

12 February 2021

Our ref M999-265 JLA:vs
Your ref

SUBMISSION TO THE PARLIAMENTARY STANDING COMMITTEE ON JUSTICE, LAW AND HUMAN RIGHTS ON THE TRADEMARKS BILL 2020

Introduction

1. Munro Leys is pleased to respond to the Committee's invitation to make submissions on the Trademarks Bill 2020.

About Munro Leys and Fiji IP law generally

2. Munro Leys is Fiji's largest law firm with a practice primarily directed to commercial law and foreign investment. It has a significant international linkages, including with the major international law firms who deal in intellectual property (**IP**). Munro Leys is a member of the International Trade Mark Association (**INTA**) the leading international body of practitioners in the trade-mark area (which is the bulk of IP work with which Fiji is concerned). The firm's partners travel to the main INTA annual conference each year (and also to regional events) to promote trade mark filings in Fiji and the Pacific Islands. In the process, we meet and hear the views of a wide range of international lawyers on trade-mark issues and Fiji's general performance in the IP area.
3. Approximately five Fiji law firms specialise in IP work, particularly for international clients. Other firms perform trade-mark work from time to time.

Our Submissions

4. We attach a table containing our submissions on relevant clauses of the Bill.

Commencement and Regulations

5. If passed, the Bill will introduce radically new trade mark laws. It also provides for regulations to be made implementing the Madrid System in Fiji and to cover a range of procedural matters.
6. Due to inadequate resources, the Fiji Intellectual Property Office (**FIPO**) which administers trademark registration is presently not able to operate efficiently even under

Fiji's existing legislation. There are delays of many months, even years in the processing of applications. Oppositions have not been heard for decades.

7. We submit that if passed, the new Trademarks Act should not be brought into effect, until FIPO staff are fully trained and provided with sufficient resources to administer the new system. We also submit that regulations should not be made without full public consultation.

RESPECTFULLY SUBMITTED

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MUNRO LEYS COMMENTS ON FIJI TRADEMARK BILL 2020

Section	Comments
S.2	<p>The reference to s.74 in the definition of “applicant” is incorrect. It should be to s.75.</p> <p>In the definition of “applicant” and “application” it appears that the phrase should read “the suspension of customs clearance of imported goods” rather than “if imported goods”</p> <p>The definition of “convention country” appears too broad. The NZ approach of allowing convention countries to be declared for particular provisions may be better.</p> <p>The definition of “Nice Agreement” does not include the words “as amended from time to time” which suggests that only the text of the Agreement as at the date the Bill comes into effect applies. (cp. definition of Madrid Protocol which says as amended from time to time) This seems inconsistent with the ambulatory definition of “Nice Classification”</p> <p>The definition of “TRIPS Agreement” and “WTO Agreement do not include the words “as amended from time to time” which suggests that only the text of the Agreements as at the date the Act comes into effect applies.</p> <p>There is no provision that “the Act binds the State”. There should be one. Trade mark owners should have remedies against the State and statutory bodies for infringement.</p>
S.6	<p>The exclusive right of an owner to give receipts for an assignment or transmission (which is in the NZ provision) has not been included</p>
S.12	<p>Subsection 12(2) which was inserted into in our current Trade Marks Act in 2012 is ungrammatical and unclear in its meaning. The first limb relating to the word “Fiji” appears clear but what the rest of the provision sets out to achieve is uncertain. The explanatory note saying that the provision relates only to the word “Fiji” is not consistent with the actual words of the subsection. It is unclear whether “words implying geographic origins” means origin in Fiji or origin in any part of the world and what kinds of words are in issue. It is unclear why a company should not be able to register their registered name or trading name as this may well be their trade mark. What the words relating to disclaimers are supposed to mean is unclear especially as the rules around ‘disclaimers’ in the current Act will not be carried over to the new Act.</p>
S.13	<p>A decision of the Minister under s.12 is final and cannot be challenged in any court of law. The inability to challenge the decision of the Minister appears to infringe s.16 of the Fiji Constitution which applies to laws passed after 2013. It is also not desirable that an applicant should not be able to seek redress.</p> <p>Although this provision is in our current Trade Marks Act, the Constitution does not apply to that Act.</p> <p>The section also wrongly protects refusals by the Minister on the grounds of bad faith made under s.12(4). It is Commission not the Minister who may refuse bad faith applications under that section.</p>
S.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. This may be in breach of s.16 of the Constitution.</p>
Ss. 40 & 44	<p>This provides that the Commissioner must ensure that applications are advertised. Presently, applicants are required to advertise. If this arrangement is to be continued, the provision should be amended to say that if an application is accepted, the Commissioner must direct the applicant to advertise it in the prescribed way and the applicant must comply.</p>

Section	Comments
	S.44 should also be amended to expressly require advertisement to have taken place before the Commissioner is empowered to register the trade mark
Ss.53 and 54	<p>Makes it mandatory for FIPO to issue renewal notices 6 months before expiry and requires the mark to be removed after a grace period for 6 months. The current Act has a similar provision requiring renewal notices but FIPO does not send these. This is not currently a problem as the marks are left on the register and FIPO will accept very late renewal applications. It will be a problem under the Bill which limits the grace period to 6 months. There should be amendments to subsections (3) and (6) recognising that the renewal notice may be sent later than 6 months before expiry and only allowing the mark to be removed 6 months after the Commissioner has actually sent the notice. Without this, marks will be removed without FIPO having notified owners of the need to renew.</p> <p>S.54 should be amended also to provide for this.</p>
S.69	<p>Currently the Trade Marks Act deems the registration of a trademark valid after 7 years. The NZ Act also specifies 7 years. The Bill reduces this to 5 years. This seems too short.</p> <p>The fact that 5 years applies for non-use does not mean that the same period should apply for deemed validity. Non-use must be based on what is a reasonable time for an owner to invest in use of a mark. Deemed validity must be based on what is a reasonable time for a person claiming to own the mark to find out about the registration by someone else.</p>
S.88	The purpose of s.82 which applies to medicines imported by the State is unclear. The explanatory note does not match the section.
Ss.107-123	These sections do not make clear who has the power to investigate offences. There is no provision for search, seizure and detention of goods in the market that are suspected to be infringing before prosecution. Such provisions are vital. This is a gap that has led to confusion in the enforcement of the Copyright Act.
S.124	<p>The effect of the definition of ‘rights holder’ is unclear. It is used interchangeably with ‘applicant’ which is defined in s.2. Are these just trade mark owners and licensees or do they include owners of other IP rights (which seems inconsistent with some of the other provisions). This should refer to just owners and licensees.</p> <p>It is unclear why only an exclusive licensee may act. Owners may have different licensees in different jurisdictions any of whom may want to act.</p>
S.125	<p>Any rights owner may apply to the Comptroller to seize goods at the border that are suspected to be infringing goods.</p> <p>There appears no provision for watch notices. There should be provision for this as owners are unlikely to have prior notice of incoming infringing goods.</p>
S.129	Gives discretion to the Comptroller to seize goods on its own initiative if he or she has prima facie evidence or reasonable grounds that goods are infringing. Once seized, ss.127 and 128 apply. Those sections relate to applicants and applications. It is unclear who the Comptroller will treat as an applicant in the absence of an application.
S.145	<p>Provides that an appeal under s.136 must be filed in Court and served on the Commissioner within 20 working days. The reference to s.136 is wrong. This should be to s.144.</p> <p>This period of 4 weeks 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.</p>
S.149	The Solicitor General is to be the Commissioner of Trade Marks by law. The SG has many other more important responsibilities.

Section	Comments
	This should be amended to be flexible to allow the option of a full time Commissioner being appointed.
S.170	<p>Most of the most important provisions regarding the application of the Madrid System and the rules and procedure for the TMO are to be made in regulations.</p> <p>Regulations are often published in Fiji without consultation or prior notice, despite s.50(2) of the 2013 Constitution saying that “A person making any regulations or issuing any instrument having the force of law must, so far as practicable, provide reasonable opportunity for public participation in the development or review of the law before it is made”.</p> <p>We recommend that s.170 specifically require a reasonable opportunity for public participation before they are made to allow interested parties to be heard.</p>
S.172	<p>The transitional provisions are inadequate. They do not make clear how the Bill will apply to existing registrations. (Compare the NZ transitional provisions in their ss.208 and 209).</p> <p>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.</p> <p>Some UK registrations which are based on the Nice classification have been split into more than one Fijian registration. There should be provision allowing these to be amalgamated back into a single certificate.</p> <p>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.</p> <p>The Bill must also make transitional provision for UK-based trade marks which are currently registered as of right for the life of the UK mark and can be renewed for periods of 10 years.</p> <p>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</p> <p>There should be express provisions that existing registrations are not invalidated automatically but may be declared invalid under s.77, that the dates relating to existing registered trademarks continue to apply, that they may be revoked for non-use under this Act.</p> <p>There also needs to be provisions saying that existing registered associations between trademarks do not apply any more since that is not a concept under the new Bill but that existing registered disclaimers and conditions continue to apply.</p>
Licensing	The Bill makes no provision for the registration of licences. The Bill is based on the New Zealand Trademarks Act. In New Zealand, licensing was originally subject to registration. We are not aware of New Zealand’s reasons for revoking those provisions and wonder if they are applicable to Fiji.