

# Brief Overview of the Various IP Rights & the Legal Framework for IP Enforcement in Jamaica

Workshop on Building Respect for Intellectual Property Rights for Members of the Judiciary

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# Overview

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# Brief History of IP system in Jamaica

- **Prior to establishment of JIPO:**
- Patent applications were received by the Ministry of Industry and Commerce, reviewed by the Attorney General's Chambers, examined by the Bureau of Standards and/or the Government Chemist and recorded at the Office of Registrar of Companies.
- The Registrar of Companies also registered Trade Marks and Designs.
- The Copyright portfolio originated in the Ministry of Information and Culture and was later established as a Unit in the Office of the Prime Minister.
- Ministry of Industry Commerce & Technology (MICT) was established in 1998 and assumed the portfolio for all Intellectual Property matters.
- The administration of IP streamlined under one dedicated office by setting up JIPO as an Agency within the MICT in January 2001.

# Jamaica Intellectual Property Office

- Established in January 2001 by the Jamaica Intellectual Property Office Act, 2001
- Acquired status as a statutory body on February 1, 2002
- Agency of the Ministry of Industry, Commerce, Agriculture & Fisheries
- Government agency responsible for:
  - i. Administering IP laws in Jamaica
  - ii. Public Education
  - iii. Registration –TMs, Designs, Patents, GIs, ©
  - iv. Liaising with interest groups
  - v. Policy development
  - vi. Updating laws



# Current GOJ IP Administration

- Ministry of Industry, Commerce, Agriculture & Fisheries
- JIPO Advisory Board
- JIPO



# Jamaica Intellectual Property Office

- **JIPO's mandate** is to establish and administer a modern and effective IPR system that will act as a catalyst for international competitiveness, facilitating economic growth and national development.
- **JIPO's vision** is to be a state of the art IP Office that contributes to wealth creation in Jamaica and the main point of reference for all matters relating to IPR protection & enforcement in Jamaica.
- **JIPO's goal** is to create a robust ecosystem for IP in Jamaica to attract investments in high-grossing industries that will facilitate the growth of local industries, thereby enabling all Jamaicans to benefit from the three critical areas that are necessary for a strong IP environment: Protection, Income Generation and Enforcement.

## IP Policy & Legislative Development

- » **JIPO is a member of the UN Special Agency on IP - World Intellectual Property Organization (WIPO), 1 of 192 members**
- » **Jamaica is signatory to many international treaties including:**
  - > **The Berne Convention**
  - > **The Paris Convention**
  - > **The Phonograms & Performances Treaty**
  - > **The Beijing Treaty**
  - > **WTO Trade-Related Aspects of IP Rights (TRIPS) Agreement**
- » **The international framework is then incorporated into local legislation after extensive consultations with local industry stakeholders.**

## IP Treaties, Bilateral & Multilateral Agreements

- Beijing Treaty on Audiovisual Performances (Signed: June 26, 2012)
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (February 7, 2006)
- Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (February 7, 2006)
- WIPO Copyright Treaty (June 12, 2002)
- WIPO Performances and Phonograms Treaty (June 12, 2002)
- Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (January 12, 2000)
- Paris Convention for the Protection of Industrial Property (December 24, 1999)

## IP Treaties, Bilateral & Multilateral Agreements

- Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (January 27, 1994)
- Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms (January 11, 1994)
- Berne Convention for the Protection of Literary and Artistic Works (January 1, 1994)
- Convention Establishing the World Intellectual Property Organization (December 25, 1978)
- Marrakesh Treaty for the Visually Impaired (Signed: June 28, 2013; not yet in force)
- WTO TRIPS Agreement

## IP Legislation

- **Jamaica has the following primary IP legislation:**
- Trade Marks Act, 1999 as amended by the Trade Marks (Amendment) Act 2013
- Copyright Act 1993 as amended by the Copyright (Amendment) Act, 1999 and the Copyright (Amendment) Act, 2015
- Protection of Geographical Indications Act 2004, as amended by the Protection of Geographical Indications (Amendment) Act, 2017
- The Designs Act 1937, as amended 1976
- The Merchandise Marks Act, as amended 1985
- The Patents Act 1857, as amended 1975
- The Layout-Designs (Topographies) Act, 1999

## Pending legislation

- **The Trade Marks (Amendment) Act** will:
  - allow for Jamaica's accession to the Madrid Protocol
  - protect the country name "Jamaica" against being registered in trademarks for goods and/or services which do not originate in Jamaica
  - protect the traditional knowledge and traditional cultural expressions of local communities in Jamaica against registration as trademarks
- The Patent Act and the Designs Act will be repealed by the **Patents and Designs Bill** which will allow for int'l patents (PCT) & int'l designs (Hague Agreement) to be easily registered
- The **Protection of the Rights of Plant Breeders of New Varieties Bill** will recognise and protect the rights of breeders of new plant varieties
- **Copyright Act** awaiting amendment to strengthen performers' rights

## National IP Strategy

- **Vision-** *"A creative, innovative and productive society where Jamaicans can develop their fullest potential to ensure sustainable social, economic and cultural development to meet the challenges of a rapidly changing global economy".*

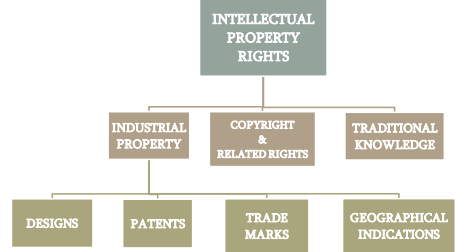
### Seven (7) key strategic objectives:

1. develop an efficient world-class IP administrative and regulatory system;
2. maximise the full potential of the cultural & creative industries;
3. develop & implement a nation brand strategy to promote all things Jamaican;
4. foster a culture of IP asset management for wealth creation;
5. build IP knowledge capacity through education and training;
6. create an enabling environment to drive innovation at all levels;
7. Manage natural & cultural resources for sustained development

## IP Enforcement

- Annual cooperation with the Counter Terrorism & Organised Crime (C-TOC) Division of the Jamaica Constabulary Force, the Jamaica Customs Agency and the United States Embassy, participated in a press conference and public destruction of seized counterfeit goods (IP Week).
- Specialized IP enforcement training for enforcement officials including judges, police, clerks of the courts, crown prosecutors and customs officers.
- JIPO officers also give statements to the police regarding IP crime investigations and attend court and give evidence in courts across the island in cases brought against persons for offences under the Trade Marks Act and the Designs Act.

## IP FOCUS AREAS



## Patents

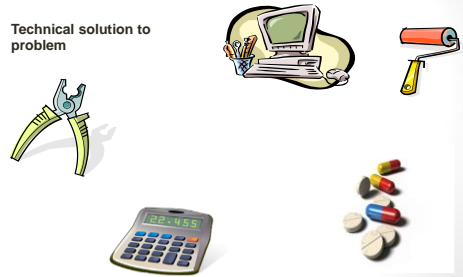
**A patent is an exclusive right granted for an invention, which is a Product or a Process that provides a new way of doing something, or offers a new Technical Solution to a problem**

Copyright JIPO 2018

## Patents

Process or Product

Technical solution to problem



## Patents

- Exclusive rights granted by the Government to an inventor allowing him to control the making, using or selling of the invention for a specified period.
- Under the current legislation, the Patent Act of 1857, the period is fourteen (14) years.
- However, the Governor-General may extend the period of grant for an additional seven (7) years based on specific reasons.

## Industrial Designs

Aesthetic appearance of a product





Designs are what make an article attractive and appealing, hence, they add to the commercial value of the product and increase its marketability.

## Registered Designs

- Registration valid for 15 years
- Use of a registered design without permission of owner is an infringement of the designer's rights.

## What is a Geographical Indication?

- Protection of Geographical Indications Act, 2004 (Jamaica):
- a "Geographical Indication" is *"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."*

## Geographical Indications

Quality or reputation of product is specifically linked to a geographical location such as a town, region, or country.



## GI protection

- A GI offers protection to producers of agricultural and agricultural-based goods, including handicrafts, which have a link between the place of origin of the product, and the quality, characteristic or reputation of the product.

## GI protection

- GIs protect:
  1. reputation of the product acquired and maintained due to the connection to the geographical location.
  2. quality standards of the product
  3. against misleading terms like "Jamaica-style", "Jamaica-kind" and "Jamaica-type"

## Traditional Knowledge & Traditional Cultural Expressions

Traditional music, dance, musical instruments, dress, sayings, words/phrases, knowledge of medicinal plants



- Maroon and Rastafari communities
- Jamaica



## Trade Marks

A sign distinguishing the goods or services of one enterprise from another.



## Trade Mark registration

- Valid for 10 years
- Renewable every 10 years

## Definition of 'Trade Mark'

- s. 2 Trade Marks Act
- Any sign
- that is capable of being graphically represented
- and capable of distinguishing the goods or services of one undertaking from those of another undertaking.
- ("sign" includes a word (including a personal name, design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging)

## Types of Trade Marks

- Word only
- Word & logo
- Logo only
- Service marks
- Collective marks
- Certification marks
- Well-known marks
- Sound marks
- Smell marks

## Collective and Certification Marks

- "certification mark" - a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance services, quality, accuracy or other characteristics.
- "collective mark" - a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

## Property Rights / Exclusive Rights

- **Trade Marks Act**
- **S. 4.(1)** The registration of a trade mark under this Act confers a property right on the proprietor of the trade mark who is entitled to the rights and remedies provided by this Act.
- **S. 5.** Subject to section 10, the proprietor of a registered trade mark has exclusive rights in the trade mark; and any use of the mark in Jamaica without the proprietor's consent, constitutes an infringement of such rights

## Commencement of Rights

- **Trade Marks Act**
- **S. 5(2)** - The rights of the proprietor have effect from the date of registration (which is the date of filing in accordance with section 24(4) **BUT**
- **no infringement proceedings may be begun before the date on which the trade mark is in fact registered;** and
- no offence under s. 70 (false entry in the Register) is committed by anything done before the date on which the TM was in fact registered.
- **S. 17** - The date of filing of an application for registration is the date on which the applicant furnishes documents containing everything required under section 16.
- **S. 24(4)** - The registration of a TM shall take effect as of the date of filing of the application for registration, and that date shall be deemed to be the date of registration.

## Trade Mark infringement

- uses in the course of trade
- Identical mark - identical goods/services
- Identical mark - similar goods/services
- + likely to deceive or confuse the public
- Similar mark - identical goods/services
- + likely to deceive or confuse the public
- Identical/similar mark - dissimilar goods/services
- + the sign has a reputation in Jamaica and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark

## Trade Mark Infringement

- a person uses a sign if he does anything which associates or purports to associate the sign with any goods or services, in particular if he-
- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for the those purposes under the sign or offers or supplies services under the sign;
- (c) imports or exports goods under the sign; or
- (d) uses the sign on business papers or in advertising.

## Defences to Infringement

- **S. 9(8)** - Nothing in the foregoing provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of **identifying goods or services as those of the proprietor or a licensee**, so, however, that any such use otherwise than **in accordance with honest practices in industrial or commercial matters**, shall be treated as infringing the rights in the registered trade mark if the use without due cause takes unfair advantage of or is detrimental to, the distinctive character or the reputation of the trade mark.

## Defences to Infringement

- **S. 10(2)** - A registered trade mark is not infringed by the use of the mark in any of the following circumstances, so long as such use is in accordance with **honest practices in industrial or commercial matters**:
- (a) the use by a person of his own name or address;
- (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular, as accessories or spare parts.

## Criminal Offences - TMs

s.69

- Use a sign identical or likely to be mistaken for registered TM
- Sell, expose for sale, hire, distribute goods with such sign
- Applied on material to be used as labelling or packaging or business papers
- In possession, custody, control, use in course of business such goods, business papers, labels

Have intent to gain or cause loss to other and apply sign without consent of owner

## Criminal offences - TMs

s. 69

- Make article specifically designed /adapted to make copies of identical sign
- In possession, custody, control of such article
- Know, have reason to believe that article is to be used to reproduce goods, material for labelling, packaging, business paper
- Have intent to cause loss to another and without consent of proprietor

## Criminal offences - TMs

s.69(5)

- Defence: belief on reasonable grounds that use of sign was not infringement

Punishment: per offence

- Parish Ct - \$1M, 12 months imprisonment
- Circuit – fine, 5 years imprisonment

## Copyright

**Literary Works**



typographical arrangements  
of  
published editions



**Dramatic Works**

**Musical Works**




**Sound Recordings (music  
and words)**

**Artistic Works**



**Films, Broadcast  
and Cable  
Programmes**

## Qualifying for Copyright

- Written on paper or recorded 
- Arises automatically. No requirement for registration
- ©, name, date of creation – ‘Notice to the world’

## Related Rights

Rights of persons who communicate the copyrighted work to the public:

- **Performers** : singers, dancers, musicians, actors
- **Producers of phonograms**: record companies
- **Broadcast organisations**: e.g. radio and TV stations

## Duration of Copyright

- Literary, musical, dramatic, artistic works:  
Lifetime + 95 years
- Sound recordings, broadcasts, films:  
95 years from when made or 1<sup>st</sup> published
- Typographical arrangements: 50 years
- After expiry – Public Domain

## COPYRIGHT – rights of owner

### Economic rights:

1. Exclusive right to copy (reproduce)
2. Distribute
3. Perform in public
4. Broadcast
5. Adapt (include translate)

### Moral Right:

1. Right of Attribution
2. Right of Integrity

## Collective Management Organisations or Licensing Bodies in Jamaica

### Jamaican Copyright Licensing Agency



licenses the reproduction of text & image based works

### Jamaica Association of Composers, Authors and Publishers



Licenses public performance and reproduction rights of songwriters and music publishers

### Jamaica Music Society

licenses the public performance rights of phonogram producers



## Infringement – Economic rights

[s.31]

If anyone does any of the exclusive activities without the permission/ licence of the copyright owner

Civil and Criminal action

## Infringement - Moral Rights

- [s.36] Failure to identify author of work / director of film
- [s.38] commercial use of derogatory work
- [s.40] falsely attributing authorship of work to a person

## • CRIMINAL ENFORCEMENT OF COPYRIGHT



### © Criminal Offences : s.46(1)

Any person:

- making for sale or hire
- in course of business sells, offers, exposes for sale, exhibits in public
- imports for other than private or domestic use
- non-commercial distribution prejudicial to copyright owner



any article which he knows/has reason to believe is an infringing copy

### © Criminal Penalties : s.46(1)

- On summary conviction before Parish Judge  
Fine not exceeding \$100,000 *per infringement* or  
Term not exceeding 2 years or both

**OR**

- On conviction before Circuit Court  
Fine (not specified) or  
Term not exceeding 5 years or both

### © Criminal Offences: s.46(2) & (3)

- Makes /has in possession article specifically designed for making copies
- Knowledge that to be used in making copies
- Any person who causes the work to be performed in public, played, shown
- Knowledge that public performance is an infringement

### © Criminal Penalties : s.46(2) & (3)

On Summary conviction before Parish Judge

- Fine not exceeding \$50,000 *per infringement* ;or  
Term not exceeding 1 years or both

**OR**

On conviction before Circuit Court

- Fine (not specified) or  
Term no exceeding 3 years or both

### Criminal Offences: s.134

- Sell, import for non-private use, possess in course of business, distribute illicit recording
- Causes an illicit recording to be shown / played in public, broadcast/included in cable programme

### Criminal Penalties: s.134(6)

On summary conviction before Parish Judge

- Fine not exceeding \$100,000 or  
• Term not exceeding 2 years or both

**OR**

On conviction before Circuit Court

- Fine (not specified) or  
• Term not exceeding 5 years or both

## Criminal Offences & Penalties

[s.136]

- Falsely stating that authorized to give consent for recording of performance, unless believes on reasonable grounds that he is authorized
- Parish Court: \$50,000, 6 months

## Criminal Offence & Penalties : s.136A

### Unauthorised transmission of satellite-carrying signals

- Dealing in **unauthorised decoders**  
  
(Making, importing for commercial purposes, advertising for sale/hire )
- Parish Court: \$250,000 , 12 months

**Defence:** did not know/had no reasonable ground for believing that the decoder was an unauthorised decoder

## Civil Action : s.136B Unauthorised transmission of satellite-carrying signals

Anyone who without lawful authority;

- Receives or
- Distributes programmes from an encrypted transmission for the purpose of distributing the programmes to other persons under commercial arrangements with them

Civil action

[s.136B]

Person who,

- charges for reception of programme (broadcast/cable)
- sends encrypted transmission from a place in Jamaica
- has rights in the content (programme) transmitted encrypted or otherwise, ie the same rights as copyright owner in relation to infringement
- Can bring action against the person who deals in unauthorised decoders (see s.32)
- Can apply for delivery up of unauthorised decoder

## Warrants / Police Powers

[s.140]

- Police officer of / above rank of Inspector
- reasonable cause an offence being committed
- **May give direction** to any constable to:
  - Enter and search any premises
  - Stop/ board/search vessel, aircraft, vehicle
  - Seize, remove, detain articles, evidence

[s.140(2)]

- Constable given powers to break open doors, forcibly enter vessel

## Warrants / Police Powers

[s.141]

Magistrate Warrant to enter domestic premises and search

- satisfied by information on oath
- reasonable ground for suspecting
- any article which may be seized, removed, detained under any provision of this Act
- located on any domestic premises

Warrant authorises officer above rank of Sergeant

## Warrants [s.142]

Any person willfully obstructing police

- Parish Judge: \$10,000, 12 months

Any person knowingly give false/misleading information to police

- Parish Judge: \$5,000 , 6 months

## Criminal Enforcement of Registered Design Rights

- **S. 12( 1) - Penalty on Piracy**
- Any person who
- (a) for purposes of sale, applies or causes to be applied a registered design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, to any article of manufacture, or to any substance
- (b) publishes or exposes for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof was applied, knowing that the same has been so applied without the consent of the registered proprietor
- shall be liable for every offence to pay up to J\$100

## Civil Enforcement of Registered Design Rights

- **S. 12** - The registered proprietor may, by action brought in the Court, recover either that sum (J\$100 per offence) as a simple contract debt, or damages arising from any breach of the section.
- **S. 21** -
- Injunction
- Inspection
- Account

## Revocation of Patents

- **S. 25** - if at any time it be made to appear to the Supreme Court that the grant of Letters Patent is contrary to law, or that the said alleged invention is not a new invention within this Island, or that the said patentee is not the true and first inventor within this Island, it shall be lawful for the Supreme Court to revoke the said Letters Patent.

## Civil enforcement of patents

- **S. 37** - If any person, without the written consent of the patentee, his executors, administrators, or assigns, makes, devises, uses, or sells the thing, invention, or discovery, such person shall pay to the said patentee, his executors, administrators, or assigns a sum equal to three times the actual damage sustained by the patentee, his executors, administrators, or assigns, which sum shall and may be recoverable together with costs in the Supreme Court.

## Criminal enforcement of patents

- **S. 38** - If any person without authorization shall **write, paint, or print, or mould, cast, or carve, or engrave, or stamp upon anything made, used or sold by him,** for the sole making or selling of a patented product, for the sole making and vending of such thing, or **write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "Patent", the words "Letters Patent", or the words "by the Queen's Patent",** or any similar words **with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall, in any other manner, imitate or counterfeit the stamp or mark, or other device of the patentee,** he shall for every such offence, be liable to a penalty of J\$100, to be recovered by action of debt in the Supreme Court, one-half to the Crown and the other to the claimant.

## Civil Enforcement of GIs

- **S. 3 Protection of Geographical Indications Act**
- Any interested party may apply to the Court to prevent, in respect of a geographical indication
- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good;
- (b) any use which constitutes an act of unfair competition within the meaning of the Fair Competition Act; or
- (c) any use which identifies wines or spirits, that do not originate in the place indicated by the GI as wines or spirits of that origin (even where (i) the true origin' of those wines or spirits is indicated; or (ii) the GI is used in translation or accompanied by such expressions as "kind", "type", "style", "imitation", "comparable to" or other similar expressions.)

## Criminal Enforcement of GIs

- S. 7(1) Any person who knowingly or wilfully uses a GI in a manner specified in section 3 (1) (a) or (c), commits an offence and, subject to subsection (2), is liable
- (a) on summary conviction in a Parish Court to a fine not exceeding J\$1,000,000.00 dollars or to imprisonment for a term not exceeding 12 months or both;
- (b) on conviction before a Circuit Court, to a fine or to imprisonment for up to 5 years or both
- (2) where the Court is satisfied that any benefits were derived by or accruing to the person convicted, the Court may order the person convicted to pay to the Crown such pecuniary penalty as the Court determines to be equivalent to the total value of such benefits.

## Refusal & revocation of GIs

- S. 17
- The Registrar shall, on his own initiative or at the request of any interested party, refuse or revoke a trademark that:
  - (a) contains or consists of a GI relating to a good which does not originate in the territory indicated by the GI, if the use of the GI in the trademark in Jamaica is of such a nature as to mislead the public as to the true place of origin.
  - (b) contains or consists of a GI which identifies wines or spirits as originating from a territory, region or locality indicated by the GI which is not the true place of origin of such wines or spirits.

## Tort of Passing Off

- Unregistered trade marks
- Unregistered designs
- Trade dress, get up etc
- Must show:
  1. Goodwill
  2. Misrepresentation
  3. Damage suffered or likely to be suffered

## Protecting Personality Rights

## Thank You for Your Attention !



Jamaica Intellectual Property Office  
18 Trafalgar Road  
Kingston 10

<http://www.jipo.gov.jm>  
Email: [info@jipo.gov.jm](mailto:info@jipo.gov.jm)  
946-1300 / 927-6744