

BILL NO. 28 OF 2025

A BILL

FOR AN ACT TO AMEND THE TRADEMARKS ACT 2021

ENACTED by the Parliament of the Republic of Fiji—

Short title and commencement

1.—(1) This Act may be cited as the Trademarks (Amendment) Act 2025.

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

(3) In this Act, the Trademarks Act 2021 is referred to as the “Principal Act”.

Section 12 amended

2. Section 12(2) of the Principal Act is amended by—

(a) in paragraph (a), deleting “and”;

(b) in paragraph (b), deleting “,” and substituting “; and”; and

(c) after paragraph (b), inserting the following new paragraph—

“(c) that comprises of—

(i) any iTaukei word, phrase, or symbol of cultural, spiritual, or historical significance;

- (ii) any Fiji Hindi, Rotuman or any other indigenous word deeply tied to cultural identity or societal values;
- (iii) religious or communal symbol; or
- (iv) any term likely to mislead or falsely suggest association with Fiji’s indigenous communities, traditions, or institutions.”.

Section 107A inserted

3. The Principal Act is amended after section 107 by inserting the following new section—

“Application for provisional measures

107A.—(1) The owner of a registered trademark which has been, or is likely to be infringed, may at any time, make an application to the court for an order for provisional measures to—

- (a) prevent an infringement or imminent infringement of an intellectual property right; or
- (b) preserve evidence relating to an alleged infringement.

(2) The court may make an order under subsection (1) with or without notice to the respondent, where the court is satisfied that—

- (a) a delay is likely to cause irreparable harm to the owner of a registered trademark; or
- (b) there is a real risk that evidence may be destroyed, concealed, or otherwise rendered inaccessible.

(3) Without limiting subsection (1), an order for provisional measures may include—

- (a) an interlocutory injunction restraining the sale, distribution, importation, customs clearance or other dealing with the infringing goods, infringing material, or infringing objects;
- (b) the seizure or detention of suspected infringing goods, infringing material, or infringing objects; or
- (c) the preservation or inspection of documents, data, or articles relevant to the alleged infringement.

(4) An application for an order under this section must be supported by evidence that—

- (a) the applicant has a *prima facie* right to the intellectual property;
- (b) there is credible evidence of infringement or imminent infringement; and
- (c) the measures sought are proportionate and necessary in the circumstances.

(5) The court may require the applicant to provide security, an undertaking, or other appropriate assurance, as the court considers just, for the payment of any costs, damages, or losses that may arise from the making or execution of the order.

(6) Where an order is made without notice to the respondent—

- (a) the order must be served on the respondent as soon as practicable, in any event, not later than 7 working days; and
- (b) the respondent is entitled to apply to the court for variation or discharge of the order, and the matter must be heard as soon as practicable and, in any event, not later than 7 working days from the date of service.

(7) An order made under this section lapses unless the applicant initiates proceedings on the merits of the case—

- (a) within 20 working days; or
- (b) within 31 calendar days,

whichever is longer, from the date of the order.

(8) A respondent who has suffered damage as a result of an order made under this section, which is subsequently discharged or found to be unjustified, is entitled to compensation from the applicant, including reasonable legal costs and expenses, in accordance with the rules of the court.”.

Section 110 amended

4. Section 110 of the Principal Act is amended by—

- (a) renumbering subsection (1) as subsection (2);
- (b) renumbering subsection (2) as subsection (3); and
- (c) inserting the following new subsection (1)—

“(1) For the purposes of this section, “commercial scale” means any act or conduct involving the unauthorised use of intellectual property rights that, having regard to its magnitude, context, frequency, or economic impact, is carried out for commercial advantage or financial gain, or is otherwise of a nature or extent that affects legitimate commercial interests, whether or not for profit.”.

Section 131 amended

5. Section 131(3)(a) of the Principal Act is amended by deleting “20 working days” and substituting “7 working days”.

Section 173 amended

6. Section 173 of the Principal Act is amended after subsection (3) by inserting the following new subsection—

“(4) Notwithstanding subsection (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 may not be renewed if it is prohibited under section 12 (2) (c).”.

August 2025

TRADEMARKS (AMENDMENT) BILL 2025

EXPLANATORY NOTE

(This note is not part of the Bill and is intended only to indicate its general effect)

1.0 BACKGROUND

- 1.1 The Trademarks (Amendment) Bill 2025 (**‘Bill’**) seeks to amend the Trademarks Act 2021 (**‘Act’**).
- 1.2 The Act was passed in 2021 and is yet to be commenced by the Minister. Once commenced the Act will replace the Trade-Marks Act of 1933.
- 1.3 The Act establishes an updated regime for the registration, protection, and enforcement of trademarks in Fiji. It brings Fiji’s intellectual property law into conformity with its international obligations, particularly under the World Trade Organization’s Agreement on Trade-Related Aspects of Intellectual Property Rights (**‘TRIPS’**) and the Paris Convention for the Protection of Industrial Property.
- 1.4 The Act reflects the development of a legal environment that supports innovation and fair competition. It is designed to facilitate both domestic and international brand protection and provide effective legal remedies against trademark infringement and counterfeiting.
- 1.5 The Act introduces significant reforms to the trademark system in Fiji, both procedurally and substantively. It adopts the Nice Classification system, thereby aligning Fiji’s trademark registration process with international norms and enabling the classification of both goods and services. It introduces a multi-class application process, allowing trademark applicants to register in multiple classes under a single application, reducing administrative burden and cost.

- 1.6 The Act also establishes a clear and robust opposition process, including the introduction of a post-acceptance opposition period that allows third parties to contest a trademark before registration is finalised. This enhances the transparency and fairness of the registration process. Further, the Act strengthens enforcement mechanisms by introducing broader infringement provisions and enabling criminal sanctions for wilful trademark counterfeiting conducted on a commercial scale. These provisions are in line with Fiji’s obligations under Article 61 of the TRIPS Agreement.
- 1.7 Notwithstanding the above, the World Intellectual Property Organization (‘WIPO’) has been providing assistance through providing a review of the enforcement provisions contained in the Act in order to assess its compatibility with the TRIPS Agreement, in particular, Part III, which deals with the enforcement of intellectual property rights.
- 1.8 WIPO noted that there is a gap in the enforcement measures provided for in the Act, as they do not sufficiently capture measures aimed at preventing an infringement occurring in Fiji as well as measures aimed at preserving evidence that is the result of an alleged infringement. In common law countries, these are referred to as the *Anton Piller orders*.
- 1.9 It must be noted that some of the procedural aspects that were identified by WIPO are provided for under statute, in particular, the High Court Rules 1988. However, there is need to adhere to the objectives of the Act, which includes defining the scope of protected rights and to specify the procedures necessary to register and protect trademarks.

2.0 CLAUSES

- 2.1 Clause 1 of the Bill provides for the short title and commencement. If passed by Parliament, the amending legislation will come into force on a date or dates appointed by the Minister by notice in the Gazette.
- 2.2 Clause 2 of the Bill expands the grounds for refusal for registering a trademark, if the words, phrases or symbols make reference to culturally or religiously significant words, symbols or phrases.
- 2.3 Clause 3 of the Bill amends the Act by inserting a new section 107A which allows owners of a registered trademark to apply to the court for an order for temporary or provisional measures to prevent trademark infringements or to preserve evidence before formal legal proceedings are commenced.
- 2.4 Clause 4 of the Bill amends section 110 of the Act by inserting a definition of “commercial scale” which covers commercial activity of various qualities and quantities, as long as it is likely to cause harm to the owner of a registered trademark.

- 2.5 Clause 5 of the Bill amends section 131 of the Act by reducing the time required for a person to respond to infringement proceedings, thereby allowing for matters to be dispensed with without having to always resort to legal proceedings. This also aligns this clause with section 129(2) which had conflicting timelines.
- 2.6 Clause 6 of the Bill amends section 173 of the Act by inserting a new transitional provision. This ensures that any existing trademarks which include indigenous words, marks, symbols or images may not be renewed upon their expiry, without the express written consent of the Minister.

3.0 MINISTERIAL RESPONSIBILITY

- 3.1 The Act comes under the responsibility of the Attorney-General.

S. D. TURAGA
Acting Attorney-General