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By email and courier

The Chairperson
Standing Committee on Justice, Law and Human Rights
P.O. Box 2352
Parliament Complex, Government Buildings,
Suva

Attention Chairperson

WRITTEN SUBMISSION

Trademarks Bill 2020 – Bill No. 45

AJP ref 680534 LXT

We are making the following submissions on the Trademarks Bill 2020 – Bill No. 45 of 2020 ('the Trademarks Bill').

Background and preliminary comments

We are a specialist intellectual property law firm. We have extensive experience in dealing with design registration systems in New Zealand, Australia, and other countries.

We support Fiji introducing a comprehensive trademark law.

We note that the Regulations to support the Trademarks Bill are not yet available. Much of the detail relating to timeframes and procedures will be determined by the Regulations. We would appreciate the opportunity to make submissions on the draft Regulations once they are drafted.

We note that the Trademarks Bill is based on the New Zealand Trade Marks Act 2002. We generally agree with basing the Trademarks Bill on this law, as it means that there will be trademark practitioners who are intimately familiar with the procedures and requirements of the law. There is also extensive case law under the NZ Trademarks Act 2002, which can assist with interpreting the provisions of the Trademarks Bill.

There is one provision of the New Zealand Trade Marks Act 2002, which is proposed to be updated by the New Zealand government. We comment on that provision below and submit that this provision should be updated in the Trademarks Bill before the bill is enacted.

We also make some general comments below.

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Section 20 – exceptions

Section 20 states:

‘The commissioner must register trademark A if –

- (a) the owner of trademark B, trademark C, or trademark D (as the case may require) consents to the registration of trademark A; or
- (b) the Commissioner or the court, as the case may be, considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Commissioner or the court, makes it proper for the trademark to be registered subject to any conditions that the Commissioner or the court may impose.

In Australia, a similar provision includes ‘prior use’ as a ground the Registrar can rely on to allow a mark to progress to registration.

In New Zealand, we understand the legislature is considering introducing a similar ground to the provision.

We recommend you allow ‘prior use’ as a ground the Commissioner can rely on to allow a mark to progress to registration under this section.

Section 13 – No appeal against decision of Minister

In Section 13, it makes it clear that the decision of the Minister under Section 12(2), (3) or (4) cannot be appealed.

But Section 12(4) grants a power to the Commissioner to refuse the registration of a mark if the application is made in bad faith. The Minister does not make any decision under Section 12(4).

We suggest that Section 13 be limited to decisions of the Minister under Sections 12(2) and (3).

Concluding remarks

We thank you for the opportunity to submit on the Trademarks Bill. We are happy to discuss further any of the points raised.

Yours sincerely



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