

TRADEMARKS ACT 2021
(ACT NO. 36 OF 2021)

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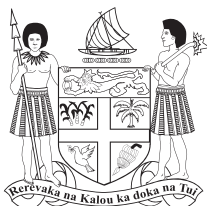
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ACT NO. 36 OF 2021

I assent.

J. K. KONROTE
President

[19 August 2021]

AN ACT

TO PROVIDE FOR THE REGISTRATION OF TRADEMARKS IN FIJI AND FOR
RELATED MATTERS

ENACTED by the Parliament of the Republic of Fiji—

PART 1—PRELIMINARY*Short title and commencement*

1.—(1) This Act may be cited as the Trademarks Act 2021.

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

Interpretation

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

“actual date of registration” means the date entered on the register by the Commissioner under section 46(a);

“applicant” means, as the case may be, a person who applies for—

(a) the registration of a trademark and includes the assignee of an application, if the assignment has been effected under section 76; or

- (b) the suspension of customs clearance of imported goods under Part 4, Division 3;

“application” means, as the case may be—

- (a) an application for the registration of a trademark, and includes an application for the registration of a series of trademarks; or
- (b) an application for the suspension of customs clearance of imported goods under Part 4, Division 3;

“assignment” means assignment by the acts of the parties concerned;

“certification trademark” means a sign capable of—

- (a) being represented graphically; and
- (b) distinguishing, in the course of trade—
 - (i) goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified; or
 - (ii) services certified by any person in respect of quality, accuracy, performance or other characteristic from services not so certified;

“collective association” means a body (whether incorporated or not) that has or is able to have members, and is—

- (a) constituted for the joint benefit of its members for the time being; and
- (b) so constituted that its membership at any time can be ascertained;

“collective trademark” means a sign capable of—

- (a) being represented graphically; and
- (b) distinguishing the goods or services of members of the collective association that is the owner of the sign from those of persons who are not members of the collective association;

“Commissioner” means the Commissioner of Trademarks;

“condition” includes a limitation of the exclusive right to use a trademark given by the registration of the trademark, including a limitation of that right as to—

- (a) mode of use;
- (b) use in relation to goods to be sold or otherwise traded in any place within Fiji;
- (c) use in relation to services to be provided within Fiji; and

(d) use in relation to goods to be exported to any market outside Fiji;

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

“convention country application” means an application for the registration of a trademark that is made in a convention country, whether before or after it became a convention country, and that is in accordance with the—

(a) terms of a treaty between 2 or more convention countries, equivalent to an application made in any one of those convention countries; or

(b) law of any convention country, equivalent to an application made in that convention country;

“counterfeit trademark goods” means any goods, including packaging, bearing without authorisation a trademark which is identical to the trademark of the rights holder validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the rights holder of the trademark in question;

“court” means the High Court of Fiji;

“deceased owner” means a registered owner of any trademark who has died, whether before or after the commencement of this Act, and includes an applicant for the registration of a trademark who has died before it is registered, whether before or after the commencement of this Act;

“deemed date of registration” means—

(a) in the case of a trademark to which section 31 applies, the date of the application in the convention country, subject to any enactment relating to international arrangements; or

(b) in any other case, the date of the application;

“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;

“infringing goods”, in relation to a registered trademark, means goods that bear, or goods the packaging of which bears, a sign that is identical or similar to the registered trademark and—

(a) the application of the sign to the goods or their packaging is an infringement of the registered trademark; or

(b) the sign has been used in relation to the goods or their packaging in a way that infringes the registered trademark;

“infringing material”, in relation to a registered trademark, means material that bears a sign that is identical or similar to the registered trademark and either the sign is—

- (a) used for labelling or packaging goods, as a business paper, or for advertising goods or services, in a way that infringes the registered trademark; or
- (b) intended to be used in a way that would infringe the registered trademark;

“infringing object”, in relation to a registered trademark, means an object that is—

- (a) specifically designed or adapted for making copies of a sign that is identical or similar to the registered trademark; and
- (b) in the possession, custody or control of a person who knows or has reason to believe that the object has been or is to be used to produce infringing goods or material;

“licensee”, in relation to a trademark, means a person whose use of the trademark is authorised by, and subject to the control of, the owner of the trademark;

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on 27 June 1989, as amended from time to time;

“member” means—

- (a) in relation to a collective association, a member of the association; and
- (b) in relation to a collective trademark, a member of the collective association that is the owner of the collective trademark;

“Minister” means the Minister responsible for trademarks;

“Ministry” means the Ministry responsible for trademarks;

“Nice Agreement” means the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks adopted at Nice on 15 June 1957, as revised or amended from time to time;

“Nice Classification” means the classification of goods and services for the registration of marks published from time to time under the Nice Agreement;

“owner” means—

- (a) in relation to a registered trademark that is not a certification trademark or a collective trademark, the person in whose name the trademark is registered;

- (b) in relation to a collective trademark that is registered, the collective association in whose name the trademark is registered;
- (c) in relation to a certification trademark that is registered, the person who certifies the goods or services to which the certification trademark relates; and
- (d) in relation to an unregistered trademark, the person who owns all of the rights in the mark;

“Paris Convention” means the Convention for the Protection of Industrial Property as revised and amended at Stockholm on July 14, 1967;

“Permanent Secretary” means the permanent secretary responsible for trademarks;

“protected international trademark (Fiji)” means a trademark that is entitled to protection in Fiji under the Madrid Protocol;

“qualified person”, in relation to a deceased owner, means a person who satisfies the Commissioner—

- (a) that he or she has obtained or is entitled to obtain probate of the will of the deceased owner or letters of administration in his or her estate in the place where the deceased owner was domiciled at his or her death, or that he or she is the legal representative of the deceased owner in that place;
- (b) that probate of the will of the deceased owner or letters of administration in his or her estate have not been granted or resealed in Fiji;
- (c) that the interests of the creditors of the deceased owner, and of all persons beneficially interested under his or her will or on his or her intestacy, will be adequately safeguarded if the Commissioner registers the qualified person as the owner of the trademark;

“register” means the register of trademarks kept under section 155;

“registered trademark” means, subject to section 55, a trademark that is on the register;

“series of trademarks” means a number of trademarks for the same goods or description of goods or the same services or description of services, as the case may be, that—

- (a) resemble each other in their material particulars; and
- (b) differ only in respect of one or more of the following matters—
 - (i) statements of the goods or services for which they are, or are proposed to be, used;

- (ii) statements of number, price, quality, or names of places;
- (iii) other matters of a non-distinctive character that do not substantially affect the identity of the trademarks; or
- (iv) colour;

“sign” includes—

- (a) a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word; and
- (b) any combination of signs;

“specification” means the goods or services specified on the application for the registration of the trademark in relation to which the registered trademark is to be used or is proposed to be used;

“trademark”—

- (a) means any sign capable of—
 - (i) being represented graphically; and
 - (ii) distinguishing the goods or services of one person from those of another person; and
- (b) includes, except in section 77, a certification trademark and collective trademark;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer that is not assignment;

“TRIPS Agreement” means the Agreement on Trade-related Aspects of Intellectual Property Rights set out in Annex 1C to the WTO Agreement, as revised or amended from time to time;

“working day” means a day of the week other than Saturday, Sunday or a public holiday;

“writing” includes the—

- (a) recording of words in a permanent and legible form;
- (b) recording of words by electronic means that can be retrieved and read; and
- (c) display of words by any form of electronic or other means of communication that is subsequently recorded by electronic means that can, by any means, be retrieved and read; and

“WTO Agreement” means the World Trade Organization Agreement signed in Marrakesh in 1994, as revised or amended from time to time.

(2) In the case of an entity that is a convention country but is not a State, part of a State or a territory for whose international relations a State is responsible, a reference in this Act to an application for protection in a country must be read as a reference to an application for protection under the rules of the entity.

(3) In this Act, unless the context otherwise requires, every reference to—

- (a) the use of a sign in relation to goods is a reference to the use of the sign on, or in physical or other relation to, goods;
- (b) the use of a sign in relation to services is a reference to the use of the sign in relation to the provision or availability of services; and
- (c) the use of a sign in relation to goods or services includes a reference to the audible use of the sign in relation to goods or services.

(4) In this Act, unless the context otherwise requires, use, in relation to a trademark, includes—

- (a) use in a form differing in elements that do not alter the distinctive character of the trademark in the form in which it was registered;
- (b) applying the trademark to goods or services or to materials for the labelling or packaging of goods or services in Fiji solely for export purposes;
- (c) the application in Fiji of a trademark to goods or services to be exported from Fiji, and any other act done in Fiji in relation to those goods or services that, if done in relation to goods or services to be sold or otherwise traded in Fiji, would constitute use of a trademark in relation to those goods or services for which the use is material under this Act or at common law; and
- (d) the use of the trademark by—
 - (i) the owner; or
 - (ii) if the owner is a collective association, a member of the collective association.

(5) References in this Act to use of a trademark by the owner include use by a person other than the owner if that use is authorised by, and subject to, the control of the owner.

(6) The use of the whole of a registered trademark is also a use of any registered component part of a trademark registered in the name of the same owner.

Objectives

3. The objectives of this Act are to—

- (a) define the scope of rights protected by registered trademarks;
- (b) specify the procedures for registering trademarks in Fiji;
- (c) deter counterfeit activity in relation to registered trademarks in Fiji; and
- (d) ensure that Fiji's trademark regime takes account of international developments.

Act binds the State

4. This Act binds the State.

PART 2—REGISTRABILITY OF TRADEMARKS

*Division 1—Preliminary**Nature of registered trademark*

- 5.—(1) A registered trademark is personal property.

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

Rights that attach to registered trademarks

6.—(1) The owner of a registered trademark has, in relation to any or all of the goods or services in respect of which the trademark is registered, the rights and remedies provided by this Act and, in particular, has the exclusive right to—

- (a) use the registered trademark;
- (b) authorise another person to use the registered trademark; and
- (c) assign or transmit the registered trademark either in connection with the goodwill of a business or not.

(2) For the purposes of subsection (1)(a), a member of a collective association that owns a collective trademark that is registered in respect of goods or services—

- (a) has, together with the collective association, the exclusive right to use the trademark in respect of those goods or services; and
- (b) does not have the right to exclude any other member from using the trademark in respect of goods produced or services provided by the other members.

Additional matters that relate to rights attaching to registered trademarks

7. Subject to section 91, the rights referred to in section 6—

- (a) are subject to any conditions entered on the register in relation to the registered trademark;
- (b) accrue from the deemed date of registration of the trademark;
- (c) are conferred in respect of each of the registered trademark's component parts that are registered as separate trademarks; and
- (d) are to be exercised by joint owners, if any, of the registered trademark as if they were the rights of a single person.

Rights that attach to application

8.—(1) An applicant may assign or transmit the applicant's application (whether made before or after the commencement of this Act).

(2) An application for the registration of a trademark is personal property.

(3) Equities in respect of an application for the registration of a trademark may be enforced in the same way as equities in respect of any other personal property.

When trademark registrable

9.—(1) If all the requirements set out in subsection (2) are met, a trademark is registrable under this Act in respect of the following—

- (a) particular goods or services within one or more classes; or
 - (b) particular goods and services within one or more classes.
- (2) The following requirements must be met—
- (a) an application for the registration of the trademark must be made in accordance with this Act;
 - (b) all prescribed fees, if any, must be paid in respect of the application;
 - (c) the Commissioner must be satisfied that there are no absolute or relative grounds set out in this Part that would prevent the registration of the trademark.

(3) If a person owns a certification trademark in respect of goods or services, a trademark in respect of goods or services of the kind certified must not be registered in the name of that person.

Additional provisions that relate to registrability of certification trademarks

10. A certification trademark in respect of goods or services—

- (a) may be registered in the name, as owner, of the person who certifies the goods or services; but
- (b) may not be registered in the name of a person who owns a trademark in respect of, or otherwise carries on trade in, goods or in services of the kind certified.

Additional provisions that relate to registrability of collective trademarks

11. A collective trademark may be registered in the name of a collective association, as owner, in respect of goods produced by its members, services provided by its members, or both.

Division 2—Absolute grounds for not registering trademark

Absolute grounds for not registering trademark: general

12.—(1) The Commissioner must not register a sign as a trademark or part of a trademark where the use or registration of the sign or any part of the sign—

- (a) would be likely to deceive or cause confusion;
- (b) is contrary to any written law or would otherwise be disentitled to protection in any court; or

(c) would, in the opinion of the Commissioner, be likely to offend a significant section of the community.

(2) The Commissioner must not register as a trademark or part of a trademark—

- (a) the word “Fiji” or any word that makes reference to or implies approval from the State; and
- (b) a body corporate’s name or trading name duly registered under the Companies Act 2015,

unless the use of the word or mark or the use of a disclaimer on the word or mark is approved by the Minister.

(3) The Minister may approve the use of the word or mark in subsection (2) on such terms and conditions as the Minister deems proper, if—

- (a) the mark is necessary for the public interest;
- (b) the mark complies and is in accordance generally with approved marks and brands recognised and licensed in accordance with written laws;
- (c) the registration of the trademark has the effect of developing Fiji’s economy and technology;
- (d) the company seeking registration of its company name as a trademark is a government owned entity; or
- (e) on any other reasonable ground.

(4) The Commissioner must not register a trademark if the application is made in bad faith.

No appeal against decision of Minister

13. No court, tribunal, commission or adjudicating body has the power or entitlement to hear or determine a claim, complaint or application that purports or purported to challenge the decision of the Minister made under section 12(2) and (3).

Non-distinctive trademark not registrable

14.—(1) The Commissioner must not register any of the following—

- (a) a sign that is not a trademark;
- (b) a trademark that has no distinctive character;
- (c) 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;
- (d) 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.

(2) The Commissioner must not refuse to register a trademark under subsection (1)(b), (c) or (d) if, before the date of application for registration, as a result of either the use made of it or of any other circumstances, the trademark has acquired a distinctive character.

Relevance of colour to distinctive character of trademark

15.—(1) In determining the distinctive character of a trademark, the Commissioner or the court, as the case may be, must consider whether or not the trademark is, or is to be, limited in whole or in part to one or more specified colours.

(2) A trademark that is, or is to be, registered without limitation of colour is, or will be, registered for all colours.

Trademark containing or consisting of 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 relevant 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) applies 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 or the applicant’s 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.

Trademark that contains commonly used chemical names must not be registered

17.—(1) The Commissioner must not register, in respect of a chemical substance or preparation, a trademark that contains the commonly used and accepted name of any single chemical element or single chemical compound.

(2) Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or a licensee of the trademark, together with a suitable name or description open to the public use.

Division 3—Relative grounds for not registering trademark

Registrability of trademark that contains certain words

18. The Commissioner may register a trademark that contains 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.

Registrability of trademark that contains person’s name

19. If a person applies for the registration of a sign as a trademark and the sign contains the name or representation of a person, the Commissioner may require the written consent of—

- (a) that person unless the person died 10 years or more before the making of the application; or
- (b) the person’s legal representative if—
 - (i) the person died within 10 years before the making of the application; or
 - (ii) the Commissioner thinks the person’s consent cannot for any other reason be obtained.

Registrability of identical or similar trademark

20. Subject to section 21, the Commissioner must not register a trademark (**trademark A**) in respect of any goods or services if—

- (a) it is identical to a trademark (**trademark B**) that belongs to a different owner and that is registered, or has priority under section 29 or 31—
 - (i) in respect of the same goods or services; or
 - (ii) in respect of goods or services that are similar to those goods and services, and its use is likely to deceive or cause confusion; *or*
- (b) it is similar to a trademark (**trademark C**) that belongs to a different owner and that is registered, or has priority under section 29 or 31, in respect of the same goods or services or goods or services that are similar to those goods or services, and its use is likely to deceive or cause confusion; or
- (c) it is, or an essential element of it 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.

Exceptions

21. 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.

Registrability of trademark that contains representation of flag, etc., generally

22.—(1) If a person applies for the registration of a sign as a trademark and the sign includes a representation of the flag, armorial bearing, insignia, orders of chivalry, or decorations of any entity, 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.

(2) Subsection (1) does not apply if section 23 or section 24 applies.

Registrability of trademark that contains flag, State emblems, etc., of convention country

23. The Commissioner must not, without the authorisation of the competent authorities of the country concerned, register a trademark that contains a representation of—

- (a) the flag of a convention country unless the Commissioner considers that the use of the flag in the manner proposed is permitted without that authorisation;
- (b) the armorial bearings or any other State emblem of a convention country that is protected under the Paris Convention or the TRIPS Agreement; or
- (c) an official sign or hallmark—
 - (i) adopted by a convention country;
 - (ii) that indicates control and warranty in relation to goods or services of the same, or similar, kind as those goods or services in relation to which the trademark is to be registered; and
 - (iii) that is protected under the Paris Convention or the TRIPS Agreement.

Registrability of trademark that contains armorial bearings, etc., of certain international organisations

24.—(1) The Commissioner must not, without the authorisation of the international organisation concerned, register a trademark that contains a representation of the armorial bearing, flag, or other emblem, or the abbreviation or name, of an international

intergovernmental organisation of which one or more convention countries are members if the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned is protected under the Paris Convention or the TRIPS Agreement.

(2) Notwithstanding subsection (1), the Commissioner may register a trademark if the Commissioner considers that the use of the armorial bearing, flag, or other emblem, or the abbreviation or name, of the international organisation concerned in the manner proposed—

- (a) is not likely to suggest to the public that a connection exists between the international organisation and the trademark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the international organisation.

When emblems, etc, are protected under Paris Convention or TRIPS Agreement

25. For the purposes of sections 23 and 24, the State emblems (other than the national flag) of, or the official signs or hallmarks adopted by, a convention country, or the emblems, abbreviations, or names, of an international organisation, as the case may be, are protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that—

- (a) the country or the organisation concerned has notified Fiji in accordance with Article 6ter(3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect the State emblem, official sign, or hallmark, or the emblem, abbreviation, or name, as the case may be;
- (b) the notification remains in force; and
- (c) Fiji has not objected to it in accordance with Article 6ter(4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

PART 3—PROCESS FOR OBTAINING REGISTRATION OF TRADEMARK AND OTHER MATTERS

Division 1—Classification

Classification of trademarks

26.—(1) Goods and services must be classified, for the purpose of registration of a trademark, according to the edition of the Nice Classification in effect at the time of application for the registration of the trademark.

(2) Any question arising as to the class within which any goods or services fall must be determined by the Commissioner, whose decision is final.

*Division 2—Applications**Application: how made*

27.—(1) A person claiming to be the owner of a trademark or series of trademarks may, on payment of the prescribed fee, apply in the prescribed manner for the registration of the trademark or series of trademarks used or proposed to be used in respect of the following—

- (a) particular goods or services within one or more classes;
- (b) particular goods and services within one or more classes.

(2) The Commissioner must not register a trademark in respect of all of the goods and services included in a class, or a large variety of goods or services, unless the specification is justified by the use or intended use of the sign.

Joint applications

28. Two or more persons may make a joint application if either or any of those persons 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.

Priority of applications for the registration of identical or similar trademarks

29.—(1) If different persons separately apply 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 the other applications and may proceed.

(2) If different persons separately apply 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 and their applications are received at the same time by the Commissioner—

- (a) each application has equal priority and may proceed; and
- (b) the Commissioner must notify each applicant of each other's application.

(3) For the purposes of subsection (2), 2 or more applications that are received on the same day are to be treated as if they had been received at the same time.

(4) This section is subject to section 31.

Commissioner's requirements in relation to applications without priority

30. The Commissioner must—

- (a) inform each applicant whose application does not have priority over all other applications under section 29(1) or 31, or does not have equal priority under section 29(2), of the applicant's order of priority; and
- (b) determine, according to its order of priority, each application.

Priority of application to which convention country application relates

31.—(1) A person who has applied for the registration of a trademark in a convention country, whether before or after it became 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.

(2) Subsection (1) applies only in respect of the first application for the trademark that is made in a convention country by a person and does not apply to any subsequent application for the trademark by that person.

(3) The use of the trademark in Fiji during the 6-month period referred to in subsection (1) does not affect the priority of the application for the registration of the trademark to which the convention country application relates.

Withdrawal, etc, of application

32.—(1) An applicant may, at any time, withdraw an application or limit the specification.

(2) An application may also be altered, at the request of the applicant, by correcting only—

- (a) the name or address of the applicant; or
- (b) an error or omission if, in the Commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.

When Commissioner or court may amend application

33. Subject to section 32(2)(b), the Commissioner or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in connection with the application.

Examination of application

34. The Commissioner must examine an application in order to determine whether it complies with the requirements of this Act.

Acceptance of application

35. The Commissioner must, subject to any conditions the Commissioner thinks fit, accept an application that complies with the requirements of this Act.

Applicant must be notified of non-complying application

36. If the Commissioner considers that an application does not comply with the requirements of this Act, the Commissioner must—

- (a) inform the applicant; and
- (b) give the applicant an opportunity to respond, or to amend the application by correcting only those matters set out in section 32(2), within the time specified by the Commissioner.

Revocation of acceptance of application

37.—(1) The Commissioner may revoke the acceptance of an application before the trademark to which the application relates is registered if the Commissioner is satisfied that—

- (a) the application was accepted because of an error or omission made by the Commissioner; or
 - (b) another application that relates to the trademark has priority under section 31.
- (2) If the Commissioner revokes the acceptance of an application—
- (a) the application is to be treated as if it had not been accepted; and
 - (b) section 34 again applies to the application.

Rejection of application

38. The Commissioner must reject an application if, within the time specified by the Commissioner, the applicant does not satisfy the Commissioner that the applicant has complied with the requirements in this Act for registering a trademark.

Abandonment of application

39.—(1) Subject to subsection (2), if, within the time specified by the Commissioner, the Commissioner does not receive a response from the applicant to a notification under section 36, the Commissioner must treat the application as abandoned.

(2) The Commissioner must not treat an application as abandoned under subsection (1) if the application is awaiting the outcome of—

- (a) opposition proceedings in respect of a prior application; or
- (b) cancellation, revocation or invalidity proceedings in respect of a prior registration.

Applicant must be notified of grounds, etc, of conditional acceptance or rejection of application

40. The Commissioner must, if required to do so by an applicant, state in writing the grounds for the Commissioner's decision and the materials used in arriving at the decision.

Advertisement of accepted application

41. The Commissioner must ensure that an application that has been accepted is advertised in the prescribed manner, if any.

*Division 3—Opposition to application**Opposition to accepted application*

42.—(1) A person may, within the prescribed time and in the prescribed manner, give the Commissioner written notice of opposition to an application.

(2) The notice of opposition must include a statement of the grounds of opposition and any prescribed matters.

(3) The Commissioner must send a copy of the notice to the applicant.

Applicant's counter-statement

43.—(1) An applicant to whom a notice of opposition has been sent must, within the prescribed time, send to the Commissioner a counter-statement of the grounds on which the applicant relies for his or her application.

(2) If an applicant does not send a counter-statement to the Commissioner within the prescribed time, the applicant is deemed to have abandoned the application.

(3) If an applicant sends a counter-statement to the Commissioner, the Commissioner must send a copy of the counter-statement to every person who gave notice of opposition.

Commissioner's determination on opposition

44. The Commissioner must—

- (a) hear the parties, if so required;
- (b) consider the evidence; and
- (c) determine whether, and subject to what conditions, if any, the trademark is to be registered.

*Division 4—Registration of trademark**When trademark must be registered*

45.—(1) Subject to subsection (2), the Commissioner must register a trademark if the Commissioner has accepted the application for its registration and—

- (a) either—
 - (i) no notice of opposition is given in accordance with section 42; or
 - (ii) all opposition proceedings are withdrawn or decided in favour of allowing registration of the trademark; and
- (b) the Commissioner does not intend to revoke the acceptance of the application.

(2) The Commissioner must not register a trademark until 6 months after the date of application for the registration.

Commissioner's requirements on registration

46. On the registration of a trademark, the Commissioner must—

- (a) enter, on the register, the actual date of registration and the deemed date of registration;
- (b) issue to the applicant a certificate of registration; and
- (c) in the case of an application for the registration of a series of trademarks, register the trademarks as a series in one registration.

Commissioner may dispense with production of probate or letters of administration in certain cases

47.—(1) On application in the prescribed manner and payment of any prescribed fee, the Commissioner may, without requiring the production of probate or letters of administration—

- (a) if the owner of a registered trademark has died, whether before or after the commencement of this Act, register a qualified person as the owner of the trademark;
- (b) if an applicant has died before the registration of the trademark, whether before or after the commencement of this Act, allow a qualified person to complete the application and may register that person as the owner of the trademark.

(2) Every qualified person who is registered under this section as the owner of a trademark must hold it subject to all existing interests and equities affecting it.

(3) Nothing in section 45 of the Succession, Probate and Administration Act 1970 limits this section.

Replacement of certificate of registration

48. The Commissioner must issue a new certificate of registration to replace an existing certificate if—

- (a) an application for a new certificate of registration has been made in the prescribed manner; and
- (b) the prescribed fee, if any, has been paid.

Division 5—Additional matters that relate to certification trademarks

When rules that govern use of certification trademark must be provided

49. Before the Commissioner makes a decision on an application for the registration of a certification trademark, the applicant must provide the Commissioner with draft rules that govern the use of the certification trademark for the Commissioner's approval.

Consideration of application for the registration of certification trademark

50.—(1) When the Commissioner or the court deals with an application for the registration of a certification trademark, the Commissioner or the court, as the case may be, must consider—

- (a) the matters that are relevant to an application under section 27;
- (b) whether or not the certification trademark should indicate that it is such a trademark;
- (c) whether the applicant is competent to certify the goods or services in respect of which the certification trademark is to be registered;
- (d) whether the draft rules are satisfactory in terms of subsection (2); and
- (e) whether in all the circumstances the registration applied for would be in the public interest.

- (2) For the purposes of subsection (1)(d), the draft rules must—
- (a) contain provisions that relate to when the owner is to—
 - (i) certify goods or services; and
 - (ii) authorise the use of the trademark; and
 - (b) contain, or may contain, any other provisions that the Commissioner requires or permits, as the case may be, to be inserted in them.

Approved rules must be deposited at Fiji Intellectual Property Office

51. After the Commissioner has approved the draft rules, the approved rules that govern the use of the registered certification trademark must be deposited at the Fiji Intellectual Property Office for inspection.

Division 6—When registration of trademark ceases

Duration of registration

52.—(1) The duration of the registration of a trademark under this Act is effective for a period of 10 years commencing on the deemed date of registration unless the trademark ceases to be registered before the expiration of that period.

(2) Subsection (1) does not apply to a trademark registered under the Trade-Marks Act 1933.

Renewal of registration

53. The registration of a trademark may be renewed in accordance with section 54 for a further period of 10 years.

Procedure for renewal of registration

54.—(1) On application by the owner of a registered trademark, the Commissioner must renew the registration of the trademark from the date on which the registration expires (the **expiry date**).

- (2) An application for renewal must be made to the Commissioner—
- (a) not more than 12 months before, and not more than 6 months after, the expiry date; and
 - (b) in the prescribed manner.
- (3) If the owner has not applied for renewal, the Commissioner must send to the owner a notice setting out—
- (a) the date on which the registration of the trademark will expire; and
 - (b) the conditions, as to the payment of prescribed fees or otherwise, on which the registration will be renewed (the **renewal conditions**); and
 - (c) that—
 - (i) if the registration is not renewed before the expiry date, the register will be changed to record that the trademark's status is registered-past expiry date; and

- (ii) if the registration has still not been renewed 6 months after the expiry date, the trademark will be removed from the register.

(4) The notice must be sent in the prescribed manner before the expiry date.

(5) If the registration of a trademark is not renewed before its expiry date, the Commissioner must record on the register that its status is registered-past expiry date, until the registration is renewed or it is removed from the register.

(6) The Commissioner must remove the trademark from the register if—

- (a) notice has been sent under subsection (3);
- (b) 6 months have elapsed since the expiry date; and
- (c) the renewal conditions have not been met.

Effect of registered-past expiry date status

55.—(1) A trademark has the status of registered-past expiry date if—

- (a) the trademark's registration expiry date, referred to in section 54, has passed; but
- (b) the trademark has not yet been removed from the register.

(2) While the trademark's status is registered-past expiry date, the trademark—

- (a) is not a registered trademark for the purposes of Part 4; but
- (b) is a registered trademark for all other purposes.

(3) If the trademark's registration is renewed before it is removed from the register under section 54(6)—

- (a) the renewed registration takes effect from the expiry date; and
- (b) the trademark is taken to have remained a registered trademark for all purposes from that date as if its status had not changed.

Voluntary cancellation of registration of trademark

56. The registration of a trademark may be cancelled by the owner in relation to any or all of the goods or services in respect of which it is registered.

Cancellation or alteration of registration of trademark for breach of condition

57. The Commissioner or the court, as the case may be, may, on the application of an aggrieved person or on the Commissioner's own motion, make an order that cancels or alters the registration of a trademark on the ground of failure to comply with a condition entered on the register in relation to the trademark.

Cancellation or alteration of registration of certification trademark

58. The Commissioner may, on the application of an aggrieved person or on the Commissioner's own motion, require that any entry in the register that relates to a certification trademark be cancelled or altered, or that the deposited rules be altered, on any of the following grounds—

- (a) that the owner is no longer competent to certify any goods or services in respect of which the certification trademark is registered;
- (b) that the owner has not complied with the deposited rules;
- (c) that it is not in the public interest for the certification trademark to be registered;
- (d) that it is in the public interest to alter the deposited rules.

Cancellation or alteration of registration of collective trademark

59. The Commissioner may, on the application of an aggrieved person or on the Commissioner's own motion, require an entry in the register that relates to a collective trademark to be cancelled or altered on any of the following grounds—

- (a) that the collective association concerned is an unlawful association under any written law;
- (b) that the collective association concerned no longer exists; or
- (c) that it is not in the public interest for the collective trademark to be registered.

Application for revocation of registration of trademark

60.—(1) An aggrieved person may apply to the Commissioner or the court for the revocation of the registration of a trademark on any of the grounds set out in section 61.

(2) The Commissioner or the court may refuse any application for the revocation of the registration of a trademark that is frivolous or vexatious.

Grounds for revoking registration of trademark

61.—(1) The grounds for revoking the registration of a trademark are as follows—

- (a) that at no time during a continuous period of 5 years or more was the trademark put to genuine use in the course of trade in Fiji, by the owner for the time being, in relation to goods or services in respect of which it is registered;
- (b) that, in consequence of acts or inactivity of the owner, the trademark has become a common name in general public use for a product or service in respect of which it is registered;
- (c) that—
 - (i) the article or substance was formerly manufactured under a patent or the service was formerly a patented process;

- (ii) a period of 2 years or more has elapsed since the expiry of the patent; and
 - (iii) the word is or the words are the only practicable name or description of the article, substance or service;
- (d) that, in consequence of the trademark's use by the owner or with the owner's consent in relation to the goods or services in respect of which the trademark is registered, the trademark is likely to deceive or confuse the public, for instance as to the nature, quality, or geographical origin of those goods or services.

(2) For the purposes of subsection (1)(a), “continuous period” means a period that commences from a date after the actual date of registration and continues uninterrupted up to the date one month before the application for revocation.

(3) Notwithstanding subsection (1), a trademark may not be revoked for its non-use if its non-use is due to special circumstances that are outside the control of the owner of the trademark.

(4) Subsection (1)(a) does not apply if the owner commences or resumes genuine use of the trademark in the course of trade in Fiji after the expiry of the 5-year period and before the application for revocation is made.

(5) Any commencement or resumption of use after the expiry of the 5-year period but within the period of one month before the making of the application for revocation must be disregarded unless preparation for the commencement or resumption began before the owner became aware that the application may be made.

Onus of proof for revocation of registration of trademark for non-use

62. If an owner or a licensee intends to oppose an application for the revocation of the registration of a trademark under section 61(1)(a), the owner or the licensee must, within the period specified by the Commissioner or the court—

- (a) provide proof of the use of the trademark if the ground in section 61(1)(a) forms the basis for the application; or
- (b) raise the special circumstances that justify the non-use of the trademark if section 61(3) applies.

Revocation of registration of trademark

63.—(1) If the Commissioner or the court is satisfied that grounds for revocation of the registration of the trademark exist, the Commissioner or the court must—

- (a) if the grounds exist in respect of all of the goods or services in respect of which the trademark is registered, revoke the registration of the trademark; or
- (b) if the grounds exist in respect of only some of the goods or services in respect of which the trademark is registered, revoke the registration of the trademark in so far as it relates to those goods or services.

(2) If the registration of a trademark is revoked to any extent, the rights of the owner, to that extent, cease on—

- (a) the date of the application for revocation of the registration of the trademark; or
- (b) if the Commissioner or the court is satisfied that the grounds for revocation of the registration of the trademark existed at an earlier date, that date.

Voluntary disclaimer of trademark by owner

64. The owner of a trademark may disclaim any right to the exclusive use of any part of the trademark.

Disclaimer of trademark as condition of not revoking its registration

65. If the grounds specified in section 61(1)(b) or (c) exist, the Commissioner or the court may, as a condition of the registration of a trademark not being revoked, require the owner of the trademark to disclaim any right to the exclusive use of a word or words in relation to any goods or services.

Disclaimer of trademark for public interest reasons

66. If, in determining whether a trademark is to be registered or is to remain on the register, the Commissioner or the court considers that there are public interest reasons for doing so, the Commissioner or the court may require, as a condition of the trademark being on the register, that the owner—

- (a) disclaims any right to the exclusive use of any part of the trademark; or
- (b) makes any other disclaimer that the Commissioner or the court considers necessary for the purpose of defining the owner's rights under the registration.

Rights affected by disclaimer

67. A disclaimer on the register affects only those rights of the owner of a trademark that arise out of the registration of the trademark in respect of which the disclaimer is made.

Invalidity of registration of trademark

68.—(1) The Commissioner or the court may, on the application of an aggrieved person, declare that the registration of a trademark is invalid to the extent that the trademark was not registrable under Part 2 at the deemed date of registration.

(2) Notwithstanding subsection (1), the registration of a trademark that has acquired a distinctive character after its registration must not be declared invalid even though the trademark was not registrable under section 14(1)(b), (c) or (d) at the deemed date of its registration.

(3) The Commissioner or the court, as the case may be, may refuse any application for a declaration of invalidity that is frivolous or vexatious.

Effect of declaration of invalidity

69.—(1) If the registration of a trademark is declared invalid to any extent—

- (a) the trademark is, to that extent, to be treated as if it had not been registered; and
- (b) the Commissioner may alter the register accordingly.

(2) The validity of any transaction that occurred in respect of a registered trademark before the registration of the trademark was declared invalid is not affected.

Presumption of validity of registration of trademark

70. The registration of a trademark is, after the expiration of 7 years from the deemed date of registration, deemed to be valid unless—

- (a) the registration was obtained by fraud;
- (b) the trademark should not have been registered on any of the grounds set out in section 14; or
- (c) the registration may be revoked on any of the grounds set out in section 61.

Correction of register

71.—(1) A person who has an interest may apply for the correction of an error or omission in the register.

(2) An application for correction of the register may be made either to the Commissioner or the court.

(3) An application for correction of the register may not be made in respect of a matter that affects the validity of the registration of a trademark.

(4) The effect of the correction of the register is that the error or omission concerned is to be treated as if it had never existed unless the Commissioner or the court directs otherwise.

*Division 7—Other matters**Alteration of registered trademark not permitted*

72. The owner of a registered trademark may not alter the registered trademark after its actual date of registration.

Alteration of register

73. After the actual date of registration of a trademark, the Commissioner may—

- (a) at the request of the owner of the trademark, allow the owner's name or address to be altered on the register;
- (b) at the request of the owner, strike out any goods or services, or classes of goods or services, from those in respect of which the trademark is registered;

- (c) at the request of the owner—
- (i) enter a memorandum that relates to the trademark, provided that the memorandum does not in any way extend the rights given by the existing registration of the trademark;
 - (ii) alter a memorandum, provided that the alteration does not in any way extend the rights given by the existing registration of the trademark; or
 - (iii) remove a memorandum, provided that the removal does not in any way extend the rights given by the existing registration of the trademark.

Alteration of certification trademark rules

74.—(1) The Commissioner may, on the application of the owner of a registered certification trademark, alter the rules that govern the use of the certification trademark.

(2) The owner of a registered certification trademark who has applied under subsection (1) must provide the Commissioner with a draft of the altered rules for the Commissioner's approval.

Advertisement of application for alteration of rules

75.—(1) The Commissioner must ensure that an application for an alteration of the rules that relate to a registered certification trademark is advertised in the prescribed manner.

(2) The Commissioner must not, without giving the parties an opportunity to be heard, decide the application if, within the specified time, any person notifies the Commissioner that the person opposes the alteration of the rules.

Registration of title to trademark

76.—(1) A trademark is assignable and transmittable in respect of all or some of the goods or services for which it is registered.

(2) If the title to a trademark is assigned or transmitted after the actual date of registration, either of the following persons may apply to the Commissioner to register the new owner's title—

- (a) the person registered as the owner of the trademark;
 - (b) the person to whom the trademark has been assigned or transmitted.
- (3) On proof of the new owner's title, the Commissioner—
- (a) must register the new owner as the owner of the trademark in relation to the goods or services in respect of which the assignment or transmission has effect;
 - (b) may issue a replacement certificate of registration in the name of the new owner; and

- (c) must cause any assignment, transmission, or other document produced in evidence of title, or a copy of any of those documents, to be filed for public record.
- (4) If the title to a trademark is assigned or transmitted before the actual date of registration, either of the following persons may apply to the Commissioner to change the name of the applicant on the application—
- (a) the applicant for registration of the trademark;
 - (b) the person to whom the trademark has been assigned or transmitted.
- (5) On proof of the new owner's title, the Commissioner must—
- (a) change the name of the applicant on the application; and
 - (b) cause any assignment, transmission, or other document produced in evidence of title, or a copy of any of those documents, to be filed for public record.

Assigning or transmitting right to use trademark

77. Nothing in this Act prevents a licensee from assigning or transmitting the right to use a trademark.

PART 4—LEGAL PROCEEDINGS

Division 1—Civil proceedings for infringement

How Act affects other rights

78. Nothing in this Act affects the—

- (a) rights of action against any person for passing off goods or services as those of another person; or
- (b) rights relating to fair trading under the Fijian Competition and Consumer Commission Act 2010.

Infringement where identical or similar sign used in course of trade

79.—(1) A person infringes a registered trademark if the person does not have the right to use the registered trademark and uses in the course of trade a sign—

- (a) identical to the registered trademark in relation to any goods or services in respect of which the trademark is registered;
- (b) identical to the registered trademark in relation to any goods or services that are similar to any goods or services in respect of which the trademark is registered, if that use would be likely to deceive or cause confusion;
- (c) similar to the registered trademark in relation to any goods or services that are identical to or similar to any goods or services in respect of which the trademark is registered, if that use would be likely to deceive or cause confusion; or

(d) identical or similar to the registered trademark in relation to any goods or services that are not similar to the goods or services in respect of which the trademark is registered where the trademark is well known in Fiji and the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

(2) Subsection (1) applies only if the sign is used in such a manner as to render the use of the sign as likely to be taken as being used as a trademark.

(3) This section is subject to sections 82 to 89.

Infringement where non-compliance with certain contractual requirements

80.—(1) A registered trademark is infringed if—

(a) a purchaser or owner of goods and the owner or licensee of the registered trademark have entered into a written contract that requires the purchaser or owner of the goods not to do, in relation to the goods, any of the acts listed in subsection (2); and

(b) the owner, for the time being, of the goods—

- (i) has notice of the contractual requirement;
- (ii) does or authorises, in the course of trade, or with a view to dealing with the goods in the course of trade, any of those listed acts;
- (iii) did not purchase the goods for value and in good faith before receiving notice of the contractual requirement; and
- (iv) is not a successor in title to an owner to whom subparagraph (iii) applies.

(2) The acts referred to in subsection (1) are—

(a) the application of the trademark on the goods after their condition, getup, or packaging has been altered in any manner specified in the contract;

(b) if the trademark is on the goods—

- (i) the alteration, part removal, or part obliteration of the trademark;
- (ii) the application of any other trademark to the goods;
- (iii) the addition to the goods of any written material that is likely to damage the reputation of the trademark;

(c) if the trademark is on the goods, and there is something else on the goods that indicates a connection in the course of trade between the owner or licensee and the goods, the removal or obliteration, whether wholly or partly, of the trademark.

No defence that infringement arose from use of company name

81. In an action for infringement of a trademark, it is not a defence that the infringement arose from the use of the name under which a company has been registered.

No infringement where trademark used in circumstances not covered by registration

82. A registered trademark is not infringed by the use of a trademark in any way or in any circumstances to which, having regard to any condition entered on the register in relation to the trademark, the registration does not extend.

No infringement where more than one identical or similar registered trademarks used

83. A registered trademark is not infringed by the use of another registered trademark in relation to any goods or services for which that other trademark is registered.

No infringement for comparative advertising of registered trademark

84. A registered trademark is not infringed by the use of the registered trademark for the purposes of comparative advertising, but any such use otherwise than in accordance with honest practices in industrial or commercial matters must be treated as infringing the registered trademark if the use, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

No infringement for honest practices

85. A person does not infringe a registered trademark if, in accordance with honest practices in industrial or commercial matters, the person uses—

- (a) the person's name or the name of the person's place of business;
- (b) the name of the person's predecessor in business or the name of the person's predecessor's place of business;
- (c) a sign to indicate—
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or other characteristic of goods or services; or
 - (ii) the time of production of goods or of the rendering of services; or
- (d) the trademark where reasonably necessary to indicate the intended purpose of the goods (in particular as accessories or spare parts) or services.

No infringement for certain continuous use of unregistered trademark

86.—(1) A registered trademark (**trademark A**) is not infringed by the use of an unregistered trademark (**trademark B**) if—

- (a) trademark B is identical to or similar to trademark A and is used in relation to any goods or services that are identical to or similar to any goods or services in respect of which trademark A is registered;
- (b) trademark B was used in relation to those goods or services in the course of trade by the owner or a predecessor in title of the owner before whichever is the earlier of the following dates—
 - (i) the date of application in Fiji for the registration of trademark A; or
 - (ii) the date that the owner, or a predecessor in title, first used trademark A; and

(c) trademark B has been used continuously in relation to those goods and services in the course of trade by the owner's predecessors in title (if any) and the owner since that date.

(2) Nothing in this Act entitles the owner of a registered trademark to—

- (a) interfere with or restrain the use by any person of a trademark identical or similar to it in relation to goods or services in relation to which that person or the owner's predecessor in title had continuously used that trademark from a date prior to the commencement of this Act if, before that date, the use of that trademark by that person did not infringe the right to the use of the first-mentioned trademark given by the registration; or
- (b) object, if use is proved, to that person being put on the register for that identical or similar trademark in respect of those goods or services or similar goods or services.

No infringement for use in relation to certain identical or similar goods

87. A trademark registered in respect of goods is not infringed by its use in relation to identical or similar goods connected in the course of trade with the owner or licensee if, as to those goods or a bulk of which they form part—

- (a) the owner or licensee has applied the trademark and has not later removed or obliterated it; or
- (b) the owner or licensee has consented to the use of the trademark.

Exhaustion of rights conferred by registered trademark

88.—(1) A registered trademark is not infringed by the use of the trademark, including use for the purpose of advertising, in relation to goods that have been put on the market in any jurisdiction under that trademark under any one or more of the following circumstances—

- (a) by the owner;
- (b) with the owner's express or implied consent;
- (c) by an associated person of the owner.

(2) For the purposes of subsection (1)(c), a person is an associated person of the owner if—

- (a) they are in the same group of companies;
- (b) they are both bodies corporate and they consist of substantially the same members or are directly or indirectly under the control of the same persons;
- (c) either of them has effective control of the other's use of the trademark; or
- (d) a third person has effective control of the use of the trademark by each of them.

(3) For the purposes of subsection (2)—

- (a) “group of companies” includes a holding company and its subsidiaries; and
- (b) a person has effective control of the use of a trademark if that person may authorise the use of the trademark or has significant influence over how it is used, regardless of how that authorisation or influence arises (for example, whether directly or indirectly and whether by way of proprietary interest, contract, arrangement, understanding, a combination of those things, or otherwise).

When owner or licensee consents to use of registered trademark

89.—(1) For the purposes of section 87, the owner or licensee is deemed to have consented to the use of a trademark if a person with whom the owner or licensee has an arrangement that relates to the use of the trademark by the owner or licensee has consented to its use (whether or not that consent is subject to any conditions).

(2) Subsection (1) applies only to the use of a trademark in relation to a medicine that is imported by the State.

No proceedings for infringement of unregistered trademark

90. No person may bring proceedings to prevent, or to recover damages for, the infringement of an unregistered trademark.

Time for bringing proceedings for infringement of registered trademark

91. The owner of a registered trademark may bring proceedings for infringement of the registered trademark if—

- (a) in the case of a registered trademark the application for the registration of which has priority under section 31, the infringement occurred on or after the date of application in Fiji for the registration of the trademark; or
- (b) in the case of every other registered trademark, the infringement occurred on or after the deemed date of registration of the trademark.

Who may apply for relief for infringement of registered trademark

92. The owner of a registered trademark, or, in the case of a collective trademark, one or more members of a collective association acting on its behalf, may apply to the court for relief if the trademark is infringed.

Licensee may request owner of registered trademark to bring proceedings

93. Subject to agreement between the parties, a licensee of a registered trademark may request the owner of the registered trademark to bring proceedings to prevent infringement of the registered trademark.

Consequences of owner of registered trademark not bringing proceedings

94. If the owner of a registered trademark refuses or neglects to bring proceedings within 2 months after the licensee requested the owner to bring the proceedings, the licensee may commence proceedings for infringement in the licensee’s own name as if the licensee were the owner.

Consequences of licensee commencing proceedings

95. If the licensee commences proceedings under section 94—

- (a) the owner becomes a defendant in the proceedings; but
- (b) the owner is not liable for any costs unless the owner defends the proceedings.

Unjustified proceedings

96.—(1) If a person brings proceedings alleging an infringement of a registered trademark, the court may, on the application of any person against whom the proceedings are brought—

- (a) make a declaration that the bringing of proceedings is unjustified;
- (b) make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.

(2) The court must not grant relief under this section if the person who brings the proceedings proves that the acts in respect of which proceedings are brought constituted, or would have constituted if they had been done, an infringement of the trademark concerned.

(3) Nothing in this section makes a legal practitioner liable to any proceedings under this section in respect of any act done in his or her professional capacity on behalf of a client.

Types of relief available for infringement of registered trademark

97.—(1) If an application is made to the court for relief, the relief that the court may grant includes—

- (a) an injunction on any terms that the court thinks fit;
- (b) either damages or an account of profits.

(2) If an application is made to the court for relief, the court may grant such additional damages as the court requires, having regard to all the circumstances and, in particular, to—

- (a) the flagrancy of the infringement; and
- (b) any benefit accruing to the defendant by reason of the infringement.

Damages for infringement of collective trademark

98. In claiming damages for infringement of a collective trademark, the collective association that owns the collective trademark (or the member or members taking action on behalf of that collective association) may take into account any damage or loss of profits sustained or incurred by any member as a result of the infringement.

Order for erasure, etc. of offending sign

99.—(1) If a person has infringed the exclusive right to use a registered trademark, the court may make an order that requires the person—

- (a) to erase, remove, or obliterate the offending sign from any infringing goods, infringing material, or infringing object in the person's possession, custody, or control; or

- (b) if it is not reasonably practicable to erase, remove, or obliterate the offending sign, to destroy the infringing goods, infringing material, or infringing object.

(2) If an order under subsection (1) is not complied with, or it appears to the court likely that the order would not be complied with, the court may order that the infringing goods, infringing material, or infringing object be delivered to any person whom the court may direct—

- (a) to erase, remove, or obliterate the offending sign from the infringing goods, infringing material, or infringing object; or
- (b) if it is not reasonably practicable to erase, remove, or obliterate, the offending sign, to destroy the infringing goods, infringing material, or infringing object.

(3) Notwithstanding subsections (1) and (2), if any infringing goods are counterfeit trademark goods, the court must, unless the court is satisfied that there are exceptional circumstances, make an order that requires the person who has infringed to—

- (a) destroy the goods; or
- (b) deliver the goods to any person the court may direct, to destroy the goods.

Order for delivery up of infringing goods, infringing material, or infringing object

100.—(1) The court may order any infringing goods, infringing material, or infringing object in the possession of any person or before the court to be delivered up to the owner of the registered trademark or any other person that the court thinks fit.

(2) No order may be made under this section unless—

- (a) the court makes an order under section 101; or
- (b) it appears to the court that there are grounds for making an order under that section.

(3) A person to whom any infringing goods, infringing material, or infringing object is delivered up under an order made under this section must, if an order under section 101 is not made, retain them pending—

- (a) the making of an order under that section; or
- (b) the decision not to make an order under that section.

(4) Nothing in this section affects any other power of the court.

Order for disposal of infringing goods, infringing material, or infringing object

101. An application may be made to the court for an order that the infringing goods, infringing material, or infringing object delivered up under an order made under section 100 must be—

- (a) forfeited to the owner of the registered trademark or any other person that the court thinks fit; or

- (b) destroyed or otherwise dealt with as the court thinks fit.

Matters to be considered by court

102. In considering what order, if any, should be made under section 101, the court must consider—

- (a) whether other remedies available for infringement of the exclusive right to use the registered trademark would be adequate to compensate, or protect the interests of—
- (i) the owner of the registered trademark;
 - (ii) the licensee of the registered trademark; and
- (b) the need to ensure that no infringing goods, infringing material, or infringing object is disposed of in a manner that would adversely affect—
- (i) the owner of the registered trademark;
 - (ii) the licensee of the registered trademark.

Directions for service

103. The court must issue directions for the service of notice on every person who has an interest in the infringing goods, infringing material, or infringing object to which an application under section 101 relates.

Rights of persons with interest in infringing goods, infringing material, or infringing object

104. Every person who has an interest in the infringing goods, infringing material, or infringing object to which an application under section 101 relates is entitled to—

- (a) appear in proceedings for an order under that section, whether or not the person is served with notice; and
- (b) appeal against any order made, whether or not the person appears in the proceedings.

When order under section 101 takes effect

105. An order made under section 101 takes effect either—

- (a) at the end of the period within which notice of an appeal may be given; or
- (b) on the final determination or abandonment of the proceedings on appeal.

Miscellaneous court order if more than one person interested in infringing goods, infringing material or infringing object

106. If more than one person is interested in the infringing goods, infringing material, or infringing object to which an application under section 101 relates, the court may—

- (a) direct that the infringing goods, infringing material, or infringing object be sold, or otherwise dealt with, and the proceeds divided; and
- (b) make any other order that it thinks fit.

Position where no order made under section 101

107. If the court decides that no order should be made under section 101, the person in whose possession, custody, or control the infringing goods, infringing material, or infringing objects were before being delivered up is entitled to their return.

*Division 2—Criminal proceedings**When criminal proceedings may be commenced*

108. No proceeding may be commenced for any offence under sections 110 to 114 that was committed before the actual date of registration of the trademark concerned.

Liability of officers of body corporate

109. If a body corporate is convicted of an offence under sections 110 to 114, every director and every person concerned in the management of the body corporate is guilty of the offence if it is proved—

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

Offence to counterfeit registered trademark

110.—(1) Every person who, on a commercial scale, with the intention of obtaining a gain for himself or herself or any other person or of causing loss to any person, counterfeits a registered trademark commits an offence.

(2) For the purposes of subsection (1), a person counterfeits a registered trademark if, without the consent of the owner of the registered trademark, the person knowingly—

- (a) makes a sign that is identical to, or cannot be distinguished in its essential aspects from, the registered trademark so as to be likely to deceive; or
- (b) falsifies a genuine registered trademark, whether by alteration, addition, effacement, partial removal, or otherwise.

Offence to falsely apply registered trademark to goods or services

111.—(1) Every person who falsely applies a registered trademark to goods or services commits an offence.

(2) For the purposes of this section and section 114, a person falsely applies a registered trademark to goods or services if—

- (a) without the consent of the owner of the registered trademark, the person knowingly applies the trademark or a sign that the person knows is likely to be mistaken for that trademark to the goods or services; and
- (b) in the case of an application to goods, the person knows the goods are not the genuine goods of the owner or licensee of the registered trademark.

(3) For the purposes of this section and section 114, a trademark is applied to goods or services if—

- (a) the trademark is used in a sign or an advertisement including a televised advertisement or an invoice, wine list, catalogue, business letter, business paper, price list, or other commercial document; and
- (b) the goods are delivered, or services provided, as the case may be, to a person in accordance with a request or order made by reference to the trademark as so used.

(4) For the purposes of this section and section 114, a sign is applied to goods or services if the sign—

- (a) is applied to the goods themselves;
- (b) is applied to a covering, label, reel, or thing in or with which the goods are sold or exposed or had in possession for a purpose of trade or manufacture; or
- (c) is used in a manner likely to lead a person to believe that it refers to, describes, or designates the goods or services.

(5) For the purposes of subsection (4)(b)—

“covering” includes a stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper; and

“label” includes a band or ticket.

Offence to make object for making copies of registered trademark, etc

112. Every person who makes an object specifically designed or adapted for making copies of a registered trademark or a sign that is likely to be mistaken for a trademark with intent that the object be used for, or in the course of, committing an offence under section 110 or 111, commits an offence.

Offence to possess object for making copies of registered trademark, etc

113. Every person who, without lawful authority or excuse—

- (a) has in the person’s possession, custody, or control, an object specifically designed or adapted for making copies of a registered trademark or a sign that is likely to be mistaken for that trademark; and
- (b) intends the object to be used for, or in the course of, committing an offence under section 110 or 111,

commits an offence.

Offence to import or sell, etc, goods with falsely applied registered trademark

114. Every person who—

- (a) imports into Fiji for the purpose of trade or manufacture any goods to which that person knows a registered trademark is falsely applied;

- (b) sells or exposes for sale any goods to which that person knows a registered trademark is falsely applied; or
 - (c) has in the person's possession for the purpose of trade or manufacture any goods to which that person knows a registered trademark is falsely applied,
- commits an offence.

Penalties for offences

115. Every person who is convicted of an offence against—

- (a) section 110, 111, 112 or 113 is liable on conviction to—
 - (i) a fine not exceeding \$10,000 for each of the goods or services to which the offence relates, but not exceeding \$150,000 in respect of the same transaction; or
 - (ii) imprisonment for a term not exceeding 5 years; or
- (b) section 114 is liable on conviction to—
 - (i) a fine not exceeding \$150,000; or
 - (ii) imprisonment for a term not exceeding 5 years.

Order for delivery up in criminal proceedings

116. The court before which proceedings are brought against a person for an offence under sections 112 to 114 may order that goods or an object be delivered up to the owner of the registered trademark or to any other person that the court may direct if it is satisfied that, at the time of the defendant's arrest or charge—

- (a) the defendant had in the defendant's possession, custody, or control in the course of trade, goods to which—
 - (i) the registered trademark that has been counterfeited has been applied; or
 - (ii) a trademark or sign that is similar to the registered trademark so as to be likely to deceive or cause confusion has been falsely applied; or
- (b) the defendant had in the defendant's possession, custody, or control an object specifically designed or adapted for counterfeiting a particular trademark, knowing that the object had been or was to be used to counterfeit trademarks for use in the course of trade.

When order for delivery up may be made

117.—(1) An order may—

- (a) be made under section 116 by the court of its own motion or on the application of the prosecution; and
- (b) be made whether or not the person is convicted of the offence; but
- (c) not be made if it appears to the court unlikely that an order will be made under section 118.

(2) A person to whom goods or an object is delivered up under an order made under section 116 must retain the goods or object pending the making of an order or the decision not to make an order under section 118.

Order for disposal of goods or other object ordered to be delivered up

118. An application may be made to the court for an order that the goods or object delivered up under an order made under section 116 must be—

- (a) forfeited to the owner of the registered trademark; or
- (b) destroyed or otherwise dealt with as the court thinks fit.

Matters to be considered by court

119. In considering what order, if any, should be made under section 118, the court must consider—

- (a) whether other remedies available in proceedings for counterfeiting or falsely using a registered trademark would be adequate to compensate, or protect the interests of, the owner of the registered trademark; and
- (b) the need to ensure that no infringing goods are disposed of in a manner that would adversely affect the owner of the registered trademark.

Directions for service

120. The court must 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 section 118 relates.

Rights of persons with interest in goods or other object

121. Every person who has an interest in the goods or other object to which an application under section 118 relates is entitled to—

- (a) appear in proceedings for an order under that section, whether or not that person is served with notice; and
- (b) appeal against any order made, whether or not that person appears in the proceedings.

When order under section 118 takes effect

122. An order made under section 118 takes effect either—

- (a) at the end of the period within which notice of an appeal may be given; or
- (b) on the final determination or abandonment of the proceedings on appeal, if notice of the appeal is given before the end of that period.

Miscellaneous court orders if more than one person interested in goods or other object

123. If more than one person is interested in the goods or other object to which an application under section 118 relates, the court may—

- (a) direct that the goods or object be sold, or otherwise dealt with, and the proceeds divided; and
- (b) make any other order as it thinks fit.

Position where no order made under section 118

124. If the court decides that no order should be made under section 118, the person in whose possession, custody, or control the goods or other object was before being delivered up is entitled to its return.

*Division 3—Border protection measures**Interpretation of Division 3*

125. In this Division, unless the context otherwise requires—

“clearance” means the completion of formalities necessary to allow goods imported into Fiji to be released into free circulation;

“Comptroller” has the meaning given in section 2 of the Customs Act 1986;

“importation” means the act of bringing or causing any goods to be brought into Fiji;

“infringing goods” means counterfeit trademark goods but excluding infringing goods of a non-commercial nature and intended for the importer’s or consignee’s own personal use contained in personal luggage or sent in small consignments by post;

“rights holder” means the natural person or legal entity which, according to law is to be regarded as the owner or rights holder of the particular intellectual property right, its successors in title, or its duly authorised exclusive licensee as well as an individual, a corporation or an association authorised by any of these persons to protect its rights; and

“Service” means the Fiji Revenue and Customs Service established under section 3 of the Fiji Revenue and Customs Service Act 1998.

Applications for intervention

126. A rights holder may submit an application to the Comptroller in accordance with the procedures and under the conditions set out in this Act, for the suspension of customs clearance of imported goods that are suspected of being infringing goods.

Procedure

127.—(1) Any application in terms of section 126 must—

- (a) be in the prescribed form;
- (b) provide the prescribed information; and
- (c) be accompanied by the prescribed fee.

(2) The Comptroller must deal with an application within a reasonable period of time and must grant the application if *prima facie* satisfied on reasonable grounds that—

- (a) the intellectual property right which relates to the goods subsists; and
- (b) the applicant is the rights holder of that intellectual property right.

(3) If the Comptroller is not satisfied because of a lack of information necessary for adjudication of the application, the Comptroller may defer his or her decision and request in writing that the applicant submit additional information within the requested time.

(4) Where urgent applications for which immediate action is required, and where sufficiently specific information concerning known shipments containing allegedly infringing goods is provided must be assessed immediately, notification to the rights holder must be made as soon as possible and no later than 3 working days.

(5) Unless the rights holder—

(a) requests a shorter period; or

(b) applies for action in cases of specific shipments,

the Service must only take action in relation to an accepted application for a prescribed period.

(6) If the application is rejected, the reasons must be clearly stated.

(7) Provided that an applicant has submitted adequate evidence for the adjudication of the application, an application may not be rejected on the basis that the applicant has not provided all of the prescribed information.

(8) The Comptroller may refuse to suspend the clearance of 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.

(9) The rights holder must inform the Comptroller in writing when his or her intellectual property right ceases to be valid or if he or she ceases to be the owner of the right for any reason whatsoever, in which event the action period or suspension lapses.

Suspension

128.—(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.

(2) The Comptroller must immediately inform—

(a) the applicant; and

(b) provided their identity is known to the Service, the importer, exporter, consignee or the consignor,

of the suspension of the clearance of the goods and must state the reasons for such suspension.

Proceedings relating to the merits

129.—(1) The applicant must institute proceedings leading to a decision on the merits of its claim before the court.

(2) The goods must be released, if all other conditions for importation have been complied with, unless—

- (a) the court orders otherwise; or
- (b) the Comptroller is informed in writing within a period of 10 working days after the applicant was informed of the suspension that proceedings under this section have been initiated.

(3) The time limit in subsection (2)(b) may be extended by the Comptroller in appropriate cases for a further 10 working days.

(4) In the case of perishable goods, the period referred to in subsection (2)(b) is 3 working days, which may not be extended.

(5) In the event of a suspension in terms of an order of court, the periods referred to in subsections (2) to (4) are to be determined by the court, failing which the period must not exceed 20 working days or 31 calendar days, whichever is longer.

(6) The defendant may apply to the Comptroller or the court, pending the determination of the merits, for a review of the suspension and, at the election of the defendant, for the opportunity to be heard, and the Comptroller or the court may, within a reasonable time, modify, revoke or confirm the terms of the suspension.

(7) Without prejudice to the protection of confidential information, the Comptroller must permit the rights holder and the importer sufficient opportunity to inspect the goods subject to suspension in order to substantiate the rights holder's claim that the goods are infringing goods, and for no other purpose.

(8) Where a positive determination has been made by the court that goods are infringing goods, the Comptroller must at the rights holder's request inform the rights holder of the names and addresses of the exporter, the importer, the consignee, and the consignor and of the quantity of the goods in question.

(9) Where the court has determined that the goods are not infringing goods, the importer, the consignee and the owner of the goods may be entitled to damages, in an amount determined by the court, caused by the wrongful suspension and detention of the goods concerned.

Ex officio action

130.—(1) The Comptroller may, on its own initiative, suspend the clearance of goods—

- (a) in respect of which it has acquired *prima facie* evidence that the goods are infringing goods; or
- (b) where there are reasonable grounds to suspect that the goods are infringing goods.

(2) Where the Comptroller suspends the clearance of goods under subsection (1), sections 128 and 129 apply *mutatis mutandis*.

Disposal of infringing goods

131.—(1) Where a positive determination has been made by the court that goods are infringing goods, the court may, upon application by the rights holder, order that the goods be forfeited and—

- (a) destroyed; or
- (b) disposed of by placing them outside free circulation, either by the Service or by the rights holder, under the supervision of the Service.

(2) In granting an order under subsection (1), the court must have regard to the following—

- (a) disposal must be outside the normal channels of commerce and in such a manner so as to minimise the risks of further infringements, and without detriment to the rights of the rights holder;
- (b) the rights holder's proposed manner of destruction or disposal;
- (c) the effect on the environment of the manner of destruction; and
- (d) the re-exportation of the counterfeit trademark goods in an unaltered state, or subjecting them to a different customs procedure, other than in exceptional circumstances, must not be permitted.

(3) If the rights holder has provided adequate evidence to the satisfaction of the Comptroller that the goods are infringing goods and—

- (a) the importer, the exporter, the consignee, the consignor, the owner of the goods, or the declarant who has been served by the Comptroller with a notice of suspension, has been informed about the possibility of confiscation and destruction or disposal outside the channels of commerce by default of the goods and does not oppose the measure within 20 working days after having been served the notice; or
- (b) if after reasonable efforts by the Comptroller the importer, exporter, consignee, consignor, the owner of the goods, or the declarant has not been identified,

the Service may, *ex officio* and without a court order and with or without the request of the rights holder, forfeit and destroy or dispose of the goods by placing them outside the channels of commerce, and subsection (1) applies *mutatis mutandis*.

(4) Should the applicant have been granted an extension of the time limit for taking legal action, such extension automatically applies to the opposition procedure referred to in this section.

Liability

132.—(1) The Comptroller and the Service are not liable 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 including, in particular—

- (a) any failure to detect the goods; or
- (b) the inadvertent release of the goods.

(2) An importer, exporter, consignee, consignor or the owner of the goods may apply to the court for appropriate monetary compensation from the applicant or rights holder for injury caused to them through wrongful detention of goods by the Comptroller or the Service as a result of the actions of the applicant or rights holder.

(3) The owner of the goods, the importer, the exporter, the consignee or the consignor are liable to pay to the Service the costs of storage, destruction or disposal of infringing goods.

(4) If the Service is unable to recover the said costs from any such party, the rights holder is liable to pay said costs and is entitled to recover any costs so paid from any such party.

*Division 4—Miscellaneous**Application to Commissioner or court*

133. A person who may apply either to the Commissioner or the court for a determination under this Act—

- (a) must, if an action concerning the trademark in question is pending, apply to the court;
- (b) may, in any other case, apply to the Commissioner who may—
 - (i) after hearing the parties, determine the question between them; or
 - (ii) at any stage of the proceedings, refer the application to the court.

Commissioner's appearance in certain proceedings

134.—(1) In any legal proceedings in which the relief sought includes alteration or correction of the register, or alteration, revocation, or invalidity of a registered trademark, the Commissioner—

- (a) has the right to appear and be heard; and
- (b) must appear if directed by the court.

(2) The Commissioner may, unless otherwise directed by the court, give the court a written statement—

- (a) of the following particulars that are within the Commissioner's knowledge—
 - (i) the issues;
 - (ii) the grounds of any decision given by him or her;

- (iii) the practice of the Fiji Intellectual Property Office in similar cases;
 - (iv) any other matters that are relevant to the issues; and
- (b) that is signed by the Commissioner.
- (3) The Commissioner's written statement forms part of the evidence in the proceedings.

Mode of giving evidence in proceedings before Commissioner

135.—(1) Subject to any regulations, in any proceedings under this Act before the Commissioner, the evidence must be given by affidavit or statutory declaration in the absence of directions to the contrary.

- (2) Notwithstanding subsection (1), the Commissioner may —
- (a) take oral evidence instead of, or in addition to, evidence by affidavit or declaration; or
 - (b) permit a deponent or declarant to be cross-examined on his or her affidavit or declaration.

(3) Any such statutory declaration may, in the case of appeal, be used before the court instead of evidence by affidavit, and, if so used, has all the incidents and consequences of evidence by affidavit.

(4) In any proceeding under this Act before the Commissioner, the Commissioner may administer oaths to any witness, and may in the prescribed manner require the attendance of any witness and discovery and production of documents.

Evidence of entries, documents, etc

136.—(1) A certificate signed by the Commissioner that certifies that any entry that he or she is authorised by or under this Act to make has or has not been made, or that any other thing that he or she is so authorised to do has or has not been done, is *prima facie* evidence of the certified matters.

(2) A copy of, or extract from, a registered document particulars of which have been entered in any device or facility referred to in section 155(2) certified to be a true copy or extract by the Commissioner is admissible in evidence in legal proceedings to the same extent as the original document.

(3) A person may, on payment of the prescribed fee, require the Commissioner to give or certify a copy of any entry in the register.

(4) The notification in the prescribed manner of the doing, exercise, or performance of an act, power, function, or duty that the Commissioner is directed, authorised, or empowered to do under this Act or otherwise by law is *prima facie* evidence that it was lawfully done, exercised, or performed.

Registration is prima facie evidence of validity

137. In all legal proceedings that relate to a registered trademark the fact that a person is registered as owner of the trademark is *prima facie* evidence of the validity of the original registration of the trademark and of all later assignments and transmissions.

Appeal against decision of Commissioner that relates to assignments and transmissions

138. A document or instrument in respect of which no entry has been made in the register must not be admitted in evidence in a court as proof of the title to a trademark—

- (a) except for the purposes of an application under section 71 or of an appeal under section 145; or
- (b) unless the court otherwise directs.

Trade usage must be considered

139. In an action or proceeding relating to a trademark or trade name, the Commissioner or the court, as the case may be, must admit evidence of—

- (a) the usages of the trade concerned; and
- (b) any relevant trademark or trade name or get-up legitimately used by other persons.

Certificate of validity

140.—(1) In a legal proceeding in which the validity of the registration of a registered trademark comes into question, the court may certify a decision that is in favour of the owner of the trademark.

(2) The owner of a registered trademark who obtains a final order or judgment in his or her favour in a later legal proceeding in which the validity of the registration of the trademark comes into question again is entitled to his or her full costs, charges, and expenses as between solicitor and client if—

- (a) the court has already certified a decision in favour of the owner under subsection (1); and
- (b) the court does not certify in the later proceeding that the owner is not entitled to those costs, charges, and expenses.

Costs

141.—(1) In any proceedings before the Commissioner under this Act, the Commissioner may—

- (a) by order, award to any party costs that the Commissioner considers reasonable; and
- (b) direct how and by what parties they are to be paid.

(2) An order under subsection (1) may be—

- (a) entered as a judgment of the court; and
- (b) with the leave of the court, may be enforced accordingly.

Commissioner or court may require security for costs

142.—(1) The Commissioner or the court, as the case may be, may require a party to legal proceedings under this Act to give security for the costs of the proceedings if satisfied that—

- (a) the party does not reside, and does not carry on business, in Fiji; or

(b) there is reason to believe that the party will be unable to pay the costs of the other party if unsuccessful in the proceedings.

(2) If the party does not give the security required, the Commissioner or the court may treat the proceedings as abandoned by the party and determine the matter accordingly.

No costs on appeal against refusal to certify or to authorise use

143. Notwithstanding section 142, the Commissioner does not have any jurisdiction to award costs to or against any party on an appeal to the Commissioner against a refusal of the owner of a certification trademark to certify goods or services or to authorise the use of the trademark.

Costs of Commissioner in proceedings before court

144. In all court proceedings under this Act, the Commissioner's costs are at the discretion of the court.

Appeals in relation to Commissioner's decisions

145. A person who is aggrieved by a decision of the Commissioner under this Act may appeal to the court.

Notice of appeal

146. Notice of an appeal under section 145 must be filed in the court and served on the Commissioner within 20 working days after the day on which the decision appealed against was given.

Hearing of appeal

147.—(1) On an appeal, the court must hear the parties and the Commissioner.

(2) Appeals must be heard only on the materials stated by the Commissioner unless a party, either in the manner prescribed or by special leave of the court, brings forward further material for the consideration of the court.

(3) In the case of an appeal against the acceptance of an application or the registration of a trademark—

(a) no further grounds of objection are permitted by the opponent or the Commissioner, other than those stated by the opponent, except by leave of the court; and

(b) if further grounds of objection are permitted, the applicant's application may be withdrawn without payment of the costs of the opponent on giving notice as prescribed.

Determination of appeals

148. In determining an appeal, the court may do any of the following things—

(a) confirm, modify, or reverse the Commissioner's decision or any part of it;

(b) exercise any of the powers that could have been exercised by the Commissioner in relation to the matter to which the appeal relates;

- (c) in the case of an appeal against the registration of a trademark, permit the trademark proposed to be registered to be modified in any manner that does not substantially affect its identity, and, in any such case, the trademark as so modified must be advertised in the prescribed manner before being registered.

Provisions pending determination of appeal

149. The decision to which an appeal under this Act relates remains in full force pending the determination of the appeal unless the court otherwise orders.

PART 5—ADMINISTRATIVE PROVISIONS AND MISCELLANEOUS

Division 1—Commissioner of Trademarks

Commissioner of Trademarks

150. The Solicitor-General is, for the purposes of this Act, to perform the functions and exercise the powers of the Commissioner of Trademarks.

Functions of Commissioner

151. The Commissioner has the following functions—

- (a) examine applications for the registration of trademarks, consider applications for the alteration, renewal, assignment, revocation, declaration of invalidity, and cancellation of registered trademarks and make other decisions relating to the examination and registration of trademarks;
- (b) provide preliminary advice and search advice to persons who propose to apply for the registration of trademarks;
- (c) maintain the register of trademarks and carry out other duties and responsibilities relating to the register of trademarks; and
- (d) perform or exercise other functions, duties, and powers conferred on him or her by this Act and the regulations.

Commissioner may delegate

152.—(1) The Commissioner may delegate to any person, either generally or particularly, any of the Commissioner’s functions, duties, and powers, except this power of delegation.

(2) A delegation—

- (a) must be in writing;
- (b) may be subject to any restrictions and conditions that the Commissioner thinks fit;
- (c) is revocable at any time, in writing; and
- (d) does not prevent the performance or exercise of a function, duty, or power by the Commissioner.

Liability of Commissioner and others

153. The Commissioner or any other person acting on behalf of the Commissioner is not personally liable for any act or omission done in good faith in the performance or intended performance of the Commissioner's functions, duties, or powers.

Hearing before exercise of Commissioner's discretion

154. The Commissioner must not exercise any of the Commissioner's discretionary or other powers under this Act or any regulations made under this Act adversely to any person without, if required to do so within the prescribed time, giving the person an opportunity to be heard.

*Division 2—Register of trademarks**Register of trademarks*

155.—(1) The Commissioner must ensure that a register of trademarks registered in Fiji is kept and maintained.

(2) The register may be kept in any manner that the Commissioner thinks fit, including, either wholly or partly, by means of a device or facility—

- (a) that records or stores information electronically or by other means; and
- (b) that permits the information so recorded or stored to be readily inspected or reproduced in usable form.

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

Contents of register

156. The register must contain the following—

- (a) all registered trademarks with the names and addresses of their owners;
- (b) the actual date of registration, the deemed date of registration, and the date of application in Fiji;
- (c) if the trademark's status is registered-past the expiry date, as defined in section 55, a statement to that effect;
- (d) assignments and transmissions;
- (e) memoranda referred to in section 73(c);
- (f) disclaimers;
- (g) conditions;
- (h) any other prescribed matters relating to registered trademarks.

No notices of trusts may be entered in register

157. No notice of any trust may be entered in the register, and the Commissioner is not affected by any such notice.

Search of register

158.—(1) A person may, on payment of the prescribed fee, search the register—

- (a) during the hours when the office of the Commissioner is open to the public for the transaction of business on a working day; and
- (b) at any other time that the Commissioner allows.

(2) A certified copy of an entry in the register must, on payment of the prescribed fee, be given to any person who requires the certified copy.

Offence to make false entry in register

159.—(1) Every person who—

- (a) makes or causes to be made a false entry in the register or a writing falsely purporting to be a copy of an entry in the register knowing the entry or writing to be false; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false,

commits an offence.

(2) Every person who is convicted of an offence under subsection (1) is liable on conviction to imprisonment for a term not exceeding 2 years.

Offences relating to false representation of trademark

160.—(1) Every person who represents that—

- (a) a sign, or the whole or a part of a trademark, is a registered trademark when it is not;
- (b) a registered trademark is registered in respect of any goods or services when it is not; or
- (c) the registration of a trademark gives an exclusive right to its use when it does not,

commits an offence.

(2) Every person who is convicted of an offence under subsection (1) is liable on conviction to a fine not exceeding \$1,000.

(3) For the purposes of this section, a reference to—

- (a) registered is to be read as a reference to registered under this Act; and
- (b) registration is to be read as a reference to registration in the register.

(4) Subsection (3) does not apply if the relevant reference relates to the registration of a trademark under the law in force in a country outside Fiji.

*Division 3—Miscellaneous**No compensation for diminution in rights attaching to trademark*

161. No person is entitled to compensation from the State in respect of any diminution in the rights that attach to a trademark that may arise by virtue of the enactment of this Act (for example, the removal of the trademark from the register).

Opening hours of Fiji Intellectual Property Office

162.—(1) The Commissioner may—

- (a) fix the opening hours for the Fiji Intellectual Property Office; and
- (b) declare the Fiji Intellectual Property Office closed on any day.

(2) The Commissioner must publicly notify those opening hours and any closure before closing the Fiji Intellectual Property Office.

(3) A thing that must or may be done on a particular day or within a limited period of time may, if that day or the last day of that period is not an opening day of the Fiji Intellectual Property Office, be done on the next opening day.

Closing of Fiji Intellectual Property Office at short notice

163.—(1) The Commissioner may declare the Fiji Intellectual Property Office closed without giving publication of the closure under section 162 if—

- (a) he or she thinks it necessary or desirable because of an emergency or other temporary circumstances; and
- (b) it is not practicable to make that prior publication.

(2) The Commissioner must, as soon as practicable after closing the Fiji Intellectual Property Office, give public notification of the closure.

Recognition of agents

164.—(1) Any thing that must be done by or to a person under this Act, in relation to a trademark, may be done by or to the person's expressly authorised agent.

(2) Subsection (1) applies only if the agent is not a class of person prescribed by regulations.

Substitution of person other than applicant generally

165.—(1) This section applies to the following applications—

- (a) application for cancellation or alteration under section 57;
- (b) application for revocation under section 60;
- (c) application for a declaration of invalidity under section 68;
- (d) application for correction of register under section 71.

(2) An application referred to in subsection (1) may proceed in the name of any person other than the applicant if—

- (a) after the applicant has filed the application, the right or interest on which the applicant relied to file the application becomes vested in another person; and

- (b) the other person—
 - (i) notifies the Commissioner in writing that the right or interest is vested in him or her; and
 - (ii) does not withdraw the application.

Substitution of person other than opponent on notice of opposition

166. A notice of opposition to an application under section 42 may proceed in the name of any other person if—

- (a) after the person has given notice, the right or interest on which that person relied to give notice becomes vested in another person; and
- (b) that other person—
 - (i) notifies the Commissioner, in writing, that the right or interest is vested in him or her; and
 - (ii) does not withdraw the opposition.

Amendment of documents other than application

167. The 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.

Fees

168.—(1) Any sum paid to the Commissioner by mistake, or any sum the payment of which is not required by this Act, may be refunded by the Commissioner.

(2) All money that is so refunded must be paid out of public money without further appropriation than this Act.

Application of section 170

169. Section 170 does not apply to—

- (a) notices or other documents served or given in any proceedings in a court; or
- (b) notices or other documents served or given in accordance with another procedure specified in this Act.

Method of service of notices

170.—(1) A notice or any other document that is required or authorised by this Act to be served on or given to a person may be served or given by—

- (a) delivering it to the person or the person's agent;
- (b) leaving it at the person's or the person's agent's usual or last known residence or business;

- (c) posting it in a letter addressed to the person or the person's agent by name at that residence or business address; or
- (d) emailing it to the person or the person's agent at an email address that is used by the person or the person's agent.

(2) If the person is deceased, a notice or other document may be served on or given to the person's personal representative.

(3) A notice or any other document that is sent to a person by post must be treated as received by the person when it would have been delivered in the ordinary course of post, and, in proving the delivery, it is sufficient to prove that the letter was properly addressed and posted.

(4) In the absence of proof to the contrary, a notice or any other document that is e-mailed to a person must be treated as received by the person at the time when the e-mail becomes capable of being retrieved by the person and, in proving that the document was e-mailed, it is sufficient to prove that the document was properly addressed and sent to the email address.

Regulations

171. The Minister may make regulations to prescribe matters that are required or permitted by this Act to be prescribed or are necessary or convenient to be prescribed for carrying out or giving effect to this Act and generally for achieving the purposes of this Act including—

- (a) prescribing procedures, requirements, and other matters in respect of the amended or substituted classification of goods or services for the purposes of the registration of trademarks under this Act;
- (b) prescribing procedures, requirements, and other matters in respect of the registration, or renewal or alteration or cancellation, of trademarks under this Act, including—
 - (i) providing for the division of an application for the registration of a trademark into several applications;
 - (ii) providing for the division of a registration of a trademark into several registrations;
 - (iii) providing for the merging of separate applications or registrations;
 - (iv) providing for the registration of a series of trademarks;
- (c) for the purpose of giving effect in Fiji to the Madrid Protocol, including providing for any of the following—
 - (i) making applications for international registration by way of the Fiji Intellectual Property Office as office of origin;
 - (ii) procedures to be followed where the basic Fijian application for registration ceases to be in force;

- (iii) procedures to be followed where the Fiji Intellectual Property Office receives from the International Bureau, or any person specified in the regulations, a request for extension of protection to Fiji;
- (iv) the effects of a successful request for extension of protection to Fiji;
- (v) transforming an application for an international registration, or an international registration, into a national application for registration;
- (vi) communicating information to the International Bureau;
- (vii) requiring fees to be paid in respect of applications for international registrations, extensions of protection, and renewals, and prescribing the amounts of those fees;
- (viii) the application of the following provisions to a protected international trademark (Fiji)—
 - (A) section 96 (unjustified proceedings);
 - (B) Part 4, Division 2 (criminal proceedings);
 - (C) Part 4, Division 3 (border protection measures);
- (d) prescribing an entity as a convention country for the purposes of giving effect to an international agreement or arrangement to which Fiji is a party or that applies to Fiji;
- (e) prescribing classes of persons whom the Commissioner may refuse to recognise as agents in respect of proceedings;
- (f) prescribing procedures, requirements, and other matters in respect of proceedings under this Act, including—
 - (i) providing for the payment of witnesses' expenses;
 - (ii) imposing fines not exceeding \$1,000 for the failure or refusal of a person to attend and give evidence;
- (g) prescribing procedures, requirements, and other matters in respect of the register and its operation, including matters relating to—
 - (i) access to the register;
 - (ii) the location of and hours of access to the register;
- (h) prescribing matters in respect of which fees are payable under this Act and the amounts of those fees;
- (i) prescribing time and extensions of time in respect of any matters under this Act;

- (j) prescribing forms for the purposes of this Act and those regulations may require—
 - (i) the inclusion in, or attachment to, forms of specified information or documents;
 - (ii) forms to be signed by specified persons;
- (k) prescribing procedures, requirements, and other matters in respect of notices under this Act, including prescribing the matters in respect of which notices are required under this Act;
- (l) regulating the business of the Fiji Intellectual Property Office in relation to trademarks and all things that are under the direction or control of the Commissioner; and
- (m) providing for any other matters contemplated by this Act, necessary for its administration, or necessary for giving it full effect.

Repeal

172.—(1) The Trade-Marks Act 1933 and the Merchandise Marks Act 1933 are repealed.

(2) The Trade-Marks Rules 1886 and the Merchandise Marks (Detention of Goods) Regulations 1956 are revoked.

Transitional

173.—(1) Notwithstanding the repeal of the Trade-Marks Act 1933, the Trade-Marks Act 1933 continues in force and applies in respect of—

- (a) an application for the registration of a trade-mark that was received by the Solicitor-General before the commencement of this Act until the trade-mark is registered and any proceedings related to that application, whether or not the proceedings commenced before the commencement of this Act;
- (b) an application for the alteration, renewal, assignment, or cancellation of a registered trade-mark that was received by the Solicitor-General before the commencement of this Act; and
- (c) any proceedings that commenced under the Trade-Marks Act 1933 before the commencement of this Act.

(2) Nothing in this Act invalidates the original registration of a trade-mark that, immediately before the commencement of this Act, was valid.

(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 53 applies.

Passed by the Parliament of the Republic of Fiji this 19th day of August 2021.