



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 DISTINCTIVENESS

Inherent

- invented (arbitrary or fanciful): Exxon, Google
- arbitrary: Tiffany
- suggestive: Microsoft

Acquired through use:

- descriptive: General Electric, Eveready, Raisin Bran.

Main function of a trademark

- The prime function of a trademark is to protect the business of the trademark owner.
- Serve big and small
- Trademarks promote
 - invention,
 - 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:
 - Identifying the product or service
 - Guaranteeing its provenance (source or origin)
 - Guaranteeing its presumed quality.



THE ESSENCE OF INFRINGEMENT: TO CAUSE CONFUSION

- Object of trade mark law is to prevent misleading commercial speech.
- Trademark infringement consists essentially in causing confusion in relation to origin.
- It destroys or dilutes the badge of origin.
- It confuses and misleads the public.
- Through "trademark use" by the defendant.

Primary infringement

the unauthorized use

in relation to goods or services in respect of which the trade mark is registered,

of an identical mark or

of a mark so nearly resembling it as to be likely to deceive or cause confusion

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.

Secondary infringement

The unauthorized use of a mark

which is identical or similar to the trade mark registered,

which are so similar to the goods or services in respect of which the trade mark is registered,

the likelihood of deception or confusion.

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.



TRIPS definition of "counterfeit trademark goods"

any goods, including packaging,

bearing without authorization

a trademark which is identical to the trademark

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 owner of the trademark in question under the law of the country of importation.

"Registered in respect of such goods"

Trademarks are registered in respect of specific goods in classes.

Requirement of primary infringement

The mere use of an identical mark does not amount to counterfeiting.

It is only if the trademark has been registered in respect of those goods.

Jamaica Act s 69(4)(a)

Cloning

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

"Which is identical with the registered trademark"

Jamaica s 69 (1)(a)

The same in all material respects.

Based on the overall impression.

Insignificant differences must be ignored.

Comparison with the "registered mark" as it appears on the official registration certificate and not as it has actually been used by the trademark owner on its merchandise.

Unregistered marks with a reputation

- Not a TRIPS requirement.
- Jamaica s 69(4)(b)

- (4) No offense is committed under this section unless—
- (a) 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





“which cannot be distinguished in its essential aspects”

“Or which cannot be distinguished in its essential aspects from such a trademark”

Jamaica: “or likely to be mistaken for the registered tm

prevent a counterfeiter from escaping liability by modifying a protected trademark in trivial ways.

use in arguable cases of trademark infringement based on confusing similarity cannot be considered to be counterfeit.

Not necessary to consider the factors which are used to determine whether a mark creates a likelihood of confusion.

Counterfeit marks are inherently confusing.



Actual confusion is not required

Many persons buy counterfeit goods willingly.

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

There cannot be infringement of a right if what was done was with the consent of the rights owner.

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

Evidentiary problems

Counterfeiting In more than one country;

In one country, but a substantial part of its preparation, planning, direction or control takes place in another country;

In one country but involves an organized criminal group that engages in criminal activities in more than one country; or

In one country but has substantial effects in another country.

“Which infringes the rights of the owner of the trademark”

Axiomatic in Jamaica

Trademark infringement by means of counterfeiting is a crime while “ordinary” trademark infringement is a statutory civil wrong.

Criminal counterfeiting inevitably constitutes civil infringement of the registered trademark.

“Under the law of the country of importation”

Requirement not of general application.

Applies to imported goods only.

Consequence of

the principle of territoriality and

the requirement of registration

Who counterfeits?

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