



February 8, 2021

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

Via e-mail to [ira.komaisavai@parliament.gov.fj](mailto:ira.komaisavai@parliament.gov.fj) and [jackson.cakcaka@parliament.gov.fj](mailto:jackson.cakcaka@parliament.gov.fj)

RE: INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON TRADEMARKS BILL 2020

Dear Hon. Alvick Avhikrit Maharaj:

The International Trademark Association is pleased to provide comments on Fiji's proposed Trademarks Bill of 2020 and other intellectual property bills under consideration including the Designs Bill of 2020.

INTA is a not-for-profit global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation.

INTA's has 7,200 member organizations from 189 countries. INTA members collectively contribute almost US \$12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. The Association's member organizations represent over 31,000 trademark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms, and nonprofits.

Headquartered in New York City, INTA also has offices in Brussels, Santiago, Beijing, Singapore, and Washington D.C. and representatives in New Delhi.

### **General Comments**

INTA commends the government of Fiji to update existing intellectual property laws. The value of trademark intensive industries to developing economies is well documented.<sup>1</sup> For example, research conducted by INTA in 2017 in Southeast Asia found that the direct contribution of trademark-intensive industries to GDP varies between around a fifth and a third of GDP. Fiji's development of trademark rights will likely also contribute to the value of trademark-intensive industries to overall GDP.

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<sup>1</sup> [https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/INTA\\_ASEAN\\_Economic\\_Impact\\_Study\\_082717.pdf](https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/INTA_ASEAN_Economic_Impact_Study_082717.pdf) and <https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/Latin-America-Part-2-Summary-EN.pdf>

Furthermore, INTA offers its resources to the Fiji government as it implements new intellectual property laws. In addition to INTA's Model Trademark Law Guidelines,<sup>2</sup> INTA also recommends the provisions contained in our Model Trademark Examination Guidelines, as well as our Model Design Law Guidelines<sup>3</sup> and Model Design Examination Guidelines.<sup>4</sup> We extend a general offer of engagement with INTA's expert committees to train IP-related officers and communicate with the global brand owner community, including through our Trademark Office Practices Committee, and Anticounterfeiting Committee among others.

The changes proposed in Fiji's Trademarks Bill 2020 are very welcome. The Bill brings Fiji into the modern trademark community by updating its antiquated legislation; by abandoning the grant of rights by re-registration of UK marks; by adopting the Nice classification system; by abandoning the long-superseded UK class system of the early 20th century; by adopting the legislation that conforms to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS); by signing up to the Paris Convention; and by acceding the Madrid Protocol. It replaces the previous legislation dating from 1933, which predates the repealed UK Trade Marks Act of 1938.

## **Trademark Office Practice**

### *Non-traditional Marks*

The definition of "sign" arguably is not exhaustive and allows for consideration of other signs. There is no explicit mention of aspects of packaging and there is no mention of holograms, motion, or position trademarks. INTA recommends specific inclusion or interpretation of "sign" to include these types of non-traditional marks. Additionally, the requirement that a trademark be capable of graphical representation may impose a burden on applicants seeking registration of certain non-traditional trademarks. The examination guidelines to be issued by the Fiji IP Office should address these concerns and adopt global best-practices for examination of non-traditional marks. INTA offers the resources of its Non-traditional Marks Committee for training and sharing of best practices in this regard.

### *Review of Decisions*

Section 13 and other sections of the Bill indicate that decisions by the Minister are final. For example, Section 25 requires goods and services to be filed according to the Nice Classification and any issue arising from the classification may be determined by the Commissioner and such decision is final.

Registry procedures concerning the acquisition or maintenance of trademark rights (including procedures for opposition, revocation and cancellation whether *inter partes* or *ex officio*) should be fair and equitable. The procedures should not be unnecessarily complicated or costly or entail unreasonable time limits or unwarranted delays.

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<sup>2</sup> <https://www.inta.org/wp-content/uploads/public-files/advocacy/model-laws-guidelines/INTA-Model-Trademark-Law-Guidelines-v2019.pdf>

<sup>3</sup> <https://www.inta.org/wp-content/uploads/public-files/advocacy/model-laws-guidelines/2019-draft-Model-Design-Law-Guidelines.pdf>

<sup>4</sup> <https://www.inta.org/wp-content/uploads/public-files/advocacy/model-laws-guidelines/INTA-Guidelines-for-Examination-Designs-Nov-2018.pdf>

Decisions on the merits of a case should be in writing and reasoned and made available to those directly affected by the decision without undue delay. Such decisions should be based only on evidence in respect of which parties have been offered the opportunity to be heard. Such decisions should be subject to review by a judicial or quasi-judicial authority.<sup>5</sup>

Registries should not require the notarization or certification of any signatures in trademark application or renewal procedures, or of any evidence submitted in administrative appeals or other proceedings before the registries including, without limitation, oppositions, cancellation actions, nullity actions, revocation proceedings and the like.

### *Transition Provisions*

The transitional provisions should be given further consideration. They do not make clear how the Bill will apply to existing registrations. As a reference, compare the New Zealand transitional provisions in the New Zealand Trade Mark Act Sections 208 and 209.

Existing registrations are based on the old British Imperial system. There is no provision regarding whether and how these registrations are to be segued into the new Nice Classifications including where additional classes may be involved. If the existing registrations are not to be reclassified, the Act should make provision for this.

Existing registrations are for one class only. The Bill provides for multi-class registrations. The Bill makes no provision for amalgamating existing registrations. Presumably each existing registration will continue separately. Presently registrations may cover all goods in a class which is no longer permitted under the new Act. The Bill should make clear what happens to the existing class-wide registrations.

There should be express provisions that existing registrations are not invalidated automatically but may be declared invalid under section 77, that the dates relating to existing registered trademarks continue to apply, and that they may be revoked for non-use under this Act.

### **Deadlines**

The Bill provides that an appeal under Section 136 must be filed in Court and served on the Commissioner within 20 working days. This period of time is very short given the fact that letters from FIPO are often delivered after the date of the letter and owners are often offshore and have to liaise with local lawyers for documentation and evidence.

### **Border Protection and Anticounterfeiting**

INTA provided comments in 2020 on recent proposed amendments to Fiji's Customs Law, and we provide a summary of our concerns as they related to cross border and anticounterfeiting measures below.

The effect of the definition of 'rights holder' is unclear. It is used interchangeably with 'applicant' which is defined in Section 2. Elsewhere the Act refers to "exclusive licensee" but owners may have different licensees in different jurisdictions any of whom may want to act.

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<sup>5</sup> See TRIPS Agreement Article 15.5 and INTA Model Trademark Law Guidelines Section 6.7

Section 107 includes the terms of “commercial scale” counterfeiting. INTA recommends clarification of these terms and notes the need for discretion in determining “commercial scale” given the realities that small consignments of counterfeits are sold via e-commerce and thus measures relying on quantity or value alone may be insufficient to properly identify this crime.

#### *Counterfeit Goods in Transit*

INTA strongly encourages Fiji to prevent the transshipment of counterfeit goods and protect the integrity of the global trading system by preventing criminal abuse of Fiji’s ports through the transshipment of illegal counterfeit goods.

INTA believes that Fiji should intercept and seize counterfeit goods in transit without exemption. The practice hurts companies whose products are being counterfeited and distributed within Fiji and abroad, not to mention any goods in transit that are re-imported from their destination countries back into the Fiji market.

Allowing counterfeit goods in transit to pass through Fiji undermines the good work of law enforcement and Fiji officers and exposes consumers in countless countries to harmful counterfeit products. It may also encourage the use of Fiji as a convenient transit destination by organized crime.

#### *Customs Recordation System*

A customs recordal system for trademarks would also be an advantageous means to provide notice to customs of brands that are actively seeking protection from cross-border trade in counterfeit goods. Customs officials are an important line of defense against counterfeit products entering the country. In order to effectively ensure that counterfeits do not enter the market, customs authorities need appropriate resources and tools to identify counterfeits and exchange information with each other and with trademark owners. Currently, there is no efficient system in place to allow trademark owners to provide information that is critical to identifying counterfeit goods, such as identification manuals on how to determine a good is genuine or contact information of a designee of the brand owner to provide any additional support needed, to the customs officers. We recommend that Fiji enact such a system which has proven beneficial to brand owners in combating counterfeiting in many jurisdictions.

#### *Trainings and Capacity Building*

INTA would like to suggest that continuous training and capacity building for enforcement officials occur on a regular basis. Capacity building for officials on brand identification, IPR and IPR regulations could be helpful in connecting the public and private sectors and encourage information sharing between the two stakeholders. Continuous workshops and training sessions jointly conducted by rights holders in coordination with customs is crucial to ensure smooth and effective implementation of customs rules and regulations.

#### *Intellectual Property Rights Coordination Center*

INTA welcomes amendments to streamline domestic and international coordination among law enforcement agencies and wishes to also highlight the importance of information sharing between brand owners and enforcement agencies to achieve effective brand protection. The formation of a national IPR coordination center would be strongly recommended for your consideration. INTA produced [this guide](#) for government seeking to implement such a body. The goal of the proposed office would be to establish a

central coordination unit to fight against counterfeits, piracy, and other intellectual property crimes. Because of counterfeiting's links to organized crime, money laundering, threats to public safety, etc., many agencies at the national level are looking at this type of crime in isolation without developing the expertise to tackle the complexities of the crime. The IPRC would be a singular unit of coordination between the different industries effected by these crimes, the governmental officials that work to stop it, and the targeted public. The office would also provide coordination between the different governmental offices at the national level and would facilitate coordination between national officials and other jurisdictions globally.

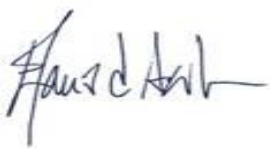
## **Designs**

Currently designs are protected in Fiji under the UK Designs (Protection) Act 1936 which extends the protections under the UK design registration legislation to Fiji. The new Fiji Designs Bill will allow new and original designs to be registered and protected in Fiji for 2 periods of 5 years. It will repeal the existing UK Designs (Protection) Act 1936 which will leave design owners who were relying on their rights in the UK to protect their designs in Fiji, without protection. There should be a transitional provision providing that UK registrations continue to be protected in Fiji for a certain period.

INTA encourages Fiji to join the Hague Agreement concerning the International Registration of Industrial Designs. In line with the Hague Agreement, we support a term of protection of at least 15 years from application (even if made up of renewals after multiple shorter periods - for example, 3 terms of 5 years).

INTA appreciates your consideration of its comments on the Trademarks Bill of 2020. This document was prepared by INTA advocacy committees, and staff. For any questions relating to this submission please contact Mr. Seth Hays, Chief Representative, Asia Pacific, at [shays@inta.org](mailto:shays@inta.org) and Ms. Valentina Salmoiraghi, Anticounterfeiting Advisor, Asia Pacific, at [vsalmoiraghi@inta.org](mailto:vsalmoiraghi@inta.org).

Sincerely,

A handwritten signature in dark ink, appearing to read 'Etienne Sanz de Acedo', with a stylized, cursive script.

Etienne Sanz de Acedo

Chief Executive Officer  
International Trademark Association