

## Trade mark protection in the Pacific Island region

FB Rice manages trade mark portfolios throughout the Pacific Islands. We act directly before the Australian, New Zealand and Papua New Guinea trade marks offices and have strong relationships with local trade mark offices and attorneys in a range of Pacific Island nations to assist us with securing trade mark protection throughout the region.

Trade mark registration processes are diverse throughout the Pacific Island region. Some countries operate Trade Mark Registers, others allow re-registration of marks registered in other jurisdictions, while some smaller countries have no formal trade mark registration processes. For these smaller Island nations with no formal system, we recommend the placement of "Cautionary Notices" in local newspapers once a year, to place potential infringers on notice of a registered owner's rights. In addition, use of a trade mark will provide common law rights in most countries, and these rights may be enforced against infringers.

When dealing with trade mark protection and enforcement in the Pacific Island region, it should be remembered that many of the Island nations are small countries with limited resources. Trade mark registration or enforcement processes can be difficult, protracted, or fall into disarray at times of national conflict or environmental disaster.

### Trade mark protection in key pacific countries

The following key Pacific Island countries operate Trade Mark Registers or allow re-registration of marks registered in the United Kingdom (UK).

Country	Who may apply	Action available for counterfeiting	International classification	Goods & services	Multi classes
<b>Fiji</b>	First user or first applicant (whichever is earlier) AND owner of a UK registration	Customs seizure Infringement/ passing off	No – local class system used	Goods only	No
<b>Kiribati</b>	Owner of a UK registration	Infringement	Yes	Goods only	No
<b>Papua New Guinea</b>	First user or first applicant (whichever is earlier)	Infringement/ passing off	Yes	Yes	No
<b>Solomon Islands</b>	Owner of a UK registration	Infringement	Yes	Goods only	No
<b>Tonga</b>	First user or first applicant (whichever is earlier)	Infringement/ passing off	Yes	Yes	Yes
<b>Tuvalu</b>	Owner of a UK registration	Infringement	Yes	Goods only	No
<b>Vanuatu</b>	Owner of a UK registration	Infringement/ passing off	Yes	Yes	No
<b>Samoa</b>	First user or first applicant (whichever is earlier)	Infringement	Yes	Yes	Yes

On the following pages, we provide some further information on the trade mark protection regimes in each of the Pacific Island nations.

## Cook Islands

### Legal system

Incorporating English common law, certain British and New Zealand statutes and customary laws.

### Registration and protection of trade marks

The Cook Islands do not have an intellectual property system. Common law rights resulting from reputation and use will support a claim against counterfeit use. Regular publication of cautionary notices in a newspaper is useful to place others on notice of trade mark rights.

## Federated States of Micronesia

### Registration and protection of trade marks

It is not possible to register a trade mark in Micronesia. The only way to claim and assert rights in Micronesia is through common law and is based on use of the trade mark and public awareness of the trade mark and the goods/services it covers. Publication of cautionary notices in Islands Business and Fiji Islands Magazine are recommended.

## Fiji

### Legal system

English common law

### Registration and protection of trade marks

Registration may be obtained by filing a national registration or by seeking registration based on an existing, corresponding United Kingdom registration. Fiji does not use the Nice International Classification system (rather it uses the old British classes), does not have multiclass applications, nor are service marks able to be registered in Fiji. An authorisation of agent and certified copy of the UK registration (if re-registration of a UK registration is sought) are needed.

## French Polynesia (Tahiti)

### Legal system

French law

### Registration and protection of trade marks

As of 1 February 2014, national French trade mark registrations no longer automatically extend to French Polynesia. However, protection may be obtained in French Polynesia by filing a request at the French Trade Marks Office to revalidate a French registration in French Polynesia. The deadline to revalidate was 1 September 2015.

There is no national system for registration of trade marks in French Polynesia. Therefore, there is no opportunity for protection of a trade mark in French Polynesia at the moment.

## Kiribati

### Legal system

English common law and customary laws

### Registration and protection of trade marks

It is possible to register trade marks in Kiribati, and we are able to assist with this process. Only the owner of a UK registration for the same mark and goods can apply in Kiribati. It is not possible to cover services in Kiribati. An authorisation of agent and certified copy of the UK registration are needed.

## Marshall Islands

### Legal system

Mixed legal system of US and English common law, customary law, and local statutes

### Registration and protection of trade marks

It is not possible to register a trade mark in the Marshall Islands. Common law rights may be relied on to challenge counterfeit use of a mark. It is recommended that cautionary notices are published in a local newspaper in addition to use.

## Nauru

### Legal system

English common law

### Registration and protection of trade marks

Registration in Nauru may be obtained by filing a national registration and multiclass applications are permitted. An authorisation of agent and a notarised Declaration of Use or Intention to Use document are required to be submitted.

## New Caledonia

### Legal system

French law

### Registration and protection of trade marks

A French national registration automatically extends to New Caledonia. There is no national system for trade mark registration in New Caledonia.

## Niue

### Legal system

English and New Zealand common laws; customary laws

### Registration and protection of trade marks

A New Zealand trade mark registration under the 1953 Act previously extended coverage to Niue. However, this Act was repealed and the new 2002 Act does not extend the same coverage. It is possible to claim and assert common law rights in a trade mark in Niue. Publication of cautionary notices are also recommended.

## Palau

### Legal system

based on United States law

### Registration and protection of trade marks

It is not possible to register a trade mark in Palau. The only way to assert rights in a trade mark is through common law and is based on the use of the mark, the public's awareness of the mark and the goods/services which it covers. Publication of cautionary notices in local newspapers and Pacific Island magazines are recommended.

## Papua New Guinea

### Legal system

Based on English Common law

### Registration and protection of trade marks

Trade marks are registrable in Papua New Guinea. Services are covered but multiclass applications are not available. We act directly on behalf of applicants before the Intellectual Property Office of Papua New Guinea.

## Samoa

### Legal system

Based on English Common law

### Registration and protection of trade marks

For Samoa national applications can be lodged via our local associates with the Ministry of Commerce Industry and Labour. An authorisation of agent is needed appointing our local associates. Samoa is also a member of the Madrid Protocol and can be designated under the International Registration system.

## Solomon Islands

### Legal system

Based on English Common law

### Registration and protection of trade marks

Trade mark registrations in the Solomon Islands must be based on a corresponding United Kingdom registration which is re-registered directly with the Registrar General of the Solomon Islands. Multiclass applications are registrable but services marks are not permitted.

## Timor-Leste (East Timor)

### Legal system

Customary law

### Registration and protection of trade marks

There is no legislation to enable the registration of trade marks in Timor-Leste. Publication of a cautionary notice every one to two years in Timor-Leste newspapers to place third parties on notice of any claimed rights may be useful but effectiveness has not been tested. Common law rights can also be acquired by genuine use of a trade mark in Timor-Leste.

## Tokelau

### Legal system

Based on English Common law

### Registration and protection of trade marks

A New Zealand trade mark registration under the 1953 Act previously extended coverage to Tokelau. However, this Act was repealed and the new 2002 Act does not extend this same coverage. Tokelau is an extremely small country with a limited legal system and it is unlikely that common law trade mark rights can be enforced.

## Tonga

### Legal system

Based on English Common law

### Registration and protection of trade marks

Tonga has its own independent registration system. Multiclass applications are permitted and it is possible to register both goods and service marks.

## Tuvalu

### Legal system

Based on English Common law

### Registration and protection of trade marks

Only the owner of a United Kingdom registration for the same mark and goods/services can apply in Tuvalu. An authorisation of agent and certified copy of the United Kingdom registration are needed. Although trade mark legislation in Tuvalu does not provide for registration of service marks, the Registrar will register services if they are covered in the corresponding UK registration, although they are not necessarily enforceable.

## Vanuatu

### Legal system

Combined common law system, incorporating British, French and customary law

### Registration and protection of trade marks

Trade mark registration in Vanuatu is now independent; that is, registration is no longer based on an EU registration. Multiclass applications are permitted and service marks are registrable.

## How can we support you?

Your trade mark advisors are available to assist. As trade mark specialists, we are able to help you devise a trade mark protection strategy in the Pacific Islands. For further information, please contact the FB Rice trade marks team at [TradeMarks@fbrice.com.au](mailto:TradeMarks@fbrice.com.au).



Contact us

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