

**U.S. GOVERNMENT COMMENTS AND QUESTIONS REGARDING FIJI'S
PROPOSED TRADEMARKS BILL, PATENTS BILL, AND DESIGNS BILL**

February 11, 2021

General Comments

The United States appreciates the opportunity to provide comments and questions regarding Fiji's proposed bills on trademarks, patents, and designs. The United States looks forward to hearing the Government of Fiji's responses to our questions below and to continuing our discussions in the near future.

The United States has several comments and questions regarding the proposed Trademarks Bill, Patents Bill, and Designs Bill. The United States also encourages Fiji to accede to international intellectual property treaties, including the Singapore Treaty on the Law of Trademarks (Singapore Treaty) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol). The United States stands ready to provide additional information and training on these treaties, as well as on any of the comments listed below.

Specific Comments and Questions

TRADEMARKS BILL 2020 (BILL NO. 45 OF 2020)

It appears that Fiji protects geographical indications through its trademark system. Can Fiji please confirm this?

The United States encourages Fiji to provide public access to trademark registries online and the ability to search the registry electronically. Does Fiji currently have plans to host its registry on a public, searchable, electronic database?

Article 2(1)

This article defines a "sign" to include "a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word," and "any combination of signs." This definition includes smell, sound, and taste, which are not visually perceptible. However, the definitions of the terms "certification trademark," "collective trademark," and "trademark" in the same article include the wording "a sign capable of... being represented graphically." This definition appears to contradict the registrability of non-visually perceptible trademarks, which may not have a graphic representation. Can Fiji explain this discrepancy?

If a graphic representation is required for all marks, would a written description of a non-visually perceptible sign, such as a smell or scent, sound, or taste, which functions as a trademark satisfy the requirement of "capable of... being represented graphically" under Fiji's draft law? The United States recommends that the draft law allow for non-visually perceptible signs that function as trademarks to be eligible for registration and that Fiji allow for written descriptions of such trademarks to satisfy the graphic representation requirement. The United States believes

that businesses are best positioned to select what identifies their source to consumers and if non-visually perceptible trademarks function as source indicators, the United States believes that such trademarks should be eligible for trademark protection. In the alternative, the United States recommends striking the requirement for graphical representation from the definitions of “certification trademark,” “collective trademark,” and “trademark,” to allow non-visually perceptible signs to be eligible for protection in Fiji.

The definition of “certification trademark” includes wording that indicate that such signs include “goods certified by any *person*...” and “services certified by any *person*...” (emphasis added). Also, the definition of “owner” indicates that “in relation to a certification trademark that is registered... [the owner is] the *person* who certifies...” (emphasis added). In addition, the term “person” is used in connection with certification trademarks in Article 9(3) and Article 10, as well as elsewhere in the draft law. Can Fiji clarify whether a legal person such as a business entity (e.g. a corporation, a partnership, etc.) serve as a certifier? The United States recommends permitting both legal and natural persons to serve as certifiers.

Article 12(1)

This article indicates absolute grounds for refusing registration, and subpart (1)(2) indicates that signs that “is contrary to any written law *or would otherwise be disentitled to protection in any court*,” are not registerable in Fiji (emphasis added). Is “would otherwise be disentitled to protection in any court” intended to capture common law in Fiji that is not yet codified by statute or regulation?

Article 12(2)

This article prevents registration of the term “Fiji” unless approved by the Minister. This article appears to contradict Article 14(1)(c), which notes that geographic terms will not be denied registration if they can show the terms have acquired distinctiveness as a trademark under Article 14(2). Since “Fiji” is a geographic term, can Fiji clarify how these provisions work together?

Article 12(3)

This article indicates conditions on when approval from the Minister for registration of the term “Fiji” would be granted. One of the reasons listed is that “the mark complies and is in accordance generally with approved marks and brands recognised and licensed in accordance with written laws.” Can Fiji clarify what would qualify as being “in accordance generally with approved marks and brands recognised and licensed in accordance with written laws”?

Article 12(4)

The United States applauds Fiji for including a refusal for applications made in bad faith. The United States would be interested in exchanging information with Fiji regarding the implementation of laws to address trademark applications filed in bad faith.

Article 14(1)(d)

This article includes a refusal for trademark applications consisting only of “signs or indications that have become customary in the current language or in the *bona fide* and established practices of trade.” Can Fiji explain the purpose of the wording “in the current language”? Does this mean that the sign is currently in customary use in Fiji?

Article 15(1)

Is this article intended to apply to marks solely consisting of color? Please clarify.

Article 17

This article indicates that a trademark containing the words “copyright,” “layout design,” “patent,” “patented,” “plant variety right,” “registered,” “registered design,” or “trademark,” “or any abbreviations of those words, or any similar words,” may be registered. Does Fiji intend to include a “condition,” as defined by Article 2(1), in the registration certificate to clarify that it does not grant rights to the trademark owner as to these words?

Article 18

This article requires consent if the name of a person appears in the trademark. The United States supports the inclusion of such a provision. The article notes that consent is not required if the person has been deceased more than ten years. Are there provisions of the law that provide protection for names of famous deceased persons (e.g. “Elvis Presley”), which may have an estate still managing use of their name? Would Fiji utilize Article 12(4), which allows for refusal of applications in bad faith, to refuse registration in such circumstances?

Article 20(b)

This article provides that the Commissioner or the court must register a trademark if the Commissioner or the court “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.” The phrase “or other special circumstances exist” is very broad. Can Fiji clarify the specific types of special circumstances that would be encompassed by this phrase?

Article 22(a)

This article allows for the use of a flag in a mark without authorization if the “use of the flag in the manner proposed is permitted without that authorisation.” Can Fiji clarify the circumstances under which registration of a flag would be permitted? In the United States, registration will be refused if the design sought to be registered includes a true representation of the flag of the United States, any state, municipality, or foreign nation, or is a simulation thereof. The United States does not accept authorizations as a way to overcome this refusal to register. A refusal must be issued if the design would be perceived by the public as a flag, regardless of whether

other matter appears with or on the flag. However, registration may be permitted if the flag is highly stylized or incomplete. See [TMEP Section 1204](#).

Article 26

The United States applauds Article 26(2) as trademarks should be in actual use or filed with intent to actually use the mark.

Article 28(3)

This subpart of the article notes that “[f]or purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.” As the Fiji trademark office grows and receives additional filings, the ability to designate priority may become more important. As such, the United States recommends implementing a system that would give priority to the earlier received application. The United States is willing to further discuss U.S. practice with respect to handling priority of trademark applications.

Article 40

This article indicates that “[t]he Commissioner must ensure that an application that has been accepted is advertised in the prescribed manner, if any.” Read in concert with Articles 41 et seq., it appears that this article intends to allow, but not mandate, pre-registration publication of the trademark for opposition. The United States encourages Fiji to provide for pre-registration publication of applied-for trademarks for opposition, which is permitted under TRIPS Article 15(5). The United States also encourages Fiji to make these publications after the Commissioner has completed its review of the applications, through an official channel easily accessible by the public and preferably online. Further, the United States encourages Fiji to provide a reasonable time period for parties to bring oppositions after the mark is published and to include this information in its law or implementing regulation.

Article 41

This article addresses opposition to accepted trademark applications. Under this article, does a “person” include both legal and natural persons? Can Fiji clarify whether any legal or natural person may bring an opposition proceeding, or whether there is a requirement for them to have an interest or standing?

Does Fiji have plans to specify the possible grounds for opposition in its law or implementing regulations? Moreover, the United States recommends that these grounds include those which are set forth in *Division 2 - Absolute grounds for not registering trademark* and *Division 3 - Relative grounds for not registering trademark*.

Article 43

This article outlines certain steps the Commissioner must take in making an opposition determination. Can Fiji explain in what instances would the Commissioner be required to hear

the parties? For instance, if a party requests a hearing with the Commissioner, must the Commissioner hear the parties?

Article 56

This article addresses the cancellation or alteration of a trademark. In this article, does the word “person” apply to both natural and legal persons?

Articles 57 and 58

The United States recommends that the cancellation grounds included in Article 60(1)(a),(b), and (c) be added to the grounds for cancellation of certification and collective trademarks, including lack of use during a continuous period of five years or more, the certification trademark or collective trademark has become a common name, or the certification or collective trademark is likely to deceive the public as to the nature, quality, or geographical origin of those goods or services.

Article 60(1)(c)

This subpart of the article indicates that one ground for revoking a trademark is when “(i) the article or substance was formerly manufactured under a patent or the service was formerly a patented process; and (ii) a period of 2 years or more has elapsed since the expiration of the patent; and (iii) the word is or the words are the only practicable name or description of the article, substance or service.” This subpart appears to be a more narrow version of ground for revoking a trademark than the ground included in Article 60(1)(b). Can Fiji explain the rationale for including the more narrow ground in Article 60(1)(c)?

Articles 63-66

Will Fiji’s trademark Commissioner require applicants to disclaim non-distinctive portions of trademarks, certification trademarks, and/or collective trademarks in the course of examination of the application prior to publication? Is the requirement for a disclaimer limited to the “grounds specified in section 60(1)(b) or (c)?” The United States encourages Fiji to consider implementing a disclaimer requirement prior to publication, in which it requires applicants to disclaim non-distinctive matter in compound marks. Moreover, the United States encourages Fiji to print these disclaimers on the registration certificate and in the official record.

Article 71

This article states that “[t]he owner of a registered trademark may not alter the registered trademark after its actual date of registration.” Does Fiji’s draft law allow trademark applicants to amend the applied-for trademark after its filing date? The United States encourages Fiji to not permit any material alterations to applied-for trademarks after the date of filing to create certainty for businesses.

Article 154

This article pertains to the keeping and maintaining of the register. The United States encourages an electronic, searchable, public database of trademarks, collective marks, and certification marks. Does Fiji have plans to create such a database?

Article 155

This article describes the contents of the register. The United States recommends Fiji to add “the goods and/or services for which the trademark, certification mark, or collective mark has been filed” to this list, as an accurate recitation of the goods and services provide vital notice to businesses seeking to register their marks.

Article 166

This article states that “[t]he Commissioner may, at the written request of the person who has made an application, other than an application for the registration of a trademark, or filed a notice or other document for the purposes of this Act, or, at the written request of the person’s agent, amend the application, notice or document – (a) to correct a clerical error or an obvious mistake; or (b) if the Commissioner is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.”

Subpart (b) appears to provide the Commissioner significant discretion in determining amendments. Can Fiji explain what scenarios might be deemed “fair and reasonable in all the circumstances of the case”? Does Fiji plan to provide further clarity and details through implementing regulations?

Does Fiji’s draft law allow certification trademark and collective trademark applicants the ability to amend the applied-for certification trademarks and/or applied-for collective trademark after application filing? The United States encourages Fiji not to permit any material alterations to the applied-for certification trademark and/or applied-for collective trademarks to create greater business certainty.

For certification marks, does Fiji’s draft law permit applicants to amend their listing of goods or services certified, as submitted in the application, after the date of filing? While the United States encourages Fiji to permit the narrowing of the goods and services, the United States does not recommend permitting any broadening of the scope of the goods and services identified in the application to create greater business certainty.

For collective marks, the United States also encourages Fiji to permit the narrowing of the goods and services, but the United States does not recommend permitting any broadening of the scope of the goods and services identified in the application to create greater business certainty.

Article 170

This article states that “[t]he Minister may make regulations to prescribe matters that are required or permitted by this Act...” Does Fiji envision promulgating further regulations to implement this draft law, once it is passed? If so, the United States would welcome the opportunity to provide comments on the draft regulations.

It appears that Fiji is planning to accede to the Madrid Protocol. The United States welcomes this development and stands ready to exchange information on the United States’ experience in acceding to this agreement.

Civil Proceedings for Infringement

Article 96(1)(b)

This article specifies that relief may include “either damages or account of profits.”

It is noted that this article is limited by the term *or*. The article as presently written may not adequately compensate the right holder or put the right holder back in the position it would have been in had the infringement not occur. The United States recommends that *or* be replaced with *and* such that the right holder has the opportunity to recover both the infringer’s profits and the damages suffered by the right holder. Moreover, the United States recommends specifying that courts have the authority to order the infringer to pay the right holder’s expenses, which may include appropriate attorney’s fees, as required by TRIPS Article 45(2).

Article 96(2)

This article states that the court may grant additional damages as the court requires in particular to “the flagrancy of the infringement” and “any benefit accruing to the defendant by reason of the infringement.”

The inclusion of additional damages is a vital element in combatting large scale commercial infringement activity. The United States recommends providing clarity to this article to provide maximum deterrence against infringers who knowingly, or with reasonable grounds to know, engage in infringing activity. For example, for willful trademark counterfeiting, will Fiji consider incorporating treble damages for maximum deterrence and disruption of organized counterfeiting? For instance, in the United States, a court can enter a judgement for three times of profits or damages, whichever is greater, together with reasonable attorney’s fees.

In addition, to create an effective civil penalties regime with a view of deterring infringements, the United States recommends incorporating pre-established or statutory damages, at least for trademark counterfeiting violations. The election of pre-established damages is intended to provide ease and predictability in law to the right holder, as well as to provide notice to the public at large of the consequences of committing infringements. A common model for the establishment of statutory damages is a calculation on the basis of twice, or three times, the full price payable for the respective use of the infringed right. Some countries also fix a precise

amount, or a margin, for the pre-established damages to be paid. In the United States for instance, in cases of trademark counterfeiting, a court may award statutory damages of not less than \$1,000 or more than \$200,000 per counterfeit mark per type of goods or services distributed. Upon a finding of willfulness, statutory damages may be increased to \$2,000,000 per counterfeit mark per type of good or service.

Criminal Proceedings

Article 114

This article delineates penalties for counterfeiting offenses. The United States recommends including enhanced penalties for repeat offenders, which is a useful tool to combat organized counterfeit activities. The United States also recommends imposing enhanced penalties for health and safety products in order to create maximum deterrence for counterfeit products that harm average consumers and citizens.

PATENTS BILL 2020 (BILL NO. 46 OF 2020)

Article 9(1)

This article states that a “computer program is not an invention for the purposes of this Act.” Can Fiji explain how this article is consistent with TRIPS Article 27.1, which requires that patents “shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application”?

Article 14(2)

This article states that “methods of doing business” are not patentable inventions. Can Fiji explain how this article is consistent with TRIPS Article 27.1, which requires that patents “shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application”?

Article 16(1)

This article states that the patentee has the exclusive rights, during the term of the patent, “to exploit the invention and to authorise another person to exploit the invention.” The United States recommends revising this article to align with the text of TRIPS Article 28, which provides that a patent gives the patentee the right “to prevent third parties not having the owner’s consent from the acts of: making, using, offering for sale, selling, or importing for these purposes that product” or process.

Article 91

Can Fiji confirm that a “further patent for an improvement in, or modification of, the main invention” and “a patent of addition” under Article 91 must meet the requirements in Article 4

(meaning of novel), Article 5 (meaning of inventive step), Article 12 (patentable inventions), and has the term described in Article 18 (term of patent)? To ensure against double patenting, the United States suggests that subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be non-obvious to a person having ordinary skill in the area of technology related to the invention.

Articles 152-171

Can Fiji explain how it intends to comply with the procedural requirements of Article 31 of the TRIPS Agreement, including, but not limited to, Articles 31(h)-(j) of the TRIPS Agreement?

Article 154(1)(b)

This article states that a court may grant a compulsory license for export of pharmaceutical products to certain countries if the pharmaceutical product is “needed to address a serious public health problem” The United States suggests revising this article to align with the text of Article 31*bis* of the TRIPS Agreement and Article 1(b) of the Annex to the TRIPS Agreement, including defining the public health problem as a “national emergency or other circumstances of extreme urgency.”

DESIGNS BILL 2020 (BILL NO. 47 OF 2020)

The United States notes that the Design Bill generally lacks enforcement provisions. The United States recommends adopting some of the enforcement provisions delineated in the Trademark Bill 2020 into the Design Bill, including those provisions concerning civil infringement proceedings and border enforcement.

Article 58 states that a false representation of that a design is registered in Fiji is liable to a conviction with a fine not exceeding \$40. The United States recommends revising this amount to a level commensurate with conviction for commercial fraud under the Fiji criminal code.