

12 February 2021

Aminiasi Vulaono, Chair, FLS Legislative Committee.

Comments/Notes Re FIJI TRADEMARK BILL

Section	Comments
Section 2	<p>It is the interpretation clause of the Bill.</p> <ul style="list-style-type: none"> • Various interpretations and references need to be amended. • Definition of “applicant” in cases of assignment referring to s74 does not make sense because s74 refers to advertisement of alteration of rules. Assignments are dealt with in S75 therefore amend “74” to “75”. • Reserve comments regarding the definition of “convention country” until the regulations are made available.
Section 12	<p>The section refers to “absolute grounds” to refuse a trade mark registration (S12 (1)) yet it can be approved by the minister subject to conditions (S12 (3)). So they are not <i>absolute</i> grounds – minister over rules the commissioner.</p> <ul style="list-style-type: none"> • If the Commissioner disapproves (S12 (1)) but the Minister can approve – what are the procedures to get the minister to review (S 12(3))? Is it an appeal? Time period? • Contradicts section 144 which says that all decisions of the Commissioner under the Act can be appealed to court. • All decisions made by the minister under section 12 is final and cannot be reviewed by a court of law. Why? Wide powers given to the minister who will not be required to meet any legal standard etc.



	<ul style="list-style-type: none">• The Bill does not provide a definition of what “words implying geographic origins” constitute – does it mean of origin in Fiji only or origin in any part of the world and does constitute to imply origin.• The Bill also does not provide a reason why an applicant cannot register their trading name or company name – some trade marks a company or trading names presented in a special manner e.g. the “Apple” brand.
Section 13	<p>Decisions of the minister under S12 is final and cannot be challenged in any court of law. According to the explanatory notes of the Bill – S13 only relates to decisions of the Minister regarding the use of the word “Fiji”.</p> <ul style="list-style-type: none">• This is misleading because S12 decisions and S13 are not limited to the use of the word “Fiji”.• Laws should not prevent anyone from challenging the decisions of public officers including ministers.
Section 25	<p>Requires goods and services to be filed according to the Nice Classification. Any issue arising from the classification or which class is appropriate may be determined by the Commissioner and such decision is final.</p> <ul style="list-style-type: none">• From previous applications – what constitutes the right class is based on interpretation of the registry and not law. If the registry directs goods to be filed in wrong class then who is liable when there is an issue of infringement against client’s trademark but the court ruled that the client is not protected because due to the decision of the registry, the client’s trademark is not registered in the relevant class?• Any decision of a public officer should be subjected to challenge in a court of law.
Section 28	<p>Deals with priorities of applications for identical or similar marks that first come first serve.</p> <ul style="list-style-type: none">• Regulation should allow for scanned documents to be filed for earlier filing date and originals to be filed later upon receipt by mail/courier. This will cater for overseas applicants as well.
Section 36	<p>Registry may revoke acceptance if acceptance was issued by error of the registry. Once an application is accepted, the applicant incurs costs to advertise the application for opposition (s40).</p>

	<ul style="list-style-type: none"> If registry revokes acceptance due to its own error – it should refund costs of advertisement and/or application fees etc. Alternatively, the Act must make it mandatory that it's the registry and not the applicant that takes steps to advertise the application and also pay for it.
Section 44 (2)	<p>Commissioner must not register a trade mark until 6 months after the date of application.</p> <ul style="list-style-type: none"> Current applications may remain pending for over 2 years without any notice or update from the registry. The Act must include a provision of timelines in which the registry or commissioner must act. Under the Trade Marks Act 1933 (“the current Act”), there is a general provision that applications for registration must be completed within 12 months from date of application and any delay on the part of the applicant may make the application deemed abandoned.
Section 53	<p>Deals with procedures for renewal – makes it mandatory for the registry to issue Notice that TM about to expire and require the TM to be renewed, otherwise TM registration is removed from the register 6 months after expiry. S53 (4).</p> <ul style="list-style-type: none"> The previous Act also has a similar provision but I have never received any such notice for renewals of registration where our firm was the registered agent for services. What happens when the registry does not comply with these requirements to issue notices? Bill should be amended to state that the 6 months’ grace period will only commence from when the notice from the registry issued.
Sections 92, 93 & 94	<p>A licensee of a registered TM may request the registered owner to commence proceedings. If the registered owner refused to or neglects to commence proceeding within 2 months, then the licensee himself can commence action in its own name. If the licensee commences an action, then the registered owner will have to be named a defendant and may be liable for costs if the owner elects to defend.</p> <ul style="list-style-type: none"> What is the logic behind these provisions? Consent is discretionary but licensee will still proceed? What if consent was withheld on reasonable grounds?
Section 107	<p>Offence to counterfeit on a “<i>commercial scale</i>”?</p> <ul style="list-style-type: none"> What does this mean – by quantity or by income etc.? Need to define a minimum specific threshold.



Sections 107-123	<p>These sections outline offences under the trademark act and the penalties. It also provides the types of orders that the court may grant in criminal offences and the considerations for those orders.</p> <ul style="list-style-type: none">• However, these sections do not provide under whose jurisdiction does the investigation and prosecution of these offence come under and the complaint procedures. Similar provisions in the NZ TM Act but the NZ Act goes further and appoints “Enforcement Enforcers” and their functions which include gathering and investigating complaints of offences – the NZ Act also outlines the powers of the police in relation to the offence under their Trade Mark Act (S134A-S134ZF). Fiji’s Bill has omitted these sections and there is no reference as to who has the investigation, prosecution and enforcement powers.
Section 125	<p>Any rights owner order may apply to FRCS to seize goods at the border that was suspected to be infringing goods.</p> <ul style="list-style-type: none">• This means that the onus is on the rights owner to file an application for seizure. Problems that arise from this is time and that owners may not even know that infringing goods (counterfeit goods) are being imported into Fiji. In other case, the rights owner may file an application but the goods already have been released from FRCS’s possession.• Section 125 is not clear whether notice by rights owner refers to any shipments during a specific period of time or a specific shipment or can mean both.• Section 129 provides powers to FRCS to seize goods at its own discretion that is suspected of being infringing goods. Once seized, they then contact the rights owner and see if the rights owner has any issue.• Recommend that FRCS set up a register where right owners can register themselves for a fee (e.g. annual fee) to request FRCS to carry out border watch on their behalf and alert rights owner of any suspicious cargos. Rights owners have to provide evidence of TM registration in order to be placed on the register.
Section 126 (8)	<p>Custom may refuse to seize goods unless rights owner provide sufficient security to indemnify FRCS against any liability.</p> <ul style="list-style-type: none">• This will discourage brand owners and will take up time considering the fast pace of the commercial world.

	<ul style="list-style-type: none"> • Act should simply provide that FRCS is immune to any liability for duly performing its duties under the Act and when acting in good faith. If FRCS abuse power, malice or negligence and act outside the scope of the Act then FRCS itself should pay liability and not the brand owner. • Section 152 – the Commissioner or anyone acting on behalf of the Commissioner cannot be personally liable for any act or omission if done in good faith in accordance with the Act. Why can't a similar provision be included for FRCS?
Section 127	<p>Mandatory for FRCS to suspend clearance of good if it is satisfied that the importing goods are infringing goods.</p> <ul style="list-style-type: none"> • S127 is not subject to S126 (8) so even if FRCS require security they will have to suspend clearance if it is satisfied that the goods are infringing goods? • What is the period of the suspension? 10 working days implied from s128 (2b)?
Section 125-129	<p>Words “rights holder” and “applicant” are used interchangeably. Do they refer to same party? S131 (1) implies that they are different therefore need to clarify this to avoid confusion.</p>
Section 129	<p>Gives discretion to FRCS to seize goods on its own initiative if FRCS have prima facie evidence or reasonable grounds that goods are infringing. Once seized, s127 and 128 applies accordingly.</p> <ul style="list-style-type: none"> • Good clause. • S129 requires FRCS to immediately inform the owner of the rights (s129 jumps to s128 and 129). However, how would FRCS know the place of service of the rights owner? What happens if FRCS is not able to serve the Notice because it does not know the owner or place of service of the owner? • It is a matter of making FRCS carry out this function but I highly doubt they will. • Recommend the introduction of a register where rights owner can register themselves in providing details of their place of service in Fiji, the details of their registrations.



Section 145	<p>Provides that an appeal under section 136 must be filed in Court and served to the Commissioner within 20 working days.</p> <ul style="list-style-type: none">• Section 136 deals with registration being a prima facie evidence of validity so section 145 does not make sense.• Section 145 will make sense if it refers to section 144 which deals with appeals of decisions of the Commissioner made under the Act and not section 136.
Section 149	<p>The Solicitor General is the Commissioner of Trade Marks.</p> <ul style="list-style-type: none">• This is the same as the current system where the TM Act was amended to omit the Office of the Administrator General and gave this function to the Office of the Solicitor General.• Since the amendment, the procedures and turnaround time for applications to be processed has taken longer.• Needs a separate office of the Commissioner who can only consult the Office of the Solicitor General in contentious matters.
Section 161 & 162	<p>Deals with the opening and closing hours of the Fiji Intellectual Property Office.</p> <ul style="list-style-type: none">• While the Bill deals with the opening and closing hours and procedures of notifying closure, it does not provide how the Office fits into the Bill and Trade Mark Bill.• The Bill does not provide the roles and function of FIPO.• The Bill does not provide the powers of FIPO.• Under the current procedure, filings are address to the Solicitor General but filings made at FIPO. While the current law stipulates that the Solicitor General is the governing office of the Trade Mark Act, decisions or directions are issued under the letter head of FIPO.• Recommend that the Bill provides details of the functions, powers and roles of FIPO.• By providing clarification, we are not confused as to whose decision is to be appealed etc.

Section 172	<p>S172 (1) – Fiji TM Act 1933 shall continue to apply for any application for registration, renewal, alteration, assignment or cancellation etc. received before the new TM Acts come into place.</p> <p>S172 (2) – New Act does not invalidate any valid and current registrations.</p> <ul style="list-style-type: none"> • Sections 172 (1) and (2) are vague. • Once pending applications are approved, will they be deemed valid under the new Act? • Will existing registrations be deemed valid under the new Act or will they continued to be renewed under the current Trade Marks Act every 10 or 14 years whichever is applicable? • Opposition proceedings that were and have been pending in Fiji for over a decade and they still have not been heard. What happens to these proceedings when the new Act comes into force?
GENERAL COMMENTS	<p>S12 (1)(c) prohibits the registration of a trademark that in the opinion of the Commissioner may offend a significant section of the community.</p> <p>Recommend: Setting up an advisory committee to review applications and determine whether it will offend sections of the community. This relates to traditional knowledge/issues, religious issues. Committee to be made up of a fair representation of members of the communities.</p> <p>-----</p> <p>Insert clause for local address for filing and/or services. Prevents registry from incurring costs to send certificates overseas. Prevents local parties for applying to Court for overseas services in terms of proceedings etc.</p> <p>-----</p> <p>Regulations and what will be considered as “Prescribed” forms, procedures are yet to be provided or written. Reserve further comments until we are provided with copies of regulations under sections 170.</p> <p>-----</p>



I believe that a new Trade Mark Act for Fiji is long overdue and any effort to update the law is very much welcomed. However, based on current practices, the main issue in Fiji is the lack of enforcement and/compliance by the registry, commissioner and FRCS. While laws may be developed, it may not be useful if the registries and relevant authorities do not perform their duties under these laws. An example is that while opponents have filed Notices of Oppositions and applicants have filed counter statements, the Commissioner has not heard any opposition proceeding for more than 10 years either due to lack of resources or willingness.

The Act does not bind the State - Trade mark owners should have remedies against the State and statutory bodies for infringement.