

Jamaica

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1. Legal framework

National

The relevant laws in Jamaica are as follows:

- the Trademarks Act 1999 and the Trademark Rules 2001;
- the Fair Competition Act 1993;
- the Merchandise Marks Act 1888; and
- the Jamaica Intellectual Property Office Act 2001.

International

The applicable international treaties are as follows:

- the Paris Convention for the Protection of Industrial Property;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the US-Jamaica Bilateral Agreement on the Protection and Enforcement of IP Rights 1994.

2. Unregistered marks

Protection

Users of unregistered marks can acquire significant rights through use of these signs in the course of trade. Under Jamaican law, unregistered marks may be protected by an action under the law of passing off. While an action for infringement under the Trademarks Act protects a property right in the registered mark, the law of passing off protects the right of property in the business or goodwill in connection with which the name, word or mark is used. That goodwill has been described as that power of attraction which is sufficient to draw customers to the source from which it emanates.

UK case law is accorded persuasive authority in the Jamaican courts, and Jamaica has developed a well-established body of case law of its own

applying the principles of passing off to the protection of unregistered marks. A registered trademark owner retains its rights to protect any reputation acquired through use of the mark, by means of a passing off action. The Trademarks Act expressly preserves the law of passing off.

Use requirements

The Trademarks Act does not specify how much use is required to establish unregistered rights. It simply states that, in the case of a mark which is devoid of distinctive character or descriptive, or which consists exclusively of indications that have become customary in the current language or in the good-faith and established practices of the trade, “if, before the date of the application for registration, it has in fact acquired a distinctive character as a result of the use made of it”, it will not be refused registration.

In determining whether a mark has acquired distinctive character through use, the registrar of trademarks must make an overall assessment from the evidence that the mark has come to identify the goods or services concerned as originating from the particular undertaking, and thus to distinguish the goods or services from those of other undertakings. For most marks, evidence of at least three to five years’ use prior to the date of application is usually sufficient. Such evidence should constitute:

- the relative market share held by the mark;
- how intensive, geographically widespread and longstanding use of the mark has been;
- the income derived from the mark; and
- the amount invested in promoting the mark during the years in question.

3. Registered marks

Ownership

Any person (including a corporate body or legal entity deemed to be a person under the law) can apply for and own a trademark.

Scope of protection

Any sign that is capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of others can be protected as a trademark under Section 2(1) of the Trademarks Act. These signs include traditional marks such as words (including a personal name), designs, letters and numerals, and non-traditional marks such as a colour or combination of colours, the appearance or shape of goods or their packaging, sounds, smells, taste or touch.

Marks that cannot be protected include those caught under the following absolute grounds for refusal:

- marks that do not satisfy the definition of a ‘trademark’ under Section 2(1);
- marks that are devoid of any distinctive character;
- marks that serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or provision of the services, or other characteristics of the goods or services (ie, descriptive marks);
- marks that have become customary in the current language or in the good-faith and established practices of the trade (ie, generic marks);
- marks comprised of a shape which results from the nature of the goods themselves;
- marks comprised of the shape of goods which is necessary to obtain a technical result or which gives substantial value to the goods (ie, functional marks);
- marks that are contrary to public policy or accepted principles of morality (eg, matters of race, sex, religious beliefs, decency);
- marks of such a nature as to deceive the public as to the nature, quality or geographic origin of the goods or services, or otherwise;
- marks whose use is prohibited by Jamaican law;
- marks for which registration is sought in bad faith;
- marks that disparage or falsely suggest a connection with persons (living or dead) or institutions or beliefs; and
- marks that contain the Jamaican coat of arms, national flag or other national symbols, or the national symbols of any convention country.

In addition, marks cannot be protected if they fall under the following relative grounds for refusal:

- marks that are identical to an earlier trademark registered for identical goods or services, where there is a likelihood of confusion, including the likelihood of association with the earlier mark;
- marks that are identical to an earlier trademark registered for similar goods or services, where there is a likelihood of confusion, including the likelihood of association with the earlier mark;
- marks that are similar to an earlier trademark for identical or similar goods or services, where there is a likelihood of confusion, including the likelihood of association with the earlier mark; or
- marks that are identical or similar to an earlier mark to be registered in relation to dissimilar goods or services, where the earlier mark has a reputation in Jamaica and the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

An ‘earlier mark’ is defined under the act as:

- a registered trademark;
- a trademark which, at the date of filing or priority, is entitled to protection under the Paris Convention as a well-known trademark; or
- a trademark in respect of which an application has been filed and which, if registered, would

be an earlier trademark (as defined above), subject to it being so registered.

Further, the act states that a trademark shall not be registered if, or to the extent that, its use in Jamaica is liable to be prevented:

- by virtue of any law (in particular the law of passing off) protecting an unregistered mark or other sign used in the course of trade; or
- by virtue of any earlier right other than those relating to earlier trademarks, or rights protected by passing off, in particular by virtue of the law relating to copyright or design rights.

4. Procedures

Examination

On the filing of a trademark application, the registrar first considers:

- whether the mark meets the requirements of Section 2(1) (ie, whether it is capable of functioning as a trademark);
- whether any absolute grounds for refusal exist; or
- whether the mark offends against the provision prohibiting the inclusion of specially prohibited emblems such as national symbols.

If none of the absolute grounds for refusal exist, the registrar will conduct a search of earlier trademarks to ascertain whether there are any relative grounds for refusal. If it appears to the registrar that the registration requirements are not satisfied, either on absolute or relative grounds, the applicant is informed by way of an examination report and given two months to respond.

If the registrar refuses an application, the applicant must be given an opportunity to be heard, whether at an oral hearing or by making

submissions in writing. On reaching a decision after a hearing or considering submissions, the registrar must send a notice of his decision to the applicant and provide reasons if requested. For purposes of any appeal, the date of decision will be the date on which the statement of reasons is sent.

Once the registrar is satisfied that the requirements of the act are satisfied, he must accept the application and, on the applicant paying the prescribed fee, proceed to publication in the *Gazette* or “such other manner as may be prescribed”.

Opposition

Once the application is published in the *Gazette*, third parties may file a notice and grounds of opposition in duplicate within two months of the date of publication.

Within two months of receipt of the duplicate notice and grounds of opposition, the applicant must file a counter-statement in duplicate setting out the grounds on which it relies in support of its application and the facts, if any, alleged in the notice of opposition which it admits.

If the applicant fails to file a counter-statement, its application will be deemed withdrawn. The times specified for the filing of an opposition and counter-statement cannot be extended under the act.

Upon receipt of the duplicate counter-statement, the opponent has an extendible deadline of two months to file such evidence, by way of statutory declaration or affidavit, as it wishes to adduce in support of its opposition.

The applicant likewise has two months upon receipt of the opponent's evidence to file evidence it wishes to adduce in support of the application, by way of statutory declaration or affidavit. The opponent may file evidence

strictly in reply to the applicant's evidence and no further evidence may be submitted by either party, although in proceedings before the registrar he may at any time give leave to either party to submit any evidence upon such terms as to costs or otherwise as he thinks fit.

Upon completion of the evidence, the registrar gives notice of a date when arguments in the case will be heard.

Registration

If no notice of opposition is given, or on a withdrawal or a decision of opposition proceedings in the applicant's favour, the registrar must register the mark unless it appears, having regard to matters coming to the registrar's attention since the acceptance of the application, that it was accepted in error, or unless the prescribed fee has not been paid within the prescribed period.

The registration takes effect as of the date of filing of the application for registration, which is deemed to be the date of registration. On registration, the registrar issues a registration certificate to the applicant. The registration remains in effect from the date of filing of the application (the registration date) for a period of 10 years. Registrations are renewable for successive 10-year periods.

Cancellation/surrender

A registered trademark may be surrendered by the owner in respect of some or all of the goods or services for which it is registered. Surrender is effected by notice to the registrar in the prescribed form; and the notice has no effect unless the owner, in that notice:

- gives the name and address of any person with a registered interest in the mark;
- certifies that any such person has been sent at least three months' notice of the owner's intention to surrender the mark; and
- certifies that any such person is not affected, or if affected, consents thereto.

Upon the surrender taking effect, the registrar makes the appropriate entry in the register.

Revocation

An application for revocation may be made by any person to the registrar or the court. If court proceedings are pending concerning the mark in question, a revocation application must be made to the court; where made to the registrar, it will be referred to the court.

A trademark registration may be revoked on any of the following grounds:

- Within the three years following the date of completion of the registration procedure and up to one month before the date of application for revocation, the trademark has not been put to genuine use in Jamaica by the owner or with its consent in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- As a result of the actions or inactivity of the owner, the trademark has become the common name in the trade for goods or services for which the trademark is registered; or
- The trademark is likely to deceive or confuse the public on account of its use by the owner or with its consent in relation to the goods or services for which it is registered.

Use of a trademark includes use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it is registered. Use in Jamaica includes affixing the trademark to goods or to their packaging in Jamaica solely for export purposes.

The act provides that a trademark will not be revoked for non-use if use of the mark is resumed or commenced after the expiry of three years, but before the application for revocation is made. However, any such commencement or resumption shall be disregarded unless

preparations for the commencement or resumption began before the owner became aware that the application might be made.

Finally, a trademark registration will not be revoked where the registrar is satisfied that the owner intends to use the trademark before the expiration of the period for which it is registered.

Where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation will relate to those goods or services only.

Where a trademark registration is revoked to any extent, the rights of the owner shall be deemed to have ceased to that extent as from:

- the date of the application for revocation; or
- an earlier date, if the registrar or court is satisfied that the grounds for revocation existed at that earlier date.

Invalidation

An application for a declaration of invalidity may be made by any person to the registrar or the court. If proceedings are pending in court concerning the mark in question, a revocation application must be made to the court; where made to the registrar, it will be referred to the court.

The registrar may also apply to the court for a declaration of invalidity in case of bad faith or error in the registration.

A trademark registration may be declared invalid on either of the following grounds:

- It was disqualified for registration under the absolute grounds for refusal specified in the act; or
- An earlier trademark exists in relation to which the relative grounds for refusal obtain, or an earlier right exists which is protected by passing off or the law relating

to copyright or design rights, and the owner of that earlier trademark or right has not consented to the registration.

However, where a trademark is registered despite being disqualified under the absolute grounds for refusal, it will not be declared invalid if it has acquired a distinctive character through use in relation to the goods or services for which it is registered.

Where grounds for invalidity exist in respect of only some of the goods or services for which the trademark is registered, the declaration of invalidity shall relate to those goods or services only.

Where a trademark registration is declared invalid to any extent, the registration shall, to that extent, be deemed never to have been made, but without prejudice to any transactions past and closed.

5. Enforcement

Complexity

The enforcement of unregistered rights through a passing off action is much more complex than the enforcement of registered rights through an infringement action. A person claiming ownership in an action for passing off must prove each one of the five essential elements of this tort, namely:

- a misrepresentation;
- made by a trader in the course of trade;
- to its prospective customers or ultimate consumers of goods or services it supplies;
- which was calculated to injure the business or goodwill of another trader (in the sense that such injury is a reasonably foreseeable consequence of such misrepresentation); and
- results or will likely result in actual damage to the business or goodwill of the trader that brings the passing off action.

Despite the reference to ‘calculated’, liability for passing off is not affected by a defendant trader’s state of mind or intention. There is no requirement for a claimant to prove that the defendant trader acted fraudulently, maliciously or even negligently. ‘Calculated’ is better understood if it is interpreted as meaning ‘likely’.

Nonetheless, the requirement of proof that the misrepresentation was calculated to injure the business or goodwill is quite a difficult hurdle to surmount.

By contrast, the infringement action is more straightforward and can be brought on any use in the course of trade of a sign that is identical to a registered trademark, in relation to goods or services that are identical to those for which the trademark is registered, without the trademark owner’s consent.

The Trademarks Act also provides that a registered trademark is infringed by an unauthorized third party who uses a sign in the course of trade:

- which is likely to deceive or confuse the public because the sign is identical to the registered trademark and is used in relation to similar goods or services to those for which the trademark is registered; or
- which is similar to the registered trademark and is used in relation to identical or similar goods or services to those for which the trademark is registered.

There will also be infringement where an identical or similar sign to the registered trademark is used in the course of trade in relation to goods or services dissimilar to those for which the trademark is registered, where the sign has a reputation in Jamaica and the unauthorized use of that sign takes unfair advantage of, or is detrimental to, that reputation.

The act provides that an infringer ‘uses’ a sign if it:

- affixes it to goods or packaging;
- offers or exposes goods for sale under the sign;
- imports or exports goods under the sign; or
- uses the sign on business papers in advertising.

Timeframe

The timeframe from filing of an action for either passing off or infringement to trial is approximately three years. However, assuming the same factual situation, the length of a trial for passing off will invariably exceed that for infringement.

In most cases, a passing off or infringement action terminates on the outcome of an application for an interlocutory injunction to restrain the use of the mark until trial. An early determination of the issue concerning the use of the mark during the pre-trial period often leads to settlement negotiations or an abandonment of the action by the losing party. An application for an interlocutory injunction is normally filed simultaneously with or very soon after the bringing of an action, and is usually heard within three months of the application.

6. Ownership changes – legalization requirements

There is no requirement for the legalization of assignment documents.

7. Areas of overlap with related rights

Trademark rights can co-exist and do overlap with rights in copyright and design. In this way,

copyright and the rights conferred by a registered design can be relied on to protect device marks of artistic or technical merit.

8. Online issues

Registered and unregistered marks are now frequently used on the Internet to identify a trader and its goods or services. Unauthorized use of such marks can be restrained by an action for either infringement or passing off.