



TRADEMARK COUNTERFEITING

Commercial Scale
Willfulness

Introduction

TRIPS: Counterfeiting and piracy must be criminalized at least if it takes place

- on a “commercial scale”
- and
- willfully

Higher standards optional

Commercial scale

TRIPS: “commercial scale”

- Not defined
- Dispute panel decision:
- Depends on what is the typical or usual commercial activity in respect to
 - the particular product
 - in the local market



TRIPS
cont.

Factual issue

Relative standard

Varies when applied to different factual situations.

Varies by product and market.

May be small or large.

National laws

Almost all countries define the criminal offense by reference to overtly commercial acts, such as

- sale or offer for sale of infringing copies,
- to obtain a “commercial advantage” or
- “in the course of trade or commerce” or
- Importation except for personal use.

JAMAICA

applies to goods a sign identical with, or likely to be mistaken for, a registered trade mark; or

sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or

has in his possession, custody or control in the course of a business any [infringing] goods with a view to [sell etc anything, by himself or another.

Statutory thresholds

Numerical threshold, for instance requiring at least 50 fake DVDs, not permitted.

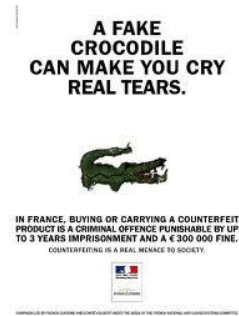
The test remains one of commercial scale which may, depending on the circumstances, be even one instance.

Making or buying of fakes for personal or private use

TRIPS directed at punishing the counterfeiter and the dealer

Does not require that the purchaser of a fake watch, CD or DVD be criminally liable unless the purchase is with the object of an on-sale.

A person who for own use makes an otherwise unauthorized copy does not commit a crime.



5/6/2019

10

Wilfullness

TRIPS

- Requires willfulness for
 - trademark counterfeiting and
 - copyright piracy.
- National laws may have other standards

National laws

Accused to prove the absence of *mens rea* by establishing that he believed on reasonable grounds that the act was not an infringement.

Accused knew or had reason to suspect that the goods were counterfeit;

Accused failed to take all reasonable steps in order to avoid any act or conduct with reference to the counterfeit goods.

Jamaica

A person commits an offence if

with intent to gain for himself or another,

or with intent to cause loss to another

[infringes]

Meaning of "willfulness"

Same as in criminal law generally.

It refers to

- an intention to infringe,
- willful blindness, or
- a conscious disregard of a substantial risk of infringement (subjective recklessness).

Wilful blindness

That the accused

had a subjective realization that a certain fact was likely or that there was a "real suspicion"

failed to make the inquiry

to avoid actual knowledge of the suspected fact.

Recklessness

Subjective.

Not the same as wilful blindness.

Requires

- Knowledge of a danger or risk and
- persistence in a course of conduct which creates a risk that the prohibited result will occur.

Culpability

The culpability in recklessness is justified by consciousness of the risk and by proceeding in the face of it.

In willful blindness it is justified by the accused's fault in deliberately failing to inquire when he knows there is reason for inquiry.

Establishing
willfulness
through
circumstantial
evidence

Knowledge or willful blindness is often established through direct or circumstantial evidence.

Relevant circumstantial evidence typically includes evidence concerning

- origin of the goods
- the circumstances the transaction,
- alteration of the goods,
- method of delivery,
- nature of the packaging or
- an unusually low price.