



STANDING COMMITTEE ON JUSTICE, LAW AND HUMAN RIGHTS

Report on the Review of the Trademarks Bill 2020 (Bill No. 45 of 2020)



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CHAIRPERSON'S FOREWORD



The Fijian Government has been undertaking reforms of regulatory frameworks of vital sectors of the nation. Through this undertaking, there have been numerous prominent work carried out, which affects policies, including the Parliament resolution to ratify the Madrid Protocol and the Paris Convention in relation to trademarks. This important step taken by Parliament has led to the review of the current Act that governs our trademark registration in Fiji, which goes back to 1933. There have been numerous consultations held, including with the World Intellectual Property Office (WIPO), in respect of the reform of the current Act.

The *Trademarks Bill 2020* is the fruition of this reform work carried out by the Fijian Government. The next phase has now fallen onto Parliament, which had referred the Bill to the Standing Committee on Justice, Law and Human Rights, for review.

At the commencement of the review, the Committee made preliminary deliberations on the Clauses of the Bill and noted that the key objectives of the Bill include:

- defining the scope of rights protected by registered trademarks;
- specifying the procedures for registering trademarks in Fiji;
- deterring counterfeit activity in relation to registered trademarks in Fiji; and
- ensuring that Fiji's trademark regime takes account of international developments.

The Bill seeks to modernise the laws of Fiji relating to trademarks and repeal the archaic laws.

As part of the review the Committee conducted public consultation on the Bill. The Committee received support on the introduction of the Bill, from majority of the public and relevant stakeholders that had participated in the public consultation. There were also comments and suggestions put forth by submitters, which the Committee placed reasonable emphasis on. This part of the review saw the Committee identify the following salient issues:

- That the Bill has various phrases and words that may need to be defined or may need changes to its definition;
- That the Bill has certain provisions, which were considered to be vague or ambiguous;
- That the Bill, as per the submissions received, needs to include provisions that provide for necessary matters such as:
 - Protection of clients, who would like to register a trademark, from decisions of public officers;
 - Allowance of flexibility so that scanned documents can be used for filing for registration of trademarks;
 - Refunds by the Registry, for costs of advertisements and/or application fees, if application is revoked;
 - Provision for timelines in which the Registry or the Commissioner must act after receiving an application;

- That renewal notices are sent to owners of trademarks 6 months before expiry and that the protection of the trademark is only removed 6 months after the Commissioner has actually sent the notice;
- That there be provision, which provides maximum deterrence against infringers who knowingly, or with reasonable grounds to know, engage in infringing activity; and
- That there be provisions that require border control authorities, such as the Fiji Revenue Customs Service, carry out border watches for infringing goods.

Consideration was also given to the impact of the Bill on Fiji's efforts in combating counterfeit activities that pose a threat to the business sector of Fiji along with meeting its targets of the sustainable development goals and the national development plan. It was encouraging to note that the Bill was introduced for the purpose of economic development. Additionally, the objective of the Bill is as such that it applies equally to all persons, irrespective of gender.

The issues noted from the review were deliberated on extensively and clarification on these was also sought from the Office of the Solicitor-General and the consultants from the World Intellectual Property Office and other Intellectual Property Office from around the region. This ensured that the issues were properly addressed and that the primary objectives of the Bill are preserved.

At the conclusion of the review, the Committee addresses each issue that was raised by agreeing to some suggestions that were put forward by submitters and disagreeing with others and providing reasons for such a stance. As a result, the Committee also recommends that necessary amendments be made to Bill and these amendments are captured in magenta coloured texts in the copy of the Bill tabled with this Report.

The Committee is also of the opinion that as we start implementing this law, this would be an opportune moment to gauge the implications of the Bill on Fiji's business sector and that a review of these may be initiated after a few years.

I would like to thank my Honourable Members, Hon. Rohit Sharma (Deputy Chairperson), Hon. Ratu Suliano Matanitobua, Hon. Dr. Salik Govind, and Hon. Mosese Bulitavu, for their input. The Committee acknowledges the public, key stakeholders and entities that provided their views on the Bill and for taking an interest in the proceedings of the Committee and Parliament.



Hon. Alvick Avhikrit Maharaj
Chairperson

Committee Composition



Hon. Alvick A. Maharaj (Chairperson)

- *Assistant Minister of Employment, Productivity, Industry Relations, Youth and Sports*
- *Chairperson of Public Accounts Committee*
- *Government Whip*
- *Pharmacist*



Hon. Rohit Sharma (Deputy Chairperson)

- *Former Civil Servant – Education Sector*
- *Deputy Chairperson of the Standing Committee on Justice, Law and Human Rights*
- *Deputy Government Whip*



Hon. Ratu Suliano Matanitobua (Member)

- *Shadow Minister for Youth and Sports*
- *Former State Minister of Fijian Affairs*
- *Former Military Territorial Officer*



Hon. Dr. Salik Govind (Member)

- *Public Health Specialist – United Nations (World Health Organisation)*
- *Deputy Chairperson of the Standing Committee on Foreign Affairs and Defence Committee*



Hon. Mosese Bulitavu (Member)

- *Shadow Minister for Defense, National Security, Immigration and Correction Services*
- *Former Opposition Whip*
- *Business Consultant/Farmer*
- *Territorial Military Officer – Republic of Fiji Military Forces*
- *Law Graduate and Researcher*

Committee Secretariat Team

Supporting the Committee in its work is a group of dedicated Parliament Officers who make-up the Committee Secretariat, and are appointed and delegated by the Secretary-General to Parliament pursuant to Standing Order 15 (3)(i). The Secretariat team is made of the following Parliament officers:

- Mr. Ira Komaisavai – Senior Committee Clerk
- Mr. Jackson Cakacaka – Deputy Committee Clerk
- Ms. Darolin Vinisha – Committee Assistant

1.0 INTRODUCTION

1.1 **Background**

As a way of background, the Committee noted that the Fijian Government has been undertaking reforms of regulatory frameworks of vital sectors of the nation. Through this undertakings, there have been numerous prominent policy-impacting work carried out. One such prominent work is the Parliament resolution to ratify the Madrid Protocol and the Paris Convention in relation to trademarks.

This then led to the review of the current Acts (*Trade-Marks Act 1933* and *Merchandise Marks Act 1933*) that govern our trademark registration in Fiji, which are more than eight (8) decades old. There have been numerous consultations held, including with the World Intellectual Property Office (WIPO). The result of the reform work carried out is the *Trademarks Bill 2020*.

The Standing Committee on Justice, Law and Human Rights, hereinafter referred to as the Committee, was referred the *Trademarks Bill 2020* for review on 11 December 2020. The Bill was referred to the Committee pursuant to Standing Order 51 of the Standing Orders of the Parliament of Fiji, whereby the Committee was tasked with scrutinising the Bill and to report back on the Bill in the April 2021 Parliament Sitting.

The Bill aims to define the scope of rights protected by registered trademarks, specify the procedures for registering trademarks in Fiji, deter counterfeit activity in relation to registered trademarks in Fiji; and ensure that Fiji's trademark regime takes account of international developments.

1.2 **Committee's Review Procedure**

The Committee's review process was through the resolution of the Committee and the following provides a brief summary of the agreed upon procedure and program.

The first step in the Committee's review process was the formulation of its program with regards to its review process. The Committee's agreed upon review program was as follows:

i) Initial Analysis of the Bill

The Committee began with an initial reading of the Bill and conducting its own deliberation of the Clauses in the Bill. An in-depth deliberation of the Bill was conducted by the Committee, whereby pertinent issues were identified.

ii) Identification of mode of public consultation

The Committee then discussed, which mode of public consultation would be suitable for the review the Bill. The Committee resolved to rely on two main modes, which is to call for written submission and conducting in-person public consultation.

iii) Awareness on the Committee's public consultation through advertisement

The Committee then conducted awareness on its proposed public consultations, through advertisements via newspaper advertisements.

iv) Conducting of public consultation

The Committee was also committed to upholding public trust in Parliament, by ensuring that there is public participation and that all such participation is given due consideration. The Committee was mindful of the provisions in Standing Order 111(1)(a) and ensured that its meetings were open to the public and the media, except during such deliberations and discussions to develop and finalise the Committee's observations and this Report.

The Committee called for written submissions from the public and other interested stakeholders by placing an advertisement through the Parliament website and Parliament social media pages on social media platforms; Facebook, Twitter and Instagram. The Committee received a written submission on the Bill from relevant stakeholders. A summary of these submissions is provided in a later part of this report, under the heading '*Committee's Deliberation and Analysis of the Bill*'.

The Committee then visited various communities to conduct in-person public consultation. A list of the areas visited by the Committee is appended to the Appendices of this Report. All the face-to-face submissions conducted during the public consultation were recorded and open to the public and the media.

v) Review of evidence collected and seeking legal clarification on pertinent issues

The Committee reviewed all the evidence received from the public consultation and to maintain due diligence, the Committee also relies on legal clarification on technical issues identified from the Bill, which is obtained from the Office of the Solicitor-General. These clarifications also assist the Committee in deliberating on these pertinent issues and in deciding whether there would be recommendations for any changes to the Bill.

vi) Drafting of Committee Report

The final step of the review process is the compilation of all issues identified from the evidence received from the public consultation. This is then deliberated on with the necessary legal clarifications and the Committee forms its own independent view on all issues identified.

2.0 COMMITTEE'S DELIBERATION AND ANALYSIS OF THE BILL

2.1 Initial deliberation by the Committee

The Committee commenced its analysis of the Bill going through Clause by Clause. From this initial reading, it was noted that the Bill aims to repeal the *Trade-marks Act 1933* and the *Merchandise Marks Act 1933* and its subsidiary legislation and put in place a regulatory framework, which is modern and addresses current issues on trademarks registration in Fiji.

The Committee had extensive discussions on the provisions of the Bill and resolved that given the time provided to the Committee to review the Bill; that it be prudent to firstly hear the views of the public on this very important piece of proposed legislation. This public consultation would then allow the Committee to gauge the public's perspective on the Bill before deliberating further, whilst also bearing in mind the requirements as set down by Parliament in referring the Bill to the Committee.

2.2 Bill Summary

By way of consensus, the Committee believed that it be prudent to also capture in this Report the necessary provisions that the proposed law is intending to bring about to the trademarks regulatory framework. This would be achieved by providing a brief summary of the Clauses of the Bill in this part of the Report. This would conveniently provide the reader of this Report with the aforementioned information about the Bill. The Bill summary is provided below¹.

Clause 1 of the Bill provides for the short title and commencement. If passed by Parliament, the Act will come into force on a date or dates appointed by the Minister by notice in the Gazette.

Clause 2 of the Bill provides for the definitions of the terms used throughout the Bill.

Clause 3 of the Bill outlines the objectives of the Bill. The Bill is intended to define the scope of rights protected by registered trademarks, specify the procedures for registering trademarks in Fiji, deter counterfeit activity in relation to registered trademarks in Fiji and ensure that Fiji's trademark regime takes account of international developments.

Clause 4 of the Bill states that the Bill binds the State. This means that the provisions of the Bill bind every person in Fiji including the State.

Clause 5 of the Bill clarifies that a registered trademark is personal property.

Clause 6 of the Bill outlines the rights that are attached to a registered trademark. The owner of a registered trademark ('owner') has the rights and remedies as specified in the Bill as well as the exclusive right to: (i) use the registered trademark; (ii) authorise others

¹ Explanatory Note to the *Trademarks Bill; Trademarks Bill 2020* (Bill No. 49 of 2020), pages 60-79.

to use the registered trademark; and (iii) assign or transmit the registered trademark to another person. A member of a collective association that owns a registered collective trademark has the exclusive right to use the collective trademark in respect of the goods and services for which the collective trademark is registered, but the member of the collective association has that exclusive right of use together with the collective association to which he or she is a member and cannot exclude any other member of the collective association from using the registered collective trademark. The terms ‘collective association’ and ‘collective trademark’ are defined in clause 2 of the Bill.

Clause 7 of the Bill clarifies that: (i) the rights of an owner are subject to conditions attached to the registered trademark as entered on the register of trademarks (‘register’); (ii) the rights of an owner accrue from the deemed date of registration; (iii) if the registered trademark has parts that are registered as separate trademarks the rights of an owner are conferred in respect of each part of the registered trademarks; (iv) if there are joint owners of the registered trademark, the rights are to be exercised by the joint owners. The term ‘deemed date of registration’ is defined in clause 2 of the Bill.

Clause 8 of the Bill clarifies that an application for the registration of a trademark (‘application’) is personal property. An applicant may assign or transmit their application regardless of whether the application is made before or after the commencement of the Act.

Clause 9 of the Bill specifies when a trademark is registrable. A trademark is registrable in respect of particular goods and/or services within one or more classes if certain requirements have been met i.e. the application is made in accordance with the provisions of the Bill, the prescribed fees for the application are paid and the Commissioner is satisfied that there are no grounds that would prevent the registration of the trademark.

Clause 10 of the Bill specifies that a certification trademark in respect of goods or services may be registered in the name of the person who certifies the goods or services and not in the name of the person who carries on a trade in the goods or services of the kind certified. The term ‘certification trademark’ is defined in clause 2 of the Bill.

Clause 11 of the Bill specifies that a collective trademark in respect of goods produced or services provided by members of a collective association may be registered in the name of the collective association.

Clause 12 of the Bill sets out the absolute grounds for the Commissioner to not register a sign as a trademark or part of a trademark. The Commissioner must not register as a trademark or part of a trademark a sign which is: (i) likely to deceive or cause confusion; (ii) contrary to written law or does not have protection in any court of law; or (iii) in the opinion of the Commissioner, likely to offend a significant section of the community. Also, the Commissioner must not register a trademark if the mark contains the term ‘Fiji’ and a body corporate’s registered name and the application is made in bad faith.

Clause 13 of the Bill provides that no court or tribunal may hear a claim that challenges a decision of the Minister in relation to the use of the term ‘Fiji’.

Clause 14 of the Bill sets out the grounds for the Commissioner to not register a trademark. The Commissioner must not register: (i) a sign that is not a trademark; (ii) a trademark that has no distinctive character; (iii) a trademark that consists only of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services; (iv) a trademark that consists only of signs or indications that have become customary in the current language or in the bona fide and established practices of trade.

Clause 15 of the Bill deals with the relevance of colour in relation to the distinctive character of a trademark. The Commissioner or the court must consider whether or not the trademark is, or is to be, limited in whole or in part to one or more specified colours. If a trademark is, or is to be, registered without limitation of colour, then the trademark is, or will be, registered for all colours.

Clause 16 of the Bill prohibits the registration, in respect of a chemical substance or preparation, of a trademark that contains the commonly used and accepted name of any single chemical element or single chemical compound.

Clause 17 of the Bill allows the Commissioner to register a trademark that contains the words ‘copyright’, ‘layout design’, ‘patent’, ‘patented’, ‘plantvariety right’, ‘registered’, ‘registered design’ or ‘trademark’, or any abbreviations or similar words.

Clause 18 of the Bill deals with the registrability of a sign as a trademark that contains the name or representation of a person. If a person applies for a sign to be registered as a trademark and the sign contains the name or representation of another person (‘other person’), the Commissioner may require the written consent of the other person unless the other person is deceased and had died 10 years or more before the making of the application. If the other person is deceased and had died within the 10 years before the making of the application, then the Commissioner may require the written consent of the deceased person’s legal representative.

Clause 19 of the Bill deals with the registrability of identical or similar trademarks. The Commissioner must not register a trademark (‘trademark A’) in respect of any goods or services if: (i) trademark A is identical to a trademark that belongs to a different owner (‘trademark B’) and is registered, or has priority, in respect of the same goods or services; (ii) trademark A is identical to trademark B and is registered, or has priority, in respect of the same goods or services; (iii) trademark A is identical to trademark B and is registered, or has priority, in respect of the goods or services that are similar to those goods or services and the use of trademark A is likely to deceive or cause confusion; (iv) trademark A is similar to a trademark that belongs to different owner (‘trademark C’) and is registered, or has priority, in respect of the same goods or services or goods or services that are similar to those goods or services and the use of trademark A is likely to deceive or cause confusion; or (v) trademark A is, or an essential element of trademark A is, identical or similar to, or a translation of, a trademark that is well known in Fiji (‘trademark D’), whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of trademark A would be taken as indicating a connection in the course of trade between those other

goods or services and the owner of trademark D, and would be likely to prejudice the interests of the owner.

Clause 20 of the Bill outlines the exceptions to the rules in clause 19 of the Bill. If the owner of trademark B, trademark C or trademark D consents to the registration of trademark A, the Commissioner must register trademark. Also, if the Commissioner or the court considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Commissioner or the court, makes it proper for the trademark to be registered subject to any conditions that the Commissioner or the court may impose.

Clause 21 of the Bill deals with the registrability of a trademark that contains a representation of a flag, armorial bearing, insignia, order of chivalry or decoration of any entity. If a person applies for the registration of these, the Commissioner may require that the applicant obtain the written consent of the person who appears to the Commissioner to be entitled to consent to the registration and use of the sign as a trademark. However, this clause does not apply if clauses 22 or 23 apply.

Clause 22 of the Bill deals with the registrability of a trademark that contains a representation of a flag, armorial bearing or State emblem, official sign or hallmark of a convention country.

Clause 23 of the Bill deals with the registrability of a trademark that contains a representation of an armorial bearing, flag or other emblem or abbreviation or name of an international intergovernmental organisation. The authorisation of the international organisation is required for the registration of the trademark. However, the Commissioner may register a trademark if the Commissioner considers that the use of the armorial bearing, flag or other emblem or abbreviation or name of the international organisation is not likely to suggest that a connection exists between the international organisation and the trademark, or it is not likely to mislead as to the existence of a connection between the user and the international organisation.

Clause 24 of the Bill provides for the extent of the protection of State emblems of, or the official signs or hallmarks adopted by, a convention country, or the emblems, abbreviations, or names, of an international organisation under the Paris Convention or the TRIPS Agreement.

Clause 25 of the Bill provides for the classification of goods and services under the most recent edition of the Nice Classification for the purpose of registration of a trademark. The Commissioner decides on the class within which any goods or services fall and the Commissioner's decision is final.

Clause 26 of the Bill specifies who may apply for the registration of a trademark. A person claiming to be the owner of a trademark or series of trademarks may, with the prescribed fee, apply for the registration of the trademark or series of trademarks used or proposed to be used in respect of particular goods and/or services within one or more classes.

Clause 27 of the Bill specifies who may make a joint application for the registration of a trademark. Two or more persons may make a joint application if one of them or any of them is entitled to use the trademark only on behalf of both or all of them, or in relation to goods or services with which both or all of them are connected in the course of trade.

Clause 28 of the Bill deals with priority applications. If there are several applications for the registration of trademarks that are identical or similar to each other and that are in respect of identical or similar goods or services, the first application received by the Commissioner has priority over all other applications, subject to clause 30.

Clause 29 of the Bill requires the Commissioner to inform each applicant whose application does not have priority over all other applications or who does not have equal priority, of their order of priority and then determine each application according to their order of priority.

Clause 30 of the Bill deals with priority applications to which convention country applications relate. A person who has applied for the registration of a trademark in a convention country, or his or her legal representative or assignee, is entitled to the registration of his or her trademark in priority to other applicants, and the registration has the same date as the date of the application in the convention country if the application is made within 6 months after the date of the convention country application.

Clause 31 of the Bill allows an applicant to withdraw an application or limit the specification of an application. An applicant can also request for the correction of the applicant's name or address or an error or omission if the Commissioner is of the opinion that the correction does not materially alter the meaning or scope of the application.

Clause 32 of the Bill allows the Commissioner or the court to correct any error in connection with an application.

Clause 33 of the Bill states that an application is to be examined by the Commissioner to determine whether the application complies with all the requirements of the Bill.

Clause 34 of the Bill states that an application that complies with all the requirements of the Bill is to be accepted by the Commissioner subject to conditions that the Commissioner thinks fit.

Clause 35 of the Bill requires the Commissioner to inform an applicant that the application does not comply with the requirements of the Bill and to also give the applicant an opportunity to respond or to amend the application within the time set by the Commissioner.

Clause 36 of the Bill allows the Commissioner to revoke the acceptance of an application before the trademark applied to be registered is registered if the Commissioner is satisfied that the application was accepted because of an error or omission made by the Commissioner or that another application has priority over the application. If the Commissioner revokes the acceptance of the application, the application is treated as 'not accepted' and the Commissioner needs to examine the application to determine whether it complies with the requirements of the Bill.

Clause 37 of the Bill states that the Commissioner must reject an application if the applicant does not satisfy the Commissioner that the applicant has complied with the requirements for registering a trademark within the time set by the Commissioner.

Clause 38 of the Bill provides the grounds for abandonment of an application. If the Commissioner does not receive a response from the applicant to a notification, the Commissioner must treat the application as abandoned.

Clause 39 of the Bill requires the Commissioner to state the reasons for his or her decision in writing if the applicant requires the Commissioner to do so.

Clause 40 of the Bill ensures that an application that has been accepted is advertised in the prescribed manner.

Clause 41 of the Bill provides for how an accepted application may be opposed. A person may give written notice of opposition to an accepted application to the Commissioner who must send a copy to the applicant. The notice must inter alia include a statement of the grounds for opposition.

Clause 42 of the Bill provides for a counter-statement to a notice of opposition. An applicant to whom a notice of opposition has been sent must send to the Commissioner a counter-statement. If the applicant sends a counter-statement, the Commissioner must send a copy of the counter-statement to every person who gave notice of opposition. If the applicant does not send a counter-statement, the applicant is deemed to have abandoned the application. Clause 43 of the Bill ensures that, in relation to opposition to an accepted application, the Commissioner hears the parties, considers the evidence and determines whether the trademark is to be registered.

Clause 44 of the Bill deals with when a trademark is to be registered. The Commissioner must register a trademark if the Commissioner has accepted the application and the following have taken place: (i) no notice of opposition is given; or (ii) if notice of opposition is given, all opposition proceedings are withdrawn or decided in favour of the registration; and (iii) the Commissioner does not intend to revoke the acceptance of the application.

Clause 45 of the Bill states that the Commissioner must, on registration of a trademark: (i) enter the actual date of registration and the deemed date of registration on the register; (ii) issue a certificate of registration to the applicant; (iii) in the case of an application for the registration of a series of trademarks, register the trademarks as a series in one registration.

Clause 46 of the Bill allows the Commissioner to register a qualified person as the owner of a trademark if the owner has died, without requiring the production of probate or letters of administration. Similarly, the Commissioner may allow a qualified person to complete the application for registration of a trademark as the owner of the trademark if the applicant has died before the registration of the trademark. The qualified person who is registered must hold the registration subject to all existing interest and equities affecting the registration. The term 'qualified person' is defined in clause 2 of the Bill.

Clause 47 of the Bill deals with the reissuance of a certificate of registration.

Clause 48 of the Bill deals with certification trademarks. An applicant for the registration of a certification trademark must provide the Commissioner with draft rules that govern the use of the certification trademark for the Commissioner's approval.

Clause 49 of the Bill deals with the consideration of an application for registration of a certification trademark. When the Commissioner or the court deals with an application for the registration of a certification trademark, the following must be considered: (i) the matters that are relevant to an application; (ii) whether or not the certification trademark should indicate that it is such a trademark; (iii) whether the applicant is competent to certify the goods or services in respect of which the certification trademark is to be registered; (iv) whether the draft rules are satisfactory; and (v) whether in all the circumstances the registration applied for would be in the public interest.

Clause 50 of the Bill states that the approved rules that govern the use of the registered certification trademark must be deposited at the Fiji Intellectual Property Office ('FIPO').

Clause 51 of the Bill specifies the duration of a registered trademark. The duration of the registration of a trademark is effective for a period of 10 years from the deemed date of registration. This, however, does not apply to a trademark registered under the existing Trade-Marks Act 1933.

Clause 52 of the Bill allows for renewal of the registration of a trademark. The registration of a trademark may be renewed for a further period of 10 years.

Clause 53 of the Bill provides for notification of the impending expiration of registration of a trademark. If the owner of a registered trademark applies for the renewal of the registration of a trademark, the Commissioner must renew the registration of the trademark from the date the registration expires. If the owner has not applied before the expiration of the registration of the trademark, the Commissioner must send a notice of the following to the owner: (i) date on which the registration expires; (ii) conditions as to the payment of fees or otherwise on which a renewal of registration may be obtained; and (iii) removal of the registration, subject to any conditions specified by the Commissioner as to the trademark's restoration to the register if, at the expiration of the period of 10 years, the conditions have not been complied with. If, after the expiration of the registration and 6 months, notification has not been complied with and renewal conditions have not been met, the Commissioner must remove the trademark from the register.

Clause 54 of the Bill deals with the status of a trademark that has passed its expiry date but has not been removed from the register.

Clause 55 of the Bill allows for voluntary cancellation of registration of a trademark. The owner of a registered trademark may cancel the registration.

Clause 56 of the Bill allows the Commissioner or court to, on the application of a person or on its own motion, cancel the registration of a trademark if a condition entered on the register has been breached.

Clause 57 of the Bill allows the Commissioner to require that an entry in the register that relates to a certification trademark be cancelled or altered, or that the deposited rules be altered, on specific grounds.

Clause 58 of the Bill allows the Commissioner to require an entry in the register that relates to a collective trademark be cancelled or altered on specific grounds.

Clause 59 of the Bill allows an aggrieved person to apply to the Commissioner or the court for the revocation of the registration of a trademark.

Clause 60 of the Bill sets out the grounds for the revocation of registration of a trademark.

Clause 61 of the Bill states that the owner or a licensee who intends to oppose an application for the revocation of the registration under clause 60(1)(a) has the onus of proof.

Clause 62 of the Bill states that if the grounds for revocation exist in respect of only some of the goods or services in respect of which the trademark is registered, then revocation relates only to those goods or services.

Clause 63 of the Bill allows the owner to disclaim any right to the exclusive use of any part of the trademark.

Clause 64 of the Bill states that if the grounds for revocation in clause 60(1)(b) or (c) exists, the Commissioner or the court may require the owner to disclaim any right to the exclusive use of a word or words in relation any goods or services.

Clause 65 of the Bill allows the Commissioner or the court to require an owner to disclaim any right to the exclusive use of any part of the trademark or to make any other necessary disclaimer if the Commissioner or the court considers it to be in the public interest to do so.

Clause 66 of the Bill provides the rights affected by a disclaimer.

Clause 67 of the Bill allows the Commissioner or the court to declare a registration invalid to the extent that the trademark was not registrable under Part 2 at the deemed date of registration.

Clause 68 of the Bill sets out the effect of an invalid registration.

Clause 69 of the Bill deals with the presumption of validity of registration.

Clause 70 of the Bill provides for the correction of the register. It allows a person who has interest to apply to the Commissioner or the court for correction of the register.

Clause 71 of the Bill states that the owner may not alter the registered trademark after its actual date of registration.

Clause 72 of the Bill allows the Commissioner to alter the register after the actual date of registration of a trademark.

Clause 73 of the Bill allows the Commissioner to alter the rules that govern the use of a certification trademark.

Clause 74 of the Bill requires the Commissioner to advertise an application for an alteration of the rules that govern a registered certification trademark. The Commissioner must not decide on an application without having given the parties an opportunity to be heard.

Clause 75 of the Bill provides for the registration of the title to a trademark that has been assigned or transmitted.

Clause 76 of the Bill states that nothing in the Bill prevents a licensee from assigning or transmitting the right to use a trademark.

Clause 77 of the Bill states that nothing in the Bill affects the rights of action against any person for passing off goods or services as those of another person or the rights relating to fair trading under the Fijian Competition and Consumer Commission Act 2010.

Clause 78 of the Bill addresses infringement where an identical or similar sign is used in the course of trade.

Clause 79 of the Bill addresses infringement where there is non-compliance with certain contractual requirements.

Clause 80 of the Bill states that it is not a defence that an infringement arose from the use of the name under which a company has been registered.

Clause 81 of the Bill states a registered trademark is not infringed by the use of a trademark in any way or in any circumstances to which the registration does not extend.

Clause 82 of the Bill states that a registered trademark is not infringed by the use of another registered trademark in relation to any goods or services for that other trademark is registered.

Clause 83 of the Bill states that a registered trademark is not infringed by the use of the registered trademark for the purposes of comparative advertising.

Clause 84 of the Bill states that there is, subject to certain conditions, no infringement for honest practices in industrial or commercial matters.

Clause 85 of the Bill states there is no infringement for certain continuous use of unregistered trademark.

Clause 86 of the Bill states that there is no infringement for use in relation to certain identical or similar goods.

Clause 87 of the Bill deals with the exhaustion of the rights conferred by a registered trademark.

Clause 88 of the Bill provides for when the owner or licensee consents to the use of the registered trademark.

Clause 89 of the Bill states that no proceedings may be brought to prevent or to recover damages for infringement of an unregistered trademark.

Clause 90 of the Bill deals with the time for bringing proceedings for the infringement of a registered trademark.

Clause 91 of the Bill deals with who may apply for relief for infringement of registered trademark.

Clause 92 of the Bill states that the licensee may request the owner to bring proceedings to prevent infringement of the registered trademark.

Clause 93 of the Bill states that if the owner refuses or neglects to bring proceedings within 2 months after the request, the licensee may commence proceedings for infringement in the licensee's own name as if the licensee were the owner.

Clause 94 of the Bill outlines the consequences if the licensee commences proceedings under clause 93.

Clause 95 of the Bill deals with unjustified proceedings.

Clause 96 of the Bill provides the types of relief available for infringement of a registered trademark.

Clause 97 of the Bill provides that when claiming for damages for the infringement of a collective trademark, the collective association that owns the collective trademark may take into account any damage or loss of profits suffered by any member as a result of the infringement.

Clause 98 of the Bill provides that where a person has infringed the exclusive right to use a registered trademark, the court may order the person to erase or remove the offending sign in the person's possession or control or destroy the infringing good, infringing material or infringing object. Clause 98 of the Bill further provides that where an order is not complied with, or likely would not be complied, the court may order that the infringing good, material or object be delivered to a person that the court directs to erase or remove the offending sign or destroy the infringing good, material or object.

Clause 99 of the Bill provides that the court may order that any infringing good, material or object that a person possesses or that is before the court be delivered up to the owner of the registered trademark or any other person the court thinks fit. An order made under this clause is subject to the making of an order under clause 100 of the Bill.

Clause 100 of the Bill provides that where infringing goods, infringing material or infringing objects have been delivered up under an order under clause 99 of the Bill, an application may be made to the court to order that these infringing goods, material or objects be forfeited to the owner or any other person the court thinks fit or destroyed or dealt with as determined by the court.

Clause 101 of the Bill outlines matters to be considered by the court when considering what order to make under clause 100 of the Bill.

Clause 102 of the Bill requires the court to issue directions for the service of notice on every person who has an interest in the infringing goods, material or object to which an application under clause 100 relates.

Clause 103 of the Bill provides that every person who has an interest in the infringing good, material or object to which an application under clause 100 relates is entitled to appear in proceedings, whether or not the person is served with a notice and appeal against any order made, whether or not the person appears in the proceedings.

Clause 104 of the Bill provides for when an order under clause 100 takes effect, that is, at the end of the period within which notice of appeal may be given or on the final determination or abandonment of proceedings on appeal.

Clause 105 of the Bill provides that where there is more than one interested person to which an application under clause 100 of the Bill relates, the court may direct that the infringing goods, material or object be sold or dealt with, and the proceedings divided and make any other order that the court thinks fit. Where the court orders that no order should be made under clause 100 of the Bill, the person who possessed or controlled the infringing goods, material or object before being delivered up, is entitled to their return as provided for under clause 106 of the Bill.

Clause 107 of the Bill prohibits any proceeding to commence for any offence under clauses 109 to 113 of the Bill committed before the actual date of registration of a trademark.

Clause 108 of the Bill provides for the liability of directors and every person in management of a body corporate that is guilty of an offence if it is proved that the act that constituted the offence took place with the authority or consent of the director or officer in management and that he or she knew or could reasonably have known that the offence was to be or being committed and did not take reasonable steps to prevent or stop the offence.

Clause 109 of the Bill provides that it is an offence to counterfeit a registered trademark.

Clause 110 of the Bill provides that it is an offence to falsely apply a registered trademark to goods or services.

Clause 111 of the Bill provides that it is an offence to make an object specifically designed or adapted for making copies of a registered trademark or a sign likely to be mistaken for a trademark with the intention that the object be used to commit an offence.

Clause 112 of the Bill provides that it is an offence to possess or control an object made or adapted specifically for making copies of a registered trademark.

Clause 113 of the Bill provides that it is an offence to import or sell goods with a falsely applied registered trademark.

Clause 114 of the Bill provides for the collective penalties for offences under clauses 109, 110, 111, 112 and 113 of the Bill respectively.

Clause 115 of the Bill provides that the court may order that the goods or object be delivered up to the owner of the registered trademark or to any other person the court directs in any proceedings under clauses 111 to 113 of the Bill.

Clause 116 of the Bill provides for when the delivery up of goods may be made that is, under clause 115 by the court of its own motion or on an application of the prosecution, whether or not the person is convicted of the offence. Clause 116 further provides that an order may not be made if it appears to the court unlikely that an order will be made under clause 117 of the Bill. Where the person to whom goods or objects are delivered up under an order under clause 115 of the Bill, the person must then retain the goods or objects until the making or not making of, an order under clause 117 of the Bill.

Clause 117 of the Bill provides that an application may be made for an order that the goods or object delivered up under an order made under clause 115 of the Bill be forfeited to the owner of the registered trademark or destroyed or dealt with as the court thinks fit.

Clause 118 of the Bill lists what the court must consider when determining what order should be made.

Clause 119 of the Bill requires the court to issue directions for the service of notice on every person who has an interest in the goods or other object to which an application under clause 117 relates.

Clause 120 of the Bill grants every person who has an interest in the goods or other object applied for under clause 117 of the Bill the right to appear in proceedings for an order whether or not he or she is served with a notice and appeal against any order made, whether or not that person appears in the proceedings.

Clause 121 of the Bill provides for when an order under clause 117 of the Bill would take effect, that is, at the end of the period within which notice of appeal may be given or on the final determination or abandonment of proceedings on appeal.

Clause 122 of the Bill provides that where there is more than one interested person, the court may direct that the goods or other object be sold or dealt with otherwise, and the proceeds divided and make any other order that the court thinks fit.

Clause 123 of the Bill provides that where the court decides no order should be made under clause 117 of the Bill, the person who possessed or controlled the goods or other object before the goods or other object were delivered up, is entitled to its return.

Clause 124 of the Bill provides the definitions for the terms used in Part 4, Division 3, which pertains to border protection measures.

Clause 125 of the Bill empowers a rights holder of a trademark to apply to the Comptroller of the Fiji Revenue and Customs Service ('Service') to suspend the customs clearance of infringing goods.

Clause 126 of the Bill sets out the procedure for an application to suspend the customs clearance of infringing goods.

Clause 127 of the Bill empowers the Comptroller to suspend the customs clearance of infringing goods if covered by the grant of the application for suspension.

Clause 128 of the Bill mandates the applicant to institute proceedings on the merits of the applicant's claim before the court and sets out the procedure for such process.

Clause 129 of the Bill empowers the Comptroller to suspend the customs clearance of goods on his or her own initiative if the Comptroller has prima facie evidence that the goods are infringing goods or there are reasonable grounds to suspect so.

Clause 130 of the Bill provides for the disposal of infringing goods.

Clause 131 of the Bill indemnifies the Comptroller and the Service from the liability for any action taken or not taken in good faith in respect of the release or suspension of release into free circulation of infringing goods.

Clause 132 of the Bill provides clarity as to where a person may apply to determine matters in question in relation to trademarks. If a person decides to take action and where concerning a trademark in question that is pending, the person must apply to the court, and in any other case, apply to the Commissioner who may determine the matter or refer the application to the court.

Clause 133 of the Bill provides that where relief sought in a legal proceeding is to have the register altered or corrected, or the registered trademark altered, revoked or invalidated, the Commissioner has the right to appear and be heard, or make an appearance if directed by the court. If not directed so by the court, the Commissioner may give the court a written and signed statement outlining inter alia the issues, grounds for his or her decision and the practice of FIPO.

Clause 134 of the Bill provides that evidence in any proceeding under the Bill must be given by affidavit or statutory declaration in the absence of any directions stating otherwise. Clause 134 of the Bill also allows the Commissioner to take oral evidence or permit a person to be cross-examined on his or her affidavit or declaration. Clause 134 of the Bill further empowers the Commissioner to administer oaths to any witness and

require any witness to attend such proceedings as well as the discovery and production of documents.

Clause 135 of the Bill provides that a certificate signed by the Commissioner certifying whether an entry has or has not been done as empowered under the Bill is prima facie evidence of certified matters. The Commissioner is also empowered under clause 135 of the Bill to certify a copy of an entry in the register upon payment of a prescribed fee. Furthermore, a notification of any action or performance of a function or exercise of a power that the Commissioner is authorised to do, is prima facie evidence of the lawful action, exercise of power or performance of function.

Clause 136 of the Bill states that the fact that a person is registered as owner of a trademark is prima facie evidence of the validity of the original registration of the trademark and of subsequent assignments and transmissions.

Clause 137 of the Bill prohibits any document or instrument that is not entered in the register from being produced as evidence in court as proof of ownership of a trademark except for an application made under clause 70 or 144 of the Bill or where the court directs otherwise.

Clause 138 of the Bill mandates the Commissioner or the court to admit evidence of the usage of the trade concerned and any relevant trademark or trade name or get-up legitimately used by other persons in an action or proceeding relating to a trademark or trade name.

Clause 139 of the Bill provides that where the registration of a registered trademark is questioned in a legal proceeding, the court may certify a decision that is in favour of the owner of the trademark. Clause 139 of the Bill further provides that where the owner who obtains final order or judgment in his or her favour in a later legal proceeding in which registration of the trademark is questioned, he or she is entitled to full costs, charges and expenses if the court has already certified a decision in his or her favour and the court does not certify that the owner is not entitled to those costs, charges and expenses.

Clause 140 of the Bill provides for costs of proceedings that are before the Commissioner where the Commissioner may by order, award and direct how costs are to be paid and to whom as the Commissioner considers reasonable. An order made for costs may be entered as a judgment of the court and with leave of the court, enforced.

Clause 141 of the Bill provides that where a party to any legal proceedings does not reside or carry on business in Fiji, the Commissioner or the court may require the person to provide security for costs of the proceedings. Where such an order is not complied with, the Commissioner or the court may treat the proceedings as being abandoned by the person and may proceed to determine the matter.

Clause 142 of the Bill provides that the Commissioner cannot award costs to or against any party on an appeal to the Commissioner against refusal of the owner of a certification trademark to certify goods or services or to authorise the use of the trademark, as the Commissioner does not have jurisdiction despite clause 141 of the Bill.

Clause 143 of the Bill gives the court the discretion to determine the costs of the Commissioner in all court proceedings.

Clause 144 of the Bill allows a person to appeal a Commissioner's decision to the court if aggrieved by such a decision. The person is required to file a notice of appeal in court which must be then be served on the Commissioner within 20 working days after the day on which the decision in question was given. This is provided for under clause 145 of the Bill.

Clause 146 of the Bill provides that a court must hear both the parties and the Commissioner in an appeal on materials stated by the Commissioner unless a party brings further material in the prescribed manner or with the leave of the court. Where the appeal is against the acceptance of an application or the registration of a trademark, further grounds of objection by the opponent may be permitted only by leave of the court in which case, the applicant's application may be withdrawn without payment of costs of the opponent on giving notice.

Clause 147 of the Bill provides what the court may do in determining an appeal including the confirmation, modification or reversal of the Commissioner's decision and any part of it, and the modification of a proposed trademark without substantially affecting its identity.

Clause 148 of the Bill provides that a decision to which an appeal relates remains in force until an appeal is determined or as the court orders otherwise.

Clause 149 of the Bill provides that the Solicitor-General is to perform the functions of the Commissioner for the purposes of the Act.

Clause 150 of the Bill provides for the functions of the Commissioner.

Clause 151 of the Bill allows the Commissioner to delegate in writing any of the Commissioner's functions, duties and powers, except the power to further delegate. A delegation may be subject to any restriction and condition that the Commissioner thinks and may in writing, be revoked at any time and does not prevent the Commissioner from performing a function or duty, or exercising a power.

Clause 152 of the Bill provides that the Commissioner or any person acting on the Commissioner's behalf is not liable for any act or omission.

Clause 153 of the Bill ensures that the Commissioner gives a person an opportunity to be heard before exercising any discretionary power under the Bill or regulations adversely to the person.

Clause 154 of the Bill requires the Commissioner to ensure that a register of trademarks registered in Fiji is kept in Fiji and accordingly kept in a manner that the Commissioner thinks fit including by means of a device or facility that records or stores information, and permits such information to be readily inspected or reproduced in usable form. Clause 154 of the Bill further provides that the register is prima facie evidence of any matter required or authorised by or under the Bill.

Clause 155 of the Bill provides for what the register must contain which includes all registered trademarks with the names and addresses of the owners of these trademarks, the actual date of registration, any assignment, transmissions and conditions, and any other prescribed matter.

Clause 156 of the Bill clarifies that no notice of any trust is to be entered in the register and that the Commissioner is not affected such notice.

Clause 157 of the Bill provides that a person may search the register, upon payment of the prescribed fee when the office of the Commissioner is open to the public for business as well as at any other time that the Commissioner 78 allows. Clause 157 of the Bill also provides that a person is able to obtain a certified copy of an entry in the register upon payment of the prescribed fee.

Clause 158 of the Bill provides that it is an offence to make a false entry in the register and any person convicted of the offence is liable to imprisonment not exceeding 2 years.

Clause 159 of the Bill provides that it is an offence to falsely represent a trademark registered in Fiji and any person convicted of the offence is liable to a fine not exceeding \$1,000.

Clause 160 of the Bill provides that no person is entitled to compensation from the State for the diminution or reduction of rights attached to a trademark that may arise by virtue of the Bill.

Clause 161 of the Bill provides for the opening hours of FIPO as fixed by the Commissioner in addition to when FIPO may be closed as declared by the Commissioner. The Commissioner accordingly must publicly notify the opening hours and any closure beforehand. Clause 161 of the Bill further provides that where something must or may be done on a day or time when FIPO is not opened, it may be done on the next opening day of the office.

Clause 162 of the Bill allows the Commissioner to declare FIPO closed without giving public notice in the case of an emergency or where it is not practicable to make a prior publication. However, public notification must be given as soon as practicable after closure of the office.

Clause 163 of the Bill allows a person's authorised agent to do anything required under the Bill on behalf of the person provided the agent is not part of a prescribed class of persons under the Bill.

Clause 164 of the Bill provides for the substitution of persons other than the applicant generally if the right or interest to file the application becomes vested in another person and he or she notifies the Commissioner in writing that the right or interest has vested in him or her, and does not withdraw the application.

Clause 165 of the Bill provides for the substitution of persons on a notice of opposition to an application under clause 41 of the Bill if notice that the right or interest to give

notice has been vested in another person and he or she has notified the Commissioner in writing that the right or interest has vested in him or her, and does not withdraw the opposition.

Clause 166 of the Bill allows the Commissioner to amend an application other than an application for registration of a trademark, notice or other document under the Bill at the written request of the person making the application or filing a notice or other document or the person's agent. The amendment however would be to correct a clerical error or obvious mistake and where the Commissioner thinks it fair and reasonable to make amendments.

Clause 167 of the Bill provides for fees under the Bill and where any sum is paid to the Commissioner by mistake or not required under the Bill, the sum may be refunded by the Commissioner out of public money without further appropriation than the Bill.

Clause 168 of the Bill provides that clause 169 of the Bill does not apply to those notices or documents served or given in any court proceedings or where there is another specific procedure provided for under the Bill.

Clause 169 of the Bill provides the ways in which a notice or any other document can be served under the Bill. Clause 169 of the Bill further provides that service by post must be treated as received by the recipient when it would be delivered in the ordinary course of post and service by e-mail must be treated as received by the recipient when the e-mail becomes capable of being received. Where a person is deceased, the notice or other document may be served on the deceased's person's personal representative.

Clause 170 of the Bill empowers the Minister to make regulations to give effect to the provisions of the Bill and prescribe matters that are required or permitted by the Bill to be so prescribed, and to achieve the general purpose of the Bill. Clause 170 of the Bill also includes a list of what matters may specifically be prescribed by regulations.

Clause 171 of the Bill repeals the Acts and their subsidiary legislation.

Clause 172 provides for transitional provisions.

2.3 Evidence received via public consultation

As part of the review, the Committee conducted public consultation on the Bill, in various key locations in Fiji and also called for written submissions from interested individuals or entities. This consultation ensured that the public participated in the legislative process, which is fundamental to democracy. All the submissions received were considered and deliberated on extensively. The main points and issues noted from the submissions are summarised below.

Members of the public commended and supported the introduction of the Bill given that it aims to promote economic development by putting in place a modern business regulatory framework.

Apart from this commendations from the members of the public, there were also a written submissions, which highlighted a few pertinent issues, which the Committee placed reasonable emphasis on.

To begin with, certain submissions noted that in regards to the interpretation clause of the Bill, the following were recommended by the submitters:

- That various interpretations and references need to be amended.
- Definition of “applicant” in cases of assignment referring to s74 does not make sense because Clause 74 refers to advertisement of alteration of rules. Assignments are dealt with in Clause 75 therefore amend “74” to “75”.

Comments were also made in regards to the Trademark Office Practice regarding Non-traditional Marks, the following was submitted by submitters:

- The definition of “sign” arguably is not exhaustive and allows for consideration of other signs. There is no explicit mention of aspects of packaging and there is no mention of holograms, motion, or position trademarks. It was recommended that specific inclusion or interpretation of “sign” to include these types of non-traditional marks. Additionally, the requirement that a trademark be capable of graphical representation may impose a burden on applicants seeking registration of certain non-traditional trademarks. The examination guidelines to be issued by the Fiji IP Office should address these concerns and adopt global best-practices for examination of non-traditional marks.

Additionally, it was submitted that:

- In the definition of “applicant” and “application” that the word “of” replace the word “if” wherever it appears in the provision.
- The definition of “convention country” appears too broad. The NZ approach of allowing convention countries to be declared for particular provisions may be better.
- The definition of “Nice Agreement” does not include the words “as amended from time to time” which suggests that only the text of the Agreement as at the date the Bill comes into effect applies. (cp. definition of Madrid Protocol which says as amended from time to time) This seems inconsistent with the ambulatory definition of “Nice Classification.
- The definition of “TRIPS Agreement” and “WTO Agreement do not include the words “as amended from time to time” which suggests that only the text of the Agreements as at the date the Act comes into effect applies.
- There is no provision that “the Act binds the State”. There should be one. Trade mark owners should have remedies against the State and statutory bodies for infringement.

Furthermore, submission received also noted the following:

- Clause 2(1) - This Clause defines a “sign” to include “a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word,” and “any combination of signs.” This definition includes smell, sound, and taste, which are not visually perceptible. However, the definitions of the terms “certification trademark,” “collective trademark,” and “trademark” in the same Clause include the wording “a sign capable of... being represented graphically.” This definition appears to contradict the registrability of non-visually perceptible trademarks, which may not have a graphic representation. Can Fiji explain this discrepancy? If a graphic representation is required for all marks, would a written

description of a non-visually perceptible sign, such as a smell or scent, sound, or taste, which functions as a trademark satisfy the requirement of “capable of... being represented graphically” under Fiji’s draft law? The United States recommends that the draft law allow for non-visually perceptible signs that function as trademarks to be eligible for registration and that Fiji allow for written descriptions of such trademarks to satisfy the graphic representation requirement. The United States believes that businesses are best positioned to select what identifies their source to consumers and if nonvisually perceptible trademarks function as source indicators, the United States believes that such trademarks should be eligible for trademark protection. In the alternative, the United States recommends striking the requirement for graphical representation from the definitions of “certification trademark,” “collective trademark,” and “trademark,” to allow non-visually perceptible signs to be eligible for protection in Fiji.

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

There were comments on Clause 6 of the Bill, whereby the exclusive right of an owner to give receipts for an assignment or transmission (which is in the NZ Trademarks Act) has not been included.

The submission also highlighted Clause 12, specifically in regards to subclause 12(2), which is said to be ungrammatical and unclear in its meaning. The first limb relating to the word “Fiji” appears clear but what the rest of the provision sets out to achieve is uncertain. The explanatory note saying that the provision relates only to the word “Fiji” is not consistent with the actual words of the subclause. It is unclear whether “words implying geographic origins” means origin in Fiji or origin in any part of the world and what kinds of words are in issue. It is unclear why a company should not be able to register their registered name or trading name as this may well be their trade mark. What the words relating to disclaimers are supposed to mean, is unclear especially as the rules around ‘disclaimers’ in the current Act will not be carried over to the new Act.

Also, the submission noted that Clause 12 refers to “absolute grounds” to refuse a trade mark registration (Clause 12 (1)), yet it can be approved by the minister subject to conditions (Clause 12 (3)). So they are not *absolute* grounds – the Minister can overrule the commissioner.

- If the Commissioner disapproves (Clause 12 (1)) but the Minister can approve – what are the procedures to get the Minister to review (Clause 12(3))? Is it an appeal? What (if any) is the Time period?
- The Clause contradicts Clause 144, which says that all decisions of the Commissioner under the Act can be appealed to court.
- All decisions made by the minister under Clause 12 is final and cannot be reviewed by a court of law. The submitter queried why such a Clause was included and that

such provisions will mean wide powers given to the Minister who will not be required to meet any legal standard etc.

- The Bill does not provide a definition of what “words implying geographic origins” constitute – does it mean of origin in Fiji only or origin in any part of the world and does constitute to imply origin.
- The Bill also does not provide a reason why an applicant cannot register their trading name or company name – some trade marks a company or trading names presented in a special manner e.g. the “Apple” brand.

It was also noted that Clause 12(1) indicates absolute grounds for refusing registration, and subpart (1)(2) indicates that signs that “is contrary to any written law or would otherwise be disentitled to protection in any court,” are not registerable in Fiji (emphasis added). The submitter queried whether the phrase “would otherwise be disentitled to protection in any court” intended to capture common law in Fiji that is not yet codified by statute or regulation.

Clause 12(2); This Clause prevents registration of the term “Fiji” unless approved by the Minister. This Clause appears to contradict Clause 14(1)(c), which notes that geographic terms will not be denied registration if they can show the terms have acquired distinctiveness as a trademark under Clause 14(2). Therefore a sentiment was raised as follows; since “Fiji” is a geographic term, can Fiji clarify how these provisions work together?

Clause 12(3); This Clause indicates conditions on when approval from the Minister for registration of the term “Fiji” would be granted. One of the reasons listed is that “the mark complies and is in accordance generally with approved marks and brands recognised and licensed in accordance with written laws.” The submitter sought clarification on what would qualify as being “in accordance generally with approved marks and brands recognised and licensed in accordance with written laws”?

In regards to Clause 12(4); a submission was received from the Office of the Trade Representative of the United States of America. The submission applauds Fiji for including a refusal for applications made in bad faith. The United States would be interested in exchanging information with Fiji regarding the implementation of laws to address trademark applications filed in bad faith.

Also, Clause 12 (1)(c) prohibits the registration of a trademark that in the opinion of the Commissioner may offend a significant Clause of the community. It was recommended that an advisory committee is set up to review applications and determine whether it will offend Clauses of the community. This relates to traditional knowledge/issues, religious issues. The Committee to be made up of a fair representation of members of the communities. It was also recommended that an additional clause be inserted to provide for local address for filing and/or services. Prevents registry from incurring costs to send certificates overseas. Prevents local parties for applying to Court for overseas services in terms of proceedings etc.

There was submission raising concern regarding Clause 13 and other Clauses of the Bill, which provides that decisions by the Minister are final. It was noted that, Clause 25 requires goods and services to be filed according to the Nice Classification and any issue

arising from the classification may be determined by the Commissioner and such decision is final. The Registry procedures concerning the acquisition or maintenance of trademark rights (including procedures for opposition, revocation and cancellation whether inter partes or ex officio) should be fair and equitable. The procedures should not be unnecessarily complicated or costly or entail unreasonable time limits or unwarranted delays. Decisions of the minister under Clause 12 is final and cannot be challenged in any court of law. According to the explanatory notes of the Bill – Clause 13 only relates to decisions of the Minister regarding the use of the word “Fiji”.

- This is misleading because Clause 12 decisions and Clause 13 are not limited to the use of the word “Fiji”.
- Laws should not prevent anyone from challenging the decisions of public officers including Ministers.

A decision of the Minister under section 12 is final and cannot be challenged in any court of law. The inability to challenge the decision of the Minister appears to infringe s.16 of the **Fiji Constitution** which applies to laws passed after 2013. It is also not desirable that an applicant should not be able to seek redress. Although this provision is in our current **Trade Marks Act**, the **Constitution** does not apply to that Act.

Additionally, submitters also submitted that in Clause 13, it makes it clear that the decision of the Minister under Clause 12(2), (3) or (4) cannot be appealed. But Clause 12(4) grants a power to the Commissioner to refuse the registration of a mark if the application is made in bad faith. The Clause wrongly protects refusals by the Minister on the grounds of bad faith made under Clause 12(4). It is the Commission not the Minister who may refuse bad faith applications under that Clause. The Minister does not make any decision under Clause 12(4).

It was also suggested that Clause 13 be limited to decisions of the Minister under Clause 12(2) and (3). Decisions on the merits of a case should be in writing and reasoned and made available to those directly affected by the decision without undue delay. Such decisions should be based only on evidence in respect of which parties have been offered the opportunity to be heard. Such decisions should be subject to review by a judicial or quasi-judicial authority.

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

Submission also commented on Clause 14(1)(d) - This Clause includes a refusal for trademark applications consisting only of “signs or indications that have become customary in the current language or in the bona fide and established practices of trade.” The submitter queried whether Fiji explain the purpose of the wording “in the current language” and whether this means that the sign is currently in customary use in Fiji.

Submitters queried about Clause 15(1) – and whether this Clause is intended to apply to marks solely consisting of colour?

Comments were received on Clause 17, whereby this Clause indicates that a trademark containing the words “copyright,” “layout design,” “patent,” “patented,” “plant variety right,” “registered,” “registered design,” or “trademark,” “or any abbreviations of those words, or any similar words,” may be registered. It was queried whether Fiji intends to include a “condition,” as defined by Clause 2(1), in the registration certificate to clarify that it does not grant rights to the trademark owner as to these words.

It was noted that Clause 18 requires consent if the name of a person appears in the trademark. The submission received from the Office of the Trade Representatives of the United States supports the inclusion of such a provision. The Clause notes that consent is not required if the person has been deceased more than ten years. It was also queried whether there are provisions of the law that provide protection for names of famous deceased persons (e.g. “Elvis Presley”), which may have an estate still managing use of their name. The submitter commented about how Fiji will implement Clause 12(4), which allows for refusal of applications in bad faith, to refuse registration in such circumstances?

There was also submission on Clause 20, which states:

“The commissioner must register trademark A if –

(a) the owner of trademark B, trademark C, or trademark D (as the case may require) consents to the registration of trademark A; or

(b) the Commissioner or the court, as the case may be, considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Commissioner or the court, makes it proper for the trademark to be registered subject to any conditions that the Commissioner or the court may impose.”

In Australia, a similar provision includes ‘prior use’ as a ground the Registrar can rely on to allow a mark to progress to registration. In New Zealand, we understand the legislature is considering introducing a similar ground to the provision. It was recommended by the submitter that the Bill allow ‘prior use’ as a ground the Commissioner can rely on to allow a mark to progress to registration under this Clause.

Additionally, Clause 20(b) - This Clause provides that the Commissioner or the court must register a trademark if the Commissioner or the court “considers that a case of honest concurrent use exists, or other special circumstances exist, that, in the opinion of the Commissioner or the court, makes it proper for the trademark to be registered subject to any conditions that the Commissioner or the court may impose.” The phrase “or other special circumstances exist” is very broad. The submitter sought clarification on the specific types of special circumstances that would be encompassed by the aforementioned phrase.

It was noted that Clause 22(a) allows for the use of a flag in a mark without authorization if the “use of the flag in the manner proposed is permitted without that authorisation.” The submitter sought clarification on the circumstances under which, registration of a flag would be permitted. It was noted that in the United States of America, registration will be refused if the design sought to be registered includes a true representation of the flag of the United States, any state, municipality, or foreign nation, or is a simulation thereof. The United States does not accept authorizations as a way to overcome this

refusal to register. A refusal must be issued if the design would be perceived by the public as a flag, regardless of whether other matter appears with or on the flag. However, registration may be permitted if the flag is highly stylized or incomplete.

Comments were put forward regarding Clause 25, which requires that goods and services are to be filed according to the Nice Classification. Any issue arising from the classification or which class is appropriate may be determined by the Commissioner and such decision is final. This may be in breach of s.16 of the *Constitution*. Submitters noted that from previous applications – what constitutes the right class is based on interpretation of the registry and not law. If the registry directs goods to be filed in wrong class then who is liable when there is an issue of infringement against client’s trademark but the court ruled that the client is not protected because due to the decision of the registry, the client’s trademark is not registered in the relevant class? Any decision of a public officer should be subjected to challenge in a court of law.

In regards to Clause 26; submission was received from the Office of the Trade Representative of the United States of America, which applauds Clause 26(2), but also noted that trademarks should be in actual use or filed with intent to actually use the mark.

In regards to Clause 28(3) - it was noted that this provision provides that “[f]or purposes of subclause (2), two or more applications that are received on the same day are to be treated as if they had been received at the same time.” As the Fiji trademark office grows and receives additional filings, the ability to designate priority may become more important. As such, the submission from the Office of the Trade Representative of the United States recommends implementing a system that would give priority to the earlier received application. The submission also highlighted the willingness of the submitter in further discussions on U.S.A practice with respect to handling priority of trademark applications. Additionally, Clause 28, deals with priorities of applications for identical or similar marks that first come first serve. Submitters recommend that regulations should allow for scanned documents to be filed for earlier filing date and originals to be filed later upon receipt by mail/courier. This will cater for overseas applicants as well.

It was noted that Clause 36 provides that the Registry may revoke acceptance if acceptance was issued by error of the registry. Once an application is accepted, the applicant incurs costs to advertise the application for opposition (Clause 40). If the registry revokes acceptance due to its own error – it should refund costs of advertisement and/or application fees etc. Alternatively, the law must make it mandatory that it’s the registry and not the applicant that takes steps to advertise the application and also pay for it.

In regard to Clause 40; this Clause indicates that “[t]he Commissioner must ensure that an application that has been accepted is advertised in the prescribed manner, if any.” Read in concert with Clauses 41 et seq., it appears that this Clause intends to allow, but not mandate, pre-registration publication of the trademark for opposition. It was noted from the submission by the Office of the Trade Representative of the United States that Fiji is encouraged to provide for pre-registration publication of applied-for trademarks for opposition, which is permitted under TRIPS Clause 15(5). The United States also encourages Fiji to make these publications after the Commissioner has completed its review of the applications, through an official channel easily accessible by the public and

preferably online. Further, the United States encourages Fiji to provide a reasonable time period for parties to bring oppositions after the mark is published and to include this information in its law or implementing regulation.

Additionally, Clause 40 provides that the Commissioner must ensure that applications are advertised. Presently, applicants are required to be advertised. If this arrangement is to be continued, the provision should be amended to say that if an application is accepted, the Commissioner must direct the applicant to advertise it in the prescribed way and the applicant must comply.

In regard to Clause 41; it was noted that this Clause addresses opposition to accepted trademark applications. It was queried whether under the Clause, does a “person” include both legal and natural persons. Additionally, it was queried whether any legal or natural person may bring an opposition proceeding, or whether there is a requirement for them to have an interest or standing. There was also a query on whether Fiji has plans to specify the possible grounds for opposition in its law or implementing regulations? Moreover, it was recommended by the submitter that these grounds include those which are set forth in *Division 2 - Absolute grounds for not registering trademark* and *Division 3 - Relative grounds for not registering trademark*.

In regard to Clause 43, it was noted that this Clause outlines certain steps the Commissioner must take in making an opposition determination. And it was queried as to what instances the Commissioner would be required to hear the parties. For instance, if a party requests a hearing with the Commissioner, must the Commissioner hear the parties?

In regard to Clause 44, it was noted that the Commissioner must not register a trade mark until 6 months after the date of application. Current applications may remain pending for over 2 years without any notice or update from the registry. The submitter suggested that the proposed law must include a provision of timelines in which the registry or commissioner must act. Under the Trade Marks Act 1933 (“the current Act”), there is a general provision that applications for registration must be completed within 12 months from date of application and any delay on the part of the applicant may make the application deemed abandoned.

Additionally, it was submitted that Clause 44 should also be amended to expressly require advertisement to have taken place before the Commissioner is empowered to register the trade mark.

Comments were made regarding Clause 53 and 54, noting that these provisions make it mandatory for the Fiji Intellectual Property Office (‘**FIPO**’) to issue renewal notices 6 months before expiry and requires the mark to be removed after a grace period for 6 months. The current Act has a similar provision requiring renewal notices but FIPO does not send these. This is not currently a problem as the marks are left on the register and FIPO will accept very late renewal applications. It will be a problem under the Bill which limits the grace period to 6 months. It was suggested that there should be amendments to subclauses (3) and (6) recognising that the renewal notice may be sent later than 6 months before expiry and only allowing the mark to be removed 6 months after the Commissioner has actually sent the notice. Without this, marks will be removed without

FIPO having notified owners of the need to renew. Clause 54 should be amended also to provide for this.

In regard to Clause 56, which addresses the cancellation or alteration of a trademark; it was queried whether the word “person” applies to both natural and legal persons.

In regard Clauses 57 and 58, there was a submission received whereby it was recommended that the cancellation grounds included in Clause 60(1)(a),(b), and (c) be added to the grounds for cancellation of certification and collective trademarks, including lack of use during a continuous period of five years or more, the certification trademark or collective trademark has become a common name, or the certification or collective trademark is likely to deceive the public as to the nature, quality, or geographical origin of those goods or services.

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

In regard to Clauses 63-66; it was queried whether Fiji’s trademark Commissioner will require applicants to disclaim non-distinctive portions of trademarks, certification trademarks, and/or collective trademarks in the course of examination of the application prior to publication. Is the requirement for a disclaimer limited to the “grounds specified in Clause 60(1)(b) or (c)”? It was also noted that the United States encourages Fiji to consider implementing a disclaimer requirement prior to publication, in which it requires applicants to disclaim non-distinctive matter in compound marks. Moreover, the submitter encouraged that these disclaimers be printed on the registration certificate and in the official record.

Currently the *Trade Marks Act* deems the registration of a trademark valid after 7 years. The NZ Act also specifies 7 years. The Bill reduces this to 5 years. This seems too short. The fact that 5 years applies for non-use does not mean that the same period should apply for deemed validity. Non-use must be based on what is a reasonable time for an owner to invest in use of a mark. Deemed validity must be based on what is a reasonable time for a person claiming to own the mark to find out about the registration by someone else.

It was noted that Clause 71 states that “[t]he owner of a registered trademark may not alter the registered trademark after its actual date of registration.” Thus it was queried, where Fiji’s draft law allows trademark applicants to amend the applied-for trademark after its filing date? The submitter suggests that the law not permit any material alterations to applied-for trademarks after the date of filing to create certainty for businesses.

It was noted that the purpose of Clause 88, which applies to medicines imported by the State, is unclear. The explanatory note does not match the Clause.

Comments were provided on Clauses 92, 93 and 94, whereby it was noted that a licensee of a registered trademark may request the registered owner to commence proceedings. If the registered owner refused to or neglects to commence proceeding within 2 months, then the licensee himself can commence action in its own name. If the licensee commences an action, then the registered owner will have to be named a defendant and may be liable for costs if the owner elects to defend. The submitter queried what the logic behind the provisions were. Consent is discretionary but licensee will still proceed. What if consent was withheld on reasonable grounds?

In regards to Clause 96(1)(b), it was noted that this Clause specifies that relief may include “either damages or account of profits”. It is noted that this Clause is limited by those terms. The Clause as presently written may not adequately compensate the right holder or put the right holder back in the position it would have been in had the infringement not occur. The submission recommends that “or” be replaced with “and” such that the right holder has the opportunity to recover both the infringer’s profits and the damages suffered by the right holder. Moreover, the submitter recommends specifying that courts have the authority to order the infringer to pay the right holder’s expenses, which may include appropriate attorney’s fees, as required by TRIPS Clause 45(2).

In regards to Clause 96(2), it was noted that this Clause states that the court may grant additional damages as the court requires in particular to “the flagrancy of the infringement” and “any benefit accruing to the defendant by reason of the infringement.” The inclusion of additional damages is a vital element in combatting large scale commercial infringement activity. The submitter recommends providing clarity to this Clause to provide maximum deterrence against infringers who knowingly, or with reasonable grounds to know, engage in infringing activity. For example, for wilful trademark counterfeiting, will Fiji consider incorporating treble damages for maximum deterrence and disruption of organized counterfeiting? For instance, in the United States, a court can enter a judgement for three times of profits or damages, whichever is greater, together with reasonable attorney’s fees.

In addition, to create an effective civil penalties regime with a view of deterring infringements, a submission recommended incorporating pre-established or statutory damages, at least for trademark counterfeiting violations. The election of pre-established damages is intended to provide ease and predictability in law to the right holder, as well as to provide notice to the public at large of the consequences of committing infringements. A common model for the establishment of statutory damages is a calculation on the basis of twice, or three times, the full price payable for the respective use of the infringed right. Some countries also fix a precise amount, or a margin, for the pre-established damages to be paid. In the United States for instance, in cases of trademark counterfeiting, a court may award statutory damages of not less than \$1,000 or more than \$200,000 per counterfeit mark per type of goods or services distributed. Upon a finding of wilfulness, statutory damages may be increased to \$2,000,000 per counterfeit mark per type of good or service.

In regard to Clause 107, submitters queried about the offence to counterfeit on a “*commercial scale*” and what does this mean – by quantity or by income etc.? It was

suggested that there is a need to define a minimum specific threshold. It was also recommended that consideration should be given to discretion in determining “commercial scale” given the realities that small consignments of counterfeits are sold via e-commerce and thus measures relying on quantity or value alone may be insufficient to properly identify this crime.

Clause 114 delineates penalties for counterfeiting offenses. Certain submitters recommended including enhanced penalties for repeat offenders, which is a useful tool to combat organized counterfeit activities. It was also recommended that enhanced penalties for health and safety products should be imposed in order to create maximum deterrence for counterfeit products that harm average consumers and citizens.

In regard to Clauses 107-123; these provisions outline offences under the trademarks act and the penalties. It also provides the types of orders that the court may grant in criminal offences and the considerations for those orders. However, these Clauses do not make it clear who has the power to investigate offences. There is no provision for search, seizure and detention of goods in the market that are suspected to be infringing before prosecution. Such provisions are vital. This is a gap that has led to confusion in the enforcement of the **Copyright Act**.

Additionally, there are similar provisions in the NZ Trade-Marks Act but the NZ Act goes further and appoints “Enforcement Enforcers” and their functions which include gathering and investigating complaints of offences – the NZ Act also outlines the powers of the police in relation to the offence under their Trade Mark Act (S134A-S134ZF). Fiji’s Bill has omitted these Clauses and there is no reference as to who has the investigation, prosecution and enforcement powers.

There were comments on Clause 124, whereby it was noted that the effect of the definition of ‘rights holder’ is unclear. It is used interchangeably with ‘applicant’ which is defined in Clause 2. Are these just trade mark owners and licensees or do they include owners of other IP rights (which seems inconsistent with some of the other provisions). This should refer to just owners and licensees. It is unclear why only an exclusive licensee may act. Owners may have different licensees in different jurisdictions any of whom may want to act.

Comments were submitted regarding Clause 125, noting that any rights owner may apply to the Comptroller to seize goods at the border that are suspected to be infringing goods. There appears no provision for watch notices. This means that the onus is on the rights owner to file an application for seizure. Problems that arise from this is time and that owners may not even know that infringing goods (counterfeit goods) are being imported into Fiji. In other case, the rights owner may file an application but the goods already have been released from FRCS’s possession. It was suggested by the submitter that there should be provision for this as owners are unlikely to have prior notice of incoming infringing goods.

It was also noted that Clause 125 is not clear whether notice by rights owner refers to any shipments during a specific period of time or a specific shipment or can mean both. Additionally, Clause 129 provides powers to FRCS to seize goods at its own discretion

that is suspected of being infringing goods. Once seized, they then contact the rights owner and see if the rights owner has any issue.

As a consequence of the above, certain submitters recommend that FRCS set up a register where right owners can register themselves for a fee (e.g. annual fee) to request FRCS to carry out border watch on their behalf and alert rights owner of any suspicious cargos. Rights owners have to provide evidence of TM registration in order to be placed on the register.

Clause 126 (8) provides that Custom may refuse to seize goods unless rights owner provide sufficient security to indemnify FRCS against any liability. This will discourage brand owners and will take up time considering the fast pace of the commercial world. The proposed law should simply provide that FRCS is immune to any liability for duly performing its duties under the Act and when acting in good faith. If FRCS abuse power, malice or negligence and act outside the scope of the Act then FRCS itself should pay liability and not the brand owner. Clause 152 – the Commissioner or anyone acting on behalf of the Commissioner cannot be personally liable for any act or omission if done in good faith in accordance with the Act. It was also queried why a similar provision is not included for FRCS.

Clause 127 makes it mandatory for FRCS to suspend clearance of good if it is satisfied that the importing goods are infringing goods. Clause 127 is not subject to Clause 126 (8) so even if FRCS require security, they will have to suspend clearance if it is satisfied that the goods are infringing goods. The submitter queried about the period of suspension; whether it is 10 working days as implied from Clause 128 (2)(b).

In Clauses 125-129; Words “rights holder” and “applicant” are used inter changeably. The submission queried whether the words refer to same party? Clause 131 (1) implies that they are different therefore need to clarify this to avoid confusion.

Clause 129 gives discretion to FRCS to seize goods on its own initiative if FRCS have prima facie evidence or reasonable grounds that goods are infringing. Once seized, Clause 127 and 128 applies accordingly. Those Clauses relate to applicants and applications. It is unclear who the Comptroller will treat as an applicant in the absence of an application.

Clause 129 also requires FRCS to immediately inform the owner of the rights (Clause 129 jumps to Clause 128 and 129). However, how would FRCS know the place of service of the rights owner? What happens if FRCS is not able to serve the Notice because it does not know the owner or place of service of the owner? It is a matter of making FRCS carry out this function but it is highly doubtful they will. Recommend the introduction of a register where rights owner can register themselves in providing details of their place of service in Fiji, the details of their registrations.

Clause 145 provides that an appeal under Clause 136 must be filed in Court and served on the Commissioner within 20 working days. It was highlighted that the reference to Clause 136 is wrong. Clause 136 also deals with registration being a prima facie evidence of validity so Clause 145 does not make sense. This period of 4 weeks is very short given

the fact that letters from FIPO are often delivered after the date of the letter and owners are often offshore and have to liaise with local lawyers for documentation and evidence.

Clause 145 will make sense if it refers to Clause 144 which deals with appeals of decisions of the Commissioner made under the Act and not Clause 136. Clause 149 provides that the Solicitor-General (SG) is to be the Commissioner of Trade Marks by law and it was argued that the SG has many other more important responsibilities. This should be amended to be flexible to allow the option of a full time Commissioner being appointed.

Clause 149, provides that the Solicitor General is the Commissioner of Trade Marks. This is the same as the current system where the *Trade-Marks Act* was amended to omit the Office of the Administrator General and gave this function to the Office of the Solicitor General. Submitters have raised the point that since the amendment, the procedures and turnaround time for applications to be processed has taken longer. There is a need for a separate office of the Commissioner who can only consult the Office of the Solicitor General in contentious matters.

Clause 154, pertains to the keeping and maintaining of the register and it was suggested and encouraged by the submitter that the setting up of an electronic, searchable, public database of trademarks, collective marks, and certification marks. Additionally, it was queried whether Fiji has plans to create such a database.

It was noted that Clause 155 describes the contents of the register. Submission received from the Office of the Trade Representative of the United States recommended that Fiji to add “the goods and/or services for which the trademark, certification mark, or collective mark has been filed” to this list, as an accurate recitation of the goods and services provide vital notice to businesses seeking to register their marks.

Clauses 161 & 162 deals with the opening and closing hours of the Fiji Intellectual Property Office (‘FIPO’). While the Bill deals with the opening and closing hours and procedures of notifying closure, it does not provide how the Office fits into the Bill and Trade Mark Bill. The Bill does not provide the roles and function of FIPO. The Bill does not provide the powers of FIPO. Under the current procedure, filings are addressed to the Solicitor General but filings made at FIPO. While the current law stipulates that the Solicitor General is the governing office of the Trade Mark Act, decisions or directions are issued under the letter head of FIPO. It was recommended by submitters that the Bill provides details of the functions, powers and roles of FIPO. By providing clarification, readers of the Bill are not confused as to whose decision is to be appealed, and so forth.

Clause 166 states that “[t]he Commissioner may, at the written request of the person who has made an application, other than an application for the registration of a trademark, or filed a notice or other document for the purposes of this Act, or, at the written request of the person’s agent, amend the application, notice or document – (a) to correct a clerical error or an obvious mistake; or (b) if the Commissioner is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.” Subpart (b) appears to provide the Commissioner significant discretion in determining amendments. Thus a few queries were raised in regard to aforementioned, which include:

- what scenarios might be deemed “fair and reasonable in all the circumstances of the case”?
- does Fiji plan to provide further clarity and details through implementing regulations?
- does Fiji’s draft law allow certification trademark and collective trademark applicants the ability to amend the applied-for certification trademarks and/or applied-for collective trademark after application filing?

Submission also encouraged Fiji not to permit any material alterations to the applied-for certification trademark and/or applied-for collective trademarks to create greater business certainty. For certification marks, it was queried whether Fiji’s draft law permit applicants to amend their listing of goods or services certified, as submitted in the application, after the date of filing?

Submission also commented and encouraged that the law should permit the narrowing of the goods and services, and it is not recommended to permit any broadening of the scope of the goods and services identified in the application to create greater business certainty.

Clause 170 states that “[t]he Minister may make regulations to prescribe matters that are required or permitted by this Act...” The submitter queried whether Fiji envisions promulgating further regulations to implement this draft law, once it is passed?

It was also noted that most of the important provisions regarding the application of the Madrid System and the rules and procedure for the TMO are to be made in regulations. Regulations are often published in Fiji without consultation or prior notice, despite s.50(2) of the 2013 Constitution saying that “A person making any regulations or issuing any instrument having the force of law must, so far as practicable, provide reasonable opportunity for public participation in the development or review of the law before it is made”. It was recommended that s.170 specifically require a reasonable opportunity for public participation before they are made to allow interested parties to be heard.

The transitional provisions are inadequate. They do not make clear how the Bill will apply to existing registrations. (Compare the NZ transitional provisions in their ss.208 and 209). Clause 172 (1) provides that the *Fiji Trade-marks Act 1933* shall continue to apply for any application for registration, renewal, alteration, assignment or cancellation etc. received before the new TM Acts come into place. Clause 172 (2) – New Act does not invalidate any valid and current registrations. Clauses 172 (1) and (2) are vague. Once pending applications are approved, will they be deemed valid under the new Act? It was also queried whether existing registrations will be deemed valid under the new Act or will they continued to be renewed under the current Trade Marks Act every 10 or 14 years whichever is applicable?

A submitter queried on what happens to opposition proceedings that were and have been pending in Fiji for over a decade and still have not been heard, when the new Act comes into force. Existing registrations are based on the old British Imperial system. There is no provision regarding whether and how these registrations are to be segued into the new Nice Classifications including where additional classes may be involved. If the existing registrations are not to be reclassified, the Act should make provision for this. Some UK registrations which are based on the Nice classification have been split into more than

one Fijian registration. There should be provision allowing these to be amalgamated back into a single certificate.

Existing registrations are for one class only. The Bill provides for multi-class registrations. The Bill makes no provision for amalgamating existing registrations. Presumably each existing registration will continue separately. The Bill must also make transitional provision for UK-based trade marks which are currently registered as of right for the life of the UK mark and can be renewed for periods of 10 years.

Presently registrations may cover all goods in a class which is no longer permitted under the new Act. The Bill should make clear what happens to the existing class-wide registrations. Submitters suggested that there should be express provisions that existing registrations are not invalidated automatically but may be declared invalid under Clause 77, that the dates relating to existing registered trademarks continue to apply, that they may be revoked for non-use under this Act. There also needs to be provisions saying that existing registered associations between trademarks do not apply any more since that is not a concept under the new Bill but that existing registered disclaimers and conditions continue to apply.

There was a query on whether Fiji protects geographical indications through its trademark system. Additionally, from the submission noted that Fiji is encouraged to provide public access to trademark registries online and the ability to search the registry electronically and whether there are plans to host the registry on a public, searchable, electronic database.

The transitional provisions should be given further consideration. They do not make clear how the Bill will apply to existing registrations. As a reference, compare the New Zealand transitional provisions in the New Zealand Trade Mark Act Clauses 208 and 209. Existing registrations are based on the old British Imperial system. There is no provision regarding whether and how these registrations are to be segued into the new Nice Classifications including where additional classes may be involved. If the existing registrations are not to be reclassified, the Act should make provision for this.

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

The Bill makes no provision for the registration of licences. The Bill is based on the New Zealand Trademarks Act. In New Zealand, licensing was originally subject to registration. It was highlighted that that is not clear why New Zealand revoked those provisions and submitters wonder if these are applicable to Fiji.

Certain submitters, like the International Trademark Association strongly encourages Fiji to prevent the transshipment of counterfeit goods and protect the integrity of the global trading system by preventing criminal abuse of Fiji's ports through the transshipment of illegal counterfeit goods. It is believed that Fiji should intercept and seize counterfeit goods in transit without exemption. The practice hurts companies whose products are

being counterfeited and distributed within Fiji and abroad, not to mention any goods in transit that are re-imported from their destination countries back into the Fiji market.

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

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

The International Trademark Association also suggests that continuous training and capacity building for enforcement officials occur on a regular basis. Capacity building for officials on brand identification, Intellectual Property Rights (“IPR”) and IPR regulations could be helpful in connecting the public and private sectors and encourage information sharing between the two stakeholders. Continuous workshops and training sessions jointly conducted by rights holders in coordination with customs is crucial to ensure smooth and effective implementation of customs rules and regulations.

The International Trademark Association (“INTA”) welcomes amendments to streamline domestic and international coordination among law enforcement agencies and wishes to also highlight the importance of information sharing between brand owners and enforcement agencies to achieve effective brand protection. The formation of a national Intellectual Property Rights (“IPR”) coordination center would be strongly recommended for the consideration of the Fijian Government. INTA produced this guide for government seeking to implement such a body. The goal of the proposed office would be to establish a central coordination unit to fight against counterfeits, piracy, and other intellectual property crimes. Because of counterfeiting’s links to organized crime, money laundering, threats to public safety, etc., many agencies at the national level are looking at this type of crime in isolation without developing the expertise to tackle the complexities of the crime. The IPR center would be a singular unit of coordination between the different industries effected by these crimes, the governmental officials that work to stop it, and the targeted public.

A copy of the written submission received can be obtained from the online Appendices of this Report, which can be accessed via the parliament website: www.parliament.gov.fj.

2.4 Sustainable Development Goals/National Development Plan Impact Analysis

In reviewing the Bill, the Committee was mindful of the Bill's impact on Fiji's efforts in achieving the targets set out in the national development plan, which in turn contributes to Fiji's overall commitment and obligations towards the global agenda - the sustainable development goals.

As a starting point, the objectives of the Bill aims to define the scope of rights protected by registered trademarks, specify the procedures for registering trademarks in Fiji, deter counterfeit activity in relation to registered trademarks in Fiji; and ensure that Fiji's trademark regime takes account of international developments.

This objective relates to the ambitious development plan and goal by the Government of Fiji in reviewing and modernising the regulatory framework regarding the business sector,² which in turn is envisioned to develop the economy.

The Bill will bring about the necessary regulatory framework, which is envisioned to also boost business activities in Fiji.

The Committee was also mindful of the requirements of the Standing Orders of Parliament regarding gender, which is also a key goal in the sustainable development goals. The Committee ensured that full consideration will be given to the principle of gender equality so as to ensure all matters are considered with regard to the impact and benefit on both men and women equally. Despite the lack of gender-related information during the review, it is evident from the deliberations on the Clauses of the Bill that it was designed to impact all Fijians and the people living in Fiji, irrespective of gender.

² Fijian Government 5-Year & 20-Year National Development Plan, "*Mordernising the Business Regulatory Environment*", page 87.

3.0 KEY ISSUES IDENTIFIED

Nearing the completion stage of the review, the Committee identified a few key issues, which the Committee placed reasonable emphasis on and which the Committee believed, need legal clarification. The following are these key issues that were identified:

- That the Bill has various phrases and words that may need to be defined or may need changes to its definition;
- That the Bill has certain provisions, which were considered to be vague or ambiguous;
- That the Bill, as per the submissions received, needs to include provisions that provide for necessary matters such as:
 - Protection of clients, who would like to register a trademark, from decisions of public officers;
 - Allowance of flexibility so that scanned documents can be used for filing for registration of trademarks;
 - Refunds by the Registry, for costs of advertisements and/or application fees, if application is revoked;
 - Provision for timelines in which the Registry or the Commissioner must act after receiving an application;
 - That renewal notices are sent to owners of trademarks 6 months before expiry and that the protection of the trademark is only removed 6 months after the Commissioner has actually sent the notice;
 - That there is provision, which provides maximum deterrence against infringers who knowingly, or with reasonable grounds to know, engage in infringing activity;
 - That there are provisions that require border control authorities, such as the Fiji Revenue Customs Service, carry out border watches for infringing goods; and
- That the vesting of authority to the Solicitor-General in being the Commissioner for Trademarks, may result in practicability issues, specifically in terms of turnaround time for applications being processed.
- That there are provisions of the Bill that relate to ulster clauses, which remove the option for seeking redress against the decision of the Minister responsible for trademarks.

4.0 Outcome of Review

After extensive deliberation, the following outlines some of the main outcomes of the Committee's deliberation and review.

The Committee weighed all options concerning the issues that had been identified and had extensive discussions on these. Clarification was then sought on the implication of these issues from the legal team at the Solicitor-General's Office and the consultants from the World Intellectual Property Office, so as to ensure that all these relevant issues were appropriately addressed and that the objectives of the Bill were preserved.

Following the aforementioned discussions, the Committee again had extensive discussions on the issues raised from the review and came to a consensus on its stance on these. The Committee following provides details of Committee's view and stance on the issues.

In regards to the issue on various interpretations and references which were suggested to be amended, the Committee noted that there were indeed cross-referencing and drafting errors in the Bill. Also that certain definitions in the Bill are in line with international standards in that they mirror provisions of other jurisdictions, such as the NZ Trade Marks Act 2002 and the TRIPS Agreement.

In regard to the issue on the definition of "convention country" being too broad, the Committee had extensive discussions on these and agreed that this can be made clearer. However, it was recommended that an amendment to clause 170(d) would be more appropriate. This provision can be further clarified after "country" by inserting the words "for the purpose of giving effect to an international agreement or arrangement to which Fiji is a party or that applies to Fiji". This clarifies the purpose for which an entity may be prescribed as a convention country.

With regard to the definition of "Nice Agreement", "TRIPS Agreement" and "WTO Agreement" not including the words "as amended from time to time", the Committee agreed to amend the provisions accordingly.

In regard to the issue noted on Clause 2(1), the Committee was advised that this is incorrect and it is not a contradiction. The Committee was advised that the WIPO provides description of how scents, sounds and tastes are visually or graphically represented for the purposes of trademarks.

Scent: To obtain registration of a smell mark applicants must be able to visually represent the product's scent and must show it is distinctive from the product itself. A bottled sample of the smell for example would decay over time and could therefore not be kept on a trademark register. Any written description of a smell must be so precise that that particular smell would not be confused with any other.

Sound: In the case of sound marks, alternative methods have emerged for their visual representation: depictions by oscillogram, spectrum, spectrogram and sonogram are now being accepted. Such representations must be handled carefully in order to meet the requirements of individual trademark offices. In 2003, the Court of Justice of the

European Communities ruled in case no. C-283/01 that a trademark may only consist of a graphically represented sound – such as by images, lines or characters – and that its representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Taste: Taste marks may be easier to represent graphically – the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications reports that “the graphic representation requirement was satisfied by using a written description of the taste and an indication that it concerns a taste mark”

In regard to the issue on the definition and provisions relating to the term “person”, the Committee was advised that the Interpretation Act 1967 section 2 provides for the definition of “person” and is applicable across all laws:

In regard to non-inclusion of provision relating to exclusive right of an owner to give receipts for an assignment or transmission, the Committee was advised that this unnecessary. Although it is mentioned in section 10 of the NZ Trade Marks Act 2002 for the purposes of assignments or transmissions, there is no mention of receipts in sections 81 and 82 of the NZ Trade Marks Act 2002 on Assignment or in Part 16 of the NZ TM Regulations on Assignment. It does not appear to serve a specific legislative purpose.

In regards to the issue on Subclause 12(2) relating to the word “Fiji”, the Committee was advised that Clause 12(2) is currently section 14A of the Trade-Marks Act 1933. It is workable law, currently in force. However, the Committee after extensive discussions, agreed that it could be made clearer and thus it was recommended that paragraph (a) be deleted and substituted with the following—

“(a) the word “Fiji” or any word that makes reference to or implies approval from the State”

Thus as a consequence of the proposed change, it was also recommended that a new standalone provision be included to clearly address geographical indications, as follows:

“Trademark consisting of or containing a geographical indication

16.—(1) The registration of a trademark in respect of particular goods (relevant goods) may be opposed on the ground that the trademark contains or consists of a sign that is a geographical indication for goods (designated goods) originating in—

(a) a country, or in a region or locality in a country, other than the country in which the relevant goods originated; or

(b) a region or locality in the country in which the relevant goods originated other than the region or locality in which the relevant goods originated, if the relevant goods are similar to the designated goods or the use of a trademark in respect of the relevant goods would be likely to deceive or cause confusion.

(2) The registration of a trademark in respect of particular goods may be opposed on the ground that the trademark contains or consists of a sign that is a geographical indication in respect of a wine or spirit and the trademark will

be used in relation to a wine or spirit not originating from the place indicated in the geographical indication.

(3) Subsection (2) shall apply whether or not the trademark has or is accompanied by, an indication of the true geographical origin of the wine or spirit, as the case may be, or an expression such as “kind”, “type”, “style”, “imitation” or the like and irrespective of the language the geographical indication is expressed in that trademark.

(4) An opposition on a ground referred to in subsections (1) to (3) fails if the application was made in good faith or if the trademark has been used continuously in good faith in the course of trade by the applicant for its registration of his predecessor in title, either—

(a) before 14 January 1996; or

(b) before the geographical indication in question was protected in its country of origin;

(5) An opposition on a ground referred to in subsections (1) to (3) fails if the sign has ceased to be protected as a geographical indication for the designated goods in the country in which the designated goods originated, or has fallen into misuse in that country.”

In regard to the issue of a Company registering its registered name or trading name, the Committee was advised that the Bill does not state that a company cannot register their company name or trading name. The Bill requires the approval of the Minister for such registration. This is provided in the current Trade-Marks Act 1933.

In regard to the issue on the meaning of disclaimers, the Committee was advised that in relation to disclaimers, clause 12(2) simply provides that a disclaimer may only be permissible in relation to the use of the word Fiji and terms indicating geographic origin or an approval from the State, if the Minister approves such disclaimer. And that clauses 63 to 66 of the Bill set out a framework for disclaimers generally.

In respect of the issue regarding Clause 12 in reference to “absolute grounds”, the Committee was advised that if the Minister approves under clause 12(2), the Commissioner is only able to disapprove if the mark falls under one of the absolute grounds of refusal under clause 12(1). The decision of the Commissioner is then appealable as per clause 144 (and the timelines are provided in clause 145). There are no contradictions.

In regard to the issue on decisions made by the minister under Clause 12 is final and cannot be reviewed by a court of law, the Committee was advised that Clause 13 is an ouster clause and is a matter of policy. Clause 13 is currently section 14B of the Trade-Marks Act 1933.

In regard to the issue on providing a definition for “words implying geographic origins”, the Committee was advised that this is indeed unclear, thus the Committee recommends that for the purposes of clarity, it is recommended that the following be inserted into the definition in clause 2—

“geographical indication” means an indication which identifies a good as originating in the territory of a country, or a region or locality in that territory, where a given quality,

reputation or other characteristic of the good is essentially attributable to its geographical origin;”

This definition is in line with TRIPS (article 22) and does not limit the geographical indication protection to Fiji, however, it provides an element of quality, reputation or other characteristic which is attributable to the place of origin. These elements help define the goods more closely for the purposes of the Act.

In relation to the issue on Clause 12(1) regarding the phrase “would otherwise be disentitled to protection in any court”, the Committee was advised that yes, this refers to signs that would not be protected under common law. Furthermore it was advised that the case of *Pioneer Hi-Bred Corn Co v Hy-Line Chicks Pty Ltd [1978] 2 NZLR 50 at [52]* is a good reference, where it was noted that these words should be given effect “in accordance with their ordinary and natural meaning”. This is similar to the NZ Trade Marks Act 2002 s17(1).

In regard to the issue on Clause 12(2) regarding the term “Fiji”, the Committee was advised that Clause 14(1)(c) provides that if a mark consists of only descriptive language (including descriptive language pertaining to geographical origin), the Commissioner must not register it. However, under clause 14(2), the Commissioner must not refuse to register such mark if, through use or other reason, it is of a distinctive character. Clause 14(2) serves to negate clause 14(1) in limited conditions. The language used is “The Commissioner must not refuse”, not “the Commissioner must register”. Clause 14(2) only exists to negate clause 14(1), it is not a blanket provision. Other processes must still be followed. The application may still be opposed and the authorisation of the Minister for geographical origins must still be sought.

In regard to the issue on Clause 12(3); the Committee was advised that this is language taken from the current Trade-Marks Act 1933. It does not, however, refer to marks licensed as trademarks under other written laws. It refers to word marks which have been registered as business names under the Companies Act 2015.

In regard to the issue on Clause 13 and other Clauses of the Bill, relating to the decisions by the Minister are final, the Committee was advised that Clause 13 is currently section 14B in the Trade-Marks Act 1933.

In relation to the issue regarding the sentiment that ‘Laws should not prevent anyone from challenging the decisions of public officers including ministers’, the Committee was advised that Clause 13 is currently section 14B in the Trade-Marks Act 1933. Furthermore, s16 of the Constitution is “Subject to the provisions of this Constitution and such other limitations as may be prescribed by law”. As such, the right under s16 is not absolute and may be limited by written law.

In regard to the issue on Clause 14(1)(d), the Committee was advised that yes; is commonly used language assigned ordinary meaning in everyday trade and custom. It is expected that a common sense approach be taken for the interpretation of such language. This provision is similar to the NZ Trade Marks Act 2002, s.18.

In regard to the issue on Clause 15(1), the Committee was advised that this applies to any trademark. Also, under clause 15(2) a trademark is automatically registered for all colours unless there is a specific limitation as to what colour the trademark is to be in. An applicant would thus have to specify whether the trademark is to be limited to a specific colour or colours.

Clause 15(1) is a directive to the commissioner or court, when determining whether the trademark is of distinctive character, to consider whether the mark will be represented in those specific colour(s). Sometimes, the limitation requested by the applicant in relation to colour is what provides a greater degree of distinctiveness to the mark.

In regard to the issue on Clause 17, the Committee was advised that this provision is also found in section 22(3) of the NZ Trade Marks Act 2002. It should be noted this is a “may” and not a “shall” provision. Therefore, the Commissioner may also exercise discretion on whether or not to accept these applications.

In regard to the issue on Clause 18, the Committee was advised that the following provisions are relevant:

- Clause 12(1)(a) which prohibits registration of a mark that is likely to deceive or cause confusion; or
- Clause 12(4) for applications made in bad faith.

Clause 18 is not to be interpreted as empowering the Commissioner to register on a whim, trademarks of names of people if 10 years have passed since their death. It does not negate the provisions mentioned above.

In regard to the issue on Clause 20, the Committee was advised that in the UK, “special circumstances” has been extended to apply to instances of ‘prior use’. A case law that can be reference is *Holt & Co (Leeds) Appn* [1957] RPC 289 where the special circumstance was the fact of 15 years’ use prior to the registration or first use of the conflicting mark.

Also special circumstances may be interpreted to mean:

- Prior use as referenced in *Holt & Co (Leeds) Appn* [1957] RPC 289.
- The way customers refer to a product by name, e.g “American Bud” (See *BUDWEISER Trade marks* [2000] RPC 906 EWCA); and
- Circumstances “which justified taking the case out of the ordinary rules so that justice may be done to the applicant”. (See *Re Lacoste* [2017] NZHC 2216)

In regards to the issue on Clause 22(a), the Committee was advised that the words “the use of the flag in the manner proposed is permitted without that authorisation” refer to inter alia the same circumstances listed in the question. That is, the ‘flag’ is used in so highly stylised or incomplete a manner which essentially renders it equivalent to a mark so distinct that it would not have needed that authorisation from the competent authority of that country in the first place.

In relation to the issue on Clause 25, the Committee was advised that this in an incorrect interpretation. Clause 25(2) is not an ouster clause. The decision is final for the purposes

of the application at that time. However, the decision may still be appealed under clause 144 to the High Court.

In regard to the issue noted on Clause 36, the Committee was advised that no similar framework exists in jurisdictions such as NZ, and for good reason. Clause 36 refers to an acceptance made by “error or omission”. An error or omission is not taken to include a simple mistake of fact or mere change of mind or opinion of the Commissioner. A case law that can be referenced for the purpose of this issue is *Re Application by Remington Products Inc (1990) 18 IPR 251 for Australia, and for New Zealand — The Muir Electrical Company Pty Ltd v The Good Guys Group Ltd HC Wellington CIV-20100485-1955, 31 March 2011*).

An error or omission that extends beyond a mistake of fact or mere error or mission would need to be quite substantive, and thus understandable. As such, compensatory measures are unnecessary.

In regard to the issue on Clause 40, the Committee was advised that this is not an issue as Clause 40 clearly mandates the publication of accepted applications.

In relation to the issue on making publications after the Commissioner has completed its review of the applications, the Committee was advised that the manner of publication is to be prescribed by regulations.

In relation to the issue on providing a reasonable time period for parties to bring oppositions after the mark is published, the Committee was advised that these are to be provided by regulations.

In relation to the issue on Clause 40 regarding applications to be directed by Commissioner to be advertised, the Committee was advised that this was unnecessary since the current Trade-Marks Act 1933 states that the “Solicitor-General shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner”.

In regard to the issue on Clause 41, the Committee was advised that person includes legal persons, as provided in the Interpretation Act 1967, s.2.

In regard to the issue a legal or natural person may bring an opposition proceeding, the Committee was advised that there is no requirement that a person must have standing to oppose an application. A person simply concerned with the public interest may oppose, e.g., on cultural offensiveness grounds.

In regard to the issue noted on Clause 43, the Committee was advised that this is to be covered by regulations. A formal in person hearing may be conducted; however, a determination may be made based on written submissions or on the documents already submitted in the proceedings.

In regard to the issue on Clause 44, the Committee was advised that the process that the Bill follows is the same as the process provided under the NZ Trade Marks Act 2002 (ss. 41 to 44).

Under Clause 35, the Commissioner must give an applicant an opportunity to respond or time to correct matters listed in clause 31. If the applicant does not respond within the specified time, clause 38 provides that the application is abandoned.

This is similar to section 17 of the current Trade-Marks Act 1933, as pointed out, however, the current Act deems the application abandoned if it isn't completed within 12 months. It does not set out a process for the applicant to respond and thus does not give the applicant a fair opportunity.

In relation to the requirement that the Commissioner reach out to the applicant within a specific time frame, this would be set out in regulations.

Additionally, in regard to the issue on Clause 44, the Committee was advised that Clause 40 already mandates advertising.

In regard to the issue raised on Clause 56, 57 & 58, the Committee was advised that the Interpretation Act 1967 s2, caters for the definition of person.

In regard to the issues noted on Clauses 57 and 58, the Committee was advised that the term "trademark" is defined in clause 2 to include certification trademarks and collective trademarks. As such, the grounds for revocation of a trademark under clause 60 (and revocation of registration under clause 62) already apply to certification and collective trademarks.

In relation to the issue noted on Clause 60(1)(c), the Committee was advised that Clause 60(1)(b) pertains to trademarks which have become a common name in public use – essentially a mark that has become generic. Clause 60(1)(c) is in relation to patents which have expired. These are different things.

In relation to the issue raised on Clauses 63-66, the Committee was advised that a voluntary disclaimer may be made during the applications process as well as after registration; however, mandatory disclaimers can only be made during the applications process (and prior to registration) if it is on the basis of public interest.

In relation to the issue on disclaimer grounds, the Committee was advised that the requirement is not limited to grounds under clause 60(1)(b) or (c). See clause 65 where the Commissioner or court may require disclaimers for public interest.

In regard to the issue on Clause 69, the Committee was advised that it is a good suggestion to revert back to 7 years. The reduction was intended to harmonise the timeframes under the Bill and is similar to the US 'incontestability' right after 5 years of use (15 US Code, Section 1065). However, there is no legal obstacle to remaining with 7 years. Seven years would also be a safer option as it provides more time for a person with a valid claim to contest the mark.

In regard to the issue noted on Clause 71, the Committee was advised that the purpose of this provision is simply to clarify that amendments are not possible after registration. It

is not intended to imply that substantive amendments of any kind to the applied-for trademark are permissible before registration.

Amendments before the date of registration are only in a limited scope. See clause 31(2). An applicant may apply to the Commissioner for alteration of an application. However, such alteration is only permissible to correct an error or omission which does not materially alter the scope of the application.

In relation to the issue noted on Clause 88, the Committee was advised that this Clause must be read together with clause 86. Clause 86 provides for the defence of ‘genuine use’ – a defence which provides that, for goods, if a trademark has been applied to goods by either the owner or licensee and neither have removed the mark, or if they have consented to the use of that mark — those goods may be used without infringing the trademark. Or to put it simply, a second-hand car dealer may sell a car without worrying about infringing the trademark of the car brand.

Clause 88 provides that if those ‘goods’ are medicines; consent is automatically deemed for imports by the State, if a person with whom the owner or licensee has an arrangement for the use of the mark has consented.

In relation to the issue noted on Clause 92, 93 & 94, the Committee was advised that the licensee requests the registered owner to bring an action for infringement of the trademark. If the owner refuses, the licensee may bring the action himself against the person infringing. This provision is similar to the NZ Trade Marks Act 2002 ss 102-104 and Australian Trade Marks Act 1995 – see s 26(2).

In regard to the issue noted on Clause 96(1)(b), the Committee was advised that this is an alternative remedy in both New Zealand (See New Zealand Trade Marks Act 2002 s106(1)) and Australia (See Australian Trade Marks Act 1995 s126(1)).

The rationale is that damages of a compensatory nature are distinct from the equitable remedy of an account of profits. The former is designed to compensate, where the trademark owner has suffered damages, and the latter is to claim the profits that the infringing party has made on the trademark. Common law has also taken a very clear approach on this issue, reinforcing this separation. (See *Colbean Palmer Lt v Stock Affiliates Pty Ltd* (1968) 122 CLR 25 at 32 where Windeyer J states “The plaintiff whose mark has been infringed can choose between damages or an account of profits. He cannot have both. In this, s 65 merely echoes old law, now trite for nearly a hundred years”).

In regard to the issue raised on specifying that courts have the authority to order the infringer to pay the right holder’s expenses, the Committee was advised that the Bill only provides for orders as to costs in certain situations (see clause 94(b) for licensors added as defendants to proceedings and 139(2) for proceedings where the validity of registration is questioned), and generally allows for the Commissioner to order costs for proceedings before the Commissioner (clause 140). There is no general power as to costs for proceedings before the court as this authority is already provided by the High Court Rules 1988 (Order 62).

In regard to the issue noted on Clause 96(2), the Committee was advised that it is preferable to allow courts to establish their own regime for damages on a case by case basis. The Bill's approach is consistent with common law jurisdictions in the region (e.g NZ and Australia) and fulfils the requirements of TRIPS (Article 45).

Furthermore, providing for pre-established damages set out in legislation:

- carries the risk of increased litigation – given that damages are set out in written law with minimum thresholds, litigants are more willing to sue directly for the purpose of acquiring awards of damages. This carries the risk of the system becoming less compensatory in nature.
- is too prescriptive and cumbersome – (carries complicated questions such as the unit to be imposed – would it be by article or product type?- and the minimum thresholds relevant to a market and jurisdiction.
- may result in disproportionate damages which are far too large, particularly if thresholds and units are not assessed properly.

In regard to the issue noted on Clause 107, the Committee was advised that a good reference would be the WTO Panel Report, China – Measures affecting the protection and enforcement of intellectual property rights, WT/DS362/R, par. 7.577. The Report provides that “counterfeiting [...] “on a commercial scale” refers to counterfeiting [...] carried on at the magnitude or extent of typical or usual commercial activity with respect to a given product in a given market”. As the scale is relative to the given market, a threshold is not recommended.

In regard to the issue noted on Clause 114, the Committee was advised that penalties provide for maximum offences. The courts should be allowed to develop their tariff system for penalties based on the circumstances of the offences. This recommendation is unnecessarily prescriptive.

In relation to the issue raised on Clauses 107-123, the Committee was advised that the powers of the Fiji Police Force pertaining to arrest, search and seizure are provided under Part 3 and 4 of the Criminal Procedure Act 2009. It is the responsibility of the Police to enforce the laws of Fiji.

In regard to the issue regarding “Enforcement Enforcers”, the Committee was advised that it is not an obligation under the WTO TRIPS Agreement to provide such enforcement powers.

In regard to the issue on Clause 124, the Committee was advised that the applicant is the rights holder that has applied.

In regard to the issue noted regarding exclusive licensee, the Committee was advised that an “exclusive licensee” is one whose license is only granted to her/him and which excludes the holder from using the mark and from granting licenses to any other person. A good reference for such an issue is Rule 1 Abbreviated Expressions of the Regulations under the Singapore Treaty on the Law of Trademarks.

Therefore, clause 124, as currently worded makes perfect sense as it provides for the definition of a rights holder. An exclusive licensee would serve as the appropriate person to enforce the rights under Part 4, Division 3.

Moreover, sometimes non-exclusive licensees cannot act on their own and need to be recorded with the IP Office first, and secondly contact the owner of the mark to be able to join in proceedings started by that owner and subsequently receive any damages deriving from such actions.

In regard to the issue noted on Clause 125, the Committee was advised that under Clause 129, the Comptroller may act on his or her own initiative to suspend the clearance of goods. The onus does not only rest with the rights holder to make an application.

In regard to the issue noted on Clause 126 (8), the Committee was advised that Clause 126(8) provides a discretionary authority to require security. This is as per TRIPS article 53.

In regard to the issue noted on Clause 127, the Committee was advised that the structure of Division 3 is drafted in a logical sequence by providing for interpretation (clause 124), followed by establishing the legal right or basis to apply to the Comptroller (clause 125) and then the application requirements/conditions (clause 126), and the decision of suspension by the Comptroller (clause 127).

In light of the above, clause 127(1) cannot be applied or come into force if the application does not satisfy the requirement provided in clause 126(8) “The Comptroller may refuse to suspend the clearance of the goods unless the rights holder furnishes to the Service security in the manner and amount that the Service may reasonably require to indemnify itself against any liability that may be incurred pursuant to such suspension, and to cover any expenses that may be incurred in effecting the suspension.”

This conclusion could be supported by the reference in clause 127(1) which provides for “(1) The comptroller must suspend clearance of the goods if satisfied that the goods to be imported are infringing goods covered by the grant of the application.” In other words, clause 126 is a prerequisite to implement clause 127.

In regard to the issue noted on Clause 125-129 and 131, the Committee was advised that Clause 131(1) does not imply that applicant and rights holders are different.

In regard to the issue noted on Clause 129, the Committee was advised that Clause 129(2) expressly states that clauses 127 and 128 apply *mutatis mutandis*. This means that they must be read with the necessary modifications. The applicant is thus the rights holder in the context of clause 129.

In regard to the issue noted on Clause 145, the Committee was advised that there was cross-referencing error.

In regard to the issue noted on Clause 149, regarding the role of the Solicitor-General, the Committee notes that this is a policy decision.

In relation to the comments put forward regarding Clause 154 & 155, the Committee was advised that maintaining an electronic register is being considered.

In relation to the suggestion for Clause 155, the Committee was advised that the list of applicable goods and services is the next stage of the search (search of placards). This are processes within the FIPO.

In relation to the issues noted on Clauses 161 & 162, the Committee was advised that the Bill is very clear that decisions are made by the Commissioner (the SG), the Minister and the court.

In relation to the issue noted on Clause 166, the Committee was advised that Clause 166 utilises the same language provided in section 194 of the New Zealand Trade Marks Act 2002.

In relation to the issue noted on permitting amendments to listed goods or services, the Committee was advised that Clause 72(b) addresses this, which specifically allows for alterations for the purposes of narrowing and not extending goods and services for which a trademark is registered.

With regard to the issue on consultation on the Regulations to the Act, the Committee was advised that the Constitution is sufficient, as it is the supreme law of Fiji.

In regard to the issue noted on Clause 172, the Committee was advised that Clause 172(1)(a) states “until the trademark is registered”. As such, it would be valid.

With regard to the issue on existing registrations under the new Act, the Committee was advised that this provision could be made clearer. Thus it is recommended that clause 172 is amended after subclause (2) by inserting the following new subclause—

“(3) A trademark that, immediately before the commencement of this Act, was valid retains its existing registration period, under the Trade-Marks Act 1933 but, at the expiration of that registration period, section 51 applies.”.

In regard to the issues noted in relation to opposition proceedings, the Committee was advised these proceedings continue.

In regard to the issue raised regarding existing registrations are based on the old British Imperial system, the Committee was advised that the intention is that these are to be addressed through regulations.

In regard to the issue noted on existing registrations are for one class only, the Committee was advised that the intention is that these are to be addressed through regulations.

In regard to the issue noted regarding making transitional provision for UK-based trade marks, the Committee was advised that Clause 172(2) addresses this, which provides for the transition of all valid registrations.

In regard to the issue noted on registrations covering all goods in a class which is no longer permitted under the new Act, the Committee was advised that Clause 172(2) expressly states that nothing in the new Act invalidates the registration of an existing trademark. As such, class-wide registrations will not be invalidated.

Finally, in regard to the issue raised regarding existing registered associations between trademarks, the Committee was advised that associated marks are recorded for information purposes. There is no need to provide a specific transitional provision for these.

Therefore the Committee is of the opinion that the provisions of the Bill are adequate in addressing majority of the issues identified in the review. The Committee also makes relevant amendments as highlighted in the preceding paragraphs.

5.0 APPRECIATION

The Committee, by way of consensus, during the drafting of this Report resolved that it would be appropriate to acknowledge all those that had provided great support to the Committee during the review of the Bill.

Firstly, the Committee acknowledges the Parliament of the Republic of Fiji for realising the vital aspect of public participation in the legislative making process, thus supporting and encouraging the Committee to conduct extensive public consultation. Moreover, appreciation goes to the UNDP Fiji Parliament Support Project, for its financial support, which enabled the Committee to conduct extensive awareness on its public consultations.

Furthermore, the Committee would also like to acknowledge the Parliament IT Team for its support, which enabled the Committee to have virtual meetings and continue to carry out its constitutionally mandated functions, despite the impact of Covid-19.

6.0 CONCLUSION

After adhering to due process and the requirements of the Standing Orders of Parliament, the Committee in its deliberation and review noted that there was great support for the Bill.

The review highlighted a few issues on the Bill, which were considered extensively by the Committee and clarifications being sought on these from the legal team from the Solicitor-General's Office and the consultants from the World Intellectual Property Office. This ensured that all the issues raised were adequately addressed and that the objectives of the Bill are not affected.

The Committee also recommends that relevant amendments are made to the Bill, which include substantive amendments and amendments, which are consequences of the proposed changes to the Bill. These amendments are captured in magenta coloured texts in the copy of the Bill tabled with this Report.

The Committee is also of the view that this piece of legislation needs to be reviewed periodically as the business environment relating to trademarks continuously changes with time and circumstances. An up to date business environment is vital for the economy of the nation, therefore the legal framework governing such business environments, should be in par at all times to ensure economic development in Fiji.

The Committee, through this bi-partisan report and consensus, commends the *Trademarks Bill 2020 (Bill No. 45 of 2020)*, with the proposed amendments to the Parliament.

MEMBERS SIGNATURES



**HON. ALVICK MAHARAJ
(CHAIRPERSON)**



**HON. ROHIT SHARMA
(DEPUTY CHAIRPERSON)**



**HON. RATU SULIANO
MATANITOBUA
(MEMBER)**



**HON. DR. SALIK GOVIND
(MEMBER)**



**HON. MOSESE BULITAVU
(MEMBER)**

DATE: 17 AUGUST 2021

