any damages for such an infringement, the court or the Registrar shall consider whether or not it would have been reasonable to expect, from a consideration of the application as published under section 27, that a patent would be granted conferring on the

proprietor of the patent protection from an act of the same description as that found to infringe those rights, and if the court or the Registrar finds that it would not have been reasonable, it or he shall reduce the damages to such an amount as it or he thinks just.

Remedy for groundless threats of infringement proceedings.

75. (1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (3).

(2) In any such proceedings, the plaintiff shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless —

(a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and

(b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is —

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) damages in respect of any loss which the plaintiff has sustained by the threats.

(4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.

(5) It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

(6) Nothing in this section shall render an advocate and solicitor or any other person liable to an action under this section in respect of an act done by the advocate and solicitor or the other person in his professional capacity on behalf of a client.

Declaration as to non-infringement.

76. (1) Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the Registrar in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown —

(a) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed to give any such acknowledgment.

(2) A declaration made by the Registrar under this section shall have the same effect as a declaration made by the court.

PART XIV

REVOCATION OF PATENTS AND VALIDITY PROCEEDINGS

Power to revoke patents on application.

77. (1) Subject to this Order, the Registrar may, on the application of any person, by order revoke a patent for an invention on (but only on) any of the following grounds —

(a) the invention is not a patentable invention;

(b) the patent was granted to a person who was not entitled to be granted that patent;

(c) the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art;

(d) the matter disclosed in the specification of the patent extends beyond that disclosed —

(i) in the application for the patent, as filed; or

(ii) where the patent was granted on a new application filed under section 20(3) or 48(4), or in accordance with section 26(11), in the earlier application made under this Order from which the filing date and the right of priority has been derived, as filed;

(e) an amendment or a correction has been made to the specification of —

- (i) the patent; or
- (ii) the application for the patent,

which should not have been allowed;

(f) the patent was obtained —

- (i) fraudulently;
- (ii) on any misrepresentation; or
- (iii) on any non-disclosure or inaccurate disclosure of any prescribed material information, whether or not the person under a duty to provide the information knew or ought reasonably to have known of such information or the inaccuracy;

(g) the patent is one of 2 or more patents for the same invention having the same priority date and filed by the same party or his successor in title.

(2) On the application of any person for an order to revoke a patent on any of the grounds specified in subsection (1)(a), (c), (d) and (e), the Registrar may, subject to subsection (3), cause the patent to be re-examined by an Examiner so as to determine whether the patent should be revoked on any of those grounds and require the applicant to pay the prescribed re-examination fee.

(3) The Registrar shall not cause a patent to be re-examined under subsection (2) where, within the prescribed period, the applicant for the revocation of the patent fails to give such security for the costs or expenses of the proceedings as the Registrar may specify; in which case, the application for revocation shall be treated as having been abandoned.

(4) An application for the revocation of a patent on the ground mentioned in subsection (1)(b) —

(a) may only be made by a person found by the court in an action for a declaration or found by the court or the Registrar on a reference under section 48, to be entitled to be granted that patent or to be granted a patent for part of the matter comprised in the specification of the patent sought to be revoked; and

(b) may not be made if that action was commenced or that reference was made after the end of the period of 2 years beginning with the date of the grant of the patent sought to be revoked, unless it is shown that any

person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) An order under this section may be —

(a) an order for the unconditional revocation of the patent; or

(b) where one of the grounds mentioned in subsection (1) has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 80 to the satisfaction of the Registrar.

(6) A decision of the Registrar or on appeal from the Registrar shall not estop any party to any civil proceedings in which infringement of a patent is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1), whether or not any of the issues involved were decided in the decision.

(7) An order under this section revoking a patent shall have effect from the date of the grant of the patent.

(8) Where an applicant for the revocation of a patent discontinues or withdraws his application, he shall pay such costs or expenses of the proceedings as the Registrar may determine.

(9) An application for an order to revoke a patent shall be —

(a) made in the prescribed form and filed at the Registry in the prescribed manner; and

(b) accompanied by the prescribed fee.

(10) Section 89 shall not apply in relation to the decision of the Registrar to cause a patent to be re-examined under this section.

Registrar's power to revoke patents.

78. If it appears to the Registrar that an invention for which a patent has been granted formed part of the state of the art by virtue only of section 14(3), he may on his own initiative by order revoke the patent, but shall not do so without giving the proprietor of the patent an opportunity of making any observation and of amending the specification of the patent so as to exclude any matter which formed part of the state of the art as aforesaid without contravening section 81.

Proceedings in which validity of patent may be put in issue.

79. (1) Subject to this section, the validity of a patent may be put in issue —

(a) by way of defence, in proceedings for infringement of the patent under section 65 or proceedings under section 74 for infringement of rights conferred by the publication of an application;

(b) in proceedings under section 75;

(c) in proceedings in which a declaration in relation to the patent is sought under section 76;

(d) in proceedings before the Registrar under section 77 for the revocation of the patent; or

(e) in proceedings under section 58 or 60.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Order or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 77 or otherwise) are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground mentioned in section 77(1)(b) unless —

(a) it has been determined in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue that the patent should have been granted to him and not some other person; and

(b) except where it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced before the end of the period of 2 years beginning with the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence or counterclaim, the court or the Registrar shall, if it or he thinks it just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a).

(6) In subsection (4), "entitlement proceedings", in relation to a patent, means a reference under section 48(1) on the ground that the patent was granted to a person not entitled to it or proceedings for a declaration that it was so granted.

(7) Where proceedings with respect to a patent are pending in the court under any provision of this Order mentioned in subsection (1), no proceedings may be instituted without the leave of the court before the Registrar with respect to that patent under section 65(3), 74, 76 or 77.

(8) It is hereby declared that for the purposes of this Order the validity of a patent is not put in issue merely because the Registrar is considering its validity in order to decide whether to revoke it under section 78.

PART XV

AMENDMENTS OF PATENTS AND APPLICATIONS

Amendment of patent in infringement or revocation proceedings.

80. (1) In any proceedings before the court or the Registrar in which the validity of a patent is put in issue, the court or, as the case may be, the Registrar may, subject to section 81, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to the publication and advertisement of the proposed amendment and as to costs, expenses or otherwise, as the court or Registrar thinks fit.

(2) A person may give notice to the court or the Registrar of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court or the Registrar shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Where an application for an order under this section is made to the court, the applicant shall notify the Registrar, who shall be entitled to appear and be heard and shall appear if so directed by the court.

Amendments of applications and patents not to include added matter.

81. (1) An application for a patent which —

(a) is made in respect of matter disclosed in an earlier application, or in the specification of a patent which has been granted; and

(b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier application made under this Order or in the application made under the United Kingdom Patents Act, Malaysia Patents Act or Singapore Patents Act or the application under the European Patent Convention designating the United Kingdom filed at the European Patent Office from which the filing date and right of priority is sought to be derived, as filed, or the application for the patent, as filed,

may be filed under section 20(3) or 48(4), or as mentioned in section 26(11), but shall not be allowed to proceed unless it is amended so as to exclude the additional matter.

(2) Where, in relation to an application for a patent —

(a) the documents filed at the Registry to initiate the application contain —

(i) a reference to an earlier relevant application specified in a declaration under section 17(2) made in or in connection with the application; and

(ii) a statement referred to in section 26(1)(c)(ii)(C); and

(b) the description filed under section 26(7)(b) discloses additional matter, that is, matter extending beyond that disclosed in the earlier relevant application,

the application shall not be allowed to proceed unless it is amended to exclude the additional matter.

(3) No amendment of an application for a patent shall be allowed under section 31 if it results in the application disclosing any matter extending beyond that disclosed in the application as filed.

(4) No amendment of the specification of a patent shall be allowed under section 38(1), 78 or 80 if it —

(a) results in the specification disclosing any additional matter; or

(b) extends the protection conferred by the patent.

(5) In subsection (2), "relevant application" has the same meaning as in section 17(9).

PART XVI

INTERNATIONAL APPLICATIONS FOR PATENTS

Effect of filing international application for patent.

82. (1) An international application for a patent (Brunei Darussalam) for which a date of filing has been accorded under the Patent Co-operation Treaty shall, subject to sections 83 and 84, be treated for the purposes of this Order as an application for a patent under this Order.

(2) If the application, or the designation of Brunei Darussalam in it, is withdrawn or (except as mentioned in subsection (3)) deemed to be withdrawn under the Patent Co-operation Treaty, it shall be treated as withdrawn under this Order.

(3) An application shall not be treated as withdrawn under this Order if it, or the designation of Brunei Darussalam in it, is deemed to be withdrawn under the Patent Co-operation Treaty —

(a) because of an error or omission in an institution having functions under the Treaty; or

(b) because, owing to circumstances outside the applicant's control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty; or

(c) in such other circumstances as may be prescribed.

(4) If an international application for a patent which designates Brunei Darussalam is refused a filing date under the Patent Co-operation Treaty and the Registrar determines that the refusal was caused by an error or omission in an institution having functions under that Treaty, he may direct that the application shall be treated as an application under this Order, having such date of filing as he may direct.

(5) The Registry shall act as a receiving Office under Article 2 of the Patent Co-operation Treaty in respect of international applications filed by citizens of Brunei Darussalam or persons resident in Brunei Darussalam.

(6) The prescribed transmittal fee, in addition to the fees prescribed by the Patent Co-operation Treaty, shall be paid to the Registry by any person filing an international application under that Treaty.

International and national phases of application.

83. (1) The provisions of the Patent Co-operation Treaty relating to publication, search, examination and amendment, and not those of this Order, shall apply to

an international application for a patent (Brunei Darussalam) during the international phase of the application.

(2) The international phase of the application means the period from the filing of the application in accordance with the Patent Co-operation Treaty until the national phase of the application begins.

(3) The national phase of the application begins —

(a) when the prescribed period expires, provided —

(i) where the application has been published in accordance with the Patent Co-operation Treaty in a language other than the English language, and the application is not in the English language, an English translation of the application has been filed at the Registry; and

(ii) the prescribed fee has been paid,

by the applicant; or

(b) when the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, pays the prescribed fee and complies with any of the following sub-paragraphs which is applicable —

(i) where, at the time of the request, the application has not been published in accordance with the Patent Co-operation Treaty, file at the Registry —

(A) a copy of the application; and

(B) if the copy is not in the English language, an English translation of the application;

(ii) where, at the time of the request, the application has been published in accordance with the Patent Co-operation Treaty in a language other than the English language, and the application is not in the English language, file at the Registry an English translation of the application.

(4) If the prescribed period expires without the conditions mentioned in subsection (3)(a) being satisfied, the application shall be taken to be withdrawn.

(5) Where, during the international phase, the application is amended in accordance with the Patent Co-operation Treaty, the amendment shall be treated as made under this Order if, and shall be disregarded unless —

(a) when the prescribed period expires, where —

(i) the amendment is not in the English language; and

- (ii) if any copy of the amendment has been communicated to the Registry in accordance with the Treaty, that copy is in a language other than the English language,

an English translation of the amendment has been filed at the Registry; or

(b) where the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, there is then filed at the Registry —

- (i) a copy of the amendment, if none has been communicated to the Registry in accordance with the Treaty; and

- (ii) an English translation of the amendment, if —

(A) the amendment is not in the English language; and

(B) where any copy of the amendment has been communicated to the Registry in accordance with the Treaty, that copy is in a language other than the English language.

(7) The Registrar shall on payment of the prescribed fee publish any translation filed at the Registry under subsection (3) or (5).

Adaptation of provisions in relation to international application.

84. (1) Where an international application for a patent (Brunei Darussalam) is accorded a filing date under the Patent Co-operation Treaty —

(a) that date or, if the application is re-dated under the Treaty to a later date, that later date shall be treated as the date of filing the application under this Order;

(b) any declaration of priority made under the Treaty shall be treated as made under section 17(2), and where in accordance with the Treaty any extra days are allowed, the period of 12 months referred to in section 17(3)(a) shall be treated as altered accordingly; and

(c) any statement of the name of the inventor under the Treaty shall be treated as a statement filed under section 24(2).

(2) If the application, not having been published under this Order, is published in accordance with the Patent Co-operation Treaty, it shall be treated, for purposes other than those mentioned in subsection (3), as published under section 27 when the national phase of the application begins or, if later, when published in accordance with the Treaty.

(3) For the purposes of sections 58 and 74, the application, not having been published under this Order, shall be treated as published under section 27 —

(a) if it is published in accordance with the Patent Co-operation Treaty in the English language, on its being so published; and

(b) if it is so published in a language other than the English language —

(i) on the publication of an English translation of the application in accordance with section 83(6); or

(ii) on the service by the applicant of an English translation of the specification of the application on the Government department concerned or, as the case may be, on the person committing the infringing act.

(4) The reference in subsection (3)(b)(ii) to the service of an English translation on a Government department or other person is to its being sent by post or delivered to that department or person.

(5) During the international phase of the application, section 20 does not apply (determination of questions of entitlement in relation to application under this Order), but after the end of the international phase section 20 shall apply.

Evidence of Patent Co-operation Treaty and its instruments.

85. (1) Judicial notice shall be taken of the Patent Co-operation Treaty and any *Gazette*, bulletin or journal published under the Treaty.

(2) Any such document mentioned in subsection (1) shall be admissible as evidence of any instrument or other act thereby communicated of any institution having functions under the Treaty.

(3) Evidence of any instrument issued under the Patent Co-operation Treaty by any institution or of any document in the custody of any institution or reproducing in legible form any information in such custody otherwise than in legible form, or any entry or extract from such a document, may be given in any legal proceedings by production of a copy certified as a true copy by an official of that institution.

(4) Any document purporting to be such a copy as is specified by subsection (3) shall be received in evidence without proof of the official position or handwriting of the person signing the certificate.

(5) Evidence of any instrument mentioned in subsection (3) may also be given in any legal proceedings —

(a) by production of a copy purporting to be printed by the Government Printers; or

(b) where the instrument is in the custody of a Government department, by production of a copy certified on behalf of the department to be a true copy by an officer of the department generally or specially authorised to do so.

(6) Any document purporting to be such a copy as is mentioned in subsection (5)(b) of an instrument in the custody of a Government department shall be received in evidence without proof of the official position or handwriting of the person signing the certificate, or of his authority to do so, or of the document being in the custody of the department.

(7) In this section, "proceedings" includes proceedings before the Registrar.

PART XVII

LEGAL PROCEEDINGS

Proceedings before court or Registrar.

86. (1) Any proceedings before the court relating to patents and other matters under this Order shall be dealt with by a judge sitting alone or, if he thinks fit, with one or more scientific advisers selected by the judge from the panel appointed under subsection (2).

(2) Rules under this Order may make provision for the appointment of a panel of scientific advisers to assist the court and the Registrar in proceedings under this Order, for regulating the functions of such advisers and for remunerating such advisers.

Appeals from Registrar.

87. (1) An appeal shall lie to the court from any decision of the Registrar under this Order or the rules except any of the following decisions —

(a) a decision falling within section 25(7);

(b) a decision under section 27(3) to omit any matter from a specification;

(c) a decision to give directions under section 32(1) or (2);

(d) a decision under the rules which is excepted by the rules from the right of appeal conferred by this section.

(2) For the purpose of hearing appeals under this section, the court may consist of one or more judges of the court in accordance with directions given by or on behalf of the Chief Justice.

(3) An appeal shall not lie to the Court of Appeal from a decision of the court on appeal from a decision of the Registrar under this Order or the rules —

(a) except where the decision of the Registrar was given under section 20, 38, 48, 65, 77, 78 or 80; or

(b) except where the ground of appeal is that the decision of the court is wrong in law,

but an appeal shall only lie to the Court of Appeal under this section if leave to appeal is given by the court or the Court of Appeal.

General powers of court.

88. (1) 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.

(2) In all proceedings before the court under this Order, 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.

Exercise of Registrar's discretionary powers.

89. Notwithstanding 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 or the rules.

Right of audience in patent proceedings.

90. (1) Any party to any proceedings before the Registrar under this Order or any treaty to which Brunei Darussalam is a party may appear before the Registrar in person or be represented by an advocate and solicitor or a registered patent agent.

(2) The Government may be represented by a legal officer in any proceedings before the Registrar under this Order or any treaty to which Brunei Darussalam is a party.

(3) Without prejudice to the right of counsel to appear before the court, an advocate and solicitor who is not in practice shall, notwithstanding anything in the Legal Profession Act (Chapter 132), have the right to appear and be heard on behalf of any party to an appeal under this Order from the Registrar to the court.

Extension of privilege for communications with solicitors relating to patent proceedings.

91. (1) It is hereby declared that the rule of law which confers privilege from disclosure in legal proceedings in respect of communications made with an advocate and solicitor or a person acting on his behalf, or in relation to information obtained or supplied for submission to an advocate and solicitor or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before a court in Brunei Darussalam extends to such communications so made for the purpose of any pending or contemplated proceedings before the Registrar under this Order.

(2) In this section, "legal proceedings" includes proceedings before the Registrar; and references to "legal proceedings" and "pending or contemplated proceedings" include references to applications for a patent and to international applications for a patent.

Privilege for communications with patent agents.

92. (1) A communication with respect to any matter relating to patents —

(a) between a person and a registered patent agent, a partnership entitled under Part XIX to describe itself as a firm of patent agents or a body corporate entitled under Part XIX to describe itself as a patent agent; or

(b) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his patent agent,

is privileged from disclosure in legal proceedings in Brunei Darussalam in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person seeks for the purpose of instructing his solicitor.

(2) In this section, "legal proceedings" includes proceedings before the Registrar.

Costs and expenses in proceedings before Registrar.

93. (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 an Intermediate Court or a Court of a Magistrate so orders, be recoverable by execution issued from that Court or otherwise as if they were payable under an order of that Court.

(3) If any person by whom —

(a) a reference is made to the Registrar under section 20 or 48;

(b) an application is made to the Registrar for the revocation of a patent; or

(c) notice of opposition is given to the Registrar under section 38(4), 41(2), 56(7) or 104(2),

neither resides nor carries on business in Brunei Darussalam, the Registrar may require him to give security for the costs or expenses of the proceedings and in default of such security being given may treat the reference, application or notice as abandoned.

Licences granted by order of Registrar.

94. Any order by the Registrar for the grant of a licence under this Order shall, without prejudice to any other method of enforcement, have effect as if it were a deed, executed by the proprietor of the patent and all other necessary parties, granting a licence in accordance with the order.

PART XVIII

OFFENCES

Falsification of register etc.

95. If a person makes or causes to be made a false entry in any register kept under this Order, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he is guilty of an offence and liable on conviction to a fine not exceeding \$5,000, imprisonment for a term not exceeding 12 months or both.

Unauthorised claim of patent right.

96. (1) If a person falsely represents that anything disposed of by him for value is a patented product, he is, subject to this section, guilty of an offence and liable on conviction to a fine not exceeding \$10,000, imprisonment for a term not exceeding 12 months or both.

(2) For the purposes 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 "patent" or "patented" or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) shall not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made or does not continue to be made.

(4) 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.

Unauthorised claim that patent has been applied for.

97. (1) If a person represents that a patent has been applied for in respect of any article disposed of for value by him and —

(a) no such application has been made; or

(b) any such application has been refused, withdrawn or treated as having been abandoned,

he is, subject to this section, guilty of an offence and liable on conviction to a fine not exceeding \$10,000, imprisonment for a term not exceeding 12 months or both.

(2) Subsection (1)(b) shall not apply where the representation is made or continues to be made before the expiry of a period which commences with the refusal, withdrawal or abandonment and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made or does not continue to be made.

(3) 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 words "patent applied for" or "patent pending", or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of it.

(4) In any 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.

Misuse of title "Registry of Patents".

98. If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Registry of Patents" or any other words suggesting that his place of business is, or is officially connected with, the Registry of Patents, he is guilty of an offence and liable on conviction to a fine not exceeding \$5,000, imprisonment for a term not exceeding 12 months or both.

Offences by corporations and partnerships.

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

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

(3) Proceedings for an offence under this Order alleged to have been committed by a partnership shall be brought in the name of the partnership and not in that of the partners; but without prejudice to any liability of the partners under subsection (5).

(4) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(5) 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.

Compounding of offences.

100. (1) The Registrar or any person authorised by him in writing may, in his discretion, compound any offence under this Order which is prescribed as a compoundable offence by collecting from a person reasonably suspected of having committed the offence a sum of money not exceeding \$2,000.

(2) The Minister may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make regulations to prescribe the offences which may be compounded.

(3) On payment of such sum of money, no further proceedings shall be taken against such person in respect of the offence.

PART XIX

PATENT AGENTS

Registration of patent agents.

101. (1) The Minister may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules for the registration of individuals as patent agents.

(2) Without prejudice to the generality of subsection (1), the rules may provide —

(a) for the keeping, by such person as the Minister may determine, of a register of patent agents;

(b) for the form and manner of application for registration as a patent agent, the qualifications and other requirements for registration, the fees payable for registration, and the conditions of registration;

(c) for the issuance of practising certificates to registered patent agents;

(d) for the correction of errors and updating of entries in the register of patent agents; and

(e) for transitional matters in relation to the registration of individuals as patent agents, and exclude or vary the operation of this Order in relation to such transitional matters.

(3) The rules may make provision to regulate the professional conduct of registered patent agents and their practice and, for that purpose, may make provision for and in relation to all or any of the following —

(a) making complaints against registered patent agents and hearing and deciding upon such complaints;

(b) imposing penalties on registered patent agents, including issuing a reprimand, and suspending or cancelling registration;

(c) summoning witnesses;

(d) receiving evidence from persons on oath or affirmation;

(e) administering oaths or affirmations to persons giving evidence;

(f) requiring persons to produce documents or articles;

(g) restoring any registration that has been cancelled and lifting the suspension imposed on any registration.

(4) The rules may provide that a contravention of the rules shall be an offence and may provide penalties not exceeding a fine of \$5,000, imprisonment for a term not exceeding 12 months or both.

Persons entitled to act as patent agents etc.

102. (1) An individual shall not carry on a business, practise or act as a patent agent unless he is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

(2) A partnership shall not carry on a business, practise or act as patent agents unless at least one partner is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

(3) A body corporate shall not carry on a business, practise or act as a patent agent unless at least one director is a registered patent agent, or an advocate and solicitor, who has in force a practising certificate.

(4) For the purposes of this section, a person is taken to carry on a business, practise or act as a patent agent if, the person does, or undertakes to do, on behalf of another person, any of the following in Brunei Darussalam for gain —

(a) applying for or obtaining patents in Brunei Darussalam or elsewhere;

(b) preparing specifications or other documents for the purposes of this Order or the patent law of another country; or

(c) giving advice (other than advice of a scientific or technical nature) about the validity, or infringement, of patents.

(5) An individual shall not —

(a) carry on a business under any name or other description which contains the words "patent agent"; or

(b) in the course of a business otherwise describe himself, hold himself out or permit himself to be described or held out as a "patent agent",

unless he is a registered patent agent who has in force a practising certificate.

(6) A partnership shall not —

(a) carry on a business under any name or other description which contains the words "patent agent"; or

(b) in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a firm of "patent agents",

unless at least one partner is a registered patent agent who has in force a practising certificate.

(7) A body corporate shall not —

(a) carry on a business under any name or other description which contains the words "patent agent"; or

(b) in the course of a business otherwise describe itself, hold itself out or permit itself to be described or held out as a "patent agent",

unless at least one director is a registered patent agent who has in force a practising certificate.

(8) Any person who contravenes this section is guilty of an offence and liable on conviction to a fine not exceeding \$5,000, imprisonment for a term not exceeding 12 months or both.

(9) Where subsection (5), (6) or (7) would be contravened by the use of the words "patent agent" in reference to an individual, partnership or body corporate, it is equally contravened by the use of the expression "patent attorney" in reference to that person, or his business or place of business, or any other expression in reference thereto which is likely to be understood as indicating that he is entitled to be described as a "patent agent".

(10) Where an individual's employer does not carry on a business, practise or act as a patent agent, the individual does not contravene subsection (1) in respect of anything done, or undertaken to be done, by the individual for his employer in his capacity as employee of his employer.

(11) Where —

(a) an individual's employer is a member of a related company group;

(b) the individual's employer does not carry on a business, practise or act as a patent agent; and

(c) any other member of the related company group does not carry on a business, practise or act as a patent agent,

the individual does not contravene subsection (1) in respect of anything done, or undertaken to be done, by the individual for that other member of the related company group in his capacity as employee of his employer.

(12) A legal officer does not commit an offence against subsection (1) in respect of anything done, or undertaken to be done, by him on behalf of the Government.

(13) A body corporate that is a member of a related company group does not contravene subsection (3) in respect of anything done, or undertaken to be done, by the body corporate for another member of the group.

(14) This section shall not be construed as prohibiting an advocate and solicitor from taking part in proceedings relating to patents and applications for patents and, in particular, shall not derogate from section 90 as it applies to advocates and solicitors.

(15) No offence is committed under section 19 of the Legal Profession Act (Chapter 132) by any person by reason only of the preparation by him of a document (other than a deed) for use in proceedings before the Registrar in relation to any patent or application for a patent.

(16) In this section —

"director", in relation to a body corporate whose affairs are managed by its members, means any member of the body corporate;

"practising certificate" means —

(a) in relation to a registered patent agent, a practising certificate issued to him under rules made under section 101; or

(b) in relation to an advocate and solicitor, a practising certificate issued to him under section 13 of the Legal Profession Act (Chapter 132); and

"related company group" means a group of 2 or more corporations which are related to each other.

PART XX

GENERAL

Immunity of Government, its officers and Examiners.

103. The Government, any officer of the Registry and any Examiner shall not —

(a) be taken to warrant the validity of any patent granted under this Order or any treaty to which Brunei Darussalam is a party;

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

(c) incur any liability by reason of an incorrect entry in the register of patent agents maintained under Part XIX.

Correction of errors in patents and applications.

104. (1) The Registrar may, subject to any provision of the rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

(2) Where the Registrar is requested to correct such an error or mistake, any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

Information about patent applications and patents, and inspection of documents.

105. (1) After publication of an application for a patent in accordance with section 27, the Registrar shall, on request being made to him in the prescribed manner and on payment of the prescribed fee (if any), give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restriction.

(2) Subject to this section, until an application for a patent is so published, documents or information constituting or relating to the application shall not, without the consent of the applicant, be published or communicated to any person by the Registrar.

(3) Subsection (2) shall not prevent —

(a) the Registrar from publishing or communicating to others any bibliographic information about an unpublished application for a patent; or

(b) the Minister from inspecting or authorising the inspection of an application for a patent or any connected document under section 32(5).

(4) Where a person is notified that an application for a patent has been made, but not published in accordance with section 27, and that the applicant will, if the patent is granted, bring proceedings against that person in the event of his doing an act specified in the notification after the application is so published, that person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

(5) Where an application for a patent is filed, but not published, and a new application is filed in respect of any part of the subject-matter of the earlier application (either in accordance with the rules or in pursuance of an order under section 20) and is published, any person may make a request under subsection (1) relating to the earlier application and on payment of the prescribed fee the Registrar shall give him such information and permit him to inspect such documents as could have been given or inspected if the earlier application had been published.

(6) The publication of the whole or part of a specification of a patent or an application for a patent shall not constitute an infringement of any copyright subsisting under the Copyright Order, 2000 (S 14/2000) in any literary or artistic work.

Service by post.

106. Any notice required or authorised to be given by this Order or the rules, and any application or other document so authorised or required to be made or filed, may be given, made or filed by post.

Extension of time.

107. (1) The Minister may, after consultation with the Registry and with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules to provide for the extension of any period of time specified for the doing of any act in relation to —

(a) any application for or grant of a patent;

(b) any proceedings before the Registrar under this Order or the rules;
or

(c) any other matter under this Order or the rules.

(2) The rules may contain such provision as the Minister 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.

Hours of business and excluded days.

108. (1) The Registrar may issue practice directions to specify —

(a) the hours of business of the Registry; and

(b) the days which are to be treated as excluded days.

(2) The Minister may prescribe the effect of doing any business under this Order —

(a) on any day after the hours of business of the Registry; or

(b) on any day which is an excluded day.

(3) For the purposes of subsections (1) and (2) —

(a) different hours of business may be specified for different classes of business;

(b) different excluded days may be specified for different classes of business; and

(c) different effects of doing business —

(i) outside the hours of business of the Registry; or

(ii) on an excluded day,

may be prescribed for different classes of business.

Government's right to sell forfeited articles.

109. (1) Nothing in this Order shall affect the right of the Government or any person deriving title, directly or indirectly, from the Government to dispose of or use articles forfeited under the laws relating to customs or excise.

Extent of invention.

110. (1) For the purposes of this Order, an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

(2) It is hereby declared for the avoidance of doubt that where more than one invention is specified in any such claim, each invention may have a different priority date under section 17.

Availability of samples of micro-organisms.

111. (1) Provision may be made by rules prescribing the circumstances in which the specification of an application for a patent, or of a patent, for an invention

which requires for its performance the use of a micro-organism is to be treated as disclosing the invention in a manner which is clear enough and complete enough for the invention to be performed by a person skilled in the art.

(2) The rules may in particular require the applicant or patentee —

(a) to take such steps as may be prescribed for the purposes of making available to the public samples of the micro-organism; and

(b) not to impose or maintain restrictions on the uses to which such samples may be put, except as may be prescribed.

(3) The rules may provide that, in such cases as may be prescribed, samples need only be made available to such persons or descriptions of persons as may be prescribed.

(4) The rules may identify a description of persons by reference to whether the Registrar has given his certificate as to any matter.

(5) An application for revocation of the patent under section 77(1)(c) may be made if any of the requirements of the rules ceases to be complied with.

Rules.

112. (1) The Minister may, after consultation with the Registry and with the approval of His Majesty the Sultan and Yang Di-Pertuan, make such rules as he thinks expedient for regulating the business of the Registry in relation to patents and applications for patents (including international applications for patents) and for regulating all matters placed by this Order under the direction or control of the Registrar.

(2) Without prejudice to the generality of subsection (1), the rules may make provision —

(a) prescribing the contents of applications for patents and other documents which may be filed at the Registry and requiring copies to be furnished of any such documents;

(b) regulating the procedure to be followed in connection with any proceeding or other matter before the Registrar or the Registry and authorising the rectification of irregularities of the procedure;

(c) requiring fees to be paid in connection with any such proceeding or matter or in connection with the provision of any service by the Registry and providing for the remission of fees in the prescribed circumstances;

(d) regulating the mode of giving evidence in any such proceeding and empowering the Registrar to compel the attendance of witnesses and the discovery of and production of documents;

(e) requiring the Registrar to publish any proposed amendment of patents and any other prescribed matters including any prescribed steps in any such proceeding;

(f) providing for the appointment of scientific advisers to assist the court and the Registrar in any proceeding before it or him and for the remuneration of such advisers;

(g) prescribing time limits for doing anything required to be done in connection with any such proceeding by this Order or the rules;

(h) giving effect to the right of an inventor of an invention to be mentioned in an application for a patent for the invention;

(i) providing for the publication and sale of documents in the Registry and of information about such documents;

(j) prescribing, in relation to international applications, matters necessary or convenient to be prescribed for carrying out or giving effect to the Patent Co-operation Treaty;

(k) excluding or varying the operation of the provisions of this Order in relation to international applications and applications for patents made under section 115;

(l) requiring and regulating the translation of documents in connection with any application for a patent and the filing and authentication of any such translations;

(m) prescribing the scale of costs for proceedings before the Registrar; and

(n) prescribing anything that is required or permitted to be prescribed under this Order.

(3) The rules may make different provisions for different cases.

(4) The rules shall provide for the publication by the Registrar of a journal (referred to in this Order as the journal) containing particulars of applications for and grants of patents, particulars of application for and the registration of patent agents, and of other proceedings under this Order.

(5) The rules may require or authorise the Registrar to make arrangements for the publication of reports of cases relating to patents decided by him or by any court or body whether in Brunei Darussalam or elsewhere.

Forms and directions of Registrar.

113. The Minister may, with the approval of His Majesty the Sultan and Yang Di-Pertuan, make rules for the publication by the Registrar of —

- (a) the forms to be used for any purpose relating to —
 - (i) any application for or grant of a patent;
 - (ii) any proceedings before the Registrar under this Order or the rules;
or
 - (iii) any other matter under this Order or the rules; and
- (b) the practice directions issued by the Registrar.

Repeals of Chapter 72 and S 42/1999.

114. Subject to section 115, the Inventions Act and the Emergency (Patents) Order, 1999 and any regulations made thereunder are repealed.

Transitional provisions.

115. (1) Where an application has been made under section 2 of the Inventions Act (Chapter 72) before the commencement of this Order, the Registrar may issue a certificate of registration under section 4 of that Act after that date as if that Act and any regulations made thereunder had not been repealed.

(2) Where a patent has been granted under any law relating to patents having effect in the United Kingdom, Malaysia or Singapore during the period of 36 months immediately before the commencement of this Order and that patent is still in force on that date, the proprietor of the patent may, within a period of 24 months from that commencement date, make an application for a certificate of registration and the Registrar may issue a certificate on such application as if the Inventions Act (Chapter 72) and any regulations made thereunder had not been repealed.

(3) Where an application for a patent has been made before the commencement date under any law relating to patents having effect in the United Kingdom, Malaysia or Singapore and the application is pending on that commencement date, the applicant may, within a period of 12 months from the date of issue of the grant of a patent on that application, make an application for a certificate of registration and the Registrar may issue a certificate on such

application as if the Inventions Act (Chapter 72) and any regulations made thereunder had not been repealed.

(4) Any certificate of registration issued under section 4 of the Inventions Act (Chapter 72) and is in force immediately before the commencement date, or issued after that date by virtue of subsection (1), (2) or (3) shall continue in force and the patent to which the certificate relates shall be treated for the purposes of this Order as if it were a patent under this Order granted in pursuance of an application made under this Order and the proprietor of the patent shall accordingly have the same rights, remedies, privileges and obligations and subject to the same conditions (including the payment of any fee prescribed under section 35), as the proprietor of a patent under this Order subject to the following modifications —

(a) the term of the patent shall date from the date of the patent in the United Kingdom, Malaysia and Singapore, as the case may be, and the patent shall, subject to this Order remain in force for 20 years from that date and only so long as that patent has not been revoked in the United Kingdom, Malaysia or Singapore, as the case may be;

(b) such other modifications as may be prescribed.

(5) A patent to which subsection (4) applies shall be treated for the purposes of sections 14(3) and 17(2) as being granted on an application with a date of filing under this Order and published under this Order.

(6) The date of filing an application for a patent as mentioned in subsection (5), and the priority date of an invention or other matter contained in that application, shall be determined in accordance with the provisions of the applicable law relating to patents.

(7) Where an act is commenced before the commencement date and continues to be done on or after that date, then, if it would not, under the Inventions Act (Chapter 72), repealed by this Order, amount to an infringement of a patent or the privileges or rights arising under a specification, its continuance on or after that date shall not amount to the infringement of that patent or those privileges or rights.

(8) On the commencement date, the register of patents kept under section 9 of the Inventions Act (Chapter 72), repealed by this Order, shall be taken to form part of the register of patents kept under this Order.

(9) In this section, "commencement date" means the date of commencement of this Order.

SCHEDULE

section 2(1)

SUBSTANCES WHICH ARE NOT PHARMACEUTICAL PRODUCTS

1. In this Schedule, unless the context otherwise requires —

"Chinese proprietary medicine" means any medicinal product in any dosage form used in the system of therapeutics according to the traditional Chinese method, that is to say, any medicinal product —

(a) which has been manufactured as a finished product;

(b) which contains one or more active ingredients which are derived wholly from any plant, animal or mineral or a combination of plants, animals or minerals; and

(c) which is, or all of the active ingredients of which are, described in the current edition of "A Dictionary of Chinese Pharmacy", "The Chinese Herbal Medicine: Materia Medica" or such other publication as may be approved by the Minister,

but does not include —

(i) any medicinal product to be injected into the human body;

(ii) any item specified in the Poisons List in the Schedule to the Poisons Act (Chapter 114); or

(iii) any medicinal product which contains as an active ingredient any chemically defined isolated constituent of any plant, animal or mineral or a combination of plants, animals or minerals;

"current edition", in relation to any publication which describes a Chinese proprietary medicine, means an edition which is current at the time the Chinese proprietary medicine in question is sold or supplied, and includes any amendment, addition or deletion made to that edition of the publication up to that time;

"homoeopathic medicine" means any substance used in the system of therapeutics in which a disease is treated by the use of minute amounts of one or more substances capable of producing in a healthy human being symptoms similar to those of the disease being treated;

"medicated oil or balm" means any external medicated embrocation, medicated cream, ointment or inhalant which is used mainly for soothing purposes and which contains one or more of the following substances as active ingredients —

- (a) any essential oil;
- (b) any fixed oils derived from a plant;
- (c) methyl salicylate;
- (d) menthol;
- (e) camphor;
- (f) peppermint;

"quasi-medicinal product" means —

- (a) any anti-dandruff preparation;
- (b) any type of medicated cosmetics for the treatment of pimples and acne, except any preparation containing etretinate or 13-cis-retinoic acid;
- (c) any medicated soap;
- (d) any sweet for relieving coughs or throat irritations;
- (e) any medicated plaster;
- (f) any sunscreen or suntan preparation;
- (g) any medicated beverage;
- (h) any vitamin or nutritional preparation from a natural source; or
- (i) any medicated toothpaste;

"traditional medicine" means any medicinal product consisting of one or more substances derived from natural sources, that is to say, any plant, animal or mineral or a combination of plants, animals or minerals, but does not include —

- (a) any medicinal product administered by injection into a human body;
- (b) any vaccine used by a human being;
- (c) any product derived from human blood;

(d) any item specified in the Poisons List in the Schedule to the Poisons Act (Chapter 114); or

(e) any Chinese proprietary medicine.

2. For the purposes of this Order, "pharmaceutical product" does not include —

(a) any traditional medicine;

(b) any homoeopathic medicine;

(c) any quasi-medicinal product;

(d) any raw material which is used as an ingredient in the preparation or manufacture of any medicinal product; or

(e) any medicated oil or balm.

3. For the avoidance of doubt, for the purposes of this Order, "pharmaceutical product" does not include any substance —

(a) which is a type of food, a food additive or a food supplement; or

(b) which occurs naturally in any plant, animal or mineral.

Made this 14th. day of Zulkaedah, 1432 Hijriah corresponding to the 12th. day of October, 2011 at Our Istana Nurul Iman, Bandar Seri Begawan, Brunei Darussalam.

HIS MAJESTY
THE SULTAN AND YANG DI-PERTUAN
BRUNEI DARUSSALAM