

COUNTERFEITING OF TRADEMARKS

Function of a trademark

- The sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- It must serve as a badge of origin.
- The ability to distinguish can either be:
 - Inherent in the mark, or
 - Acquired through use.

DEGREES OF DISTINCTI VENESS Concept of the process of the process



- The prime function of a trademark is to protect the business of the trademark owner.
- · Serve big and small
- · Trademarks promote
 - o invention,
 - o protect investment and
 - enhance market-share by securely identifying a product or service.



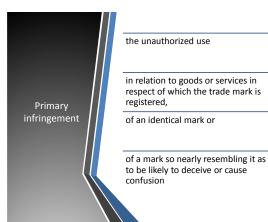


Secondary function of a trademark

- They also serve the consumer and the public in general
- Trademarks facilitate choice by:

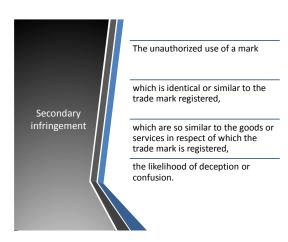
 o Identifying the product or
 - serviceGuaranteeing its provenance (source or origin)
 - Guaranteeing its presumed quality.





Jamaica sec 9

 (2) A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him. uses in the course of trade a sign that is identical with the trade mark, in relation to goods or services that are identical with the goods or services for which the trade mark is registered.



Jamaica sec 9(3)

• (3) A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade a sign which is likely to deceive or confuse the public for the reason that- (a) the sign is identical with the trade mark and is used in relation to goods or services that are similar to the goods or services for which the trade mark is registered; or (h) the sign is similar to the registered trade mark and is used in relation to goods or services that are identical with or similar to the goods or services for which the trade mark is registered.



Counterfeiting does not raise difficult questions

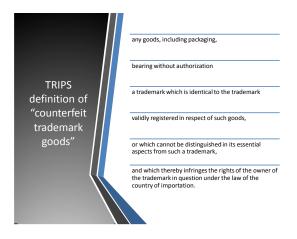
- Counterfeiting is basically concerned with primary infringement.
- Issues relating to (the likelihood of) confusion do not arise.





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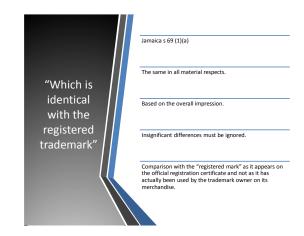
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Cloning

Can it be counterfeiting if a trademark is used in respect of goods for which the mark is registered but not used?



Unregistered marks with a reputation

- Jamaica s 69(4)(b)
- (4) No offence is committed under this section unless-
- (4) No offence is committee uncer this section uneser-ion the goods are goods in respect of which the trade mark is registered; or
 (b) the trade mark has a reputation in Jamaica and the use of the sign takes, or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the reputation of the trade mark.

Development of a tm



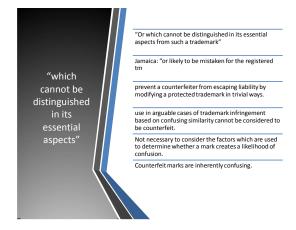






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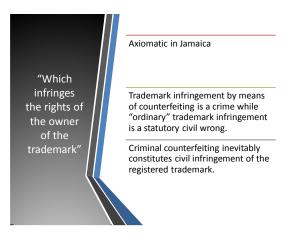
Actual confusion is not required

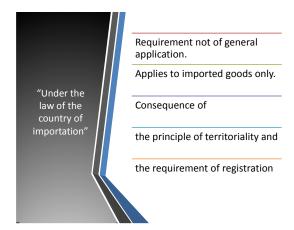
However, an accused may not rely on the fact that the purchaser was not or could not have been misled because, for instance, of the price or low quality of the goods or the location of the seller's premises.

"Without authorization" or without consent

The prosecution must prove that the goods are not genuine goods meaning that they did not originate from the trademark owner or its licensee.







Who counterfeits?

- Local law determines who is deemed to be a counterfeiter.
- Person who commits the actual act of counterfeiting
- Importer
- Dealer
- Accessory.