Jamaica

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Legal framework

In Jamaica, the legislation dealing with trademarks is the Trademarks Act (32/1999 and 25/2001), the Trademarks (Amendment) Act (17/2013) and the Trademarks Rules 2001 (as amended in 2011 and 2013).

The Trademarks Act is modelled on the UK Trademarks Act 1994, and case law interpreting the UK act provides guidance and persuasive precedent in the Jamaican courts.

Jamaica is a member of the World Trade Organisation (WTO) and the Paris Convention on Industrial Property. The Trademarks Act implements Jamaica's obligations under the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights and the Paris Convention as they relate to trademarks.

Unregistered marks

An unregistered mark can be protected by virtue of the common law tort of passing off, provided that the mark is in use and has established goodwill.

The Jamaican courts have been guided by the principles outlined in two UK decisions – *Erven Warninck BV v J Townend & Sons (Hull) Ltd* and *Reckitt & Colman Products Ltd v Borden* – which set out the essential factors to establish passing off. *Reckitt & Colman* outlined three criteria:

- goodwill;
- deception due to misrepresentation; and
- actual or potential damage.

Erven Warninck outlined five factors:

- a misrepresentation;
- made by a trader in the course of trade;
- to prospective or ultimate customers of goods or services supplied by it;
- which is calculated to, or may in a

reasonably foreseeable way, injure the business or goodwill of another trader; and
- which causes or is likely to cause actual damage to the business or goodwill of the trader by which the action is brought.

It is generally felt that there should be continued use for at least three years in order to prove the existence of the goodwill or reputation necessary to establish passing off.

Marks that are pending registration are also protected by virtue of the Trademarks (Amendment) Act, as a trademark application now confers a property right on the owner. Consequently, certain provisions which previously applied only to a registered trademark as an object of property now also apply to a mark pending registration.

Registered marks

Any legal or natural person can apply for and own a registered mark. Applications can be made by a single entity or person or by two or more applicants jointly. In relation to registered partnerships and business names, the application must be made in the name of the individual partners or business owners.

All Jamaica-based applicants are now required to disclose their taxpayer registration number on the application form and all other forms required to be submitted under the trademarks legislation.

No power of attorney is required before filing a trademark application. However, every applicant must have a service address in Jamaica for the purposes of proceedings before the registrar. The service address must be filed on a prescribed form (TM3) which can be signed by the agent and need not be notarised or legalised.

Section 2 of the Trademarks Act defines a 'trademark' as any sign that is capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of another undertaking. Words (including personal names), designs, letters, numerals, colours, combinations of colours or a combinations of these, or the shape of goods or their packaging, are examples of signs which can be protected as trademarks.

Section 11 outlines the absolute grounds on which a sign may be refused registration and provides that the following are non-registrable:

- signs which do not satisfy the definition of a 'trademark';
- signs which consist exclusively of the shapes of goods resulting from the nature of the goods or which are necessary to bring about a technical result or give substantial value to the goods;
- marks which are contrary to public policy or to accepted principles of morality;
- marks that are deceptive as to their nature, quality or geographical origin;
- marks whose use is prohibited in Jamaica by law;
- marks applied for in bad faith;
- marks which disparage persons (living or dead), institutions or beliefs or which falsely suggest a connection with them;
- marks which are devoid of distinctive character;
- marks which consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of goods or provision of services or other characteristics of goods or services; and
- marks which consist exclusively of signs or indications which have become customary in current language or in good-faith and established trade practices.

The last three types of mark can be registered if they have acquired distinctiveness through use.

Previously, the registration of the Jamaica coat of arms, the national flag of Jamaica and other national symbols was prohibited. However, the Trademarks (Amendment) Act provides that a trademark consisting of or containing such an emblem may be registered if the registrar is satisfied that consent has been given by, or the mark is being used on behalf of the government.

Procedures

Examination

The registrar of industrial property examines whether a trademark application satisfies the requirements of the Trademarks Act and the Trademarks Rules, and conducts a search of earlier trademarks which may be identical or similar to the applied-for mark in order to determine whether the mark should be refused

based on the relative grounds for refusal outlined in Section 13 of the act.

If it appears to the registrar that, by virtue of any absolute or relative grounds for refusal, the requirements for registration have not yet been met, the applicant is informed and has three months from the date of notification to respond. If the applicant does not overcome the registrar's objections or fails to respond by the deadline, the registrar can to refuse the application.

Once the registrar deems that the requirements have been met, a notice of acceptance is sent to the applicant directing it to pay the publication fees within two months of the date of the notice. Upon payment of the fees, the registrar must publish the application in the *Trademarks Journal*. If the fees are not paid, the application is abandoned or deemed to be withdrawn.

Opposition

Upon publication, any person may raise an opposition to a trademark application based on absolute or relative grounds. Rule 12 of the rules outlines the opposition procedures.

Oppositions must be made within two months of the date of publication of a trademark application. Previously, the applicant had a non-extendable period of two months from the date of receipt of a notice and grounds of opposition within which to file a counterstatement. Under the Trademarks (Amendment) Act, the parties can now agree to a further two months, known as the 'cooling-off period', for filing of the counterstatement, in order to facilitate settlement.

The registrar will grant the cooling-off period on an application by either party supported by a declaration that the other party has agreed to it. The other party's agreement must be secured in writing and attached to the form requesting the cooling-off period. The two-month cooling-off period may be extended by the registrar for up to six months after the expiration of the two-month period, on application by the applicant supported by a declaration that the opponent has agreed to it. If the applicant fails to file the counterstatement within the timeframe and in the manner specified, the application will be deemed to be withdrawn.

Once the counterstatement has been filed and served on the opponent, it has two months (extendable) from the date of receipt within which to file evidence in support of its opposition or to notify the registrar that it does not wish to file evidence. Where the opponent files evidence, the applicant has two months (extendable) from receipt to submit evidence in support of its application. Once the applicant files further evidence, the opponent has two months (extendable) from the date of receipt within which to submit evidence strictly in reply to the applicant's evidence. Once the evidence is complete, the registrar contacts the parties to set a hearing date and then issues a formal notice of hearing.

Registration

If an application is not opposed or if opposition proceedings against it either fail or are withdrawn, the registrar must proceed to register the mark unless he or she discovers that the mark was accepted in error or the prescribed fee was not paid, in which case the application shall be deemed to be withdrawn. The registrar will issue a notice of non-completion, giving the applicant an opportunity to rectify any non-payment. The effective date of registration is the date of filing of the trademark application. Upon registration, a certificate of registration is issued to the applicant.

Removal from register

A registered trademark can be removed from the register by revocation, invalidation or surrender.

Revocation: Under the Trademarks (Amendment) Act, a trademark registration is vulnerable to revocation if the mark is not used for *bona fide* purposes in Jamaica in relation to the goods and services for which it is registered in the five years before the date of an application for revocation, if no proper reasons for its non-use are put forward by the rights holder. In addition, the registration can be revoked if *bona fide* use of the mark has been suspended for a continuous period of five years, before the date of the application for revocation and no proper reasons for its disuse are put forward by the owner. If use is resumed or commenced after five years but before the application for revocation is filed (on any of the above-mentioned grounds), the mark

will not be revoked. However, any resumption or commencement occurring after the five years but within the three months before the application will be disregarded if the owner was aware of the application before it commenced or resumed use. Other grounds for revocation include where the trademark has become the common name in the trade for a product or service covered by the registration due to an act or omission by the owner.

Invalidation: A trademark registration may be declared invalid on the grounds that it was disqualified from registration by virtue of absolute or relative grounds for refusal. Once a registered trademark is found to be invalid, the effect is that the registration shall, to the extent of the invalidity, be deemed never to have been made, but without prejudice to any transaction past and closed. Where the grounds of invalidity affect only some of the goods or services covered by the registration, the declaration of invalidity will affect only those goods or services.

Surrender: A rights holder may elect to surrender the registration in respect of all or some of the goods or services covered by the registration by filing the prescribed form and paying the prescribed fees. Persons with a registered interest in the mark must be given three months' prior notice of the surrender.

Timeframes

Unopposed registration: The approximate timeframe from application to registration, provided that there is no opposition or objection, is 10 to 12 months.

Opposition procedures: Generally, each action is to be taken within two months of the preceding action. However, as a two-month cooling-off period (potentially extendable for up to six months) is now permitted and extensions are otherwise available for subsequent steps, opposition procedures could take several months.

Renewal: A registration is valid for 10 years and renewable for subsequent 10-year periods. The estimated timeframe from filing a renewal request to obtaining the certificate of renewal is two to four months.

Merger/change of name: The estimated timeframe from filing a request to register a merger or change of name to obtaining the certificate is three to four months.

Searches

Searches are available for identical and similar marks containing or comprising a word or combination of words. For pure device marks, a Vienna figurative element search can be conducted. However, as the device database of the Jamaica IP Office (JIPO) is incomplete, a manual search of the Trademarks Register is also necessary. The manual search must be conducted by international class number. Identical and phonetically similar marks can also be searched by proprietor name, agent name, trademark number, filing date and/or date of registration.

JIPO searches do not cover trade names that are not also registered or filed as trademarks, but do include slogans which are registered or filed as trademarks. The Trademarks Register dates back to 1889.

Enforcement

Civil action

The cause of action for registered rights is trademark infringement and for unregistered rights is passing off. Often both infringement and passing off are claimed in relation to a registered trademark.

Subject to certain limitations, any use of a mark in Jamaica without the rights holder's consent constitutes an infringement of such rights as specified in the Trademarks Act. The relative grounds for refusal form the same basis on which an infringement action will be founded. The rights are exercisable against:

- identical marks used in connection with goods or services that are identical to those covered by the earlier registration
- similar marks used in connection with identical or similar goods or services, where a likelihood of confusion exists; and
- similar or identical marks used in connection with dissimilar goods or services, where the use takes unfair advantage of or is detrimental to the distinctive character or reputation of the registered mark.

Damages, injunctions, accounts of profits and other relief available in respect of the infringement of any other property right are also available to the owner of a registered trademark. These remedies are also available in a passing-off action, although they may be difficult to prove. An injunction may be granted as interlocutory relief pending trial or as a final injunction awarded at trial. The statute of limitations for infringement and passing-off actions is six years.

Criminal action

Section 69 of the Trademarks Act outlines activities that constitute an offence, including where:

- a party with an intention to gain for itself or another, or to cause loss to another, applies to goods a sign which is identical to or likely to be mistaken for a registered mark; or
- such party sells or lets for hire, offers or exposes for sale or hire or distributes goods or the packaging bearing such a sign.

Offenders are liable in the lower courts to a fine of no more than J$1 million, imprisonment for up to 12 months or both. Where the conviction is handed down by the Supreme Court, the offender is liable to a fine set by the court, imprisonment for up to five years or both.

Courts

There are no specialist trademark or IP courts. Trademark infringement and passing-off actions are heard in the Civil and Commercial Divisions of the Supreme Court, with appeals to the Court of Appeal and the Privy Council (Judicial Committee).

Criminal actions for trademark offences are mainly dealt with in the lower courts (ie, the Resident Magistrate Courts).

Trademark infringement and/or passing-off actions where interim injunctive relief is sought are usually dealt with within three to six months of filing the application. If the matter proceeds to trial, it may take between two and five years to be completed.

Ownership changes and rights transfers

The registration of ownership changes or rights transfers in the Trademarks Register requires the completion of a specified form depending on the transaction, the submission of a certified and stamped copy of the document, the payment of stamp duty and the payment of a fee to the JIPO. The documents evidencing the transfer or change of ownership need not be legalised; a certified and notarised copy will suffice.

Use by a licensee is attributed to the rights holder in cases where the rights holder must rely on use (eg, in revocation or invalidation proceedings, or in seeking to establish use prior to filing an application or to prove that a mark has acquired distinctiveness through use).

Related rights

Trademark and copyright protection overlap in relation to marks with artistic and design elements, in that copyright may be applied concurrently to protect the copying of signs which amount to original artistic works.

Trademark and design protection overlaps in relation to shape marks. Such protection is desirable where the articles have a unique design or shape for purely aesthetic reasons. Industrial design protection is applicable only for original designs which have not been disclosed before the application.

Online issues

The country-code top-level domain (ccTLD) '.jm' is administered by the University of the West Indies, Mona.

While no specific provisions in the Trademarks Act protect rights holders against unauthorised use of their marks in domain names, websites, hyperlinks, online ads or metatags, trademark infringement could be established depending on the nature of the use. WTR

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	**Examination for relative grounds for refusal based on earlier rights?**	**Non-traditional marks registrable?**
No/No ✗/✗	Yes ✓	No ✗

Unregistered rights	
Protection for unregistered rights?	**Specific/increased protection for well-known marks?**
Yes ✓	Yes ✓

Opposition
Can a registration be removed for non-use? Term and start date?
Yes: two months. ✓

Removal from register		
Can a registration be removed for non-use? Term and start date?	**Are proceedings available to remove a mark that has become generic?**	**Are proceedings available to remove a mark that was incorrectly registered?**
Yes: five years retrospective from date of application for revocation. ✓	Yes ✓	Yes ✓

Enforcement		
Specialist IP/trademark court?	**Punitive damages available?**	**Interim injunctions available? Time limit?**
No ✗	Yes ✗	Yes: three to six months. ✓

Ownership changes
Mandatory registration for assignment/licensing documents?
Yes: for assignments. ✓

Online issues	
National anti-cybersquatting provisions?	**National alternative dispute resolution policy (DRP) for local ccTLD available?**
No ✗	No ✗

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Dianne Daley is an attorney and a founding partner of boutique law firm Foga Daley. She heads the firm's IP department. Ms Daley has an LLB (honours) from the University of the West Indies and an LLM in comparative law from McGill University specialising in intellectual property and international copyright.

Her professional memberships include the International Association of the Advancement of Teaching and Research in Intellectual Property, the International Trademark Association, the Global Advertising Lawyers Alliance, the Inter-American Association of Intellectual Property and the Jamaican Bar Association, where she chairs the IP Committee. She is also vice chairman of the Jamaican Copyright Licensing Agency.