

PATENTS BILL 2020  
(BILL NO. 46 OF 2020)

---

CLAUSES

PART 1—PRELIMINARY

1. Short title and commencement
2. Interpretation
3. Objectives
4. Meaning of novel
5. Meaning of inventive step
6. Meaning of prior art base
7. Disclosure to be disregarded in certain circumstances
8. Meaning of useful
9. Computer programs
10. Act binds the State

PART 2—PATENTABLE INVENTIONS AND PATENT RIGHTS

*Division 1—Patentable inventions*

11. Patent may be granted for patentable inventions only
12. Patentable inventions
13. Inventions contrary to public order or morality not patentable inventions
14. Other exclusions

*Division 2—Patent*

15. Nature of patent
16. Exclusive rights given by patent
17. Extent, effect and form of patent
18. Term of patent
19. Extension of period for paying renewal fees

*Division 3—Patent ownership*

20. Who may be granted patent
21. Power of patentee to deal with patent
22. Co-ownership of patent
23. Rights of buyers from co-owners of patent
24. Power of Commissioner to give directions to co-owners
25. Miscellaneous provisions concerning directions
26. Inventions made during and after employment
27. Employment Relations Tribunal or Commissioner may apportion benefit of invention and of patent
28. Review of Commissioner's decision

PART 3—PROCESS FOR OBTAINING GRANT OF PATENT AND OTHER  
MATTERS

*Division 1—Patent applications*

29. Right to apply for patent
30. Application requirements
31. Commissioner may post-date application or specification
32. Divisional applications
33. Applicant must pay maintenance fee

*Division 2—Specifications*

34. Complete and provisional specifications
35. Filing of complete specification after provisional specification has been filed
36. Contents of provisional specification
37. Contents of complete specification
38. Amendment of complete specification before acceptance
39. Supply of drawings

*Division 3—Convention applications*

40. Convention applicants may make convention applications
41. How convention applications are made and dealt with
42. Withdrawn, abandoned or refused basic applications
43. Basic applications for 2 or more cognate inventions

*Division 4—Priority dates*

44. Priority date of claims of complete specification
45. Priority date if complete specification filed for single application
46. Priority date if complete specification filed for 2 or more applications
47. Priority date for convention applications
48. Rules that apply if 2 or more priority dates apply or other rules do not apply
49. Priority date in case of lack of entitlement in respect of another patent application

*Division 5—Examination*

50. Request for examination
51. Examination
52. Commissioner may refuse to proceed with application or require application or specification to be amended
53. Applicants must act by deadline if deadline set by Commissioner
54. Application treated as abandoned if applicant fails to act within set deadline
55. Commissioner must examine amended specification
56. Duty to inform Commissioner of search results

*Division 6—Acceptance and publication*

- 57. Time for putting application in order for acceptance
- 58. Time may be extended if appeal pending or possible
- 59. Notice of entitlement must be filed before acceptance
- 60. Acceptance of complete specification
- 61. Applicant may request Commissioner to postpone acceptance
- 62. Publication in case of applications
- 63. Publication in case of divisional applications made as provided for in section 32
- 64. Documents open to public inspection
- 65. Certain documents not to be published
- 66. Effect of publication of complete specification
- 67. Court must consider whether it would be reasonable to expect that patent would be granted

*Division 7—Amendment of specifications after acceptance*

- 68. General rules concerning amendments of specifications after acceptance
- 69. Amendment must be published in Gazette
- 70. Amendment of specification with leave of Commissioner
- 71. Request for leave to amend must be published in Gazette
- 72. Opposition to proposed amendment
- 73. Provisions concerning amendments with leave of Commissioner do not apply in certain circumstances
- 74. Amendment of specification with leave of court

*Division 8—Assertions by third parties, opposition, and re-examinations*

- 75. Assertions by third parties on novelty and inventive step
- 76. Commissioner must consider and deal with notice in prescribed manner
- 77. Opposition to grant of patent
- 78. Hearing and decision by Commissioner
- 79. Re-examination before patent is granted
- 80. Re-examination after patent is granted
- 81. Relationship between re-examination and other proceedings
- 82. Report on re-examination
- 83. Refusal to grant patent: re-examination before grant
- 84. Revocation of patent: re-examination after grant
- 85. Person who requests re-examination has no right to participate further in re-examination proceeding

*Division 9—Grant of patent*

- 86. When patent must be granted
- 87. Validity of patent not guaranteed
- 88. Patent date

- 89. Patent granted for one invention only
- 90. Amendment of patent granted to deceased person or to body corporate that has been liquidated or wound up
- 91. Patents of addition
- 92. Commissioner may revoke patent for improvement or modification and grant patent of addition
- 93. Restrictions on granting of patents of addition
- 94. Term of patent of addition
- 95. Renewal fees for patents of addition
- 96. Provisions concerning inventive step requirement and validity in connection with patents of addition

*Division 10—Revocation and surrender of patents*

- 97. Revocation of patent
- 98. Provisions concerning applications for revocation made to Commissioner
- 99. Grounds for revoking patent
- 100. Court may also revoke patent if patentee, without reasonable cause, refuses request of Government department to exploit invention
- 101. Surrender of patent

*Division 11—Restoration of lapsed patents and restoration of patent applications*

- 102. Restoration of lapsed patents
- 103. Request must describe circumstances that led to failure to pay renewal fee
- 104. Persons who may make request for restoration of patent
- 105. When request for restoration of patent may be made
- 106. Commissioner must give person who made request reasonable opportunity to be heard if not satisfied that *prima facie* case has been made out for restoration
- 107. Commissioner to publish request in Gazette
- 108. Notice of opposition and reasonable opportunity to be heard
- 109. Order to be made on payment of unpaid fees
- 110. Request for restoration of void or abandoned patent applications
- 111. When request for restoration of void or abandoned patent applications may be made
- 112. Notice of opposition
- 113. Commissioner to determine matter

*Division 12—Miscellaneous provisions*

- 114. Persons claiming under assignment or agreement or by operation of law
- 115. Death of applicant
- 116. Disputes between interested parties
- 117. Directions in relation to inventions concerning defence
- 118. Commissioner must give notice to Minister responsible for defence

- 119. Minister responsible for defence must consider whether publication would be prejudicial to defence of Fiji
- 120. Commissioner must revoke directions on receipt of notice from Minister responsible for defence
- 121. Acceptance of complete specification while directions in force
- 122. Maintenance fees and renewal fees not payable while directions in force
- 123. Offence to fail to comply with directions
- 124. Liability of directors and managers if body corporate commits offence

**PART 4—INFRINGEMENT, OTHER PATENT PROCEEDINGS, AND MATTERS AFFECTING PATENT OWNERSHIP**

*Division 1—Infringement proceedings*

- 125. Infringement by doing anything patentee has exclusive right to do
- 126. Infringement by supplying means to infringe to another person
- 127. Presumption that product produced by infringing process
- 128. No infringement for experimental use
- 129. No infringement by use in or from foreign vessels, aircraft or vehicles
- 130. No infringement for use to produce information required by law
- 131. No infringement for prior use of invention
- 132. Defendant may counterclaim for revocation of patent
- 133. Who may bring infringement proceeding
- 134. When proceeding may be brought
- 135. Right to bring infringement proceeding if registrable assignment or licence has occurred
- 136. Proceeding brought by exclusive licensee
- 137. Types of relief available for infringement
- 138. Court must not award damages or account of profits if innocent infringement
- 139. Court must refuse damages or account of profits for infringement before amendment to accepted specification
- 140. Court may refuse damages or account of profits if renewal fees not paid
- 141. Limits on damages and accounts of profits do not affect power to grant injunction
- 142. Court may grant relief for partially valid patent
- 143. Court may grant costs for subsequent proceeding if validity of specifications contested

*Division 2—Declarations of non-infringement*

- 144. Application for declaration of non-infringement
- 145. Proceeding for declaration of non-infringement
- 146. Costs in declaration of non-infringement
- 147. Validity of patent not at issue in proceeding for, and not affected by, declaration of non-infringement

*Division 3—Patent dealings, patent licences, and transmission of interests in patents*

- 148. Application for registration of assignments, licences, and other interests in patents
- 149. Registration of assignments, licences, and other interests in patents
- 150. Commissioner may vest patent or patent application without probate or letters of administration
- 151. Termination of sales, leases, and licences of patented products and processes if patent no longer in force

*Division 4—Compulsory licences*

- 152. Application for compulsory licence where market is not being supplied, or is not being supplied on reasonable terms, in Fiji
- 153. Court may order grant of licence
- 154. Court may order grant of licence for export of pharmaceutical products to certain countries
- 155. Permanent Secretary responsible for foreign affairs may publish notices that specify eligible countries
- 156. Terms of licence
- 157. Copy of order must be sent to Commissioner and Permanent Secretary responsible for foreign affairs
- 158. Remuneration payable to patentee
- 159. Person applying for licence must have made efforts to obtain licence from patentee on reasonable commercial terms and conditions
- 160. Exercise of powers on applications under section 152, 154, or 158
- 161. Order for grant of licence has effect as deed

*Division 5—State use of inventions*

- 162. State use of inventions
- 163. Order may declare use to be State use
- 164. Protection of buyers
- 165. Rights of third parties in respect of State use
- 166. Referral of disputes concerning State use
- 167. Court may refer matter to special or official referee or arbitrator
- 168. Special provisions as to State use during emergency
- 169. Nature and scope of rights under section 162
- 170. Duty to inform nominated person or patentee
- 171. Nominated person or patentee entitled to remuneration

*Division 6—Mention of inventor in patent, specification, and patents register*

- 172. Mention of inventor in patent, specification, and patents register
- 173. Request or claim to be mentioned as inventor
- 174. Request or claim may not be considered in certain circumstances
- 175. Commissioner must give notice of claim and opportunity to be heard
- 176. Certificate concerning mention of inventor

## PART 5—ADMINISTRATIVE AND MISCELLANEOUS PROVISIONS

### *Division 1—Patent register and other information on patents and patent applications*

- 177. Patents register
- 178. Purpose of patents register
- 179. Form of patents register
- 180. Contents of patents register
- 181. Search of patents register
- 182. Requests for patent information and certified copies
- 183. Changes to patents register
- 184. Commissioner may correct own mistakes in patents register, etc.
- 185. Commissioner may correct other persons' mistakes in patents register, etc.
- 186. Court may rectify patents register
- 187. Evidence: patents register and patents
- 188. Evidence: anything done by Commissioner
- 189. Commissioner must publish in Gazette
- 190. Commissioner may keep or publish indexes, etc.

### *Division 2—General provisions on proceedings of Commissioner*

- 191. Hearing before exercise of Commissioner's discretion
- 192. How to give evidence to Commissioner in proceedings
- 193. Commissioner may receive evidence on oath
- 194. Issuing of summons by Commissioner
- 195. Commissioner may award costs
- 196. Commissioner may require security for costs
- 197. Appeals against decisions of Commissioner
- 198. Appeals against decisions of court on appeal
- 199. Costs of Commissioner in proceeding

### *Division 3—Establishment and operation of administrative bodies*

- 200. Commissioner of Patents
- 201. Functions of Commissioner
- 202. Commissioner may delegate
- 203. Liability of Commissioner and others
- 204. Fiji Intellectual Property Office
- 205. Opening hours of Fiji Intellectual Property Office
- 206. Closing of Fiji Intellectual Property Office at short notice

### *Division 4—Other miscellaneous provisions*

- 207. Commissioner may extend time limits for delays by Commissioner
- 208. Commissioner may extend time limits for certain filing requirements or for delivery failures
- 209. Requirements for applying and granting extensions of time limits under section 208

- 210. Service of notices (other than those given to or by Commissioner)
- 211. Requirements for summons
- 212. Witnesses' allowances and expenses
- 213. Offence of failing to comply with summons
- 214. Fees and penalties payable under Act or regulations
- 215. Payment and application of fees and other money paid under this Act
- 216. Protection of Coat of Arms of Fiji
- 217. Application of Personal Property Securities Act 2017

*Division 5—Regulations*

- 218. Regulations

*Division 6—Repeal and transitional*

- 219. Repeal
- 220. Transitional



**BILL NO. 46 OF 2020****A BILL****FOR AN ACT TO PROVIDE FOR PATENTS OF INVENTIONS AND FOR  
RELATED MATTERS**

ENACTED by the Parliament of the Republic of Fiji—

**PART 1—PRELIMINARY***Short title and commencement*

**1.—(1)** This Act may be cited as the Patents Act 2020~~1~~.

(2) This Act comes into force on a date or dates appointed by the Minister by notice in the Gazette.

*Interpretation*

**2.—(1)** In this Act, unless the context otherwise requires—

“applicant”—

- (a) means a person who has applied for a patent for an invention; and
- (b) includes a person in whose favour a direction has been given under section 26(7)(b)(i), 114 or 116(1)(a) and the personal representative of a deceased applicant;

“assignee” includes the personal representative of a deceased assignee, and references to the assignee of any person include references to the assignee of the personal representative or assignee of that person;

“basic application” means an application for protection in respect of an invention, being an application that is made in a convention country (whether before or after it became a convention country);

“claim” means a claim of the complete specification;

“Commissioner” means the Commissioner of Patents;

“convention applicant”, in relation to a basic application, means a person who—

- (a) has made the basic application;
- (b) is the assignee of the person who made the basic application;
- (c) is the personal representative of a person mentioned in paragraph (a) or (b); or
- (d) has the consent of a person mentioned in paragraph (a), (b) or (c) to make a convention application based on that basic application;

“convention application” means a patent application made under section 40(1);

“convention country” means a country or an entity as prescribed by regulations;

“court” means the High Court of Fiji;

“date of the publication of the accepted complete specification” means the date of publication of the Gazette containing the publication under section 60(2)(b);

“exclusive licence” means a licence from a patentee that gives the licensee (or the licensee and persons authorised by the licensee) any of the patentee’s exclusive rights under section 16 to the exclusion of the patentee and all other persons;

“exploit”, in relation to an invention, includes —

- (a) if the invention is a product, to—
  - (i) make, hire, sell, or otherwise dispose of the product;
  - (ii) offer to make, hire, sell, or otherwise dispose of the product;
  - (iii) use or import the product; or
  - (iv) keep the product for the purpose of doing any of the things referred to in subparagraphs (i) to (iii); or
- (b) if the invention is a process, to use the process or to do any act mentioned in paragraph (a) in respect of a product resulting from that use;

“Fiji” means the Republic of Fiji;

“file” means to file with the Commissioner;

“filing date”, in relation to a document filed under this Act, means—

- (a) the date on which the document is filed; or
- (b) the date on which the document is treated as having been filed (if it is treated under this Act or the regulations as having been filed on a different date);

“FIPO” means the Fiji Intellectual Property Office;

“Government” means the Government of the Republic of Fiji;

“Government department” means a department of the civil service, under a ministry;

“integrated circuit” means a circuit, in its final or an intermediate form, if—

- (a) the elements of the circuit and some or all of the interconnections are integrally formed in or on a piece of material;
- (b) at least one of the elements of the circuit is an active element; and
- (c) the circuit is intended to perform an electronic function interested party, in relation to a patent application, means the applicant or a joint applicant, or a person who claims to be entitled to the grant of a patent on the application, either alone or jointly with another person;

“inventive step” has the meaning given in section 5;

“inventor”, in relation to an invention, means the actual deviser of the invention;

“licence” means a licence to do anything that the patentee otherwise has the exclusive right to do under section 16;

“main invention” has the meaning given in section 91;

“Minister” means the Minister responsible for patents;

“Ministry” means the Ministry responsible for patents;

“nominated person”, in relation to a patent application, means the person identified as the person to whom the patent is to be granted;

“novel” has the meaning given in section 4;

“patent” means letters patent for an invention;

“patent application” means an application for a patent under this Act;

“patent area” means the area to which the sovereignty of Fiji applies;

“patent date”, in relation to a patent, means the date given to the patent under section 88;

“patent of addition” means a patent granted under sections 91 to 96;

“patentable invention” has the meaning given in section 12;

“patented process” means a process for which a patent has been granted and is in force;

“patented product” means a product for which a patent has been granted and is in force;

“patentee” means the person entered in the patents register as the owner of a patent at the relevant time;

“patents register” means the patents register kept under section 177;

“personal representative”, in relation to a deceased person—

- (a) means a person to whom probate of the will of the deceased person, letters of administration of the estate of the deceased person, or any other similar grant, has been granted, whether in Fiji or anywhere else; but
- (b) does not include a person referred to in paragraph (a) if, under the terms of the grant, the person is not entitled to do an act in relation to which the expression is used;

“prior art base” has the meaning given in section 6, and prior art has a corresponding meaning;

“relevant proceeding”, in relation to a patent, means a court proceeding—

- (a) for infringement of the patent;
- (b) for the revocation of the patent; or
- (c) in which the validity of the patent, or of a claim, is in dispute;

“Tribunal” means the Employment Relations Tribunal established by section 202 of the Employment Relations Act 2007;

“TRIPS agreement” means the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights done at Marrakesh on 15 April 1994; and

“useful” has the meaning given in section 8.

(2) In the case of an entity that is a convention country but is not a State, part of a State, or a territory for whose international relations a State is responsible—

- (a) a reference in this Act to an application for protection in a country or an application for protection in respect of a country must be read as a reference to an application for protection under the rules of the entity;

- (b) a reference in this Act to filing a specification in a convention country must be read as a reference to filing a specification under the rules of the entity;
- (c) a reference in this Act to the law of a convention country must be read as a reference to the rules of the entity; and
- (d) a reference in this Act to the Government of a convention country must be read as a reference to the governing body of the entity.

*Objectives*

**3.** The objectives of this Act are to—

- (a) provide an efficient and effective patent system that—
  - (i) promotes innovation and economic growth while providing an appropriate balance between the interests of inventors and patent owners and the interests of society as a whole; and
  - (ii) complies with Fiji’s international obligations;
- (b) ensure that a patent is granted for an invention only in appropriate circumstances by—
  - (i) establishing appropriate criteria for the granting of a patent; and
  - (ii) providing for procedures that allow the validity of a patent to be tested; and
- (c) provide greater certainty for patent owners and the users of patented inventions that patents will be valid after they are granted.

*Meaning of novel*

**4.** An invention, so far as claimed in a claim, is novel if it does not form part of the prior art base.

*Meaning of inventive step*

**5.** An invention, so far as claimed in a claim, involves an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms part of the prior art base.

*Meaning of prior art base*

**6.—(1)** For the purpose of deciding whether or not an invention is novel and for the purpose of deciding whether or not an invention involves an inventive step, the prior art base, in relation to an invention so far as claimed in a claim, means all matter (whether a product, a process, information about a product or process, or anything else) that has at any time before the priority date of that claim been made available to the public (whether in Fiji or elsewhere) by written or oral description, by use, or in any other way.

(2) For the purpose of deciding whether or not an invention is novel, the prior art base, in relation to an invention so far as claimed in a claim, also includes the information contained in a complete specification filed in respect of another patent application if all of the following circumstances apply —

- (a) if the information is, or were to be, the subject of a claim of that complete specification, the claim has, or would have, a priority date earlier than that of the claim under consideration;
- (b) that complete specification became open to public inspection after the priority date of the claim under consideration; and
- (c) the information was contained in that complete specification on its filing date and when it became open to public inspection.

*Disclosure to be disregarded in certain circumstances*

7.—(1) For the purposes of section 6, the disclosure of matter constituting an invention must be disregarded if one or more of the following applies —

- (a) that disclosure occurred during the one-year period immediately preceding the filing date of the patent application and the disclosure was due to, or made in consequence of, the matter having been obtained unlawfully or in breach of confidence by a person from —
  - (i) the inventor;
  - (ii) any other person to whom the matter was made available in confidence by the inventor;
  - (iii) any other person who obtained it from the inventor because the person or the inventor believed that the person was entitled to obtain it;
  - (iv) any other person to whom the matter was made available in confidence by any person referred to in subparagraphs (i) to (iii) or in this subparagraph; or
  - (v) any other person who obtained it from any person mentioned in subparagraphs (i) to (iv) because the person or the person from whom the person obtained it believed that the person was entitled to obtain it;
- (b) that disclosure occurred during the one-year period immediately preceding the filing date of the patent application and the disclosure was made in breach of confidence by a person who obtained the matter in confidence from the inventor or from any other person to whom it was made available by, or who obtained it from, the inventor;
- (c) that disclosure was due to the communication of the matter to a Government department or to any person authorised by a Government department to

investigate the invention or its merits, or to anything done, in consequence of that communication, for the purpose of the investigation;

- (d) that disclosure occurred during the 6-month period immediately preceding the filing date of the patent application and that disclosure was due to, or made in consequence of—
  - (i) the display of the invention with the consent of the inventor at a specified exhibition;
  - (ii) the use of the invention with the consent of the inventor for the purposes of a specified exhibition in the place where it is held;
  - (iii) the publication of any description of the invention in consequence of its display or use at a specified exhibition as referred to in subparagraph (i) or (ii); or
  - (iv) the use of the invention, after it has been displayed or used at a specified exhibition as referred to in subparagraphs (i) and (ii) and during the period of the exhibition, by any person without the consent of the inventor;
- (e) that disclosure was due to, or made in consequence of, the invention being publicly worked, at any time during the one-year period immediately preceding the filing date of the patent application, by any of the following persons if the working was effected for the purpose of reasonable trial only and if it was reasonably necessary, having regard to the nature of the invention, that the working for that purpose should be effected in public—
  - (i) the patentee or nominated person;
  - (ii) any person from whom the patentee or nominated person derives title;
  - (iii) any person with the consent of the patentee or nominated person;
  - (iv) any person with the consent of any person from whom the patentee or nominated person derives title;
- (f) that disclosure occurred during the one-year period immediately preceding the patent date and the disclosure was made by any of the following persons—
  - (i) the patentee or nominated person;
  - (ii) any person from whom the patentee or nominated person derives title;
  - (iii) any person with the consent of the patentee or nominated person;
  - (iv) any person with the consent of any person from whom the patentee or nominated person derives title.

(2) For the purposes of this section—

“inventor”, in relation to an invention—

- (a) means the actual deviser of the invention; and
- (b) includes any owner of the invention at the relevant time; and

“specified exhibition” means an exhibition (whether held in Fiji or elsewhere) that is declared to be an international or industrial exhibition by the Commissioner by notice in the Gazette.

*Meaning of useful*

**8.** An invention, so far as claimed in a claim, is useful if the invention has a specific, credible and substantial utility.

*Computer programs*

**9.—(1)** A computer program is not an invention for the purposes of this Act.

(2) Subsection (1) prevents anything from being an invention for the purposes of this Act only to the extent that a claim in a patent or an application relates to a computer program as such.

(3) A claim in a patent or an application relates to a computer program as such if the actual contribution made by the alleged invention lies solely in it being a computer program.

(4) The Commissioner or the court, as the case may be, must, in identifying the actual contribution made by the alleged invention, consider the following—

- (a) the substance of the claim (rather than its form and the contribution alleged by the applicant) and the actual contribution it makes;
- (b) what problem or other issue is to be solved or addressed;
- (c) how the relevant product or process solves or addresses the problem or other issue;
- (d) the advantages or benefits of solving or addressing the problem or other issue in that manner;
- (e) any other matters the Commissioner or the court thinks relevant.

(5) To avoid doubt, a patent must not be granted for anything that is not an invention under this section.

*Act binds the State*

**10.** This Act binds the State.



PART 2—PATENTABLE INVENTIONS AND PATENT RIGHTS

*Division 1—Patentable inventions*

*Patent may be granted for patentable inventions only*

- 11.**—(1) A patent may be granted for an invention only if it is a patentable invention.  
 (2) This section is subject to section 96.

*Patentable inventions*

- 12.** An invention is a patentable invention if the invention, so far as claimed in a claim—
- (a) when compared with the prior art base—
    - (i) is novel; and
    - (ii) involves an inventive step;
  - (b) is useful; and
  - (c) is not excluded from being a patentable invention under section 13 or 14.

*Inventions contrary to public order or morality not patentable inventions*

- 13.**—(1) An invention is not a patentable invention if the commercial exploitation of the invention, so far as claimed in a claim, is contrary to—

- (a) public order; or
- (b) morality.

(2) For the purposes of subsection (1), commercial exploitation must not be regarded as contrary to public order or morality only because it is prohibited by any written law.

(3) The Commissioner may, for the purpose of making a decision under this section, seek advice from any person that the Commissioner considers appropriate.

*Other exclusions*

**14.**—(1) Discoveries, scientific theories and mathematical methods are not patentable inventions.

(2) Schemes, rules or methods for doing business, performing purely mental acts or playing games are not patentable inventions.

(3) Human beings, and biological processes for their generation, are not patentable inventions.

(4) Methods of treatment of human beings by surgery or therapy are not patentable inventions.

(5) Methods of diagnosis practised on human beings are not patentable inventions.

(6) Natural substances, even if purified, synthesised or otherwise isolated from nature, are not patentable inventions.

(7) Plants and animals, including their parts, other than micro-organisms, and essentially biological processes for the production of plants or animals and their parts, other than non-biological and microbiological processes, are not patentable inventions.

(8) Subsections (4) and (5) do not apply to products for use in any of those methods.

(9) Subsection (6) does not apply to the processes of isolating those natural substances from their original environment.

### *Division 2—Patent*

#### *Nature of patent*

**15.—**(1) A patent is personal property.

(2) Equities in respect of a patent may be enforced in the same way as equities in respect of any other personal property.

#### *Exclusive rights given by patent*

**16.—**(1) A patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.

(2) This section is subject to Divisions 5 and 6 of Part 4.

#### *Extent, effect and form of patent*

**17.—**(1) A patent has effect throughout the patent area.

(2) A patent may be assigned for any place in, or part of, the patent area as effectively as if it were granted so as to extend to that place or part only.

(3) Subject to the provisions of this Act and section 4 of the State Proceedings Act 1951, a patent has the same effect against the State as it has against a subject.

(4) A patent must be in the form approved by the Commissioner (which may be electronic) and contain the prescribed information.

#### *Term of patent*

**18.—**(1) Subject to subsection (2), the term of every patent is 20 years from the patent date.

(2) A patent ceases to have effect on the expiry of the period prescribed for the payment of any renewal fee if that fee is not paid within that period or within that period as extended under section 19.

(3) Subsection (2) applies notwithstanding anything in the patent or any other provision in this Act.

#### *Extension of period for paying renewal fees*

**19.—**(1) A patentee may request, in the prescribed manner (if any), that the prescribed period for the payment of a renewal fee be extended to any date that is not more than 6 months after the expiry of the prescribed period.

(2) The Commissioner must extend the prescribed period for the payment of the renewal fee to the date requested under subsection (1) if, before that date—

- (a) the request under subsection (1) is made;
- (b) the renewal fee is paid; and
- (c) the prescribed penalty (if any) is paid.

*Division 3—Patent ownership*

*Who may be granted patent*

**20.**—(1) A patent for an invention may only be granted to a person who—

- (a) is the inventor;
- (b) derives title to the invention from the inventor; or
- (c) is the personal representative of a deceased person mentioned in paragraph (a) or (b).

(2) A patent may be granted to a person whether or not the person is a Fijian citizen.

*Power of patentee to deal with patent*

**21.**—(1) A patentee may (subject to any rights vested in other persons that are entered in the patents register) deal with the patent as the absolute owner of the patent and give good discharges for any consideration for that dealing.

(2) This section does not protect a person who deals with a patentee otherwise than as a purchaser in good faith for value and without notice of any fraud on the part of the patentee.

(3) This section is subject to section 15(2).

*Co-ownership of patent*

**22.**—(1) If a patent is granted to 2 or more persons, each patentee is entitled to—

- (a) an equal undivided share in the patent; and
- (b) exercise the exclusive rights given by the patent for the patentee’s own benefit without accounting to the others.

(2) A licence under a patent must not be granted, and a share in a patent must not be assigned, except with the consent of all patentees of the patent (other than the licensor or assignor).

(3) Subsections (1) and (2) are subject to any agreement to the contrary between the patentees of the patent.

(4) Nothing in subsection (1) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives.

(5) This section is subject to any direction of the Commissioner under section 24.

*Rights of buyers from co-owners of patent*

**23.** If a patented product, or a product of a patented process, is sold by any of 2 or more patentees of the patent, the buyer, and a person claiming through the buyer, may deal with the product as if the product had been sold by all of the patentees.

*Power of Commissioner to give directions to co-owners*

**24.—(1)** If 2 or more persons are patentees of a patent, the Commissioner may, on the request of any of them in the prescribed manner, give any directions in accordance with the request that the Commissioner thinks fit.

(2) The directions under subsection (1) must relate to—

- (a) the sale or lease of the patent or any interest in it;
- (b) the grant of licences; or
- (c) the exercise of any right under section 22 in relation to the patent.

(3) If any patentee fails to do anything required to carry out a direction given under subsection (1) within 14 days after being requested in writing to do so by any of the other patentees, the Commissioner may, on the request of any of them in the prescribed manner, direct a person to do that thing in the name and on behalf of the person in default.

*Miscellaneous provisions concerning directions*

**25.—(1)** Before giving a direction under section 24, the Commissioner must—

- (a) give a reasonable opportunity to be heard to—
  - (i) in the case of a request under section 24(1), the patentees of the patent; and
  - (ii) in the case of a request under section 24(3), the person in default; and
- (b) have regard to the terms of any agreement between the patentees of the patent that are brought to the Commissioner's notice.

(2) The Commissioner must not give a direction that—

- (a) affects the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as trustees or personal representatives; or
- (b) is inconsistent with the terms of an agreement between the patentees of the patent.

*Inventions made during and after employment*

**26.—(1)** In the absence of an agreement to the contrary, where an invention is made during the normal course of an employee's work—

- (a) the invention belongs to the employer;

- (b) the employee is entitled to reasonable remuneration when the economic gains extracted by the employer from the invention are disproportionately high as compared to—
  - (i) the employee’s salary; and
  - (ii) the reasonable expectations of gain that the employer had from the employee’s inventive output at the time the employer hired him.

(2) In the absence of an agreement to the contrary, where an invention is made by an employee outside the normal course of an employee’s work, with materials, data or know-how of the employer—

- (a) the invention belongs to the employer; and
- (b) the employee is entitled to reasonable remuneration for the invention.

(3) Any invention claimed in a patent application, filed by the employee within one year after the end of employment, that falls within the scope of the former employer’s main business, is presumed to have been made during the normal course of an employee’s work in terms of subsection (1), unless the employee produces evidence to the contrary.

(4) Any anticipated promise or undertaking by the inventor made to the employer to the effect that the inventor will waive any remuneration to which the inventor is entitled to under this section is without legal effect.

(5) This section applies to civil servants as well as to persons whose services are hired in accordance with the Civil Service Act 1999 including its subsidiary legislation, and General Orders.

(6) This section and sections 27 and 28 apply if a dispute arises between an employer and a person who is, or was at the material time, the employee of the employer as to the rights of the parties in respect of—

- (a) an invention made by the employee, either alone or jointly with any other person; or
- (b) any patent granted, or to be granted, in respect of an invention referred to in paragraph (a).

(7) The Commissioner may, on a request made to him or her in the prescribed manner by either of the parties and after giving to each of them a reasonable opportunity to be heard—

- (a) determine the matter in dispute;
- (b) give any directions that the Commissioner thinks fit for—
  - (i) enabling a patent application to proceed in the name of one or more of the parties alone;
  - (ii) regulating the manner in which it is to proceed; or

- (iii) both of the purposes referred to in subparagraphs (i) and (ii); and
- (c) make any orders for giving effect to his or her decision as he or she considers expedient.

(8) If it appears to the Commissioner that, in relation to any request under this section, the matter in dispute involves questions that would more properly be determined by the Tribunal, he or she may decline to deal with the matter.

(9) A decision of the Commissioner under this section or section 27 has the same effect as between the parties and persons claiming under them as a decision of the Tribunal.

(10) The parties to a dispute under this section or section 27, or a review under section 28, are the employer and employee.

(11) Section 211 of the Employment Relations Act 2007 does not limit this section or section 27 or 28.

*Employment Relations Tribunal or Commissioner may apportion benefit of invention and of patent*

**27.**—(1) In proceedings before the Tribunal, or on a request made to the Commissioner under section 26, the Tribunal or Commissioner may make an order specified in subsection (2) (unless satisfied that one or other of the parties is entitled, to the exclusion of the other, to the benefit of an invention made by an employee).

(2) The order referred to in subsection (1) is an order providing for the apportionment between the employer and employee of the benefit of the invention, and of any patent granted or to be granted in respect of the invention, in the manner that the Tribunal or Commissioner considers just.

*Review of Commissioner's decision*

**28.**—(1) A person who is aggrieved by a decision of the Commissioner under section 26 or 27 may apply to the Tribunal for a review of the decision.

(2) An application for review must be made within—

- (a) 20 working days after the date of the decision; or
- (b) any further time the Tribunal allows on an application made before or after that period expires.

(3) The Tribunal—

- (a) may confirm, reverse or modify the decision of the Commissioner; and
- (b) may make any other decision.

(4) The Tribunal must not review any decision made under section 26 or 27, or part of a decision made under those sections, that is not the subject of an application under subsection (1).

(5) A decision against which an application is made under subsection (1) continues in force pending the determination of the review unless the Tribunal orders otherwise.

PART 3—PROCESS FOR OBTAINING GRANT OF PATENT AND OTHER MATTERS

*Division 1—Patent applications*

*Right to apply for patent*

**29.** Any person may apply for a patent either alone or jointly with another person.

*Application requirements*

**30.** Every patent application must be made in accordance with this Act and the manner prescribed by the regulations.

*Commissioner may post-date application or specification*

**31.—(1)** The Commissioner may, on the request of the applicant in the prescribed manner (if any), direct that a patent application be post-dated to the date that is specified in the request.

(2) The Commissioner must not exercise the power under subsection (1) after the acceptance of the complete specification.

(3) A patent application must not be post-dated under subsection (1) to a date later than 6 months after the date that it was actually made or would, but for subsection (1), be treated as having been made.

(4) A convention application must not be post-dated under subsection (1) to a date later than the last date that, under the provisions of this Act, the application could have been made.

(5) If an application or specification filed under this Act is amended before acceptance of the complete specification, the Commissioner may direct that the application or specification be post-dated to the date that the amendment is first filed.

*Divisional applications*

**32.—(1)** If a patent application has been made (but has not become void or been abandoned) (the **parent application**), the applicant may, in the prescribed manner, make a new patent application for any part of the subject matter of the parent application (the **divisional application**).

(2) A divisional application may only be made—

(a) before the acceptance of the complete specification for the parent application; and

(b) in accordance with any further prescribed requirements relating to the period within which a divisional application may be made.

(3) The Commissioner may direct that a divisional application or a complete specification for that application (or both) be given an earlier date if—

(a) a request to that effect is made in the prescribed manner; and

(b) the divisional application is only in respect of subject matter that was in substance disclosed by the parent application as filed.

(4) The earlier date must not be earlier than—

- (a) in the case of the divisional application, the filing date of the parent application; and
- (b) in the case of a complete specification for the divisional application, the filing date of the complete specification for the parent application.

*Applicant must pay maintenance fee*

**33.—**(1) An applicant must pay a prescribed maintenance fee within the period or periods that are prescribed for the purposes of this section.

(2) A patent application must be treated as having been abandoned if the applicant does not comply with subsection (1).

### *Division 2—Specifications*

*Complete and provisional specifications*

**34.—**(1) Every patent application must—

- (a) be accompanied by a complete specification or a provisional specification unless the application is a convention application; and
- (b) be accompanied by a complete specification if the application is a convention application.

(2) The Commissioner may direct that a specification that purports to be a complete specification be treated as a provisional specification if—

- (a) the applicant requests, at any time before the acceptance of the specification, that the Commissioner make that direction; and
- (b) the patent application is not a convention application.

(3) A person is not entitled to make a request under subsection (2) if the patent application and specification filed in respect of the application have become open to public inspection.

(4) If the Commissioner makes a direction under subsection (2), the complete specification must be treated, for the purposes of this Act, to be, and to have always been, a provisional specification.

(5) The Commissioner may cancel a provisional specification and post-date the patent application to the filing date of a complete specification if—

- (a) a complete specification has been filed for a patent application that was accompanied by a provisional specification or by a specification treated as a provisional specification under subsection (2); and
- (b) the applicant requests, at any time before the acceptance of the complete specification, that the Commissioner cancel the provisional specification and post-date the application.

(6) A request under subsection (2) or (5) must be made in the prescribed manner (if any).



*Filing of complete specification after provisional specification has been filed*

**35.—**(1) If a patent application is accompanied by a provisional specification, one or more complete specifications must be filed within the period allowable under subsection (2).

(2) The period allowable is—

- (a) the period within 12 months from the filing date of the patent application; or
- (b) an extended period not exceeding the prescribed period if, on or before the date on which the complete specification is filed—
  - (i) a request for an extension of time in which to file the complete specification is made to the Commissioner in the prescribed manner (if any); and
  - (ii) the prescribed penalty (if any) is paid.

(3) A patent application referred to in subsection (1) must be treated as having been abandoned if a complete specification is not filed within the period allowable under subsection (2).

(4) Subject to subsections (1) to (3) and sections 36 to 39, if 2 or more patent applications accompanied by provisional specifications have been filed for inventions that are cognate, or of which one is a modification of another—

- (a) a single complete specification may be filed for those applications; or
- (b) if more than one complete specification has already been filed, a single complete specification may, with the leave of the Commissioner, be proceeded with in respect of those applications.

*Contents of provisional specification*

**36.** Every provisional specification must—

- (a) describe the invention; and
- (b) include any other prescribed information.

*Contents of complete specification*

**37.—**(1) Every complete specification must—

- (a) disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art;
- (b) disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection;
- (c) end with a claim or claims defining the scope of the invention claimed; and
- (d) include any other prescribed information.

(2) The claim or claims must—

- (a) relate to one invention only;
- (b) be clear and concise; and
- (c) be supported by the matter disclosed in the complete specification.

(3) A complete specification filed after a provisional specification, or filed with a convention application, may include claims concerning developments of, or additions to, the invention that was described in the provisional specification or the basic application, as the case may be, if those developments or additions are developments or additions for which the nominated person would be entitled to the grant of a separate patent under this Act.

(4) If a complete specification claims a new substance, the claim must not be construed as extending to that substance when found in nature.

*Amendment of complete specification before acceptance*

**38.—**(1) Subject to section 31(5), before the acceptance of a complete specification, the applicant may, in the prescribed manner, amend that specification.

(2) Division 8 applies in respect of amendments to a complete specification after the acceptance of the complete specification.

*Supply of drawings*

**39.—**(1) Drawings may be supplied for the purposes of any specification.

(2) Drawings must be supplied for the purposes of a specification if the Commissioner requires drawings to be supplied.

(3) Drawings supplied under this section form part of the specification unless the Commissioner directs otherwise.

*Division 3—Convention applications*

*Convention applicants may make convention applications*

**40.—**(1) A convention applicant in relation to a basic application may make a patent application, or 2 or more of those convention applicants may make a joint patent application, in respect of the relevant invention within the period of 12 months from the day on which a basic application is first made in a convention country in respect of the invention.

(2) A patent application made under subsection (1) is a **convention application**.

(3) For the purposes of this Act—

- (a) the filing of a complete specification in a convention country after the filing of a provisional specification in relation to an application for protection must be treated as a basic application made in that country;

- (b) a person must be treated as having made a basic application in a convention country in respect of an invention if the person has made an application for protection in respect of the invention by an application that—
  - (i) in accordance with the terms of a treaty subsisting between that convention country and any one or more other convention countries, is equivalent to a basic application duly made in any one of those convention countries; or
  - (ii) in accordance with the law of that convention country, is equivalent to a basic application duly made in that convention country; and
- (c) a matter must be treated as having been disclosed in a basic application made in a convention country if it was claimed or disclosed (otherwise than by way of disclaimer or acknowledgment of prior art) in that application or in documents submitted by the person who made the basic application in support of, and at the same time as, that application.

(4) Notwithstanding subsection (3)(c), if the Commissioner has given a written notice to the convention applicant requiring the convention applicant to file a copy of any or all of the documents referred to in that paragraph, account must not be taken of any disclosure in the document or those documents unless a copy of the document or documents is filed within the prescribed period after the Commissioner has given the notice.

*How convention applications are made and dealt with*

**41.**—(1) A convention application must be made and dealt with in the same manner as any other patent application.

- (2) A patent application that is a convention application must—
  - (a) include the prescribed information relating to the relevant basic application;
  - (b) be accompanied by a complete specification in accordance with section 34(1); and
  - (c) be made and dealt with in accordance with any other requirements prescribed for convention applications by this Act or regulations.

*Withdrawn, abandoned or refused basic applications*

**42.** For the purposes of this Act, if more than one basic application has been made for an invention, a previously filed basic application (**basic application A**) must be disregarded and a subsequently filed basic application (**basic application B**) must be substituted for basic application A if—

- (a) basic application A was made in, or in respect of, the same convention country and by the same applicant as basic application B;
- (b) not later than the date of filing of basic application B, basic application A was unconditionally withdrawn, abandoned or refused;
- (c) basic application A had not been made available to the public in Fiji or elsewhere before its unconditional withdrawal, abandonment or refusal;

- (d) no rights remain outstanding in respect of basic application A; and
- (e) basic application A has not served to establish a right of priority in relation to another application in any convention country.

*Basic applications for 2 or more cognate inventions*

**43.—**(1) If basic applications have been made in one or more convention countries for 2 or more inventions that are cognate or of which one is a modification of another, a single convention application may be made for those inventions at any time within 12 months from the date of the earliest of the basic applications.

(2) Notwithstanding subsection (1), the requirements of section 41(2)(a) apply separately to the basic applications for each of the inventions referred to in subsection (1).

*Division 4—Priority dates*

*Priority date of claims of complete specification*

**44.—**(1) Every claim of a complete specification has effect from the date prescribed by this Division as the priority date of that claim.

(2) A patent is not invalidated by—

- (a) reason only that the invention, so far as claimed in a claim, has been made available to the public (whether in Fiji or elsewhere) on or after the priority date of the claim by written or oral description, by use, or in any other way; or
- (b) the grant of another patent on a specification claiming the same invention in a claim of the same or a later priority date.

*Priority date if complete specification filed for single application*

**45.** The priority date of a claim is the filing date of the patent application if—

- (a) the complete specification is filed for a single application that was accompanied by a provisional specification or by a specification that is treated as a provisional specification; and
- (b) the claim is supported by the matter disclosed in that provisional specification.

*Priority date if complete specification filed for 2 or more applications*

**46.—**(1) This section applies if—

- (a) the complete specification is filed in relation to 2 or more patent applications that were accompanied by provisional specifications or by specifications that are treated as provisional specifications; and
- (b) the claim is supported by the matter disclosed in at least one of those provisional specifications.

(2) The priority date of the claim is the filing date of the patent application that is accompanied by the specification that disclosed the matter that supports the claim, or if there is more than one application accompanied by such a specification, the filing date of the earliest of them.

*Priority date for convention applications*

**47.**—(1) This section applies if the complete specification is filed for a convention application and the claim is supported by the matter disclosed—

- (a) in the basic application; or
- (b) if the convention application is founded on more than one basic application, in at least one of those basic applications.

(2) The priority date of the claim is the date of the basic application that disclosed the matter that supports the claim or, if there is more than one such basic application, the date of the earliest of them.

*Rules that apply if 2 or more priority dates apply or other rules do not apply*

**48.**—(1) If, under sections 46 and 47, a claim would, but for this provision, have 2 or more priority dates, the priority date of that claim is the earlier or earliest of those dates.

(2) If sections 45 to 47 do not apply to any case, the priority date of a claim is the filing date of the complete specification.

*Priority date in case of lack of entitlement in respect of another patent application*

**49.**—(1) This section applies if—

- (a) a patent application (**application A**) is made for an invention that has been claimed in a complete specification filed in relation to another patent application (**application B**); and
- (b) one or more of the following applies—
  - (i) the Commissioner has refused to grant a patent in relation to application B on the ground specified in section 77(1)(b) (whether in a re-examination or an opposition proceeding under Division 8);
  - (ii) the patent granted in relation to application B has been revoked by the Commissioner or the court on the ground specified in section 99(1)(b);
  - (iii) the complete specification filed in relation to application B has, in a re-examination or an opposition proceeding under Division 8 or a proceeding under Division 10, been amended by the exclusion of the claim relating to the invention as a result of a finding by the Commissioner that the patentee or nominated person is not entitled to the patent.

(2) The Commissioner may direct that application A and any specification filed in relation to it must, for the purposes of this Division, be treated as having been filed on the date on which the corresponding document was filed, or is treated as having been filed, in relation to application B.

*Division 5—Examination**Request for examination*

**50.—(1)** The applicant may, in the prescribed manner, request for an examination of the patent application and the complete specification relating to the application.

(2) The Commissioner may, on one or more of the prescribed grounds and in the prescribed manner, direct the applicant to request, within the prescribed period, for an examination of the patent application and the complete specification relating to the application.

(3) If the patent application and the complete specification relating to the application are open to public inspection, any person may, in the prescribed manner, require the Commissioner to give a direction under subsection (2).

(4) If required under subsection (3), the Commissioner must give a direction accordingly, unless the applicant has already requested, or been directed to request, for an examination of the patent application and the complete specification relating to the application.

(5) If the Commissioner gives a direction under this section, the patent application must be treated as having been abandoned if the applicant does not request, within the prescribed period, for an examination of the patent application and the complete specification relating to the application.

*Examination*

**51.—(1)** The Commissioner must, after being requested to do so under section 50, examine a patent application and the complete specification relating to the application, and report on—

- (a) whether the Commissioner is satisfied, on the balance of probabilities, that—
  - (i) the application and the specification comply with the requirements of this Act and of the regulations;
  - (ii) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this subparagraph;
  - (iii) the invention, so far as claimed, is a patentable invention under section 12; and
  - (iv) there is no other lawful ground of objection to the grant of a patent in respect of the application; and
- (b) all other matters (if any) that are prescribed.

(2) The examination must be carried out in the prescribed manner.

(3) The Commissioner must give a copy of the report to the applicant after it is issued.

*Commissioner may refuse to proceed with application or require application or specification to be amended*

**52.**—(1) This section applies if, after examining a patent application and the complete specification relating to the application under section 51, the Commissioner reports that he or she is not satisfied as to any of the matters specified in section 51(1)(a).

(2) The Commissioner—

- (a) must state the grounds of objection when reporting on an examination; and
- (b) may—
  - (i) refuse to proceed with the patent application; or
  - (ii) require the applicant to amend the patent application or any specification before the Commissioner proceeds with the application.

*Applicants must act by deadline if deadline set by Commissioner*

**53.**—(1) If the Commissioner has acted under section 52(2)(b), the applicant must, by the deadline (if any) set by the Commissioner, make a substantive response to the report.

(2) After each response, the Commissioner may issue a further report under section 51, and, if the Commissioner is still not satisfied as to any of the matters specified in section 51(1)(a), the Commissioner may act under section 52.

(3) If the Commissioner has issued a further report under section 51 and acted under section 52(2)(b), the applicant must, by the deadline (if any) set by the Commissioner, make a substantive response to the report.

(4) The Commissioner must set deadlines (if any) in the prescribed manner.

(5) The Commissioner may extend any deadlines in the prescribed manner.

(6) For the purposes of this section, a substantive response is a response that, in the opinion of the Commissioner—

- (a) gives a fair and substantial answer to the report issued by the Commissioner;
- (b) gives a fair and substantial answer to the report issued by the Commissioner and amends the application or specification to remove one or more of the grounds of objection raised by the Commissioner in the report; or
- (c) amends the application or specification to remove all of the grounds of objection raised by the Commissioner in the report.

*Application treated as abandoned if applicant fails to act within set deadline*

**54.** A patent application must be treated as having been abandoned if the applicant has failed to comply with section 53.

*Commissioner must examine amended specification*

**55.**—(1) The Commissioner must examine an amended complete specification in the same manner as the original specification if the specification is amended following the issue of a report under section 51.

(2) Subsection (1) does not apply after the complete specification is accepted.

*Duty to inform Commissioner of search results*

**56.—**(1) The applicant must, if required by the Commissioner, inform the Commissioner, in the prescribed manner, of the results of any documentary searches by, or on behalf of, a foreign patent office carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Fiji.

(2) Subsection (1)—

(a) does not apply to a search if the search is prescribed as a type of search to which this section does not apply; and

(b) applies only to searches completed before the grant of the patent.

(3) A search is completed on the earliest of—

(a) the date, if any, specified in the search report as the date that the report was issued;

(b) the date, if any, specified in the search report as the date that the search was completed; and

(c) the date that the search results were issued to the applicant or patentee by the foreign patent office.

(4) In this section, “foreign patent office” means an office, organisation, or other body that may grant protection in respect of an invention in a country outside Fiji.

*Division 6—Acceptance and publication*

*Time for putting application in order for acceptance*

**57.—**(1) A patent application is void unless, within the prescribed period, the applicant ensures that—

(a) the application and the complete specification comply with the requirements of this Act and of the regulations;

(b) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph;

(c) the invention, so far as claimed, is a patentable invention under section 12; and

(d) there is no other lawful ground of objection to the grant of a patent in respect of the application.

(2) Deadlines, or extensions of deadlines, set by the Commissioner under section 53 cannot extend the prescribed period under subsection (1).

(3) Nothing in this section limits section 54.



*Time may be extended if appeal pending or possible*

**58.**—(1) This section applies if, at the expiry of the prescribed period under section 57—

- (a) an appeal to the court is pending under section 197 in respect of the patent application (or, in the case of an application for a patent of addition, either in respect of that application or in respect of the patent application for the main invention); or
- (b) the 20-working-day period within which an appeal referred to in paragraph (a) may be brought under section 197(2)(b)(i) has not expired.

(2) The court may extend the period that applies under section 57 until the date that the court thinks fit if an appeal referred to in subsection (1)(a) is—

- (a) pending;
- (b) brought within the time referred to in subsection (1)(b); or
- (c) brought before the expiry of any extension of the time for bringing an appeal allowed by the court under section 197(2)(b)(ii)—
  - (i) in the case of a first extension, on an application for an extension made within the time referred to in subsection (1)(b); or
  - (ii) in the case of a subsequent extension, on an application for an extension made before the expiry of the last previous extension.

(3) If no appeal referred to in subsection (1)(a) is pending or is so brought, the period that applies under section 57 continues—

- (a) until the end of the time referred to in subsection (1)(b); or
- (b) if any extension of the time for bringing an appeal is allowed by the court as referred to in subsection (2)(c), until the expiry of the extension or last extension that is allowed.

*Notice of entitlement must be filed before acceptance*

**59.**—(1) The applicant must file, in the prescribed manner, a notice stating the grounds on which the nominated person is entitled to be granted the patent under section 20 before the expiry of—

- (a) the prescribed period under section 57; or
- (b) the extension or last extension under section 58 (if the prescribed period under section 57 is extended under that section).

(2) For the purposes of this Act, the applicant may be taken to be the nominated person.

(3) If the applicant is not the nominated person or is not the only nominated person, the applicant must identify all of the nominated persons in the notice referred to in subsection (1).

(4) Subsection (2) does not limit subsection (1).

(5) A patent application is void if the applicant does not comply with this section.

*Acceptance of complete specification*

**60.**—(1) The Commissioner must accept the complete specification relating to a patent application if the Commissioner is satisfied, on the balance of probabilities, that—

- (a) the application and the specification comply with the requirements of this Act and of the regulations;
- (b) the applicant has complied with all requirements imposed on the applicant by or under this Act that are prescribed for the purposes of this paragraph;
- (c) the invention, so far as claimed, is a patentable invention under section 12; and
- (d) there is no other lawful ground of objection to the grant of a patent in respect of the application.

(2) The Commissioner must, after acceptance of a complete specification—

- (a) give notice of the acceptance to the applicant; and
- (b) publish the acceptance in the Gazette.

(3) This section is subject to sections 57, 58 and 61.

*Applicant may request Commissioner to postpone acceptance*

**61.**—(1) The applicant may, in the prescribed manner (if any), give notice to the Commissioner requesting the Commissioner to postpone acceptance of the complete specification until a date that is specified in the notice.

(2) The date specified in the notice must not be a date that is after the prescribed period.

(3) The Commissioner may postpone acceptance under section 60 if a notice is given under this section.

*Publication in case of applications*

**62.**—(1) The Commissioner must publish a notice in the Gazette that a complete specification is open to public inspection if—

- (a) the specification has been filed for a patent application;
- (b) a period of 18 months after the earliest priority date claimed in respect of the patent application has ended; and
- (c) the specification is not already open to public inspection.

(2) Subsection (1) does not apply if the patent application is void or has been abandoned.

(3) If a complete specification filed in respect of a patent application has not become open to public inspection, the Commissioner must, if requested to do so by the applicant, publish, in the prescribed manner, a notice in the Gazette that the complete specification is open to public inspection.

*Publication in case of divisional applications made as provided for in section 32*

**63.**—(1) The Commissioner must publish a notice in the Gazette that a complete specification filed for a divisional application is open to public inspection if—

- (a) the divisional application is made in respect of a parent application; and
- (b) the complete specification filed for the parent application was open to public inspection when the divisional application was made.

(2) Subsection (3) applies if a divisional application is made in respect of a parent application and a notice is published in the Gazette that the complete specification filed for the—

- (a) parent application is open to public inspection; or
- (b) divisional application is open to public inspection.

(3) The Commissioner must also publish in the Gazette a notice that—

- (a) if subsection (2)(a) applies, the complete specification filed for the divisional application is open to public inspection; or
- (b) if subsection (2)(b) applies, the complete specification filed for the parent application is open to public inspection.

(4) For the purposes of this section—

“divisional application” means a divisional application referred to in section 32; and

“parent application” means the parent application referred to in section 32.

*Documents open to public inspection*

**64.**—(1) If a notice is published under section 62 or 63, the specification concerned, and the other documents (if any) that are prescribed, are open to public inspection.

(2) If acceptance of a complete specification is published under section 60(2)(b) in relation to a patent application, the following documents (being documents that have not already become open to public inspection) are open to public inspection—

- (a) all documents (other than prescribed documents) filed in relation to the application or the patent, whether before or after the acceptance or grant;
- (b) all documents (other than prescribed documents) filed, after the patent ceases, expires, or is revoked, in relation to the former patent;
- (c) copies of all documents relating to the application or patent (other than prescribed documents) given by the Commissioner to the applicant or patentee, or the former applicant or patentee.

(3) A specification, or other document, must be taken to have been made available to the public on the day on which it becomes open to public inspection unless it has been made available to the public (whether in Fiji or elsewhere) otherwise before that day.

*Certain documents not to be published*

**65.**—(1) Except as otherwise provided by or under this Act, documents of the kind mentioned in section 64—

- (a) must not be published by the Commissioner or be open to public inspection; and
- (b) must not be published before the document is open to public inspection by any person to whom the Commissioner provides the document in the performance of his or her functions; and
- (c) are not liable to be inspected or produced before the Commissioner or in a legal proceeding unless the Commissioner, court, or any person having power to order inspection or production, directs that the inspection or production be allowed.

(2) Subsection (1) does not prevent—

- (a) the Commissioner from publishing the date and number of a patent application and any details of the patent application and invention that are required to be given in or with the patent application;
- (b) documents of the kind mentioned in section 64 being published by the Commissioner and becoming open to public inspection with the consent of the applicant.

(3) Notice of an application for the production in legal proceedings of a document of the kind mentioned in section 64 must be given to the Commissioner, who is entitled to be heard on the application.

*Effect of publication of complete specification*

**66.**—(1) After a complete specification relating to a patent application has become open to public inspection and until a patent is granted on the application, the nominated person has the same privileges and rights as the nominated person would have had if a patent for the invention had been granted on the day when the specification became open to public inspection under sections 62 to 64.

(2) The nominated person is entitled to bring a proceeding by virtue of this section in respect of an act only—

- (a) after the patent has been granted; and
- (b) if the act would, if the patent had been granted on the day referred to in subsection (1), have infringed both—
  - (i) the patent; and
  - (ii) the claims (as interpreted by the description and any drawings that form part of the complete specification) in the form in which they were contained in the complete specification immediately before it became open to public inspection.

(3) Division 1 of Part 4 applies (subject to section 67) to a proceeding under this section with all necessary modifications (including reading references to the patentee as references to the nominated person and construing references to a patent being in force, granted or valid consistently with this section).

*Court must consider whether it would be reasonable to expect that patent would be granted*

**67.**—(1) In a proceeding under section 66, the court must, in considering the amount of damages or an account of profits for an infringement, consider whether or not it would have been reasonable to expect, from a consideration of the complete specification that became open to public inspection, that a patent would be granted that would confer on the patentee protection from an act of the same description as that found to infringe the rights conferred by that section.

(2) If the court finds that it would not have been reasonable, the court must reduce the damages, or the amount of an account of profits, to an amount that it thinks just.

(3) Section 139 does not apply to a proceeding under section 66.

*Division 7—Amendment of specifications after acceptance*

*General rules concerning amendments of specifications after acceptance*

**68.**—(1) After the acceptance of a complete specification, an amendment to that specification is not allowable and must not be made if the effect of the amendment is that—

- (a) the specification as amended would claim or describe matter that was not in substance disclosed in the specification before the amendment; or
- (b) a claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

(2) Subsection (1) does not apply to an amendment for the purpose of correcting an obvious mistake made in, or in relation to, a complete specification.

(3) If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed by the Commissioner or the court—

- (a) the right of the patentee or applicant to make the amendment must not be called into question except on the ground of fraud; and
- (b) the amendment must, in all courts and for all purposes, be treated as forming part of the specification.

(4) In construing the specification as amended, reference may be made to the specification as originally published.

*Amendment must be published in Gazette*

**69.** If, after the date of the publication of the accepted complete specification, any amendment of the specification is allowed under sections 70 to 74, the fact that the specification has been amended must be published in the Gazette.

*Amendment of specification with leave of Commissioner*

**70.—**(1) The Commissioner may, on a request made under this section by a patentee, or by an applicant for a patent at any time after the acceptance of the complete specification, allow the complete specification to be amended subject to any conditions that the Commissioner thinks fit.

(2) The Commissioner must not allow a specification to be amended on a request made under this section while any relevant proceeding is pending.

(3) Every request for leave to amend a specification under this section must—

- (a) state the nature of the proposed amendment;
- (b) give full particulars of the reasons for the request; and
- (c) be made in the prescribed manner (if any).

(4) This section is subject to section 68.

*Request for leave to amend must be published in Gazette*

**71.—**(1) Every request for leave to amend a specification under section 70, and the nature of the proposed amendment, must be published in the Gazette.

(2) If the request is made before the date of the publication of the accepted complete specification, the Commissioner may, if the Commissioner thinks fit, dispense with publication under subsection (1) or direct that publication be postponed until the date of the publication of the accepted complete specification.

*Opposition to proposed amendment*

**72.—**(1) Any person may, in the prescribed manner (if any), give notice to the Commissioner of opposition to a proposed amendment within the prescribed period after the publication of a request under section 71.

(2) If a notice is given within the prescribed period, the Commissioner must—

- (a) notify the person who made the request under section 70; and
- (b) give that person and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

*Provisions concerning amendments with leave of Commissioner do not apply in certain circumstances*

**73.** Sections 70 to 72 do not apply in relation to any amendment of a specification effected—

- (a) in a proceeding in opposition to the grant of a patent under sections 77 and 78; or
- (b) in accordance with section 83(2), 84(2) or 98(6)(b).

*Amendment of specification with leave of court*

**74.—**(1) In any relevant proceeding in relation to a patent, the court may, by order, allow the patentee to amend the patentee's complete specification in the manner and subject to the terms as to costs, publication, or otherwise that the court thinks fit.

(2) If, in any proceeding for the revocation of a patent, the court decides that the patent is invalid, the court may allow the specification to be amended under this section instead of revoking the patent.

(3) If an application for an order under this section is made to the court—

- (a) the applicant for that order must give notice of the application to the Commissioner;
- (b) the Commissioner may appear and be heard on the application; and
- (c) the Commissioner must appear if he or she is directed by the court to appear.

(4) This section is subject to section 68.

*Division 8—Assertions by third parties, opposition, and re-examinations*

*Assertions by third parties on novelty and inventive step*

**75.**—(1) Any person may, within the prescribed period after a complete specification becomes open to public inspection but before the date of the publication of the accepted complete specification, notify the Commissioner, in the prescribed manner (if any), that the person asserts that the invention, so far as claimed in a claim, is not a patentable invention because it does not comply with section 12(a).

(2) The notice must state the reasons for the person’s assertion.

(3) The notice and any documents accompanying it are open to public inspection.

*Commissioner must consider and deal with notice in prescribed manner*

**76.**—(1) The Commissioner must inform the applicant in writing of any matter of which the Commissioner is notified under section 75 and send the applicant a copy of any document accompanying the notice.

(2) The Commissioner must otherwise consider and deal with a notice under section 75 in the prescribed manner.

*Opposition to grant of patent*

**77.**—(1) Any person may, in the prescribed manner, oppose the grant of a patent on one or more of the following grounds—

- (a) that the invention, so far as claimed in a claim, is not a patentable invention under section 12;
- (b) that the nominated person is not entitled to the patent;
- (c) that the complete specification does not comply with any provision of Division 2 other than section 37(2)(a);
- (d) that the applicant is attempting, or has attempted, to obtain the grant of a patent by fraud, false suggestion or a misrepresentation;
- (e) that the invention, so far as claimed in a claim, was secretly used in Fiji before the priority date of that claim;
- (f) that granting the patent would be contrary to law.

(2) For the purposes of subsection (1)(a), account must not be taken of any secret use of the invention.

(3) For the purposes of subsection (1)(e), account must not be taken of any use of the invention—

- (a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title;
- (b) by a Government department or any person authorised by a Government department, in consequence of the nomination of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention directly or indirectly to that department or person; or
- (c) by any other person, in consequence of the nomination of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title.

*Hearing and decision by Commissioner*

**78.** If the grant of a patent is opposed, the Commissioner must—

- (a) give the applicant and the opponent a reasonable opportunity to be heard before deciding a case; and
- (b) consider whether any of the following grounds are established on the balance of probabilities—
  - (i) any ground set out in section 77 that is relied upon by the opponent;
  - (ii) any other ground set out in section 77 that the Commissioner has decided to take into account (whether relied upon by the opponent or not); and
- (c) otherwise decide and deal with the case in the prescribed manner.

*Re-examination before patent is granted*

**79.—**(1) The Commissioner may, and must if requested to do so by any person, re-examine a patent application and the complete specification relating to the application on or after the date of the publication of the accepted complete specification if the patent has not been granted.

(2) A request under subsection (1) must—

- (a) specify one or more of the grounds set out in section 77 that the person wants the Commissioner to consider; and
- (b) be made in the prescribed manner (if any).



*Re-examination after patent is granted*

**80.**—(1) If a patent has been granted, the Commissioner may, and must if requested to do so by any person, re-examine the patent application and the complete specification relating to the application.

(2) A request under subsection (1) must—

- (a) specify one or more of the grounds set out in section 99 that the person wants the Commissioner to consider; and
- (b) be made in the prescribed manner (if any).

(3) The Commissioner must re-examine a patent application and the complete specification relating to the application if the validity of a patent is disputed in any proceeding before the court under this Act and the court directs the Commissioner to conduct a re-examination.

*Relationship between re-examination and other proceedings*

**81.**—(1) The Commissioner must not conduct a re-examination under this Division if—

- (a) in the case of section 79, an opposition proceeding under this Division in relation to the application is pending;
- (b) in the case of section 80(1)—
  - (i) a relevant proceeding in relation to the patent is pending; or
  - (ii) a proceeding before the Commissioner under Division 11 in relation to the patent is pending.

(2) If a re-examination under this Division has commenced, the Commissioner must not continue the re-examination if—

- (a) in the case of section 79, an opposition proceeding under this Division in relation to the application is commenced;
- (b) in the case of section 80(1)—
  - (i) a relevant proceeding in relation to the patent is commenced and the Commissioner has received notification of the commencement of that proceeding; or
  - (ii) a proceeding before the Commissioner under Division 11 in relation to the patent is commenced.

(3) If a re-examination has been discontinued under subsection (2), the Commissioner may, if he or she thinks fit, continue the re-examination after the opposition proceeding, relevant proceeding or proceeding under Division 11, as the case may be, is completed.

(4) Notwithstanding sections 79(1) and 80(1), the Commissioner is not required to conduct a re-examination after receiving a request under either of those subsections if the Commissioner considers that all of the issues raised in relation to the request are the

same, or substantially the same, as those raised in a previous opposition or re-examination proceeding under this Division or a previous proceeding before the Commissioner or the court under Division 11.

(5) On a re-examination under section 79(1) or 80(1), the Commissioner may refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under this Division or a previous proceeding before the Commissioner or the court under Division 11.

(6) Sections 79, 80 and 82 are subject to this section.

*Report on re-examination*

**82.**—(1) On a re-examination under this Division, the Commissioner must consider and report on whether the Commissioner is satisfied, on the balance of probabilities, that any of the relevant grounds is established.

(2) For the purposes of subsection (1) and sections 83 and 84, “relevant grounds” means—

- (a) in the case of a request under section 79(1), the grounds specified under section 79(2)(a) and any other grounds set out in section 77 that the Commissioner has decided to consider;
- (b) in the case of a re-examination under section 79 that is commenced by the Commissioner, the grounds set out in section 77 that the Commissioner has decided to consider;
- (c) in the case of a request under section 80(1), the grounds specified under section 80(2)(a) and any other grounds set out in section 99 that the Commissioner has decided to consider;
- (d) in the case of a re-examination under section 80 that is commenced by the Commissioner, the grounds set out in section 99 that the Commissioner has decided to consider;
- (e) in the case of a re-examination that was directed under section 80(3), the grounds set out in section 99 that the court has requested the Commissioner to consider.

(3) A copy of a report under this section must, if the re-examination was directed under section 80(3), be given by the Commissioner to the court that gave the direction.

*Refusal to grant patent: re-examination before grant*

**83.**—(1) If the Commissioner reports on a re-examination under section 79 that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds is established, the Commissioner may refuse to grant the patent.

(2) The Commissioner must not refuse to grant a patent under this section unless the Commissioner has, if appropriate, given the applicant a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the applicant has failed to do so.

*Revocation of patent: re-examination after grant*

**84.**—(1) If the Commissioner reports on a re-examination under section 80 that he or she is satisfied, on the balance of probabilities, that any of the relevant grounds is established, the Commissioner may, by notice in writing, revoke the patent, either wholly or in so far as it relates to a particular claim, as the case may be.

(2) The Commissioner must not revoke a patent under this section unless the Commissioner has, if appropriate, given the patentee a reasonable opportunity to amend the relevant specification for the purpose of removing any lawful ground of objection and the patentee has failed to do so.

(3) The Commissioner must not revoke a patent under this section—

- (a) while a relevant proceeding in relation to that patent is pending; or
- (b) before the Commissioner has made a decision on an application for revocation of the patent made under section 97 (if an application has been made to the Commissioner under that section).

(4) Division 10 does not limit this section.

*Person who requests re-examination has no right to participate further in re-examination proceeding*

**85.**—(1) A person who has made a request under section 79(1) or 80(1) does not have—

- (a) the right to be heard in relation to the re-examination;
- (b) any other right to participate in the re-examination proceeding after the request is made; and
- (c) the right to appeal to the court against any decision of the Commissioner under any of sections 79 to 84.

(2) Section 197 is subject to this section.

*Division 9—Grant of patent*

*When patent must be granted*

**86.**—(1) The Commissioner must grant a patent to the nominated person, or to 2 or more nominated persons jointly, as soon as is reasonably practicable after the date that is 3 months after the date of the publication of the accepted complete specification if—

- (a) there is no opposition to the grant; or
- (b) there is opposition to the grant, the Commissioner’s decision, or the decision on appeal, is that a patent should be granted.

(2) If, before the patent is granted, a re-examination proceeding is commenced under section 79 (whether as a result of a request or a decision of the Commissioner) and that proceeding has not been discontinued or ended under section 81, the Commissioner—

- (a) must not act under subsection (1) until after the Commissioner has prepared a report under section 82; and
- (b) may refuse to grant the patent in accordance with section 83.

(3) The Commissioner may postpone the grant of the patent in the prescribed circumstances.

(4) If a nominated person dies before a patent is granted on the patent application, the patent may be granted to his or her personal representative.

(5) The date that the patent is granted must be entered in the patents register.

(6) The Commissioner must, as soon as is reasonably practicable after a patent has been granted, publish in the Gazette a notice that it has been granted.

*Validity of patent not guaranteed*

**87.** Nothing done under this Act guarantees the granting of a patent, or that a patent is valid, in Fiji or anywhere else.

*Patent date*

**88.—**(1) Every patent must be given a patent date that is—

- (a) the filing date of the relevant complete specification; or
- (b) if the regulations provide for the determination of a different date as the patent date, the date determined under the regulations.

(2) A patent is not in force for the purposes of this Act until it is granted.

(3) The patent date of every patent must be entered in the patents register.

*Patent granted for one invention only*

**89.—**(1) A patent must be granted for one invention only.

(2) It is not competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

*Amendment of patent granted to deceased person or to body corporate that has been liquidated or wound up*

**90.—**(1) This section applies if, at any time after a patent has been granted, the Commissioner is satisfied that the person to whom the patent was granted—

- (a) had died before the patent was granted; or
- (b) in the case of a body corporate, had ceased to exist before the patent was granted.

(2) The Commissioner may amend the patent by substituting for the name of that person the name of the person to whom the patent should have been granted.

(3) The patent has effect, and is to be treated as always having had effect, in accordance with that amendment.

*Patents of addition*

**91.—**(1) This section applies if—

- (a) a patent for an invention (the **main invention**) has been applied for or granted;

(b) the applicant or patentee (or a person authorised by the applicant or patentee) applies for a further patent for an improvement in, or modification of, the main invention; and

(c) the application for that further patent is made in the prescribed manner.

(2) The Commissioner may, on the request of the applicant for the further patent, grant the patent for the improvement or modification as a patent of addition.

*Commissioner may revoke patent for improvement or modification and grant patent of addition*

**92.**—(1) This section applies if—

(a) an invention that is an improvement in, or modification of, another invention is the subject of an independent patent; and

(b) the patentee of that patent is also the patentee of the patent for the main invention.

(2) The Commissioner may, on the request of the patentee, by order revoke the patent for the improvement or modification and grant to the patentee a patent of addition for the improvement or modification.

(3) A request under subsection (2) must be made in the prescribed manner (if any).

(4) The patent of addition must have the same patent date as the patent date of the patent that is revoked.

*Restrictions on granting of patents of addition*

**93.**—(1) The Commissioner must not grant a patent as a patent of addition unless the filing date of the complete specification is the same as, or later than, the filing date of the complete specification for the main invention.

(2) The Commissioner must not grant a patent of addition before the granting of the patent for the main invention.

*Term of patent of addition*

**94.**—(1) A patent of addition—

(a) must be granted for a term equal to that of the patent for the main invention, or as much of the term of the patent for the main invention that is unexpired; and

(b) remains in force during that term or until the earlier of expiry or revocation of the patent for the main invention.

(2) If the patent for the main invention is revoked under this Act, the court or the Commissioner, as the case may be, may order that the patent of addition become, and continue in force as, an independent patent for the remainder of the term of the patent for the main invention.

*Renewal fees for patents of addition*

**95.—**(1) No renewal fees are payable in respect of a patent of addition.

(2) If any patent of addition becomes an independent patent under section 94(2), the renewal fees are payable from that time, on the same dates, as if the patent had been originally granted as an independent patent.

*Provisions concerning inventive step requirement and validity in connection with patents of addition*

**96.—**(1) The grant of a patent of addition must not be refused, and a patent granted as a patent of addition must not be revoked or invalidated, on the ground only that the invention claimed in the complete specification of the patent of addition does not involve any inventive step having regard to any publication or use of—

- (a) the main invention described in the complete specification for the main invention; or
- (b) any improvement in, or modification of, the main invention described in the complete specification of—
  - (i) a patent of addition to the patent for the main invention; or
  - (ii) an application for a patent of addition to the patent for the main invention.

(2) The validity of a patent of addition must not be questioned on the ground that the invention should have been the subject of an independent patent.

*Division 10—Revocation and surrender of patents**Revocation of patent*

**97.—**(1) The Commissioner or the court may, on an application under this section, revoke a patent on any of the grounds set out in section 99.

(2) An application under this section may be made by any person.

(3) An application to the Commissioner under this section must be made in the prescribed manner (if any).

*Provisions concerning applications for revocation made to Commissioner*

**98.—**(1) The Commissioner may refuse any application to the Commissioner under section 97 if the Commissioner considers that—

- (a) the application is frivolous or vexatious; or
- (b) all of the issues raised by the application are the same, or substantially the same, as the issues raised in a previous opposition or re-examination proceeding under Division 9 or in a previous proceeding before the Commissioner or the court under this Division.

(2) The Commissioner may, in considering an application under section 97, refuse to consider any issue that the Commissioner considers is the same, or substantially the same, as an issue raised in a previous opposition or re-examination proceeding under Division 9 or in a previous proceeding before the Commissioner or the court under this Division.

(3) If a relevant proceeding in relation to a patent is pending in any court, an application to the Commissioner under section 97 may be made only with the leave of that court.

(4) If an application is made to the Commissioner under section 97, the Commissioner must—

- (a) notify the patentee; and
- (b) give to the person who made the application and the patentee a reasonable opportunity to be heard before deciding the case (unless the application has been refused under subsection (1)).

(5) The Commissioner may, at any stage of a proceeding relating to an application made to the Commissioner under section 97, refer the application to the court.

(6) If, on an application made to the Commissioner under section 97, the Commissioner is satisfied, on the balance of probabilities, that any of the grounds set out in section 99 is established, the Commissioner may by order direct that the patent is either—

- (a) revoked unconditionally; or
- (b) revoked unless the complete specification is amended to the Commissioner's satisfaction within the time that is specified in the order.

*Grounds for revoking patent*

**99.**—(1) A patent may be revoked on one or more of the following grounds—

- (a) that the invention, so far as claimed in a claim, is not a patentable invention under section 12;
- (b) that the patentee is not entitled to the patent;
- (c) that the complete specification does not comply with Division 2;
- (d) that the patent was obtained by fraud, false suggestion, or a misrepresentation;
- (e) that the invention, so far as claimed in a claim, was secretly used in Fiji before the priority date of that claim;
- (f) that the patent has been granted contrary to law.

(2) For the purposes of subsection (1)(a), account must not be taken of any secret use of the invention.

(3) For the purposes of subsection (1)(e), account must not be taken of any use of the invention—

- (a) for the purpose of reasonable trial or experiment only if the trial or experiment is conducted by, on behalf of, or with the consent of the nominated person or any person from whom the nominated person derives title;

- (b) by a Government department or any person authorised by a Government department, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention directly or indirectly to that department or person; or
- (c) by any other person, in consequence of the nominated person, or any person from whom the nominated person derives title, communicating or disclosing the invention to that person in confidence if the use of the invention is without the consent of the nominated person or of any person from whom the nominated person derives title.

(4) Every ground set out in subsection (1) is available as a ground of defence in any proceeding for the infringement of the patent.

*Court may also revoke patent if patentee, without reasonable cause, refuses request of Government department to exploit invention*

**100.**—(1) The court may, on the application of a Government department, revoke a patent if the court is satisfied that the patentee has, without reasonable cause, failed to comply with a request of the Government department to exploit the patented invention for the services of the State on reasonable terms.

(2) The ground for revoking a patent set out in subsection (1) is available as a ground of defence in any proceeding for the infringement of the patent.

*Surrender of patent*

**101.**—(1) A patentee may, by notice given to the Commissioner in the prescribed manner (if any), offer to surrender the patent.

(2) The Commissioner must publish the offer in the Gazette.

(3) A person may, within the prescribed period after the publication, give notice to the Commissioner of opposition to the surrender.

(4) The Commissioner must notify the patentee if notice of opposition is given.

(5) The Commissioner may accept the offer and by order revoke the patent if—

(a) the Commissioner has given the patentee and the opponent (if any) a reasonable opportunity to be heard; and

(b) the Commissioner is satisfied that the patent may properly be surrendered.

*Division II—Restoration of lapsed patents and restoration of patent applications*

*Restoration of lapsed patents*

**102.**—(1) This section applies if a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period or within that period as extended under section 19.

(2) The Commissioner may, on a request made in the prescribed manner and in accordance with this Division, by order restore the patent, and any patent of addition specified in the request that has ceased to have effect when the patent ceased to have effect, if the Commissioner is satisfied that the failure to pay the renewal fee was unintentional.



*Request must describe circumstances that led to failure to pay renewal fee*

**103.**—(1) A request for an order under section 102 must contain a statement that fully sets out the circumstances that led to the failure to pay the renewal fee.

(2) The Commissioner may require the person who makes the request to provide any further evidence that the Commissioner thinks fit.

*Persons who may make request for restoration of patent*

**104.**—(1) A request for an order under section 102 may be made by the person who was the patentee or, if that person is deceased, by that person’s personal representative.

(2) If the patent was held by 2 or more persons jointly, the request for an order under section 102 may, with the leave of the Commissioner, be made by one or more of them without joining the others.

*When request for restoration of patent may be made*

**105.**—(1) A request for an order under section 102 may only be made within the prescribed period.

(2) The Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The person who makes the request must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue.

(4) The Commissioner may require that person to provide any further evidence that the Commissioner thinks fit.

*Commissioner must give person who made request reasonable opportunity to be heard if not satisfied that prima facie case has been made out for restoration*

**106.** The Commissioner must, after considering a request made in accordance with sections 102 to 105, give the person who made the request a reasonable opportunity to be heard if the Commissioner is not satisfied that a *prima facie* case has been made out for an order under section 102.

*Commissioner to publish request in Gazette*

**107.** The Commissioner must publish a request made in accordance with sections 102 to 105 in the Gazette if the Commissioner is satisfied that a *prima facie* case has been made out for an order under section 102.

*Notice of opposition and reasonable opportunity to be heard*

**108.**—(1) Any person may, within the prescribed period and in the prescribed manner (if any), give notice to the Commissioner of opposition to an order being made under section 102 on either or both of the following grounds—

- (a) that the failure to pay the renewal fee was not unintentional;
- (b) if the period within which a request for an order under section 102 may be made is extended under section 105, that the delay in making the request was undue.

(2) The Commissioner must notify the person who made the request if a person has given notice under subsection (1) and provide the person who made the request with a copy of that notice.

(3) The Commissioner must give the person who made the request and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

*Order to be made on payment of unpaid fees*

**109.**—(1) If the Commissioner has published a request under section 107, he or she must make an order under section 102 in accordance with the request after the prescribed period for giving notice of opposition if—

- (a) all unpaid renewal fees are paid;
- (b) all other prescribed additional penalties (if any) are paid; and
- (c) either—
  - (i) no notice of opposition is given within the prescribed period; or
  - (ii) the decision of the Commissioner is in favour of the person who made the request (in the case of a notice of opposition having been given within the prescribed period).

(2) An order for the restoration of a patent—

- (a) may be made subject to a condition requiring the registration of any matter if the provisions of this Act concerning entries in the patents register have not been complied with; and
- (b) must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention between the date when the patent ceased to have effect and the date on which the request is published under section 107; and
- (c) may be made subject to any other conditions that the Commissioner thinks fit.

(3) If any condition of an order under this section is not complied with by the patentee, the Commissioner may revoke the order and give any directions that are consequential on the revocation that the Commissioner thinks fit.

(4) The Commissioner must, before the Commissioner makes a decision under subsection (3), give the patentee a reasonable opportunity to be heard.

*Request for restoration of void or abandoned patent applications*

**110.**—(1) This section applies if the patent application is abandoned under section 33, 50 or 54 or is void under section 57 or 59.

(2) The applicant may make a request to the Commissioner in the prescribed manner for an order to restore the patent application and to extend the period for complying with the requirements imposed on the applicant by or under this Act to a date that is specified in the order.

(3) Every request for an order must contain a statement that fully sets out the circumstances that led to the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act.

(4) The Commissioner must publish the request in the Gazette if the Commissioner is satisfied that the failure of the applicant to comply with the requirements imposed on the applicant by or under this Act within the time allowed by or under this Act was unintentional.

*When request for restoration of void or abandoned patent applications may be made*

**111.**—(1) A request under section 110 may only be made within the prescribed period.

(2) The Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.

(3) The applicant must, for the purposes of subsection (2), provide the Commissioner with a statement that fully sets out the circumstances that caused the delay and the reasons why the delay is not undue.

(4) The Commissioner may require the applicant to provide any further evidence that the Commissioner thinks fit.

*Notice of opposition*

**112.**—(1) Any person may, within the prescribed period and in the prescribed manner (if any), give notice to the Commissioner of opposition to an order being made under section 113 on either or both of the following grounds—

- (a) that any failure of the applicant to comply with the requirements imposed on the applicant by or under this Act within the time allowed by or under this Act was not unintentional;
- (b) if the period within which a request under section 110 may be made is extended under section 111, that the delay in making the request was undue.

(2) The Commissioner must notify the applicant if a person has given notice under subsection (1) and provide the applicant with a copy of that notice.

(3) The Commissioner must give the applicant and the opponent a reasonable opportunity to be heard before the Commissioner decides the case.

*Commissioner to determine matter*

**113.**—(1) The Commissioner must, after the expiry of the prescribed period for giving notice of opposition under section 112—

- (a) by order restore the patent application and extend the period for complying with the requirements imposed on the applicant by or under this Act to a period that is specified in the order if the Commissioner is satisfied that—
  - (i) every failure of the applicant to comply with the requirements imposed on the applicant by or under this Act within the time allowed by or under this Act was unintentional; and

- (ii) if the period within which the request for an order under this section may be made was extended under section 111, there was no undue delay in making the request; or

(b) dismiss the request.

(2) An order under this section must contain, or be subject to, the provisions that are prescribed for the protection or compensation of persons who availed themselves, or took definite steps by way of contract or otherwise to avail themselves, of the invention that is the subject of the patent application between the date on which the patent application became void or was abandoned and the date on which the request is published under section 110.

(3) The Commissioner must publish in the Gazette the making of an order under subsection (1) after that order is made.

#### *Division 12—Miscellaneous provisions*

##### *Persons claiming under assignment or agreement or by operation of law*

**114.**—(1) This section applies if, before a patent has been granted, a person would, if the patent were to be then granted, be entitled under an assignment or agreement, or by operation of law, to—

- (a) the patent;
- (b) an interest in the patent; or
- (c) an undivided share in the patent or in an interest in the patent.

(2) The Commissioner may, on a request made by the person in the prescribed manner, direct that the patent application proceed in the name of the person, or in the names of the person and the applicant or the other joint applicant or applicants (as the case may require).

(3) If the Commissioner gives a direction, the person must be taken to be—

- (a) the applicant, or a joint applicant, as the case may require; and
- (b) the nominated person, or joint nominated person, as the case may require.

##### *Death of applicant*

**115.**—(1) If an applicant dies before a patent is granted on the patent application, his or her personal representative may proceed with the application.

(2) The Commissioner may also dispense with probate and letters of administration and allow a person to proceed with a deceased applicant's application under section 150.

##### *Disputes between interested parties*

**116.**—(1) If a dispute arises between interested parties in relation to a patent application concerning whether, or in what manner, the application should proceed, the Commissioner may, on a request made to the Commissioner, give any directions that the Commissioner thinks fit for—

- (a) enabling the application to proceed in the name of one or more of the parties alone;

- (b) regulating the manner in which it is to proceed; or
- (c) both of the purposes referred to in paragraphs (a) and (b).

(2) A request under subsection (1) must be made in the prescribed manner and may be made by any of the parties.

(3) The Commissioner must, before giving a direction, give a reasonable opportunity to be heard to any person that the Commissioner considers is interested (whether or not that person is currently an interested party).

*Directions in relation to inventions concerning defence*

**117.**—(1) The Commissioner may give any of the directions described in subsection (2) if—

- (a) a patent application has been made for an invention either before or after the commencement of this section; and
- (b) the invention is, in the opinion of the Commissioner—
  - (i) one of a class notified to the Commissioner by the Minister responsible for defence as relevant for defence purposes; or
  - (ii) likely to be valuable for defence purposes.

(2) The directions prohibit or restrict the —

- (a) publication of information concerning the invention; or
- (b) communication of information concerning the invention to a person or class of persons specified in the directions.

(3) While the directions are in force—

- (a) the patent application may, subject to the directions, proceed up to the acceptance of the complete specification;
- (b) the patent application and the complete specification must not become open to public inspection; and
- (c) a patent must not be granted in relation to the patent application.

*Commissioner must give notice to Minister responsible for defence*

**118.** If the Commissioner gives directions under section 117, the Commissioner must give notice of the patent application and of the directions to the Minister responsible for defence.

*Minister responsible for defence must consider whether publication would be prejudicial to defence of Fiji*

**119.**—(1) The Minister responsible for defence must—

- (a) on receipt of a notice under section 118, consider whether the publication of the invention would be prejudicial to the defence of Fiji; and
- (b) unless a notice under subsection (3) has been given to the Commissioner, reconsider that question before the expiry of 9 months from the filing date of the patent application and at least once in every subsequent year.

(2) For the purposes of subsection (1), the Minister responsible for defence may, at any time after the complete specification has been accepted or, with the consent of the applicant, at any time before the complete specification has been accepted, inspect the patent application and any documents provided to the Commissioner in connection with that application.

(3) If, on consideration of the invention at any time, it appears to the Minister responsible for defence that the publication of the invention would not, or would no longer, be prejudicial to the defence of Fiji, the Minister responsible for defence must give notice to the Commissioner to that effect.

*Commissioner must revoke directions on receipt of notice from Minister responsible for defence*

**120.** On receipt of a notice under section 119, the Commissioner—

- (a) must revoke the directions given under section 117; and
- (b) may, subject to any conditions that the Commissioner thinks fit, extend the time for doing anything required or authorised to be done by or under this Act in connection with the patent application, whether or not that time has previously expired.

*Acceptance of complete specification while directions in force*

**121.—**(1) This section applies if a complete specification filed for a patent application for an invention for which directions have been given under section 117 is accepted while the directions are in force.

(2) If any use of the invention is made while the directions are in force by, on behalf of, or to the order of a Government department, Division 6 of Part 4 applies to that use as if the patent had been granted for the invention.

(3) If it appears to the Minister responsible for defence that the applicant for the patent has suffered hardship by reason of the directions being in force, the Minister responsible for finance may pay to the applicant an amount by way of compensation that the Minister responsible for finance considers is reasonable.

(4) For the purposes of subsection (3), the Minister responsible for finance must have regard to—

- (a) the novelty and usefulness of the invention;
- (b) the purpose for which the invention is designed; and
- (c) any other relevant matters.

*Maintenance fees and renewal fees not payable while directions in force*

**122.—**(1) No maintenance fees are payable for any period during which directions that are given under section 117 are in force.

(2) No renewal fees are payable for any period during which directions that are given under section 117 are in force if a patent is granted for an application for which directions have been given.

*Offence to fail to comply with directions*

**123.**—(1) Any person who fails to comply with a direction given under section 117 commits an offence if, at the time of the failure, the person knew or ought to have known that a direction had been given.

(2) Any person who commits an offence against subsection (1) is liable on conviction to a fine not exceeding \$20,000 or imprisonment for a term not exceeding 2 years or both.

*Liability of directors and managers if body corporate commits offence*

**124.** If a body corporate is convicted of an offence against section 123, every director and every person concerned in the management of the body corporate is guilty of the offence if it is proved that—

- (a) the act that constituted the offence took place with his or her authority, permission, or consent; and
- (b) he or she—
  - (i) knew, or could reasonably be expected to have known, that the offence was to be or was being committed; and
  - (ii) failed to take all reasonable steps to prevent or stop it.

PART 4—INFRINGEMENT, OTHER PATENT PROCEEDINGS, AND MATTERS AFFECTING PATENT OWNERSHIP

*Division 1—Infringement proceedings*

*Infringement by doing anything patentee has exclusive right to do*

**125.** A person infringes a patent if (other than under a licence or with the consent or agreement of the patentee) the person does anything in the patent area, while the patent is in force, that the patentee has the exclusive right to do under section 16.

*Infringement by supplying means to infringe to another person*

**126.** A person (**A**) also infringes a patent if (other than under a licence or with the consent or agreement of the patentee)—

- (a) A supplies, or offers to supply, in the patent area, while the patent is in force, another person (**B**) with any of the means, relating to an essential element of the invention, for putting the invention into effect;
- (b) either—
  - (i) A knows, or ought reasonably to know, that the means are suitable and intended by B for putting the invention into effect; or
  - (ii) if the means is a staple commercial product, A supplies the means, or offers to supply the means, for the purpose of inducing B to put the invention into effect; and
- (c) B would infringe the patent by putting the invention into effect.

*Presumption that product produced by infringing process*

**127.**—(1) If a patented process is a process for obtaining a new product, the same product produced by a person (other than under a licence or with the consent or agreement of the patentee) is presumed in an infringement proceeding to have been obtained by that process.

(2) Subsection (1) applies unless the defendant proves the contrary.

(3) In applying subsection (1), the court must not require any person to disclose any manufacturing or commercial secrets if the court thinks that it would be unreasonable to require that disclosure.

*No infringement for experimental use*

**128.**—(1) It is not an infringement of a patent for a person to do an act for experimental purposes relating to the subject matter of an invention.

(2) In this section, “act for experimental purposes relating to the subject matter of an invention” includes an act for the purpose of—

- (a) determining how the invention works;
- (b) determining the scope of the invention;
- (c) determining the validity of the claims;
- (d) seeking an improvement of the invention.

*No infringement by use in or from foreign vessels, aircraft or vehicles*

**129.**—(1) It is not an infringement of a patent if—

- (a) an invention is used—
  - (i) on board a foreign vessel, in the body of a foreign vessel, or in a foreign vessel’s machinery, tackle, apparatus, or other accessories, and the invention is used for the vessel’s actual needs only;
  - (ii) in the construction or working of a foreign aircraft or foreign land vehicle or of a foreign aircraft’s or foreign land vehicle’s accessories; and
- (b) the vessel, aircraft or land vehicle comes into the patent area accidentally or only temporarily.

(2) In this section, “foreign” means—

- (a) registered in a convention country, in the case of a vessel or aircraft; or
- (b) owned by a person resident or incorporated in a convention country, in the case of a land vehicle.

*No infringement for use to produce information required by law*

**130.** It is not an infringement of a patent for a person to make, use, import, sell, hire, or otherwise dispose of the invention solely for uses reasonably related to the development and submission of information required under any law whether in Fiji or elsewhere that regulates the manufacture, construction, use, importation, sale, hire, or disposal of any product.



*No infringement for prior use of invention*

**131.**—(1) It is not an infringement of a patent for a person to do an act that exploits an invention, and that would infringe a patent apart from this section, if, immediately before the priority date of the relevant claim, the person—

- (a) was exploiting the invention in the patent area; or
- (b) had taken definite steps (contractually or otherwise) to exploit the invention in the patent area.

(2) Subsection (1) does not apply if, before the priority date, the person had—

- (a) stopped (except temporarily) exploiting the invention; or
- (b) abandoned (except temporarily) the steps to exploit the invention.

(3) Subsection (1) does not apply to an invention the person derived from any of the following persons, unless the person derived the invention from information that was made publicly available by or with the consent of that person—

- (a) the patentee or nominated person;
- (b) any person from whom the patentee or nominated person derives title.

(4) A person (**A**)—

- (a) may dispose of the whole of A's entitlement under subsection (1) to exploit an invention without infringing a patent to another person (**B**), (and in this case subsections (1) to (3) apply to B as they applied to the first person who had that entitlement and from whom B's entitlement was directly or indirectly derived); but
- (b) may not license any or all of A's entitlement under subsection (1) to another person.

(5) This section applies in respect of a patent only if the relevant patent application was made under this Act on or after the commencement of Part 3.

*Defendant may counterclaim for revocation of patent*

**132.**—(1) A defendant may apply by way of counterclaim in an infringement proceeding for revocation of the patent on any of the grounds stated in section 99.

(2) If the defendant is a Government department, the defendant may apply by way of counterclaim in an infringement proceeding for revocation of the patent on the ground stated in section 100 (whether or not it also applies by way of counterclaim for revocation of the patent on any of the grounds stated in section 99).

*Who may bring infringement proceeding*

**133.**—(1) An infringement proceeding may be brought in court by—

- (a) the patentee; or
- (b) an exclusive licensee for any infringement that occurs during the term of the licence.

(2) Section 135 affects the right to bring a proceeding under this section.

(3) Nothing in subsection (1), section 66 or 135 enables a person to obtain any relief the granting of which is prevented by the Limitation Act 1971.

*When proceeding may be brought*

**134.**—(1) An infringement proceeding may not be brought until the patent is granted.

(2) Notwithstanding subsection (1), section 66 enables an infringement proceeding to relate to infringements before the patent is granted in the circumstances set out in that section.

*Right to bring infringement proceeding if registrable assignment or licence has occurred*

**135.**—(1) If a person has the right to bring an infringement proceeding under section 133(1) by virtue of a transaction that must be registered under section 148, that person must not bring the proceeding unless—

- (a) the person's title or interest was registered at least one month before the commencement of the proceeding; or
- (b) the person has —
  - (i) given at least one month's written notice to the proposed defendant of the intention to bring the proceeding; and
  - (ii) registered the person's title or interest before bringing the proceeding.

(2) A person may bring an infringement proceeding in court, despite not having registered the person's title or interest, if—

- (a) the person would be entitled to do so under section 133(1) if the title or interest was registered;
- (b) the person has given at least one month's written notice to the proposed defendant of the intention to bring the proceeding and provided an address for service in Fiji; and
- (c) within that notice period, the proposed defendant has not required the proposed plaintiff to register that title or interest.

(3) The court may, on application to it, authorise a person to bring an infringement proceeding in court without complying with subsection (1) or (2)(b).

*Proceeding brought by exclusive licensee*

**136.**—(1) If an exclusive licensee brings an infringement proceeding, the patentee must be joined as a defendant (unless joined as a plaintiff).

(2) A patentee joined as a defendant is not liable for costs unless the patentee actually defends the proceeding.

*Types of relief available for infringement*

**137.** The relief that the court may grant for an infringement of a patent includes—

- (a) an injunction; and
- (b) at the option of the plaintiff, damages or an account of profits.

*Court must not award damages or account of profits if innocent infringement*

**138.**—(1) The court must not award damages or an account of profits for infringement of a patent if the defendant proves that at the date of the infringement the defendant did not know, and ought not reasonably to have known, that the patent existed or, in the case of a proceeding under section 66, that the complete specification had become open to public inspection.

(2) It is presumed that a person ought reasonably to have known that a patent existed if—

- (a) a product is marked so as to indicate it is patented in Fiji and with the Fiji patent number; and
- (b) the person knew, or ought reasonably to have known, of the product,

but there is no presumption if the product is marked merely so as to indicate it is patented.

*Court must refuse damages or account of profits for infringement before amendment to accepted specification*

**139.**—(1) If an amendment has been made to an accepted complete specification under this Act, the court must not award damages or an account of profits for an infringement that occurs before the date of the decision to allow the amendment.

(2) Subsection (1) does not apply if—

- (a) the court is satisfied that the specification, as accepted, was framed in good faith and with reasonable skill and knowledge; or
- (b) it is only an amendment to correct an obvious mistake.

*Court may refuse damages or account of profits if renewal fees not paid*

**140.** The court may refuse to award damages or an account of profits for an infringement that occurs after a failure to pay any renewal fee for the patent within the prescribed period and before any extension of that period.

*Limits on damages and accounts of profits do not affect power to grant injunction*

**141.** Nothing in sections 138 to 140 affects the court’s power to grant an injunction in an infringement proceeding.

*Court may grant relief for partially valid patent*

**142.**—(1) If it is found in an infringement proceeding that a patent is only partially valid, the court may grant relief for that part of the patent that is valid and infringed.

(2) The court may grant damages, an account of profits, or costs for that part of the patent only if the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge.

(3) It is at the court’s discretion whether or not to grant costs and as to the date from which damages or the account of profits should be counted.

(4) The court may, as a condition of the relief, direct that the specification be amended by an application under section 74, and the application may be made even if the other issues in the infringement proceeding have not yet been determined.

*Court may grant costs for subsequent proceeding if validity of specifications contested*

**143.**—(1) If the validity of a claim of a specification is contested in a proceeding and the court finds the claim to be valid, the court may certify that the claim’s validity was contested in that proceeding.

(2) A party who is relying on the validity of that claim in any subsequent infringement or revocation proceeding is then entitled to reasonable legal practitioner-client costs for the certified claim if a final order or judgment is made or given in favour of that party.

(3) This section does not apply to the costs of any appeal in the subsequent proceeding.

*Division 2—Declarations of non-infringement*

*Application for declaration of non-infringement*

**144.**—(1) A person who wishes to exploit an invention may apply to a court for a declaration that the exploitation of the invention would not infringe a claim of a complete specification.

(2) An application may be made—

- (a) at any time after the complete specification has become open to public inspection; and
- (b) whether or not the patentee or nominated person has made any assertion to the effect that the exploitation of the invention would infringe the claim.

(3) The patentee or nominated person must be joined as a respondent in the proceeding.

*Proceeding for declaration of non-infringement*

**145.**—(1) The court must not make a declaration of non-infringement unless a patent has been granted in respect of the relevant invention and—

- (a) the applicant for the declaration—
  - (i) has requested the nominated person or patentee in writing for a written admission that the proposed exploitation would not infringe a claim of the complete specification;
  - (ii) has given the nominated person or patentee full written particulars of the proposed exploitation; and
  - (iii) has undertaken to pay a reasonable sum for the nominated person’s or patentee’s expenses in obtaining advice about whether the proposed exploitation would infringe the claim;
- (b) the nominated person or patentee has refused or failed to make the admission; and
- (c) the court is satisfied that the proposed exploitation would not infringe a claim of the complete specification.

(2) Nothing in this section limits the court’s jurisdiction to grant a declaration apart from this section.

*Costs in declaration of non-infringement*

**146.** The costs of the parties in a proceeding for a declaration of non-infringement are at the discretion of the court.

*Validity of patent not at issue in proceeding for, and not affected by, declaration of non-infringement*

**147.—**(1) The validity of a claim of the specification of a patent must not be questioned in a proceeding for a declaration of non-infringement.

(2) The validity of the patent is not affected whether or not a declaration is made.

*Division 3—Patent dealings, patent licences, and transmission of interests in patents*

*Application for registration of assignments, licences, and other interests in patents*

**148.—**(1) A person who acquires a patent or share in a patent or an interest in a patent (**A**) must apply to the Commissioner for registration of A's title or interest in the prescribed manner.

(2) A person who disposes of the patent or share in a patent or who confers the interest may instead apply to register A's title or interest (and in this case subsection (1) does not apply) in the prescribed manner.

(3) This section applies to acquisitions and disposals by assignment, transmission, operation of law, mortgage, licence, or by any other means (other than a compulsory licence granted under Division 4).

*Registration of assignments, licences, and other interests in patents*

**149.** If an application is made under section 148, the Commissioner, on proof satisfactory to the Commissioner of the acquisition by the person (**A**) of a patent or share or interest in a patent—

- (a) must register A's title or interest;
- (b) may issue a replacement patent in the name of the new patentee; and
- (c) must retain any documents provided with the application under section 148 or a copy of those documents.

*Commissioner may vest patent or patent application without probate or letters of administration*

**150.—**(1) If a patentee, applicant for a patent, or nominated person (**A**) dies, the Commissioner may (without requiring probate or letters of administration) register or substitute a person (**B**) as the patentee, applicant, or nominated person in place of A if—

- (a) B proves, to the Commissioner's satisfaction, that—
  - (i) B is entitled to obtain probate of A's will or letters of administration of A's estate, or is A's personal representative, in the place where A was living at the time of his or her death;
  - (ii) probate or letters of administration have not been made or resealed in Fiji; and
  - (iii) the interests of A's creditors, and of all persons beneficially interested under A's will or on A's intestacy, will be adequately safeguarded if this action is taken; and

(b) B applies in the prescribed manner.

(2) If B becomes the patentee, applicant, or nominated person under this section, B holds the patent subject to all existing interests and equities affecting it.

(3) This section applies even if A died before the commencement of this section.

(4) Nothing in section 45 of the Succession, Probation and Administration Act 1970 restricts the operation of this section.

*Termination of sales, leases, and licences of patented products and processes if patent no longer in force*

**151.**—(1) This section applies to the following contracts—

- (a) a contract for the sale or lease of a patented product;
- (b) a licence to exploit a patented product or process.

(2) A contract that this section applies to may be terminated by either party, on giving 3 months' written notice to the other party, at any time after the patent, or all the patents, by which the product or process was protected at the time the contract was made, has or have ceased to be in force.

(3) Subsection (2)—

- (a) applies whether the contract was made before or after the commencement of this section;
- (b) applies notwithstanding anything to the contrary in the contract or in any other contract; and
- (c) does not limit any right to terminate a contract exercisable apart from this section.

#### *Division 4—Compulsory licences*

*Application for compulsory licence where market is not being supplied, or is not being supplied on reasonable terms, in Fiji*

**152.** Any person may apply to the court for the grant of a licence under a patent on the grounds that a market for the patented invention is not being supplied in Fiji or is not being supplied on reasonable terms in Fiji, at any time after the later of—

- (a) the expiry of 3 years from the date that the patent is granted; or
- (b) the expiry of 4 years from the patent date.

*Court may order grant of licence*

**153.**—(1) The court may make an order for the grant of a licence in accordance with an application under section 152 on any terms that the court thinks fit if the court is satisfied that either of the grounds referred to in section 152 is established.

(2) A licence must not be granted under this section for a patent relating to an integrated circuit.

(3) An order must not be made under subsection (1) that would be contrary to any treaty, convention, arrangement, or engagement applying to Fiji and any convention country.

(4) A licence granted under this section—

- (a) is not exclusive;
- (b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used;
- (c) is limited to the supply of the patented invention predominantly in Fiji; and
- (d) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under subsection (1).

(5) Any licence granted under this section may, on the application of an interested person, be terminated by the court if the court is satisfied that the grounds on which the licence was granted have ceased to exist.

*Court may order grant of licence for export of pharmaceutical products to certain countries*

**154.**—(1) The court may, on an application made by any person, make an order for the grant of a licence under a patent if the court is satisfied that—

- (a) the patented invention is—
  - (i) a pharmaceutical product; or
  - (ii) a process for making a pharmaceutical product;
- (b) the pharmaceutical product is needed to address a serious public health problem in one or more overseas countries specified in the application;
- (c) each of those overseas countries is either—
  - (i) an eligible importing Member that has made a notification in respect of the product under either paragraph 2(a) of the relevant decision or paragraph 2(a) of the Annex to the TRIPS agreement; or
  - (ii) a country that is currently specified in respect of the product in a notice under section 155; and
- (d) all of the pharmaceutical products made under the licence will be exported to those overseas countries.

(2) A licence granted under this section—

- (a) is not exclusive;
- (b) must not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and
- (c) must be recorded in the patents register by the Commissioner as soon as is reasonably practicable after the Commissioner receives a copy of the order made under subsection (1).

(3) Any licence granted under this section may, on the application of an interested person, be terminated by the court if the court is satisfied that the grounds on which the licence was granted have ceased to exist.

(4) For the purposes of this section and sections 155 to 157—

“eligible importing Member” means—

- (a) if the amendment to the TRIPS agreement to insert Article 31bis has not yet taken effect, an eligible importing Member within the meaning of paragraph 1 of the relevant decision;
- (b) if the amendment to the TRIPS agreement to insert Article 31bis has taken effect, an eligible importing Member within the meaning of that Article;

“pharmaceutical product” includes a medicine or vaccine, an active ingredient of a medicine or vaccine that is necessary for its manufacture, or a diagnostic kit needed for the use of a medicine or vaccine; and

“relevant decision” means the decision of the General Council of the World Trade Organization of 30 August 2003 relating to the implementation of paragraph 6 of the Doha Declaration on the TRIPS agreement and public health.

*Permanent Secretary responsible for foreign affairs may publish notices that specify eligible countries*

**155.**—(1) This section applies if—

- (a) the government of a country that is not a member of the World Trade Organization has sent to the Government a request for the country to be specified under this section for the purposes of section 154(1)(c)(ii) in respect of a particular pharmaceutical product; and
- (b) the request sets out information relating to why the government of that country considers that either—
  - (i) the country has no manufacturing capacity in its pharmaceutical sector for the pharmaceutical product; or
  - (ii) the country’s manufacturing capacity in its pharmaceutical sector for the pharmaceutical product (excluding any capacity owned or controlled by the patentee) is currently insufficient for the purposes of meeting its need for the product; and
- (c) the request specifies the expected quantity of the pharmaceutical product that is needed by the country.

(2) The Permanent Secretary responsible for foreign affairs may, after a request from a country has been received under subsection (1), by notice in the *Gazette*, specify the country for the purposes of section 154(1)(c)(ii) in respect of the relevant pharmaceutical product if he or she is satisfied that either—

- (a) the country has no manufacturing capacity in its pharmaceutical sector for the product; or



- (b) the country's manufacturing capacity in its pharmaceutical sector for the product (excluding any capacity owned or controlled by the patentee) is currently insufficient for the purposes of meeting its need for the product.
- (3) The notice under subsection (2) must—
- (a) specify the country and pharmaceutical product;
  - (b) specify the expected quantity of the pharmaceutical product that is needed by the country (as notified to the Government under subsection (1)); and
  - (c) state that the Permanent Secretary responsible for foreign affairs is satisfied of the matters specified in subsection (2) and his or her reasons for being so satisfied.
- (4) The Permanent Secretary responsible for foreign affairs may, by notice in the *Gazette*—
- (a) amend or revoke a notice under subsection (2);
  - (b) revoke a notice under subsection (2) and replace it with another.
- (5) The Permanent Secretary responsible for foreign affairs must publish a copy of a notice under subsection (2) on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs.

*Terms of licence*

- 156.**—(1) An order under section 154 must specify terms of the licence relating to the following matters—
- (a) the name and address of the licensee;
  - (b) the name of the patented invention for which the licence has been granted;
  - (c) the name of the country or countries to which the pharmaceutical products made under the licence must be exported;
  - (d) the maximum quantity of pharmaceutical products that may be exported to each of those countries (which must be no more than the court considers is necessary to meet the needs of the country);
  - (e) the duration of the licence;
  - (f) the address of the licensee's Internet site for the purposes of subsection (2) (e).
- (2) A licence granted under section 154 is subject to the following terms—
- (a) all pharmaceutical products made under the licence must be clearly identified, through specific labelling or marking, as having been made under a compulsory licensing scheme for the export of the product;
  - (b) all pharmaceutical products made under the licence must have particular distinguishing features if including those features is feasible and does not have a significant impact on price;

- (c) all pharmaceutical products made under the licence must be exported to the country or countries specified under subsection (1)(c);
- (d) the licensee must, before exporting the pharmaceutical products to a country specified under subsection (1)(c), supply to the Council for Trade-Related Aspects of Intellectual Property Rights of the World Trade Organization a statement containing the following information for the purpose of the information being published on the WTO Internet site—
  - (i) the quantities of the pharmaceutical product to be exported to the country;
  - (ii) the specific labelling or marking referred to in paragraph (a) and any distinguishing features of the pharmaceutical products referred to in paragraph (b);
- (e) the licensee must, before exporting the pharmaceutical products to a country specified under subsection (1)(c), publish the information specified in paragraph (d) on the licensee’s Internet site.

(3) A licence granted under section 154 may be subject to any other terms that the court thinks fit.

(4) For the purposes of this section—

“licensee’s Internet site” means an Internet site maintained by, or on behalf of, the licensee; and

“WTO Internet site” means an Internet site maintained by, or on behalf of, the World Trade Organization.

*Copy of order must be sent to Commissioner and Permanent Secretary responsible for foreign affairs*

**157.**—(1) The Registrar of the court must, as soon as is reasonably practicable after an order is made under section 154, send a copy of the order to the Commissioner and the Permanent Secretary responsible for foreign affairs.

(2) The Secretary must, as soon as is reasonably practicable after receiving a copy of the order, publish a copy of the order on an Internet site maintained by, or on behalf of, the Ministry of Foreign Affairs.

*Remuneration payable to patentee*

**158.** If a licence is granted under this Division to a person, that person must pay to the patentee the remuneration that is —

- (a) agreed between that person and the patentee;
- (b) determined by a method agreed between that person and the patentee; or
- (c) determined by the court on the application of that person or the patentee in default of agreement.

*Person applying for licence must have made efforts to obtain licence from patentee on reasonable commercial terms and conditions*

**159.** A licence must not be granted under this Division unless the person applying for the licence, having made efforts to obtain a licence from the patentee on reasonable commercial terms and conditions, has been unable to obtain a licence, or to obtain a licence on reasonable commercial terms and conditions, from the patentee within a reasonable period of time.

*Exercise of powers on applications under section 152, 154 or 158*

**160.—**(1) The powers of the court on an application under section 152, 154 or 158 must be exercised with a view to ensuring that the inventor or other person beneficially entitled to a patent receives adequate remuneration having regard to the nature of the invention.

(2) For the purposes of subsection (1), the court must, in the case of a licence under section 154, have regard to the economic value of the products made under the licence to the country to which the products will be exported under the licence.

*Order for grant of licence has effect as deed*

**161.—**(1) Any order under this Division for the grant of a licence has effect as if it were a deed, executed by the patentee and all other necessary parties, granting a licence in accordance with the order.

(2) Subsection (1) does not limit any other method of enforcement.

#### *Division 5—State use of inventions*

*State use of inventions*

**162.—**(1) Any Government department, and any person authorised in writing by a Government department, may exploit any invention for the services of the State at any time after the complete specification relating to an application for a patent for the invention has become open to public inspection.

(2) The exploitation of an invention under subsection (1) is not an infringement if—

(a) the application for a patent is pending, of the nominated person's rights in the invention; or

(b) a patent has been granted for the invention, of the patent.

(3) Subsection (1)—

(a) is subject to sections 169 to 171; but

(b) applies despite any other provision of this Act.

(4) For the purposes of this Division—

(a) any use of an invention for the supply to the government of any country outside Fiji of products required for the defence of that country must be treated as exploitation of the invention for the services of the State if that supply is made in accordance with any agreement or arrangement between the Government and the government of that country;

- (b) the power of a Government department or a person authorised by a Government department under this section to exploit an invention includes the power to sell to any person any products made in the exercise of the powers conferred by this section that are no longer required for the purpose for which they were made;
- (c) the power of a Government department or a person authorised by a Government department under this section to sell an invention does not, in the case of an application for a patent or a patent relating to an integrated circuit, extend to the sale of the invention to the public.

*Order may declare use to be State use*

**163.** Any use of an invention must, for the purposes of this Division, be treated as a use for the services of the State if the Minister, by order, declares that the use of the invention by a person, or by any class of persons, engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in Fiji of any enterprise or undertaking in which the State or any Government department has a complete or an almost complete monopoly.

*Protection of buyers*

**164.** The buyer of any products sold in the exercise of powers conferred by section 162, and any person claiming through the buyer, has the power to deal with them in the same manner as if the patent were held on behalf of the State.

*Rights of third parties in respect of State use*

**165.—**(1) This section applies in relation to any use of a patented invention, or of an invention for which a patent application is pending, made for the services of the State by—

- (a) a Government department or a person authorised by a Government department under section 162; or
- (b) the patentee, nominated person, or applicant for the patent to the order of a Government department.

(2) The provisions of any licence, assignment, or agreement made between the patentee, nominated person, or applicant for the patent, or any person who derives title from that person or from whom that person derives title, and any person other than a Government department is of no effect to the extent that those provisions—

- (a) restrict or regulate the use of the invention referred to in subsection (1);
- (b) restrict or regulate the use of any model, document, or information relating to the invention in relation to the use of the invention referred to in subsection (1); or
- (c) provide for the making of payments for any of those uses or calculated by reference to any of those uses.

(3) The reproduction or publication of any model or document in connection with a use referred to in subsection (1) is not an infringement of any copyright subsisting in the model or document.

(4) Subsection (2)—

- (a) applies whether the licence, assignment, or agreement is made before or after the commencement of this section; and
- (b) is subject to sections 169 and 171.

*Referral of disputes concerning State use*

**166.**—(1) The following disputes may be referred to the court by either party to the dispute in the manner that is prescribed by rules of the court—

- (a) any dispute concerning the exercise by a Government department or a person authorised by a Government department of the powers conferred by section 162;
- (b) any dispute concerning the terms for the use of an invention for the services of the State under that section.

(2) In any proceeding under this section, the Government department may—

- (a) if the patentee is a party to the proceeding, apply for the revocation of the patent on any ground on which a patent may be revoked under Division 11 of Part 3; and
- (b) in any case, put in issue the validity of the patent without applying for its revocation.

(3) In determining any dispute referred to the court under this section, the court must have regard to—

- (a) any benefit or compensation that the nominated person or patentee may have received, or may be entitled to receive, directly or indirectly from any Government department or person authorised by a Government department in respect of the invention; and
- (b) the need to ensure that the nominated person or patentee receives adequate remuneration having regard to the nature of the invention.

*Court may refer matter to special or official referee or arbitrator*

**167.**—(1) In any proceeding under section 166, the court may order the whole proceeding or any question or issue of fact arising in the proceeding to be referred to a special or official referee or an arbitrator on any terms that the court thinks fit.

(2) References to the court in section 166 must be construed as including a reference to the special or official referee or arbitrator.

*Special provisions as to State use during emergency*

**168.**—(1) The powers exercisable in relation to an invention by a Government department or a person authorised by a Government department under section 162 include the power to exploit the invention for any purpose that appears to the Government department necessary or desirable to avoid prejudice to the security or defence of Fiji.

(2) This section is subject to sections 169 to 171.

*Nature and scope of rights under section 162*

**169.**—(1) The right to use an invention under section 162—

- (a) is not exclusive;
- (b) must not be assigned otherwise than in connection with the goodwill of the business in which the invention is used; and
- (c) is, notwithstanding section 162(4)(a), limited to the supply of the invention predominantly in Fiji by a Government department or a person authorised by a Government department under that section.

(2) The right to use an invention under section 162 may, on the application of any interested person, be terminated by the court if the court is satisfied that the circumstances that gave rise to the right to use the invention have ceased to exist and are unlikely to recur.

(3) The right to use an invention under section 162 is, except in a case to which section 168 applies, subject to the Government department or person authorised by a Government department under section 162 having first made efforts to obtain the consent of the patentee or nominated person for the use of the invention on reasonable commercial terms and conditions, and having failed to obtain that consent, or to obtain that consent on reasonable commercial terms and conditions, within a reasonable period of time.

*Duty to inform nominated person or patentee*

**170.**—(1) If any use of an invention is made by or with the authority of a Government department under section 162, the Government department must, as soon as practicable after the use of the invention has begun, notify and provide the nominated person or patentee with any information concerning the extent of the use as the nominated person or patentee may from time to time require.

(2) Subsection (1) does not require the Government department to notify or disclose information to the nominated person or patentee if to do so would, or might reasonably be expected to, prejudice the security or defence of Fiji.

*Nominated person or patentee entitled to remuneration*

**171.** The State must, if an act is done under section 162, pay to the nominated person or patentee the remuneration that is—

- (a) agreed between the nominated person or patentee and the State;
- (b) determined by a method agreed between the nominated person or patentee and the State; or
- (c) determined by the court under section 166 in default of agreement.

*Division 6—Mention of inventor in patent, specification, and patents register**Mention of inventor in patent, specification, and patents register*

**172.**—(1) This section applies if the Commissioner is satisfied, on a request or claim made under section 173—

- (a) that the person in respect of whom, or by whom, the request or claim is made is the inventor of—

- (i) an invention for which a patent application has been made; or
  - (ii) a substantial part of an invention for which a patent application has been made; and
- (b) that the patent application is a direct result of that person being the inventor.
- (2) The Commissioner must cause the person to be mentioned as inventor in—
- (a) any patent granted in relation to the patent application;
  - (b) the complete specification; and
  - (c) the patents register.
- (3) The mention of a person as inventor under this section does not confer or derogate from any rights under the patent.

*Request or claim to be mentioned as inventor*

**173.**—(1) A request or claim made for the purposes of section 172 must be made in the prescribed manner (if any).

- (2) A request or claim under this section must be made—
- (a) before the date that is 2 months after the complete specification becomes open to public inspection; or
  - (b) within a further period (not exceeding one month) that the Commissioner may allow.

(3) The Commissioner may only extend the period under subsection (2)(b) on a request to that effect made to the Commissioner before the expiry of the 2-month period referred to in subsection (2)(a).

*Request or claim may not be considered in certain circumstances*

**174.** No request or claim under section 173 may be considered by the Commissioner if the Commissioner considers that the request or claim is based on facts that, if proved in the case of an opposition under section 77(1)(b) by the person in respect of or by whom the request or claim is made, would have entitled the person to relief under Division 9 of Part 3.

*Commissioner must give notice of claim and opportunity to be heard*

**175.**—(1) If a claim is made under section 173, the Commissioner must give notice of the claim to every applicant for the patent (not being the claimant) and to any other person that the Commissioner considers is interested.

- (2) The Commissioner must, before deciding on any request or claim made under section 173, give a reasonable opportunity to be heard to any of the following persons—
- (a) the person in respect of whom, or by whom, the request or claim is made;
  - (b) any person to whom notice of the claim has been given under this section.

*Certificate concerning mention of inventor*

**176.**—(1) A person who alleges that another person should not have been mentioned as inventor under sections 172 to 175 may, in the prescribed manner (if any), apply to the Commissioner for a certificate to that effect.

(2) The Commissioner may issue a certificate that specifies that a person should not have been mentioned as inventor under those sections.

(3) If the Commissioner issues a certificate, the Commissioner must rectify the specification and the patents register accordingly.

(4) The Commissioner must, before deciding to issue a certificate, give a reasonable opportunity to be heard to any person that the Commissioner considers is interested.

## PART 5—ADMINISTRATIVE AND MISCELLANEOUS PROVISIONS

*Division 1—Patent register and other information on patents and patent applications**Patents register*

**177.**—(1) The Commissioner must keep a register of patents in Fiji in accordance with this Act and the regulations.

(2) Sections 187 and 188 provide for evidence relating to the patents register.

*Purpose of patents register*

**178.** The purpose of the patents register is to—

- (a) enable members of the public to—
  - (i) know what patents are in force and the key dates for those patents;
  - (ii) know who is the patentee and who has other interests in a patent and the addresses for service of those persons;
  - (iii) find out about the scope of a claim; and
  - (iv) find out other matters affecting the validity and ownership of the patent and of any licences of the patent; and
- (b) facilitate the functions of the Commissioner under this Act.

*Form of patents register*

**179.** The patents register may be—

- (a) an electronic register; or
- (b) kept in any other manner that the Commissioner thinks fit.

*Contents of patents register*

**180.**—(1) The patents register must contain the following information for patents in force in Fiji—

- (a) the names, addresses, nationality or principal place of business (as appropriate), and addresses for service of patentees;



- (b) the date of filing of the patent application, the patent date, the priority date or dates, the date of the publication of the accepted complete specification, the date the complete specification became open to public inspection, the date that the patent is granted, and the date the next renewal fee is due;
- (c) titles of the complete specifications;
- (d) details of assignments and transmissions;
- (e) the names, addresses, and addresses for service of licensees and other persons with interests in patents;
- (f) any other matters required by or under this Act to be entered in the patents register.

(2) The patents register may also contain any other information that the Commissioner considers necessary or desirable.

(3) No notice of any trust may be entered in the patents register, and the Commissioner is not affected by any notice of that kind.

*Search of patents register*

**181.** A person may search the patents register in accordance with this Act or the regulations.

*Requests for patent information and certified copies*

**182.** The Commissioner must, if a person requests it in the prescribed manner, give the person—

- (a) a copy of, or extract from, a patent or any registered document that is certified by the Commissioner as a true copy or extract of the original for the purposes of section 187;
- (b) a certificate as to any of the matters stated in section 188;
- (c) any prescribed information concerning a patent or patent application.

*Changes to patents register*

**183.** The Commissioner may make changes to the patents register in accordance with this Act or the regulations.

*Commissioner may correct own mistakes in patents register, etc.*

**184.—**(1) The Commissioner may correct an error or omission that the Commissioner is satisfied has been made by the Commissioner in—

- (a) the patents register;
- (b) any patent; or
- (c) any other document issued under this Act.

(2) The Commissioner must, before making the correction—

- (a) give notice that the Commissioner proposes to make the correction to persons that the Commissioner thinks have an interest in it; and

(b) give those persons a reasonable opportunity to be heard.

(3) The Commissioner may require production of the patent or other document to make the correction.

*Commissioner may correct other persons' mistakes in patents register, etc.*

**185.**—(1) The Commissioner may (on application by any person or on the Commissioner's own initiative) correct an error or omission that the Commissioner is satisfied has been made by any person in—

- (a) the patents register;
- (b) any patent;
- (c) any patent application; or
- (d) any documents filed in connection with a patent application or filed in proceedings before the Commissioner in connection with a patent or patent application.

(2) Any person (whether or not that person made the error or omission) may apply for a correction under this section in the prescribed manner.

(3) The Commissioner must, before making the correction, publish in the Gazette the nature of the proposed correction if the Commissioner thinks that—

- (a) the correction would materially alter the meaning or scope of the document to be corrected; and
- (b) it ought not be made without notice to persons who have an interest in it.

(4) If a person gives notice within the prescribed time to the Commissioner of opposition to the application for the proposed correction, the Commissioner must, before deciding the matter—

- (a) give notice of the opposition to the applicant (if any); and
- (b) give the applicant (if any) and opponent a reasonable opportunity to be heard.

(5) This section does not apply to an error or omission referred to in section 184(1) or to an error or omission in a complete specification.

*Court may rectify patents register*

**186.**—(1) The court may, on application of any person aggrieved, order the patents register to be rectified by making an entry, or varying or deleting an entry, in it.

(2) In a proceeding under this section, the court may determine any question that it is necessary or expedient to decide in connection with the rectification of the patents register.

(3) The applicant for rectification must give notice of the application in the prescribed manner to the Commissioner.

(4) The Commissioner is entitled to appear and be heard on the application, and must appear if so directed by the court.

(5) Any order by the court under this section must direct that notice of the order must be served on the Commissioner in the prescribed manner.

(6) The Commissioner must, on receipt of notice of an order, rectify the patents register accordingly.

*Evidence: patents register and patents*

**187.**—(1) The patents register is *prima facie* evidence of any matters required or authorised by or under this Act to be entered in it.

(2) A copy of, or extract from, a patent or registered document that purports to be certified as a true copy or extract by the Commissioner is admissible in evidence in legal proceedings as if it were the original.

*Evidence: anything done by Commissioner*

**188.**—(1) A certificate purporting to be signed by the Commissioner in relation to the matters referred to in subsection (2) is for all purposes *prima facie* evidence of those matters specified in the certificate.

(2) The matters are—

- (a) that anything that he or she is authorised to do by or under this Act, or any other enactment in relation to patents or patent applications (including entries in the patents register) has or has not been done;
- (b) that anything that he or she is authorised or required to do by or under this Act, or any other enactment in relation to patents or patent applications, has been lawfully done; or
- (c) that any entry in the patents register is as stated in the certificate.

*Commissioner must publish in Gazette*

**189.** The Commissioner must periodically publish in the Gazette the following—

- (a) prescribed details concerning patents and patent applications;
- (b) any other matter required by this Act, the regulations, or any other law to be published in it; and
- (c) other information concerning patents or patent applications that the Commissioner thinks is useful or desirable for patentees, patent applicants, licensees, or the public to know.

*Commissioner may keep or publish indexes, etc.*

**190.**—(1) The Commissioner may publish indexes, specifications, abridgments of specifications, catalogues, and other works relating to inventions, patents and patent applications that he or she thinks fit.

(2) The Commissioner may keep a classification by subject matter of—

- (a) specifications filed in Fiji and open to public inspection; and

(b) printed publications relating to patents published in Fiji that are necessary or useful for the purpose of determining with readiness and accuracy the patentability of inventions.

(3) The indexes and other documents may be published or kept electronically or in any other manner that the Commissioner thinks fit.

*Division 2—General provisions on proceedings of Commissioner*

*Hearing before exercise of Commissioner's discretion*

**191.**—(1) The Commissioner must not exercise any of the Commissioner's discretionary powers under this Act or any regulations adversely to any applicant or other party to a proceeding before the Commissioner without giving the person a reasonable opportunity of being heard in the prescribed manner.

(2) Subsection (1) does not apply to—

- (a) the Commissioner's power to direct an applicant to request an examination under section 50;
- (b) a person to whom section 85 applies.

*How to give evidence to Commissioner in proceedings*

**192.**—(1) Evidence must be given by affidavit or statutory declaration (unless the Commissioner directs otherwise under subsection (2)) in proceedings before the Commissioner under this Act.

(2) The Commissioner may—

- (a) take oral evidence instead of, or as well as, the affidavit or declaration; and
- (b) allow a witness to be cross-examined on the witness's affidavit, declaration, or oral evidence.

(3) The statutory declaration may be used before a court in any appeal instead of evidence by affidavit and, if used in this way, has all the same incidents and consequences as evidence by affidavit.

*Commissioner may receive evidence on oath*

**193.** The Commissioner may also administer oaths to any witness in proceedings before him or her.

*Issuing of summons by Commissioner*

**194.**—(1) The Commissioner may issue a summons to a person requiring that person to attend a hearing before the Commissioner and to do all or any of the following matters—

- (a) give evidence;
- (b) give evidence under oath;
- (c) produce documents, things, or information, or any specified documents, things, or information, in the possession or control of that person that are relevant to the hearing.

(2) The Commissioner may require that any documents, things, or information produced under this section be verified by oath, statutory declaration, or otherwise.

*Commissioner may award costs*

**195.**—(1) The Commissioner may, in any proceedings before him or her under this Act—

- (a) by order, award to a party costs of an amount that the Commissioner thinks appropriate (which, without limitation, may be on an indemnity basis); and
- (b) direct how and by what parties they are to be paid.

(2) The order may be entered as a judgment of the court and may be enforced accordingly.

*Commissioner may require security for costs*

**196.**—(1) The Commissioner may require a party to proceedings to give security for the costs of the proceedings if the Commissioner is satisfied that—

- (a) the party does not reside, and does not carry on business, in Fiji; or
- (b) there is reason to believe that the party will be unable to pay the costs of the other party if unsuccessful in the proceedings.

(2) If the party does not give the security required, the Commissioner may treat the proceedings as abandoned by the party and determine the matter accordingly.

*Appeals against decisions of Commissioner*

**197.**—(1) A person who is aggrieved by a decision of the Commissioner under this Act may appeal to the court.

(2) An appeal must be brought—

- (a) in accordance with the rules of court; and
- (b) within—
  - (i) 20 working days after the date of the decision; or
  - (ii) any further time the court allows on application made before or after that period expires.

(3) This section does not allow an appeal to be made to the court from a decision of the Commissioner under section 26 or 27.

*Appeals against decisions of court on appeal*

**198.**—(1) A decision of the court on an appeal against a decision of the Commissioner may be appealed to the Court of Appeal if—

- (a) the decision was made under section 24;
- (b) the decision was made under section 84 or 97 and the effect of the decision is the revocation of a patent; or
- (c) the court or Court of Appeal gives leave.

(2) All other decisions of the court on an appeal against a decision of the Commissioner are final.

*Costs of Commissioner in proceeding*

**199.** In any proceeding before a court under this Act, the costs of the Commissioner are at the discretion of the court.

*Division 3—Establishment and operation of administrative bodies*

*Commissioner of Patents*

**200.** The Solicitor-General is, for the purposes of this Act, to perform the functions and exercise the powers of the Commissioner of Patents.

*Functions of Commissioner*

**201.** The functions of the Commissioner are, in accordance with this Act and the regulations, to—

- (a) examine patent applications and specifications, grant patents, revoke patents, and accept surrenders of patents, and make other decisions relating to patent applications and patent grants;
- (b) maintain the patents register and carry out other functions relating to the patents register;
- (c) maintain and supply information on patents and patent applications, including by publishing a Gazette;
- (d) carry out other functions and powers conferred on him or her by this Act and the regulations.

*Commissioner may delegate*

**202.—**(1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner’s functions and powers (except this power of delegation).

(2) A delegation—

- (a) must be in writing;
- (b) may be made subject to any restrictions and conditions that the Commissioner thinks fit;
- (c) is revocable at any time, in writing; and
- (d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.

*Liability of Commissioner and others*

**203.** The Commissioner or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner’s functions or powers.

*Fiji Intellectual Property Office*

**204.—**(1) The Fiji Intellectual Property Office is the office situated for the purpose of communications to and from the public on matters arising under this Act and any other written law relating to intellectual property.

*Opening hours of Fiji Intellectual Property Office*

**205.**—(1) The Commissioner may—

- (a) fix the opening hours for FIPO; and
- (b) declare FIPO closed on any day.

(2) The Commissioner must publicly notify those opening hours and (before closing FIPO) must publicly notify any closure.

(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of FIPO, be done on the next opening day (and is then still in time).

*Closing of Fiji Intellectual Property Office at short notice*

**206.**—(1) The Commissioner may declare FIPO closed without giving publication of the closure under section 205 if—

- (a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and
- (b) it is not practicable to make that prior publication.

(2) The Commissioner must, as soon as practicable after closing FIPO, publicly notify the closure.

*Division 4—Other miscellaneous provisions*

*Commissioner may extend time limits for delays by Commissioner*

**207.**—(1) The Commissioner may extend the time within which anything must be done under this Act or the regulations if that thing is not or will not be done in time because of a delay by the Commissioner.

(2) The Commissioner may grant the extension even if the time has expired for doing the thing.

*Commissioner may extend time limits for certain filing requirements or for delivery failures*

**208.**—(1) The Commissioner may, on application by any person under section 210 or at the Commissioner’s own discretion, extend—

- (a) the time limit under section 35(2)(a) or (b) or section 40; or
- (b) the time within which anything must be done under this Act or the regulations if that thing is not or will not be done in time because of a failure or delay of the delivery method.

(2) The Commissioner may grant the extension even if the time has expired for doing the thing.

(3) The Commissioner must refuse to grant the extension if in his or her opinion—

- (a) the applicant or the applicant’s agent has not allowed a reasonable margin of time for the delivery of any documents or information relating to the matter for which the application for the extension is made;

- (b) the applicant or the applicant's agent has in any other way failed to act with due diligence and prudence on the matter; or
- (c) there has been undue delay in applying for the extension of time or in prosecuting the application.

(4) The Commissioner may grant the extension on any terms or conditions he or she thinks fit.

*Requirements for applying and granting extensions of time limits under section 208*

**209.**—(1) A person must apply for an extension of a time limit under section 208 in the prescribed manner.

(2) The Commissioner must publish every extension granted in the Gazette.

*Service of notices (other than those given to or by Commissioner)*

**210.**—(1) Any notice or any other document required to be served on, or given to, any person under this Act or the regulations is sufficiently served or given if the notice or document is—

- (a) delivered personally or posted to the person at the person's address for service or last known place of residence or business;
- (b) sent by fax or electronic communication to the person's last known fax number or electronic address; or
- (c) made available to the person in accordance with a prescribed electronic delivery method (if permitted under the regulations).

(2) A notice or document that is sent to a person at a fax number or an electronic address must be treated as received by that person on the second working day after the date on which it is sent.

(3) A notice or document that is posted to a person must be treated as received by that person not later than 7 days after the date on which it is posted.

(4) A notice or document must not be treated as received if the person to whom it is posted or sent proves that it was not received, otherwise than through fault on the person's part.

(5) A notice or document that is made available to a person using the prescribed electronic delivery method must be treated as received by that person when specified by the regulations.

(6) This section does not apply to—

- (a) any requirement to which section 207 applies;
- (b) notices or other documents served, given, or filed in any proceeding in a court or to the extent that a different or particular delivery method is specified by this Act or the regulations.



*Requirements for summons*

**211.**—(1) A summons issued by the Commissioner under section 194 must be in writing, be signed by the Commissioner, and state—

- (a) the date and time when, and the place where, the person must attend;
- (b) the documents, things, or information that the person is required to bring and produce to the Commissioner;
- (c) the entitlement to be paid or tendered a sum in respect of witnesses' fees, allowances, and expenses; and
- (d) the penalty for failing to attend.

(2) A summons may be served by—

- (a) delivering it personally to the person summoned;
- (b) posting it to the person summoned at that person's usual place of residence or address for service; or
- (c) sending it by electronic communication to the person's electronic address for service if the person has provided an electronic address for service.

(3) A summons must—

- (a) if it is to be served by personal delivery, be served at least 48 hours before the attendance of the witness is required;
- (b) if it is to be served by post, be served at least 10 days before the attendance of the witness is required;
- (c) if it is to be served by electronic communication, be served at least 48 hours before the attendance of the witness is required.

(4) A summons that is posted is treated as having been served when it would have been delivered in the ordinary course of post.

(5) A summons that is sent by electronic communication is treated as having been served not later than 2 days after the date on which it is sent.

*Witnesses' allowances and expenses*

**212.**—(1) A witness appearing before the Commissioner under a summons is entitled to be paid witnesses' allowances and expenses in accordance with the scales prescribed by regulations under the Criminal Procedure Act 2009.

(2) The person requiring attendance of the witness must pay or tender to the witness the allowances and expenses at the time the requirement to attend is served or at some other reasonable time before the hearing.

*Offence of failing to comply with summons*

**213.**—(1) A person summoned to attend before the Commissioner commits an offence if the person, without sufficient cause—

- (a) fails to attend in accordance with the summons;

- (b) does not give evidence when required to do so;
- (c) does not give evidence under oath when required to do so;
- (d) does not answer any question that is lawfully requested by the Commissioner; or
- (e) does not provide any documents, things, or information that the summons requires the person to provide.

(2) A person who commits an offence against this section is liable on conviction to a fine not exceeding \$2,000.

(3) A person must not be convicted of an offence against this section if witnesses' allowances and expenses to which the person is entitled under section 212 have not been paid or tendered to him or her.

*Fees and penalties payable under Act or regulations*

**214.**—(1) Fees and penalties must be paid for any matter arising under this Act if required by this Act or by the regulations.

(2) The Commissioner may (in addition to any other action permitted under this Act) decline to do any act, or to permit any act to be done, or to receive any document, for which a fee or penalty is payable until that fee or penalty is paid.

*Payment and application of fees and other money paid under this Act*

**215.**—(1) All fees and other money required to be paid by this Act or the regulations must be paid to the Commissioner (unless this Act or the regulations require otherwise).

(2) The Commissioner must pay all the fees or other money paid to him or her under this Act into the Consolidated Fund.

(3) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by the regulations, may be refunded by the Commissioner, and all money so refunded may be paid out of public money without further appropriation than this Act.

(4) Any amount of a fee or other money required to be paid by this Act or the regulations that is not paid is recoverable in a court of competent jurisdiction as a debt due to the State or, if the Act or regulations require it to be paid to a person other than the Commissioner, as a debt due to that person.

(5) This section applies to fines, disciplinary penalties and costs orders imposed under this Act other than fines for offences.

*Protection of Coat of Arms of Fiji*

**216.** The grant of a patent does not in itself authorise the patentee to use or place on a patented product the Coat of Arms of Fiji except in accordance with the Coat of Arms of Fiji (Restriction of Use) Act 1972.

*Application of Personal Property Securities Act 2017*

**217.** Nothing in sections 15(2), 21, 135, 148, 149, and 177 to 187 affects the operation of the Personal Property Securities Act 2017.

*Division 5—Regulations**Regulations*

**218.**—(1) The Minister may make regulations to prescribe matters that are required or permitted by this Act to be prescribed or are necessary or convenient to be prescribed for carrying out or giving effect to this Act and generally for achieving the purposes of this Act including—

- (a) prescribing procedures, requirements, and other matters, not inconsistent with this Act, in respect of patent applications and the granting of patents under this Act, including—
  - (i) requiring patent applications, specifications, and any other documents relating to patent applications or specifications to be filed, made, or otherwise provided to the Commissioner in a prescribed manner;
  - (ii) requiring those patent applications, specifications, and documents to be dealt or proceeded with in a prescribed manner;
  - (iii) providing for further information or documents to be filed or otherwise provided to the Commissioner in the prescribed manner, in relation to any of those patent applications, specifications, or documents;
  - (iv) providing for the procedure to be followed in connection with the division of a patent application, specification, or other document into 2 or more applications, specifications, or documents;
  - (v) providing for the procedure to be followed in connection with the merging of separate patent applications, specifications, or documents;
  - (vi) providing for the Commissioner to direct that patent applications, specifications, or documents filed under this Act be treated as having been filed on a different date from the date on which those patent applications, specifications, or other documents were actually filed;
- (b) requiring any applications, requests, or notices under this Act to be made or given in a prescribed manner;
- (c) providing for the procedure to be followed in connection with any application, request, or notice under this Act, or in connection with any opposition, re-examination, revocation, or other proceeding before the Commissioner, and for authorising the rectification of irregularities of procedure;
- (d) regulating the making of applications, requests, or notices under this Act by agents, and prescribing classes of persons whom the Commissioner may refuse to recognise as agents;
- (e) requiring a declaration concerning the inventor of an invention to be provided in prescribed cases with the complete specification or within the prescribed period after the filing of the complete specification;

- (f) providing for all matters placed under the direction or control of the Commissioner by this Act or the regulations, including—
  - (i) providing for the Commissioner to extend time limits under the regulations or waive requirements of the regulations;
  - (ii) regulating applications for, oppositions to, and the granting of extensions of time limits by the Commissioner under this Act, including providing for the protection of persons who have in good faith begun to exploit an invention for which an application for an extension is made;
  - (iii) providing for the manner in which a reasonable opportunity to be heard must be given to persons;
  - (iv) providing for how statutory declarations for proceedings before the Commissioner must be made and given;
  - (v) providing for the Commissioner to destroy documents and information provided to him or her in connection with any application, request, or notice that is abandoned, void, or otherwise inactive for the prescribed period;
- (g) prescribing procedures, requirements, and other matters, not inconsistent with this Act, for the patents register, including matters relating to—
  - (i) the operation of the register;
  - (ii) access to and search of the register;
  - (iii) the location of, and hours of access to, the register;
- (h) prescribing fees and penalties to be paid, or the means by which those fees and penalties may be calculated or ascertained, for any matter under this Act or the regulations;
- (i) prescribing the period for the payment of a renewal fee or maintenance fee;
- (j) exempting, or providing for the Commissioner to exempt from, waive, or refund, fees or penalties;
- (k) providing for the filing, serving, or giving of notices or other documents, or classes of notices or other documents, by an electronic method or any other method (including by making those notices or documents available to a person on an Internet site and for the person to be directly alerted to them by means of a notice to the person's last known electronic address or any other specified means), when notices or documents are treated as received under that method, and any other related matters.

(2) The power to make regulations under subsection (1) to prescribe the manner in which a thing is done includes the power to—

- (a) prescribe when, where, and how the thing must be done;
- (b) prescribe the form that must be used in connection with doing the thing;
- (c) prescribe what information must be provided or other evidence or documents must be provided in connection with the thing;
- (d) prescribe requirements with which information, evidence, or documents that are provided in connection with the thing must comply;
- (e) prescribe the electronic or other delivery method that must be used in connection with the thing;
- (f) provide for the Commissioner to determine any of the matters in paragraphs (a) to (e);
- (g) prescribe that fees must be paid in connection with doing the thing.

(2) Any regulations made may prescribe, or provide for the Commissioner to determine, different or additional procedures, requirements, or matters in relation to different classes of applications, requests, notices, or other matters.

(3) For the purpose of giving effect to any international agreement or arrangement to which Fiji is a party or that applies to Fiji, the Minister may, by regulations, declare that any entity specified in the order that is a party to the agreement or arrangement or to which the agreement or arrangement applies (whether a State, part of a State, a territory for whose international relations a State is responsible, a political union, an international organisation, or any other entity) is, for the purposes of all or any of the provisions of this Act, a convention country.

### *Division 6—Repeal and transitional*

#### *Repeal*

**219.** The Patents Act 1879 including its subsidiary legislation are repealed.

#### *Transitional*

**220.—**(1) Notwithstanding the repeal of the Patents Act 1879, the Patents Act 1879 continues in force and applies in respect of—

- (a) a petition for obtaining letters patent that was received by the office of the Solicitor-General before the commencement of this Act;
- (b) a declaration that was received by the office of the Solicitor-General before the commencement of this Act;
- (c) an application for the amendment of a specification that was received by the office of the Solicitor-General before the commencement of this Act;
- (d) an application for the entry on the register of an assignment, transmission or other operation of law of the privileges and rights conferred by a certificate of registration;

- (e) an application to have a patent granted in the United Kingdom registered in Fiji that was received by the office of the Solicitor-General before the commencement of this Act; and
- (f) any proceedings that commenced under the Patents Act 1879 before the commencement of this Act.

(2) Nothing in this Act invalidates the registration of letters patent and assignments of letters patent that, immediately before the commencement of this Act, was valid.

(3) The register of patents kept under the Patents Act 1879 continues to have effect as the patents register kept under section 177.

December 2020

**PATENTS BILL 2020**  
**EXPLANATORY NOTE**

*(This note is not part of the Bill and is intended only to indicate its general effect)*

**1.0 BACKGROUND**

- 1.1 At the moment, the Patents Act 1879 (**‘Act’**) (including its subsidiary legislation) provide for the issue of letters patent for inventions.
- 1.2 The Patents Bill 2020 (**‘Bill’**) seeks to repeal the Patents Act 1879 and the subsidiary legislation.
- 1.3 The objectives of the Bill are to—
- (i) provide an efficient and effective patent system that promotes innovation and economic growth while providing an appropriate balance between the interests of inventors and patent owners and the interests of society as a whole, and that complies with Fiji’s international obligations;
  - (ii) ensure that a patent is granted for an invention only in appropriate circumstances by establishing appropriate criteria for the granting of a patent and providing for procedures that allow the validity of a patent to be tested; and
  - (iii) provide greater certainty for patent owners and the users of patented inventions that patents will be valid after they are granted.

**2.0 CLAUSES**

- 2.1 Clause 1 of the Bill provides for the short title and commencement. If passed by Parliament, the new legislation will come into force on a date or dates appointed by the Minister by notice in the Gazette.
- 2.2 Clause 2 of the Bill provides for the definitions of the terms used throughout the Bill.
- 2.3 Clause 3 of the Bill provides the objectives of the Bill.

- 2.4 Clause 4 of the Bill defines the term ‘novel’. This is one of the key terms that determine whether an invention is patentable. An invention, so far as claimed in a claim, is novel, if it does not form part of the prior art base.
- 2.5 Clause 5 of the Bill defines the expression ‘inventive step’. This is another key term that determines whether an invention is patentable. An invention, so far as claimed in a claim, involves an inventive step if it is not obvious to a person skilled in the art having regard to any matter which forms part of the prior art base.
- 2.6 Clause 6 of the Bill defines the expression ‘prior art base’. Prior art base means all matter (whether a product, a process, information about a product or process, or anything else) that has at any time before the priority date of the claim been made available to the public (whether in Fiji or elsewhere) by written or oral description, by use, or in any other way. In deciding whether or not an invention is novel, prior art base also includes the information contained in a complete specification filed in respect of another patent application in certain circumstances.
- 2.7 Clause 7 of the Bill provides that a disclosure must be disregarded for the purposes of the definition of prior art base in certain circumstances.
- 2.8 Clause 8 of the Bill defines the term ‘useful’. This is the third key term that determines whether an invention is patentable. An invention, so far as claimed in a claim, is useful if it has a specific, credible and substantial utility.
- 2.9 Clause 9 of the Bill provides that a computer program is not an invention. A patent cannot be granted for anything that is not an invention.
- 2.10 Clause 10 of the Bill provides that the new legislation would bind the State.
- 2.11 Clause 11 of the Bill provides that a patent may be granted only if the invention is a patentable invention.
- 2.12 Clause 12 of the Bill sets out when an invention is a patentable invention. An invention is a patentable invention if the invention, so far as claimed in a claim:
- (i) when compared with the prior art base, is novel and involves an inventive step;
  - (ii) is useful; and
  - (iii) is not excluded from being a patentable invention.
- 2.13 Clauses 13 and 14 of the Bill contain exclusions from what is patentable. An invention is not a patentable invention if the commercial exploitation of the invention, so far as claimed in a claim, is contrary to public order or morality. Also, the following are not patentable inventions:
- (i) human beings, and biological processes for their generation;



- (ii) method of treatment of human beings by surgery or therapy;
  - (iii) method of diagnosis practised on human beings;
  - (iv) plant varieties.
- 2.14 Clause 15 of the Bill sets out the nature of a patent. A patent is personal property.
- 2.15 Clause 16 of the Bill sets out the exclusive rights given by a patent. A patent gives the patentee the exclusive rights, during the term of the patent, to exploit the invention and to authorise another person to exploit the invention.
- 2.16 Clause 17 of the Bill sets out the extent, effect and form of a patent. A patent has effect throughout the Republic of Fiji. A patent has the same effect against the State as it has against a subject. This, however, is subject to the other provisions of the Bill and section 4 of the State Proceedings Act 1951.
- 2.17 Clause 18 of the Bill provides for the term of a patent. The term of every patent is 20 years from the patent date (which is generally the filing date of the complete specification). A patent ceases to have effect on the expiry of the period prescribed for the payment of any renewal fee if that fee is not paid within that period or within any extended period.
- 2.18 Clause 19 of the Bill provides for the extension of the prescribed period for paying renewal fees provided that the extension is not more than 6 months after the expiry of the prescribed period.
- 2.19 Clause 20 of the Bill sets out who may be granted a patent. A patent for an invention may be granted to a person regardless of whether the person is a Fijian but it may only be granted to a person who:
- (i) is the inventor;
  - (ii) derives title to the invention from the inventor; or
  - (iii) is the personal representative of a deceased person in paragraph (i) or (ii).
- 2.20 Clause 21 of the Bill provides that a patentee may deal with the patent as the absolute owner of the patent and give good discharges for any consideration for the dealing. This is subject to any rights vested in other persons that are entered in the patents register, and protects those purchasers in good faith for value and without notice of any fraud on the part of the patentee.
- 2.21 Clause 22 of the Bill provides that if a patent is granted to 2 or more persons, each patentee is entitled to an equal undivided share in the patent and also to exercise the exclusive rights given by the patent for the person's own benefit without accounting to the others, subject to any agreement between the patentees.
- 2.22 Clause 23 of the Bill sets out the rights of buyers from co-owners of a patent.

2.23 Clause 24 of the Bill empowers the Commissioner to give directions to co-owners of a patent. The directions of the Commissioner must relate to:

- (i) the sale or lease of the patent or any interest in it;
- (ii) the grant of licences;
- (iii) the exercise of any right under clause 22 of the Bill in relation to the patent.

If a patentee fails to do anything required to carry out a direction within 14 days after another patentee requests so in writing, the Commissioner is empowered to direct any person (other than the defaulting patentee) to carry out the direction in the name of the defaulting patentee.

2.24 Clause 25 of the Bill sets out miscellaneous provisions concerning directions by the Commissioner under clause 24 of the Bill.

2.25 Clause 26 of the Bill empowers the Commissioner (or the Employment Relations Tribunal (**‘Tribunal’**) if the matter is referred to it by the Commissioner) to determine disputes between an employer and employee as to an inventions made by the employee.

2.26 Clause 27 of the Bill allows the Tribunal or the Commissioner to apportion the benefit of an invention made by the employee and of a patent relating to the invention.

2.27 Clause 28 of the Bill allows the Tribunal to review the decisions of the Commissioner under clauses 26 and 27. The Tribunal must not review any decision (or part of a decision) under clauses 26 and 27 of the Bill that is not part of an application made to the Tribunal.

2.28 Clause 29 of the Bill provides that any person may apply for a patent either alone or jointly with another person, but the patent may only be granted to those listed in clause 20 of the Bill.

2.29 Clause 30 of the Bill provides that every patent application must be made in accordance with the Act and regulations made under the Act.

2.30 Clause 31 of the Bill empowers the Commissioner to post-date patent applications but this power must not be exercised after the acceptance of the complete specification. A patent application must not be post-dated later than 6 months after the day the application was actually made or would be treated as having been made. A convention application must not be post-date to a date later than the last date that the application could have been made.

2.31 Clause 32 of the Bill provides that if a patent application has been made, the applicant may, before acceptance of the complete specification and in accordance

with prescribed requirements, make a fresh patent application for any part of the subject matter of the original application. The Commissioner may direct that the fresh patent application be given an earlier date that is not earlier than the filing date of the original patent application.

- 2.32 Clause 33 of the Bill requires an applicant to pay a prescribed maintenance fee. A patent application must be treated as abandoned if the prescribed maintenance fee has not been paid.
- 2.33 Clause 34 of the Bill requires every patent application to be accompanied by a:
- (i) complete specification or provisional specification (unless the patent application is a convention application); and
  - (ii) complete specification if the patent application is a convention application.
- 2.34 Clause 35 of the Bill provides that if a patent application is accompanied by a provisional specification, one or more complete specifications must be filed within the following allowable period or the patent application will be treated as having been abandoned:
- (i) within 12 months from the filing date of the patent application; or
  - (ii) within the extended period not exceeding the prescribed period.
- 2.35 Clause 36 of the Bill sets out the contents of a provisional specification. Every provisional specification must describe the invention and include any other prescribed information.
- 2.36 Clause 37 of the Bill sets out the contents of a complete specification. Every complete specification must:
- (i) disclose the invention in a manner that is clear enough and complete enough for the invention to be performed by a person skilled in the art;
  - (ii) disclose the best method of performing the invention that is known to the applicant and for which there is an entitlement to claim protection;
  - (iii) end with a claim or claims defining the scope of the invention claimed (which must relate to one invention only, be clear and concise and be supported by the matter disclosed in the complete specification); and
  - (iv) include any other prescribed information.
- 2.37 Clause 38 of the Bill allows an applicant to amend a complete specification before the acceptance of the complete specification.
- 2.38 Clause 39 of the Bill provides for the supply of drawings for the purposes of any specification.

- 2.39 Clause 40 of the Bill allows a convention applicant to make a convention application in relation to a basic application within 12 months of the day which the basic application is first made in a convention country. A basic application is an application for protection that is made in a convention country. A convention country is an entity declared by order to be a convention country. A convention applicant is a person who has made a basic application or is the assignee or personal representative of the person.
- 2.40 Clause 41 of the Bill sets out how a convention application is made and dealt with. A convention application must be made and dealt with in the same manner as any other patent application. A patent application that is a convention application must:
- (i) include the prescribed information relating to the relevant basic application;
  - (ii) be accompanied by a complete specification in accordance with clause 34(1); and
  - (iii) be made and dealt with in accordance with any other requirements prescribed for convention applications by this Act or regulations.
- 2.41 Clause 42 of the Bill provides that if more than one basic application has been made for an invention, a previously filed basic application must be disregarded and a subsequently filed basic application must be substituted for the previously filed basic application in certain circumstances.
- 2.42 Clause 43 of the Bill allows a single convention application to be made in certain circumstances where basic applications have been made in one or more convention countries for two or more cognate inventions. The requirements of clause 41(2)(a) will apply separately to the basic applications for each of the inventions.
- 2.43 Clause 44 of the Bill provides that every claim of a complete specification has effect from the date prescribed by the Division as the priority date of the claim. The priority date of the claim is important when considering the extent of the prior art base for the purposes of the novelty and inventive steps in clause 12 of the Bill.
- 2.44 Clause 45 of the Bill provides for the priority date of a claim if the complete specification is filed for a single application that was accompanied by a provisional specification. The priority date is the filing date of the patent application if the claim is supported by the matter disclosed in the provisional specification.
- 2.45 Clause 46 of the Bill provides for the priority date of a claim if the complete specification is filed for two or more applications that were accompanied by provisional specifications. The priority date is the filing date of the patent application that is accompanied by the specification that first disclosed the matter on which the claim is supported.

- 2.46 Clause 47 of the Bill provides for the priority date for convention applications if the claim is supported by the matter disclosed in an application for protection. The priority date is the date of the relevant application for protection.
- 2.47 Clause 48 of the Bill provides that if a claim would, but for this clause, have two or more priority dates, the priority date of the claim is the earlier or earliest of those dates.
- 2.48 Clause 49 of the Bill provides for the priority date in case of lack of entitlement in respect of another patent application.
- 2.49 Clause 50 of the Bill allows an applicant to request for an examination of the patent application and the complete specification relating to the application.
- 2.50 Clause 51 of the Bill provides that the Commissioner must examine a patent application and the complete specification relating to the application and report on—
- (i) whether the application and specification comply with the requirements in the Bill or of the regulations ;
  - (ii) whether the invention, so far as claimed, is a patentable invention under clause 12; and
  - (iii) any other prescribed matters.
- Examinations by the Commissioner must be carried out in the prescribed manner.
- 2.51 Clause 52 of the Bill allows the Commissioner to refuse to proceed with an application or require the application or specification to be amended if the Commissioner reports that—
- (i) the application or specification do not comply with the requirements of the Bill or of the regulations;
  - (ii) the invention is not a patentable invention; or
  - (iii) there is any other lawful ground of objection to the grant of a patent in respect of the application.
- 2.52 Clause 53 of the Bill requires an applicant, by the deadline set by the Commissioner, to provide a substantive response to the Commissioner's report. After each response, the Commissioner may issue a further report.
- 2.53 Clause 54 of the Bill provides that an application must be treated as having been abandoned if the applicant has failed to comply with clause 53.
- 2.54 Clause 55 of the Bill provides that the Commissioner must examine an amended complete specification in the same manner as the original specification if the specification is amended following the issue of a report.

- 2.55 Clause 56 of the Bill imposes a duty on applicants to inform the Commissioner of any documentary searches by, or on behalf of, a foreign patent office carried out for the purpose of assessing the patentability of an invention disclosed in the complete specification or a corresponding application filed outside Fiji. A foreign patent office is an office, organisation or other body that may grant protection in respect of an invention in a country outside Fiji.
- 2.56 Clause 57 of the Bill provides that a patent application is void unless, within the prescribed period, the applicant ensures that—
- (i) the application and the complete specification comply with the requirements of the Bill and of the regulations;
  - (ii) the invention is a patentable invention; and
  - (iii) there is no other lawful ground of objection to the grant of a patent.
- 2.57 Clause 58 of the Bill allows the High Court to extend the period allowed under clause 57 if an appeal to the court is pending or the time within which an appeal may be brought has not expired.
- 2.58 Clause 59 of the Bill requires applicants to file a notice stating the entitlement of the nominated person to the grant of the patent before the expiry of the period allowed under clause 57. A patent application is void if the applicant does not comply with this requirement. The nominated person is the person identified as the person to whom the patent is to be granted. The applicant may be taken to be the nominated person.
- 2.59 Clause 60 of the Bill provides that the Commissioner must accept the complete specification relating to a patent application if the Commissioner is satisfied, on the balance of probabilities, that—
- (i) the application and the complete specification comply with the requirements of the Bill and of the regulations;
  - (ii) the invention is a patentable invention; and
  - (iii) there is no other lawful ground of objection to the grant of a patent.
- The Commissioner must, after acceptance of a complete specification, give notice of the acceptance to the applicant and publish the acceptance in the Gazette.
- 2.60 Clause 61 of the Bill allows an applicant to request that the Commissioner postpone acceptance of the complete specification until a date that is specified in the notice given by the applicant to the Commissioner.
- 2.61 Clause 62 of the Bill requires the Commissioner to publish a notice in the journal stating that a complete specification is open to public inspection if—
- (i) the specification has been filed for a patent application other than a Treaty application; and

- (ii) a period of 18 months after the earliest priority date has ended; and
- (iii) the specification is not already open to public inspection.

The clause also provides for the Commissioner, if asked to do so by the applicant, to publish a notice in the journal stating that the complete specification is open to public inspection.

- 2.62 Clause 63 of the Bill provides publication requirements in the case of divisional applications under clause 32.
- 2.63 Clause 64 of the Bill provides that if a notice is published under clause 62 or 63, the specification concerned, and the other prescribed documents, are open to public inspection. If acceptance of a complete specification is published, certain documents (being documents that have not already become open to public inspection) become open to public inspection. A document must be taken to have been made available to the public on the day on which it becomes open to public inspection unless it has been made available otherwise before that day.
- 2.64 Clause 65 of the Bill provides that, except as provided by the Bill, documents of the kind mentioned in clause 64 must not be published by the Commissioner or be open to public inspection, and are generally not liable to be inspected or produced.
- 2.65 Clause 66 of the Bill provides that after a complete specification has become open to public inspection, the nominated person has the same privileges and rights as the nominated person would have had if a patent had been granted when the specification became open to public inspection. However, this does not give the nominated person the right to institute proceedings in respect of any act unless a patent has been granted.
- 2.66 Clause 67 of the Bill provides that the High Court must, in considering the amount of damages or an account of profits for an infringement, consider whether or not it would have been reasonable to expect, from a consideration of the complete specification that became open to public inspection, that a patent would be granted that would confer on the patentee protection from an act of the same description as that found to infringe the rights conferred.
- 2.67 Clause 68 of the Bill provides that after the acceptance of a complete specification, an amendment to that specification is not allowable, except for the purpose of correcting an obvious mistake, if the effect of the amendment is that—
  - (i) the specification as amended would claim or describe matter that was not in substance disclosed in the specification before the amendment; or
  - (ii) a claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

- 2.68 Clause 69 of the Bill provides for the publication of amendments in the Gazette.
- 2.69 Clause 70 of the Bill allows the Commissioner, on request, to allow the complete specification to be amended subject to any conditions that the Commissioner thinks fit.
- 2.70 Clause 71 of the Bill requires every request for leave to amend a specification under clause 70 of the Bill to be published in the Gazette.
- 2.71 Clause 72 of the Bill allows any person to oppose a proposed amendment.
- 2.72 Clause 73 of the Bill provides that the provisions concerning amendments with the leave of the Commissioner do not apply in certain circumstances.
- 2.73 Clause 74 of the Bill allows the court, in any relevant proceeding, to allow the patentee to amend the patentee's complete specification.
- 2.74 Clause 75 of the Bill allows any person to assert to the Commissioner that an invention is not novel or does not involve an inventive step. These assertions must be made within the prescribed period after a complete specification becomes open to public inspection.
- 2.75 Clause 76 of the Bill provides that the Commissioner must inform the applicant in writing of any matter of which the Commissioner is notified under clause 75 of the Bill, and send the applicant a copy of any document accompanying the notice.
- 2.76 Clause 77 of the Bill provides that a person may oppose the grant of a patent on certain grounds.
- 2.77 Clause 78 of the Bill provides for the hearing and decision by the Commissioner of an opposition to the grant of a patent under clause 76 of the Bill.
- 2.78 Clause 79 of the Bill requires the Commissioner, if requested, to re-examine a patent application and the complete specification relating to the application on or after the date of the publication of the accepted complete specification if the patent has not been granted.
- 2.79 Clause 80 of the Bill requires the Commissioner, if requested, to re-examine a patent application and the complete specification relating to the application if the patent has been granted.
- 2.80 Clause 81 of the Bill provides the relationship between re-examination and other proceedings.
- 2.81 Clause 82 of the Bill provides that the Commissioner must consider and report on whether the Commissioner is satisfied, on the balance of probabilities, that any of the relevant grounds, described in this clause, is established.



- 2.82 Clause 83 of the Bill provides that if the Commissioner reports on a re-examination under clause 79 of the Bill (before the patent is granted) and is satisfied that any of the relevant grounds is established, the Commissioner may refuse to grant the patent. However, the Commissioner must not refuse to grant the patent without having given the applicant an opportunity to amend the relevant specification to remove any lawful ground of objection.
- 2.83 Clause 84 of the Bill provides that if the Commissioner reports on a re-examination under clause 80 of the Bill (after the patent is granted) and is satisfied that any of the relevant grounds is established, the Commissioner may revoke the patent. However, the Commissioner must not revoke the patent without having given the patentee an opportunity to amend the relevant specification to remove any lawful ground of objection.
- 2.84 Clause 85 of the Bill provides that a person who has made a request under clause 79(1) or 80(1) of the Bill does not have:
- (i) the right to be heard in relation to the re-examination;
  - (ii) any other right to participate in the re-examination proceeding after the request is made; and
  - (iii) the right to appeal to the court against any decision of the Commissioner under any of sections 79 to 84.
- 2.85 Clause 86 of the Bill provides that the Commissioner must grant a patent to the nominated person or persons as soon as is reasonably practicable after the date that is 3 months after the date of the publication of the accepted complete specification if—
- (i) there is no opposition to the grant; or
  - (ii) there is opposition to the grant, the Commissioner’s decision, or the decision on appeal, is that a patent should be granted.
- 2.86 Clause 87 of the Bill provides that nothing done under the Bill guarantees the granting of a patent or that a patent is valid.
- 2.87 Clause 88 of the Bill provides that every patent must be given a patent date that is the filing date of the relevant complete specification or, if the regulations provide for the determination of a different date as the patent date, the date determined under the regulations. The patent date of every patent must be entered in the patents register.
- 2.88 Clause 89 of the Bill provides that a patent may be granted for one invention only.
- 2.89 Clause 90 of the Bill provides for the amendment of a patent that was granted to a deceased person or to a person that has been liquidated or wound up.

- 2.90 Clause 91 of the Bill applies if a patent application is made in respect of any improvement in, or modification of, an invention and the applicant also applies, or has applied, for a patent for that invention or is the patentee of that invention. The clause allows the Commissioner, on request, to grant the patent for the improvement or modification as a patent of addition.
- 2.91 Clause 92 of the Bill allows the Commissioner to revoke a patent for an improvement in, or modification of, an invention and to grant a patent of addition in substitution if it is the same patentee.
- 2.92 Clause 93 of the Bill contains certain restrictions on the granting of patents of addition.
- 2.93 Clause 94 of the Bill provides that a patent of addition must be granted for a term equal to that of the patent for the main invention, or as much of the term of the patent for the main invention that is unexpired. If the patent for the main invention is revoked, the court or the Commissioner may order that the patent of addition continue in force as an independent patent for the remainder of the term of the patent for the main invention.
- 2.94 Clause 95 of the Bill provides for renewal fees in relation to patents of addition.
- 2.95 Clause 96 of the Bill provides that the grant of a patent of addition must not be refused, and a patent of addition must not be revoked or invalidated, on the ground only that the invention does not involve an inventive step having regard to any publication or use of the main invention or any improvement in, or modification of, the main invention.
- 2.96 Clause 97 of the Bill allows the Commissioner or the court to revoke a patent on any of the grounds set out in clause 99 of the Bill.
- 2.97 Clause 98 of the Bill contains provisions concerning applications for revocation that are made to the Commissioner, including a provision that allows the Commissioner to refuse an application that is frivolous or vexatious.
- 2.98 Clause 99 of the Bill provides that a patent may be revoked on one or more of the following grounds:
- (i) that the invention is not a patentable invention;
  - (ii) that the patentee is not entitled to the patent;
  - (iii) that the complete specification does not comply with Division 2;
  - (iv) that the patent was obtained by fraud, false suggestion, or a misrepresentation;
  - (v) that the invention was secretly used in Fiji before the priority date;
  - (vi) that the patent has been granted contrary to law.

- 2.99 Clause 100 of the Bill allows the court to revoke a patent on the application of a Government department if the court is satisfied that the patentee has failed on reasonable terms to comply with a request of the Government department to exploit the invention for the services of the State on reasonable terms. This is also a defence in any proceeding for the infringement of the patent.
- 2.100 Clause 101 of the Bill provides for the surrender of a patent by the patentee.
- 2.101 Clause 102 of the Bill allows the Commissioner to restore a patent that has ceased to have effect by reason of a failure to pay a renewal fee if the Commissioner is satisfied that the failure to pay the renewal fee was unintentional.
- 2.102 Clause 103 of the Bill requires a request to restore a patent to describe the circumstances that led to the failure to pay the renewal fee.
- 2.103 Clause 104 of the Bill sets out who may make a request for the restoration of a patent.
- 2.104 Clause 105 of the Bill requires a request for the restoration of a patent to be made within the prescribed period. However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.
- 2.105 Clause 106 of the Bill requires the Commissioner to give the applicant a reasonable opportunity to be heard if the Commissioner is not satisfied that a *prima facie* case has been made out for an order under clause 102 of the Bill.
- 2.106 Clause 107 of the Bill requires the Commissioner to publish a request to restore a patent in the Gazette if the Commissioner is satisfied that a *prima facie* case has been made out for an order under clause 110.
- 2.107 Clause 108 of the Bill allows any person to give notice to the Commissioner of opposition to a restoration order.
- 2.108 Clause 109 of the Bill provides that a restoration order must be made if—
- (i) all unpaid renewal fees are paid;
  - (ii) all other prescribed additional penalties (if any) are paid; and
  - (iii) either no notice of opposition is given or the decision of the Commissioner is in favour of the applicant.
- 2.109 Clause 110 of the Bill allows an applicant to make a request to the Commissioner for an order to restore a void or an abandoned patent application and to extend the period for complying with the requirements imposed on the applicant by or under the Bill.

- 2.110 Clause 111 of the Bill provides that a request under clause 110 of the Bill must be made within the prescribed period. However, the Commissioner may extend the period within which a request may be made if the Commissioner is satisfied that there was no undue delay in making the request.
- 2.111 Clause 112 of the Bill allows any person to give notice to the Commissioner of opposition to a restoration order under clause 13 of the Bill.
- 2.112 Clause 113 of the Bill relates to the Commissioner's determination of a request to restore a patent application.
- 2.113 Clause 114 of the Bill provides for those who are entitled under an assignment or agreement, or by operation of law, to the patent, an interest in the patent or an undivided share in the patent or an interest in the patent.
- 2.114 Clause 115 of the Bill provides that if an applicant dies before a patent is granted on the patent application, the applicant's personal representative may proceed with the application.
- 2.115 Clause 116 of the Bill allows the Commissioner to give directions that the Commissioner thinks fit for an application to proceed if a dispute arises between interested parties in relation to a patent application on whether the application should proceed.
- 2.116 Clause 117 of the Bill provides for directions in relation to inventions concerning defence.
- 2.117 Clause 118 of the Bill provides that the Commissioner must give notice of the patent application and of the direction to the Minister responsible for defence.
- 2.118 Clause 119 of the Bill provides that the Minister responsible for defence must consider whether publication would be prejudicial to the defence of Fiji.
- 2.119 Clause 120 of the Bill provides that the Commissioner must revoke directions on receipt of notice from the Minister responsible for defence.
- 2.120 Clause 121 of the Bill provides for the acceptance of a complete specification while directions given under clause 117 are in force. If it appears to the Minister responsible for defence that the applicant for the patent has suffered hardship by reason of the directions being in force, the Minister responsible for finance may pay to the applicant reasonable compensation.
- 2.121 Clause 122 of the Bill provides that no maintenance fees or renewal fees are payable for any period during which directions are in force.
- 2.122 Clause 123 of the Bill provides that a failure to comply with the directions is an offence punishable on conviction to a fine not exceeding \$20,000 or imprisonment for a term not exceeding 2 years or both.

- 2.123 Clause 124 of the Bill provides for the liability of an officer of a body corporate that commits an offence against clause 131.
- 2.124 Clause 125 of the Bill provides that a person infringes a patent if (other than under a licence or with the consent or agreement of the patentee) the person does anything in Fiji that the patentee has the exclusive right to do under clause 16 (which relates to the exploitation of the invention).
- 2.125 Clause 126 of the Bill provides that a person also infringes a patent if the person supplies another with the means for putting an invention into effect if doing so would infringe a patent and the person knows (or ought reasonably to have known) that the supplied means are suitable and intended for that purpose.
- 2.126 Clause 127 of the Bill sets out that a new product is presumed in infringement proceedings to have been obtained by the patented process for obtaining that product.
- 2.127 Clauses 128, 129, 130 and 131 of the Bill provide the following exceptions:
- (i) it is not an infringement to do an act for experimental purposes relating to the subject matter of an invention (which includes determining how the invention works, its scope, or the validity of the claims, or seeking an improvement of the invention);
  - (ii) it is not an infringement to use an invention in the stated ways on foreign vessels, aircraft, or vehicles;
  - (iii) it is not an infringement to make, use, import, or sell, hire or otherwise dispose of an invention solely for uses reasonably related to the development and submission of information required under Fijian law, or other law, that regulates the manufacture, construction, use, or sale of any product;
  - (iv) it is not an infringement to do an act that exploits an invention, and that would infringe a patent apart from clause 131 of the Bill if immediately before the priority date of the relevant claim, the person was exploiting the invention in Fiji or had taken steps to exploit the invention in Fiji.
- 2.128 Clause 132 of the Bill provides that a defendant may counterclaim for revocation of a patent in infringement proceedings.
- 2.129 Clause 133 of the Bill provides that infringement proceedings may be brought in court by the patentee or by an exclusive licensee for any infringement that occurs during the term of the licence.
- 2.130 Clause 134 of the Bill sets out when an infringement proceeding may be brought. Infringement proceedings may not be brought until the patent is granted.

- 2.131 Clause 135 of the Bill sets out when an infringement proceeding may be brought if registrable assignment or licence has occurred.
- 2.132 Clause 136 of the Bill makes specific provision for infringement proceedings brought by exclusive licensees. The patentee (if not joined as the plaintiff) must be added as a defendant, but is not liable for costs unless the patentee actually defends the proceedings.
- 2.133 Clause 137 of the Bill sets out that the court may grant an injunction and, at the option of the plaintiff, damages or an account of profits for an infringement of a patent. This is not an exhaustive list of the relief available.
- 2.134 Clause 138 of the Bill prevents the court from awarding damages or an account of profits if the defendant proves that they did not know, and ought not reasonably to have known, that the patent existed. There is a presumption that the defendant ought to have known the patent existed if it is marked as patented in Fiji and with the Fiji patent number and the person knew, or ought reasonably to have known, of the product.
- 2.135 Clause 139 of the Bill requires the court to refuse damages or an account of profits for an infringement before an amendment to an accepted complete specification unless the specification, as accepted, was framed in good faith and with reasonable skill and knowledge or the amendment was only to correct an obvious mistake.
- 2.136 Clause 140 of the Bill allows the court to refuse damages or an account of profits for an infringement that occurs after renewal fees are not paid.
- 2.137 Clause 141 of the Bill states that clauses 138 to 140 do not affect the court's power to grant injunctions in infringement proceedings.
- 2.138 Clause 142 of the Bill enables the court to grant relief for a partially valid patent, but in the case of damages, an account of profits, or costs, the plaintiff must first prove that the invalid claim was framed in good faith and with reasonable skill and knowledge.
- 2.139 Clause 143 of the Bill enables a successful party to infringement or revocation proceedings to obtain reasonable legal practitioner-client costs if the party relied on the validity of the claim of a specification and the court has certified that the claim's validity was contested in earlier proceedings.
- 2.140 Clause 144 of the Bill enables a person to apply to the court for a declaration of non-infringement with the patentee or nominated person joined as a respondent.
- 2.141 Clause 145 of the Bill provides for proceedings for non-infringement.
- 2.142 Clause 146 of the Bill provides that costs are at the court's discretion.

- 2.143 Clause 147 of the Bill clarifies that the validity of a patent is not at issue, and is not affected by, a declaration of non-infringement.
- 2.144 Clause 148 of the Bill provides for application for registration of assignment, licences and other interests in patents.
- 2.145 Clause 149 of the Bill allows the Commissioner to register assignments, licences and other interests in patents.
- 2.146 Clause 150 of the Bill allows the Commissioner to vest patents or patent applications without probate or letters of administration.
- 2.147 Clause 151 of the Bill provides for the termination of sales, leases and licences of patented products and processes, on 3 months' notice, after the patent ceases to be in force.
- 2.148 Clause 152 of the Bill allows an interested person to apply to the court for the grant of a licence under a patent on the grounds that a market for the patented invention is not being supplied, or is not being supplied on reasonable terms, in Fiji.
- 2.149 Clause 153 of the Bill allows the court to order the grant of a licence in accordance with an application on any terms that the court thinks fit. A licence granted under this clause is not exclusive and, generally, must not be assigned.
- 2.150 Clause 154 of the Bill allows the court to order the grant of a licence for the export of pharmaceutical products in certain overseas countries.
- 2.151 Clause 155 of the Bill provides for requests by non-WTO member countries to the Government for pharmaceutical products.
- 2.152 Clause 156 of the Bill provides that an order granted under clause 154 must specify the terms of the licence.
- 2.153 Clause 157 of the Bill provides that a copy of the order granted under clause 154 must be sent by the Registrar of the court to the Commissioner and the Permanent Secretary responsible for foreign affairs, who must publish the order on an Internet site maintained by, or on behalf of, the Ministry responsible for foreign affairs.
- 2.154 Clause 158 of the Bill provides that if a licence is granted to a person, that person must pay certain remuneration to the patentee.
- 2.155 Clause 159 of the Bill prevents a licence from being granted in certain circumstances if the person applying for the licence has made effort to obtain a licence from the patentee on reasonable commercial terms and conditions and has been unable to obtain a licence.

- 2.156 Clause 160 of the Bill provides that the powers of the court on an application under clauses 152, 154 or 158 must be exercised with a view to ensuring that the inventor or other person beneficially entitled to a patent receives reasonable remuneration.
- 2.157 Clause 161 of the Bill provides that an order for the grant of a licence has effect as if it were a deed.
- 2.158 Clause 162 of the Bill allows any Government department and those authorised by a Government department to exploit any patented invention for the services of the State.
- 2.159 Clause 163 of the Bill allows an order to be made that may declare a particular use of an invention to be a State use.
- 2.160 Clause 164 of the Bill protects the buyers of products sold in the exercise of powers conferred by clause 162 of the Bill.
- 2.161 Clause 165 of the Bill provides the rights of third parties in respect of a State use of an invention.
- 2.162 Clause 166 of the Bill provides for the referral of disputes concerning a State use of an invention to the court.
- 2.163 Clause 167 of the Bill allows the court to refer matters relating to a State use of an invention to a special or official referee or arbitrator.
- 2.164 Clause 168 of the Bill contains special provisions as to a State use of an invention during an emergency.
- 2.165 Clause 169 of the sets out the nature and scope of right under clause 162 of the Bill. The right to use a patented invention under clause 162 of the Bill is not exclusive and, generally, must not be assigned.
- 2.166 Clause 170 of the Bill provides that if any use of a patented invention is made under clause 162, the Government department must, as soon as practicable after the use of the patented invention has begun, notify and provide the nominated person or patentee with information concerning the extent of the use as the patentee may from time to time require.
- 2.167 Clause 171 of the Bill provides that the State must, if an act is done under clause 162, pay certain remuneration to the patentee.
- 2.168 Clause 172 of the Bill provides for the mention of an inventor in a patent by the Commissioner.
- 2.169 Clause 173 of the Bill allows a person to make a request or claim to be mentioned as inventor in a patent.



- 2.170 Clause 174 of the Bill provides the requests or claims that may not be considered by the Commissioner.
- 2.171 Clause 175 of the Bill requires the Commissioner to give notice of requests or claims made under clause 173 of the Bill.
- 2.172 Clause 176 of the Bill provides that a person who alleges that another person should not have been mentioned as inventor under clauses 172 to 175 may apply to the Commissioner for a certificate to that effect.
- 2.173 Clause 177 of the Bill requires the Commissioner to keep a patents register in Fiji.
- 2.174 Clause 178 of the Bill sets out the purpose of the patents register, which is to enable the public to know what patents are in force and their key dates, know who is the patentee and has other interests in the patent and the addresses for service of those persons, find out about the scope of a claim, and find out other matters affecting the validity and ownership of the patent and patent licences. The purpose is also to facilitate the Commissioner's functions under the Bill.
- 2.175 Clause 179 of the Bill allows the patents register to be an electronic register or kept in any other manner the Commissioner thinks fit.
- 2.176 Clause 180 of the Bill sets out what must be contained in the patents register.
- 2.177 Clause 181 of the Bill allows a person to search the patents register in accordance with the Bill or the regulations.
- 2.178 Clause 182 of the Bill requires the Commissioner to give a person certain information if requested in the prescribed manner.
- 2.179 Clause 183 of the Bill allows the Commissioner to make changes to the patents register in accordance with the Bill or the regulations.
- 2.180 Clause 184 of the Bill allows the Commissioner to correct his or her own mistakes in the patents register, in a patent or in any other document issued.
- 2.181 Clause 185 of the Bill allows the Commissioner to correct other persons' mistakes in the patents register, in a patent, in a patent application, in a document filed in connection with a patent application, or in proceedings before the Commissioner in connection with a patent or patent application.
- 2.182 Clause 186 of the Bill allows the court to rectify the patents register.
- 2.183 Clause 187 of the Bill makes the patents register *prima facie* evidence of its entries. Certified copies or extracts are admissible in evidence to the same extent as the original.

- 2.184 Clause 188 of the Bill makes the Commissioner's certificate on various matters *prima facie* evidence of those matters. These matters include entries in the patents register.
- 2.185 Clause 189 of the Bill requires the Commissioner to periodically publish a journal on patents, patent applications and other matters. It may be published electronically.
- 2.186 Clause 190 of the Bill allows the Commissioner to publish indexes, specifications, and other works relating to inventions, patents and patent applications. The Commissioner may keep classifications, by subject matter, of specifications and printed publications to determine the patentability of inventions. These indexes and other documents may be kept and published electronically..
- 2.187 Clause 191 of the Bill provides that the Commissioner exercise any of his or her discretionary powers adversely to any applicant without having given the applicant a reasonable opportunity to be heard.
- 2.188 Clause 192 of the Bill requires evidence to be given by affidavit or statutory declaration unless the Commissioner directs otherwise.
- 2.189 Clause 193 of the Bill allows the Commissioner to receive evidence on oath.
- 2.190 Clause 194 of the Bill allows the Commissioner to summon persons to attend a hearing before the Commissioner.
- 2.191 Clause 195 of the Bill allows the Commissioner to award costs in proceedings before him or her.
- 2.192 Clause 196 of the Bill allows the Commissioner (or the court, on appeal) to require security for costs if the person does not reside and does not carry on business in Fiji.
- 2.193 Clauses 197 and 198 of the Bill entitle a person to appeal the Commissioner's decisions under the Bill to the High Court, and then to the Court of Appeal in certain cases.
- 2.194 Clause 199 of the Bill provides that the Commissioner's costs are at the discretion of the relevant court in any proceedings before that court.
- 2.195 Clause 200 of the Bill provides that the Solicitor-General will perform the functions and exercise the powers of the Commissioner of Patents.
- 2.196 Clause 201 of the Bill sets out the functions of the Commissioner.
- 2.197 Clause 202 of the Bill enables the Commissioner to delegate the Commissioner's functions and powers.

- 2.198 Clause 203 of the Bill removes liability of the Commissioner and others for good faith performance of the Commissioner's functions or exercise of the Commissioner's powers.
- 2.199 Clauses 204, 205 and 206 of the Bill provide for the Fiji Intellectual Property Office and its opening and closing hours.
- 2.200 Clause 207 of the Bill allows the Commissioner to extend any time limit if something will not be done in time due to a delay by the Commissioner.
- 2.201 Clause 208 of the Bill allows the Commissioner to extend time limits for certain filing requirements or for delivery failures.
- 2.202 Clause 209 of the Bill provides the requirements for applying and granting extensions of time limits.
- 2.203 Clause 210 of the Bill sets out the requirements for service of notices.
- 2.204 Clause 211 of the Bill sets out the requirements for a summons.
- 2.205 Clause 212 of the Bill provides that a witness appearing before the Commissioner under a summons is entitled to be paid witnesses' allowances and expenses in accordance with the scales prescribed by regulations under the Criminal Procedure Act 2009.
- 2.206 Clause 213 of the Bill provides offences for failure to comply with a summons.
- 2.207 Clause 214 of the Bill provides that fees and penalties must be paid for any matter arising under the Bill if required by the Bill or the regulations.
- 2.208 Clause 215 of the Bill provides that payment and application of fees and other money are to be paid to the Consolidated Fund.
- 2.209 Clause 216 of the Bill provides for the protection of the Coat of Arms of Fiji.
- 2.210 Clause 217 of the Bill provides that certain provisions do not affect the operation of the Personal Property Securities Act 2017.
- 2.211 Clause 218 of the Bill empowers the Minister to make regulations prescribing matters that are required or permitted by the Bill to be prescribed, or are necessary or convenient to be prescribed for carrying out or giving effect to the Bill and generally for achieving the purposes of the Bill.
- 2.212 Clause 219 of the Bill repeals the Act.
- 2.213 Clause 220 provides for transitional matters.

**3.0 MINISTERIAL RESPONSIBILITY**

3.1 The Act comes under the responsibility of the Minister responsible for patents.

A. SAYED-KHAIYUM  
Attorney-General