

LAWS OF FIJI
Ed. 1978]
CHAPTER 240

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TRADE-MARKS

Ordinances Nos. 18 of 1933, 2 of 1945, 9 of 1966, 37 of 1966, Act No. 13. of 1972.

AN ACT

TO CONSOLIDATE AND AMEND THE LAW RELATING TO TRADE-MARKS

[25th July, 1933.]

PART I-PRELIMINARY

Short title

1. This Act may be cited as the Trade-Marks Act.

Interpretation

2. In this Act, unless the context otherwise requires-

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

"trade-mark" means a mark used or proposed to be used upon or in connexion with goods for the purpose of indicating that they are the goods of the proprietor of such trade-mark by virtue of manufacture, selection, certification, dealing with or offering for sale;

"registrable trade-mark" means a trade-mark which is capable of registration under the provisions of this Act;

"the register" means the register of trade-marks kept under the provisions of this Act;

"registered trade-mark" means a trade-mark which is actually upon the register;

"prescribed" means, in relation to proceedings before the court, prescribed by rules of court, and in other cases prescribed by this Act or the rules thereunder;

"the court" means the Supreme Court.

PART II-GENERAL

Register of Trade-Marks

3. There shall be kept at the Administrator-General's office for the purposes of this Act a book called the "Register of Trade-Marks" wherein shall be entered all registered trade-marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and such other matters relating to such trade-marks as may from time to time be prescribed. The register shall be kept under the control and management of the Administrator-General who is in this Act referred to as the Registrar.

No trust to be entered

4. There shall not be entered in the register any notice of any trust, expressed, implied or constructive, nor shall any such notice be receivable by the Registrar.

Incorporation of existing Register

5. The register of trade-marks existing at the commencement of this Act shall be incorporated with and form part of the register. Subject to the provisions of sections 35 and 40, the validity of the original entry of any trade-mark upon the register so incorporated shall be determined in accordance with the statutes in force at the date of such entry and such trade-mark shall retain its original date, but for all other purposes it shall be deemed to be a trade-mark registered under this Act.

Inspection of register and granting of certified copies

6. The register kept under this Act shall at all convenient times be open to the inspection of the public subject to such regulations as may be prescribed, and entry in any, such certified copies, sealed with the seal of the Registrar, of any entry in such register shall be given to any person requiring the same on payment of the prescribed fee.

Registrable Trade-marks

Connexion of trade-marks with goods

7. A trade-mark must be registered in respect of particular goods or classes of goods.

Trade marks. What marks are registrable as such

8.-(1) A registrable trade-mark must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature or word or words other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness:

Provided always that any special or distinctive word or words, letter, numeral or combination of letters or numerals used as a trade-mark by the applicant or his predecessors in business before the twenty-second day of April, 1886, which has continued to be used either in its original form or with additions or alterations not substantially affecting the identity of the same down to the date of the application for registration shall be registrable as a trade-mark under this Act.

(2) For the purposes of this section "distinctive" shall mean adapted to distinguish the goods of the proprietor of the trade-mark from those of other persons. In determining whether a trade-mark is so adapted the tribunal may, in the case of a trade-mark in actual use, take into consideration the extent to which such user has rendered such trade-mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

Coloured trade-marks

9. A trade-mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide on the distinctive character of such trade-mark. If and so far as a trade-mark is registered without limitation of colour it shall be deemed to be registered for all colours.

Further restriction on registration

10. It shall not be lawful to register as a trade-mark or part of a trade-mark any matter the use of which would, by reason of its being calculated to deceive or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design.

Registration of Trade-Marks

Application for registration

11.-(1) Any person claiming to be the proprietor of a trade-mark who is desirous of registering the same shall apply in writing to the Registrar in the prescribed manner.

(2) Subject to the provisions of this Act, the Registrar may refuse such application or may accept it absolutely or subject to conditions, amendments or modifications or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the court.

(4) An appeal under this section shall be made in the prescribed manner and on such appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether and subject to what conditions, amendments or modifications, if any, or to what limitations, if any, as to mode or place of user or otherwise the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar other than those stated by him except by leave of the court hearing the appeal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the court as the case may be may at any time, whether before or after acceptance, correct any error in or in connexion with the application or may permit the applicant to amend his application upon such terms as they may think fit.

Advertisement of application

12. When an application for registration of a trade-mark has been accepted, whether absolutely or subject to conditions and limitations, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that an application under the provisions of paragraph (e) of subsection (1) of section 8 may be advertised on receipt of such application and before acceptance.

Opposition to registration

13.-(1) Any person may within the prescribed time from the date of the advertisement of an application for the registration of a trade-mark give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant and within the prescribed time after the receipt of such notice the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement the Registrar shall furnish a copy thereof to the persons giving notice of opposition and shall, after hearing the parties if so required and considering the evidence, decide whether and subject to what conditions or what limitations as to mode or place of user or otherwise registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the court.

(6) An appeal under this section shall be made in the prescribed manner and on such appeal the court shall, if required, hear the parties and the Registrar and shall make an order determining whether and subject to what conditions, if any, or what limitations, if any, as to mode or place of user or otherwise registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the court bring forward further material for the consideration of the court.

(8) In proceedings under this section no further grounds of objection to the registration of a trade-mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein above provided except by leave of the court hearing the appeal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section the court may, after hearing the Registrar, permit the trade-mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade-mark, but in such case the trade-mark as so modified shall be advertised on the prescribed manner before being registered.

(10) If a party giving notice of opposition or of appeal neither resides nor carries on business in Fiji, the court may require such party to give security for costs of the proceedings before it relative to such opposition or appeal and in default of such security being duly given may treat the opposition or appeal as abandoned.

Disclaimer

14. If a trade-mark contains parts not separately registered by the proprietor as trade-marks or if it contains matter common to the trade or otherwise of a nondistinctive character, the Registrar or the court in deciding whether such trademark shall be entered or shall remain upon the register may require as a condition of its being upon the register that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade-mark or of all or any portion of such matter to the exclusive use of which they hold him not to be entitled or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade-mark except such as arise out of the registration of the trade-mark in respect of which the disclaimer is made.

Date of registration

15. When an application for registration of a trade-mark has been accepted and has not been opposed and the time for notice of opposition has expired or, having been opposed, the opposition has been decided in favour of the applicant, the Registrar shall, unless the mark has been accepted in error, register the said trade-mark, and the trade-mark when registered shall be registered as of the date of the application for registration and such date shall be deemed for the purpose of this Act to be the date of registration.

Certificate of registration

16. On the registration of a trade-mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade-mark under the hand and seal of the Registrar.

Limit of time for proceeding with application

17. Where registration of a trade-mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the

prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Identical Trade-Marks

Identical marks

18. Except by order of the court or in the case of trade-marks in use before the twenty-second day of April, 1886, no trade-mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods or so nearly resembling such a trade-mark as to be calculated to deceive

Rival claims to identical marks

19. Where each of several persons claims to be proprietor of the same trademark or of nearly identical trade-marks in respect of the same goods or description of goods and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the court or have been settled by agreement in a manner approved by him.

Concurrent user

20. In the case of honest concurrent user or of other special circumstances which in the opinion of the court or Registrar make it proper so to do, the court or Registrar may permit the registration of the same trade-mark or of nearly identical trade-marks for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise as the court or the Registrar, as the case may be, may think it right to impose.

Assignment

Assignment and transmission of trade-marks

21. A trade-mark when registered shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with the goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade-mark to assign the right to use the same in any country or territory of the Commonwealth or protectorate or foreign country in connexion with any goods for which it is registered together with the goodwill of the business therein in such goods, and the assignment of such right to use the same shall constitute the assignee a proprietor of a separate trade-mark for the purpose of section 20 subject to such conditions and limitations as may be imposed under that section. (*Amended by 37 of 1966, s. 63.*)

Apportionment of marks on dissolution of partnerships

22. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business and the goodwill of such person does not pass to one successor but is divided, the Registrar may, subject to the provisions of this Act as to associated trade-marks, on the application of the parties interested permit an apportionment of the registered trade-marks of the person among the persons in fact continuing the business subject to such conditions and modifications, if any, and to such limitations, if any, as to mode or place of user as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the court.

Associated trade-marks

23. If application be made for the registration of a trade-mark identical with or so closely resembling a trade-mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade-marks shall be entered on the register as associated trade-marks.

Combined trade-marks

24. If the proprietor of a trade-mark claims to be entitled to the exclusive use of any portion of such trade-mark separately he may apply to register the same as separate trade-marks. Each such separate trade-mark must satisfy all the conditions and shall have all the incidents of an independent trade-mark except that when registered it and the trade-mark of which it forms a part shall be deemed to be associated trade-marks and shall be entered on the register as such, but the user of the whole trade-mark shall, for the purposes of this Act, be deemed to be also a user of such registered trade-marks belonging to the same proprietor as it contains.

Series of trade-marks

25. When a person claiming to be the proprietor of several trade-marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of-

- (a) statements of the goods for which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade-mark; or
- (d) colour,

seeks to register such trade-marks, they may be registered as a series in one registration. All the trade-marks in a series of trade-marks so registered shall be deemed to be and shall be registered as associated trade-marks.

Assignment and user of associated trade-marks

26. Associated trade-marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes, be deemed to have been registered as separate trade-marks:

Provided that where, under the provisions of this Act, user of a registered trade-mark is required to be proved for any purpose, the tribunal may, if and so far as it shall think right, accept user of an associated registered trade-mark or of the trade-mark with additions or alterations not substantially affecting its identity as an equivalent of such user.

Renewal of Registration

Duration and renewal of registration

27. The registration of a trade-mark shall be for a period of fourteen years but may be renewed from time to time in accordance with the provisions of this Act.

Renewal of registration

28. The Registrar shall, on application made by the registered proprietor of a trade-mark in the prescribed manner and within the prescribed period, renew the registration of such trade-mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration as the case may be, which date is herein termed "the expiration of the last registration".

Procedure on expiry of period of registration

29. At the prescribed time before the expiration of the last registration of a trade-mark the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise for which a renewal of such registration may be obtained, and, if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade-mark from the register subject to such conditions, if any, as to its restoration to the register as may be prescribed.

Status of unrenewed trade-mark

30. Where a trade-mark has been removed from the register for non-payment of the fee for renewal, such trade-mark shall nevertheless for the purpose of any application for registration during one year next after the date of such removal be deemed to be a trade-

mark which is already registered unless it is shown to the satisfaction of the Registrar that there had been no bona fide trade user of such trade-mark during the two years immediately preceding such removal.

Correction and Rectification of the Register

Registrar may correct formal errors in applications

31. The Registrar may on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name-

(a) correct any error in the name or address of the registered proprietor of a trade-mark; or

(b) enter any change in the name or address of the person who is registered as proprietor of a trade-mark; or

(c) cancel the entry of a trade-mark on the register; or

(d) strike out any goods or classes of goods from those for which a trade-mark is registered; or

(e) enter a disclaimer or memorandum relating to a trade-mark which does not in any way extend the rights given by the existing registration of such trade-mark.

Any decision of the Registrar under this section shall be subject to appeal to the court.

Entry in register of assignments

32.-(1) Where a person becomes entitled by assignment, transmission or other operation of law to a registered trade-mark, he shall make application to the Registrar to register his title and the Registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade-mark and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission or other instrument affecting the title. Any decision of the Registrar under this section shall be subject to appeal to the court.

(2) Except in cases of appeals under this section and applications made under section 34, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) shall not be admitted in evidence in any court in proof of the title to a trade-mark unless the court otherwise directs.

Application to alter registered trade-mark

33. The registered proprietor of any trade-mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade-mark in any manner not substantially affecting the identity of the same and the Registrar may refuse such leave or may grant the same on such terms and subject to such limitations as to mode or place of user as he may think fit, but any such refusal or conditional permission shall be subject to appeal

to the court. If leave be granted the trade-mark as altered shall be advertised in the prescribed manner.

Rectification of register by the court

34. Subject to the provisions of this Act-

(a) the court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry or by any entry made in the register without sufficient cause or by any entry wrongly remaining on the register or by any error or defect in any entry in the register, make such order for making, expunging or varying such entry as it may think fit;

(b) the court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register;

(c) in case of fraud in the registration or transmission of a registered trade-mark the Registrar may himself apply to the court under the provisions of this section;

(d) any order of the court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner upon the Registrar, who shall, upon receipt of such notice, rectify the register accordingly.

Trade-marks registered under previous enactments

35. No trade-mark which is upon the register at the commencement of this Act and which under this Act is a registrable trade-mark shall be removed from the register on the ground that it was not registrable under the Act in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Act then in force.

Non-user of trade-mark

36. A registered trade-mark may, on the application to the court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered on the ground that it was registered by the proprietor or a predecessor in title without any bona fide intention to use the same in connexion with such goods and there has in fact been no bona fide user of the same in connexion therewith, or on the ground that there has been no bona fide user of such trade-mark in connexion with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon such trade-mark in respect of such goods.

Effect of Registration

Powers of registered proprietor

37. Subject to the provisions of this Act-

(a) the person for the time being entered in the register as proprietor of a trade-mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same and to give effectual receipts for any consideration for such assignment;

(b) any equities in respect of a trade-mark may be enforced in like manner as in respect of any other personal property.

Rights of proprietor of trade-mark

38. Subject to the provisions of section 40 and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade-mark shall, if valid, give to such person the exclusive right to the use of such trade-mark upon or in connexion with the goods in respect of which it is registered:

Provided always that where two or more persons are registered proprietors of the same or substantially the same trade-mark in respect of the same goods, no rights of exclusive user of such trade-mark shall, except so far as their respective rights shall have been defined by the court, be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Registration to be prima facie evidence of validity

39. In all legal proceedings relating to a registered trade-mark including applications under section 34, the fact that a person is registered as proprietor of such trade-mark shall be prima facie evidence of the validity of the original registration of such trade-mark and of all subsequent assignments and transmissions of the same.

Registration to be conclusive after seven years

40. In all legal proceedings relating to a registered trade-mark including applications under section 34, the original registration of such trade-mark shall, after the expiration of seven years from the date of such original registration or seven years from the commencement of this Act, whichever shall last happen, be taken to be valid in all respects unless such original registration was obtained by fraud or unless the trade-mark offends against the provisions of section 10:

Provided that nothing in this Act shall entitle the proprietor of a registered trade-mark to interfere with or restrain the user by any person of a similar trade-mark upon or in connexion with goods upon or in connexion with which such person has by himself or

his predecessors in business continuously used such trade-mark from a date anterior to the user or registration, whichever is the earlier, of the first-mentioned trade-mark by the proprietor thereof or his predecessors in business, or to object, on such user being proved, to such person being put upon the register for such similar trade-mark in respect of such goods under the provisions of section 20.

No protection for unregistered trade-marks

41. No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade-mark unless such trade-mark was in use before the twenty-second day of April, 1886, and has been refused registration under this Act. The Registrar may on request grant a certificate that such registration has been refused.

Action for infringement

42. In any action or proceeding relating to a trade-mark or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade-mark or trade name or get-up legitimately used by other persons.

No interference with bona fide user of name or description of goods

43. No registration under Act shall interfere with any bona fide use by a person of his own name or place of business or that of any of his predecessors in business or the use by any person of any bona fide description of the character or quality of his goods.

Action for passing off goods

44. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

Legal Proceedings

Certificates of validity

45. In any legal proceedings in which the validity of the registration of a registered trade-mark comes into question and is decided in favour of the proprietor of such trade-mark, the court may certify the same and, if it so certifies, then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade-mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between barrister and solicitor and client unless in such subsequent proceeding the court certifies that he ought not to have the same.

Procedure before court

46. In any legal proceeding in which the relief sought includes alteration or rectification of the register the Registrar shall have the right to appear and be heard and shall appear if so directed by the court. Unless otherwise directed by the court the Registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases or of such other matters relevant to the issues and within his knowledge as such Registrar as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Costs

47. In all proceedings before the court under this Act, the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Evidence

48.-(1) In any proceeding under this Act before the Registrar the evidence shall be given by statutory declaration in the absence of directions to the contrary, but in any case in which he shall think it right so to do the Registrar may, with the consent of the parties, take evidence viva voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may, in the case of appeal, be used before the court in lieu of evidence by affidavit but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the Registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a magistrate.

(3) Printed or written copies or extracts of or from the register purporting to be certified by the Registrar and sealed with his seal shall be admitted in evidence in all proceedings without further proof or production of the originals.

Certificate of registration to be prima facie evidence

49. A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing which he is authorised by this Act or rules made thereunder to make or do shall be prima facie evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or not done.

Powers and Duties of Registrar of Trade-Marks

Exercise of discretionary power by Registrar

50. Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade-mark in question without, if duly required so to do within the prescribed time, giving such applicant or registered proprietor an opportunity of being heard.

Agents

51. Where by this Act any act has to be done by or to any person in connexion with a trade-mark or proposed trade-mark or any procedure relating thereto, such act may, under and in accordance with rules made under this Act or in particular cases by special leave of the court, be done by or to an agent of such party duly authorised in the prescribed manner.

Power to make rules

52. Subject to the provisions of this Act the Registrar may from time to time make such rules, prescribe such forms and generally do such things as he may think expedient-

- (a) for regulating the practice under this Act;
- (b) for classifying goods for the purposes of registration of trade-marks;
- (c) for making or requiring duplicates of trade-marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing in such manner as the Registrar thinks fit of copies of trade-marks and other documents;
- (e) generally for regulating the business of the office in relation to trademarks and all things by this Act placed under the direction or control of the Registrar. (*Section amended by 37 of 1966, s. 63.*)

Fees

53. There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Minister.

Offences

54.-(1) If any person makes or causes to be made a false entry in the register kept under this Act or a writing falsely purporting to be a copy of an entry in any such register or produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(2) Any person who represents a trade-mark as registered which is not so shall be liable for every offence to a fine not exceeding ten dollars.

A person shall be deemed for the purposes of this enactment to represent that a trade-mark is registered if he uses in connexion with the trade-mark the word "registered" or any words expressing or implying that registration has been obtained for the trade-mark. (Amended by 2 of 1945, s. 97.)

PART III-UNITED KINGDOM TRADE-MARKS

Registration of United Kingdom trade-marks

55. Any person being the registered proprietor of a trade-mark registered in the United Kingdom under the Trade Marks Acts 1905 to 1919 or any Act amending or substituted for those Acts or any person deriving his right from such registered proprietor by assignment, transmission or other operation of law may apply at any time during the existence of the registration in the United Kingdom to have such trade-mark registered in Fiji.

Form of application

56. An application for registration of a trade-mark under this Act shall be made to the Registrar and accompanied by a certified representation of the trademark and a certificate of the Comptroller- General of the United Kingdom Patent Office giving full particulars of the registration of the trade-mark in the United Kingdom.

Certificate to issue

57. Upon such application being lodged together with the documents mentioned in section 56, the Registrar shall issue a certificate of registration.

Effect of certificate

58. Such certificate of registration shall confer on the applicant privileges and rights subject to all conditions established by law of Fiji as though the certificate of registration in the United Kingdom had been issued with an extension to Fiji.

Date of registration

59. Privileges and rights so granted shall date from the date of registration in the United Kingdom and shall continue in force only so long as the registration in the United Kingdom remains in force:

Provided that no action for infringement of the trade-mark shall be entertained in respect of any use of the trade-mark prior to the date of issue of the certificate of registration in Fiji.

Passing off

60. Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

Power of court

61. The court shall have power upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration to declare that the exclusive privileges and rights conferred by such certificate have not been acquired on any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom.

Assignment

62. A trade-mark when registered under this Act shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the goods for which it has been registered and shall be determined with that goodwill.

Assignee to be entered as proprietor

63. Subject to the provisions of this Act where a person becomes entitled by assignment, transmission or other operation of law to the privileges and rights conferred by a certificate of registration issued under this Act, the Registrar shall, on application being made in the prescribed manner and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade-mark.

Renewals

64. All renewals of the registration in the United Kingdom of a trade-mark registered under this Act shall be notified to the Registrar who shall, on sufficient evidence thereof and on payment of the prescribed fee, enter the same in the register in the prescribed manner.

Powers of Registrar

65. The Registrar may on request in writing made by the registered proprietor and on payment of the prescribed fee

- (a) cancel the registration of a trade-mark either wholly or in respect of any particular goods in connexion with which the trade-mark is registered;
- (b) correct any clerical error in or in connexion with any application under this Act or in any matter which is entered upon the register;
- (c) enter in the register any change in the name or address of the person who is registered as proprietor of a trade-mark.

Saving

66. Every rule, table of fees or classification of goods made under the *Trade and Merchandise Marks Ordinance 1886 and in force at the commencement of this Act shall continue in force as if made under this Act until superseded by rules, table of fees or classification under this Act.

*

Repealed by this Act.

Controlled by Ministry of the Attorney-General

CHAPTER 240

TRADE-MARKS

SECTION 52-TRADE-MARKS RULES

Rules 6 Oct., 1886 [in force 14 Dec., 1886], 14 Nov., 1958, 10 Oct., 1967, 10 Nov., 1969, 25 Nov., 1974, 12 Nov., 1976, 31 Aug., 1984.

**Made by the Chief Justice with the approval of the Legislative Council*

Short title

1. These Rules may be cited as the Trade-Marks Rules.

Fees

2. The fees specified in the First Schedule shall be payable to the Administrator-General.

Application for registration

3. Any person desiring to register a trade-mark shall make application to the Administrator-General in the form of the Second Schedule. The application to be on foolscap paper having a margin on the left-hand of not less than one-inch-and-a-half.

Nature and size of representation of trade-mark

4. A description of a trade-mark shall be given, and shall be accompanied when practicable by a drawing or other representation, in duplicate, not more than three inches square, on foolscap paper, by pasting or otherwise fastening on such paper a specimen of the trade-mark.

When a drawing or other representation or specimen cannot be given in a manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale. The Administrator-General may, if dissatisfied with the drawing or other representation of a trade-mark, require a fresh drawing or other representation, either before he proceeds with the application or before he registers the trade-mark.

The Administrator-General may also, in exceptional cases, receive and keep in his office a specimen or copy of any trade-mark which cannot conveniently be placed on his register.

Advertisement of trade-mark application

5. As soon as may be after the receipt of an application, the Administrator-General shall require the applicant to advertise such application in the Gazette, and in such other newspaper as the Administrator-General may, if he think necessary, direct, during such time, in such form, and generally in such manner as the Administrator-General may determine.

*Made under the provisions of section 14 of the Trade and Merchandise Marks Ordinance, 1886 and continued in force by the Trade-Marks Act. (See section 67 of Cap. 89 of 1955 Edition.)

Means of advertising trade-mark to be supplied

6. For the purposes of such advertisement the applicant may be required to furnish the Government Printer, and the printer of such other newspaper, with a wood block or electrotpe of the trade-mark of such dimensions or with such information or means of advertising the trade-mark as may be determined by the Administrator-General.

Notice and proceedings for objection

7. Notice of objection to any application may be given within three months of the publication of such advertisement to the Administrator-General by sending the same in duplicate on foolscap paper, stating the grounds of the objection. The Administrator-General shall send one copy of such notice to the applicant.

Within three weeks after receipt of such notice, or such further time as the Administrator-General may allow, the applicant may send to the Administrator-General a counter statement on foolscap paper, and if he fails to do so his application shall be deemed to be withdrawn.

The Administrator-General, after hearing the applicant and objector may order costs to be paid by either of them as he may think fit.

Time of registration of trade-mark

8. On the expiration of three months from the date of the first appearance of the advertisement in the Gazette, the Administrator-General may, if he is satisfied that the applicant is entitled to registration, register the trade-mark in respect of the description of goods for which he may be entitled to be registered, and the applicant as the proprietor thereof.

Date of registration

9. When a trade-mark shall be registered, the date on which the application for registration was received by the Administrator-General shall be deemed to be the date of registration.

Assignment

10. When a trade-mark has been assigned any person claiming to be registered as assignee shall send to the Administrator-General an application in the form of the Third Schedule, and shall forward therewith an assignment by deed duly executed.

Transmission

11. When a trade-mark is transmitted by operation of law, the person applying to be registered as the transmittee shall send to the Administrator-General an application in the form in the Third Schedule, and shall produce to the Administrator-General such evidence as he may desire in support of such application.

Removal of trade-mark after fourteen years unless fee paid

12. At the expiration of fourteen years from the date of registration, or within six months thereafter, unless the fees prescribed for continuance be paid, the trade-mark may be removed from the register. (*Substituted by Legal Notice No. 83 of 1984.*)

Payment of additional fee after expiration of fourteen years

13. If before the expiration of the said six months the registered proprietor pays the said fees together with the additional prescribed fee, the Administrator-General may, without removing such trade-mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years. (*Substituted by Legal Notice No. 83 of 1984.*)

Power of Administrator-General to restore trade-mark

14. When a trade-mark has been so removed from the register, the Administrator-General may, if he is satisfied that it is just so to do, restore such trade-mark to the register on payment of the additional fee prescribed and compliance with such conditions as he may think fit.

Publication of rectification or alteration of register

15. Whenever the register is rectified or altered in any particular, the Administrator-General shall, if he consider that such rectification or alteration should be made public, publish at the expense of any person interested, by advertisement or otherwise, the circumstances attending such rectification or alteration.

Notice to Administrator-General of opposition in any matter

16. When any person objects to the registration of any assignee or transmittee, or to any rectification or alteration of the register, the Administrator-General shall give to the applicant or his agent for such registration, rectification, or alteration, the like notice. The Administrator-General in such case may, if he think fit, require the parties interested to submit their claims to the Supreme Court.

Submission to Court of conflicting claims

17. Where the Administrator-General refuses to comply with the claims of any persons until their rights have been determined by the Supreme Court, the manner in which the rights of such claimants may be submitted to the Supreme Court by the Administrator-General, or by the claimants, if the Administrator-General so require, shall, unless the Court otherwise order, be by a special case or statement of questions of fact without pleadings, and the same shall be filed and proceeded with in like manner as in the case of any other special case or statement of questions of fact without pleadings submitted to the Supreme Court.

Administrator-General may settle case

18. The special case or statement of questions of fact may be agreed to by the parties, and, if they differ, may be settled by the Administrator-General.

Service of documents

19. Applications, statements, notices, and documents, required by these Rules to be served or sent, shall be in writing or print, or partly in writing and partly in print, and may be delivered personally or sent by post, and if sent by post shall be deemed to have been served and received respectively at the time when the letter containing the same would be delivered in the ordinary course of post; and in proving such service or sending it shall be sufficient to prove that the letter containing the notice was prepaid, duly stamped, and put into the post properly stamped.

Extension of time

20. Where the Administrator-General is satisfied that the circumstances are such as to justify an extension of time for doing any act or taking any proceeding under the provisions of these Rules, not being a time expressly provided in the Act or prescribed in rules 12 and 13, he may extend the time upon such notice to the parties and upon such terms as he may direct, and the extension may be granted although the time for doing the act or taking the proceedings has expired. (*Inserted by Rules 10 October, 1967.*)

Address for service

21. The Administrator-General may require an applicant, opponent or agent, or a registered proprietor or registered user of a trade-mark, who does not reside or carry on business within Fiji to give an address for service within Fiji and such address shall be treated as the actual address of that person for all purposes connected with the matter in question. *(Inserted by Rules 10 November, 1969.)*

FIRST SCHEDULE

(RULE 2)

(Substituted by Rules 25 November, 1974.)

FEES

The following fees shall be payable to the Administrator-General on or for the following occasions or purposes:- \$.. c

1. On application to register trade-mark for one or more articles 5.00
2. For registration of a trade-mark 10.00
3. Where the same person is registered at the same time for more than one trade-mark, for registration of each additional trade-mark after the first 5.00
4. For entering notice of objection, for each trademark 10.00
5. For registering subsequent proprietor, for each trade-mark-
 - if made within six months after acquisition of proprietorship 5.00
 - if made after six months but within twelve months after acquisition of proprietorship 6.00
 - if made twelve months or more after acquisition of proprietorship 8.00
6. For altering address on the register 2.00
7. For every entry in the register of a rectification thereof, or an alteration therein not otherwise charged 5.00
8. For continuance of trade-mark on or before day of expiration of seven years 10.00
9. Additional fee where fee is paid within six months after expiration of seven years 10.00
10. Additional fee for restoration of trade-mark when removed for non-payment of fee 15.00
11. For certificate for each trade-mark 2.00
12. For inspecting register50
13. For office copy of documents, per folio of seventy-two (72) words 1.00

14. Settling a special case10.00
15. For a sketch of copy of a trade-mark, such fee as may be determined in each case by the Administrator-General
16. For registration of a series of trade-marks-
 - for the first mark10.00 for every
 - other mark of the series 4.00
17. On lodging application for registration of registered user 5.00
18. On application to lodge further evidence in opposition proceedings5.00
19. On lodging request to the Registrar for statement of grounds upon which his decision has been made5.00
20. For photographic copies of, or extracts from, the register or other documents-per sheet25
21. For certification of any document1.00
22. On lodging application for extension of time-for each month or part of the month applied for 1.00
23. On lodging declarations in opposition proceedings-for each declaration 1.00

SECOND SCHEDULE

(RULE 3)

I, [*here insert name, address, and calling of applicant*] apply to be registered as proprietor of a trade-mark [*here insert in writing description of trade-mark*] and which is represented in the paper annexed hereto.

I desire that the said trade-mark may be registered in respect of the description of goods following, that is to say:-[*here insert description of the goods which the applicant desires to register*].

Signature

Witness-

THIRD SCHEDULE

(RULES 10 AND 11)

APPLICATION BY [*assignee or transmittee*] TO BE REGISTERED AS PROPRIETOR

Trade-mark No.:

Name of Owner:

Firm:

Place of business:

1. I, [*here insert name, address, and calling of person making this application*] of hereby apply to be registered as proprietor of the above-described trade-mark as [*here state representative or other capacity of applicant*]

of [*name of owner*] the above-named registered owner; and I produce herewith the [*state nature of document or instrument produced in proof of capacity of applicant*] in support of this application.

2. And I state that I am lawfully entitled to the goodwill of the business concerned in the goods with respect to which the trade-marks so transmitted to me is registered.

Dated this..... day of19.....

Signature

Witness-

Controlled by Ministry of the Attorney-General

Source: http://www.wipo.int/portal/en/
