

Jamaica

Protecting geographical indications

After a five-year wait, the eagerly anticipated Geographical Indications Act came into force on June 8 2009, having originally been passed into law in 2004. This was followed in relatively quick succession by the Geographical Indications Regulations, promulgated on September 9 2009, which effectively brought the act into operation.

The requirement to provide special legal protection for geographical indications (GIs) initially arose as one of several IP rights obligations under the World Trade Organisation (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), when Jamaica became a WTO member on January 1 1995. However, what was then a relatively alien concept is now considered to be one of the most important forms of IP protection for Jamaica's national brand.

The regulations resulted from the work of the Jamaica Intellectual Property Office (JIPO), assisted by the Swiss Federal Intellectual Property Institute (IPI), in a two-year project between the two offices which commenced in July 2008. Under the project, the IPI has been helping the JIPO to establish a functional and effective GI system, which it is believed will better position quality authentic Jamaican products on the national and international markets.

This chapter provides a synopsis of the act and highlights areas of deficiency as well as progress.

Meaning of GIs

GIs are geographical names, signs or symbols used on or in association with a product which possesses a special quality, characteristic or reputation that is essentially attributable to its origin. World-famous GIs such as 'champagne', 'tequila', 'Scotch', 'Basmati rice', 'Havana cigars' and 'Darjeeling tea' readily denote a certain quality, characteristic and/or reputation that derives from their origin.

The act ascribes the same scope and meaning to GIs as adopted by TRIPs and implements its provisions. 'GIs' are defined under the act as indications which "identify a good as originating in the territory of a country, or a

region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin".

Protection

The act provides that any interested party may apply to the Supreme Court to prevent false and misleading uses of a GI – that is, use in the designation or presentation of a good which indicates or suggests that it originates in a particular place which is not the true place of origin and so misleads the public as to the true geographic origin. Interested parties may also prevent the use of a GI which amounts to unfair competition within the meaning of the Fair Competition Act. 'Goods' mean any natural or agricultural product or any product of industry or handicraft.

In relation to wines and spirits, interested parties may also prevent the use of GIs for goods that do not actually originate in the place indicated by the GI, even where the true place of origin is indicated and even where used in conjunction with terms such as 'kind', 'style' or 'imitation' (eg, 'champagne made in Jamaica' or 'imitation champagne'). Similar to Article 23(1) of TRIPs, this enhanced form of protection granted under the act applies only to wines and spirits.

Protection under the act extends to homonymous GIs for wines in particular, which often exist on account of immigrants carrying their place names with them to their new places of abode. However, it does not extend to services. Further, indications which are mere signs or indications of source and are contrary to public order or morality are excluded from protection. The act does not protect foreign GIs which are not protected, have ceased to be protected or have fallen into disuse in their own territory.

The act restricts the use of a protected GI to good-faith producers of goods that have a genuine link with the origin denoted by the GI, in that they possess a particular quality, reputation or other definable characteristic which is essentially attributable to their geographical origin.

Special provisions relating to trademarks

In accordance with TRIPs, the act addresses conflicts which may arise between GIs and trademarks where a foreign GI forms part of an already registered or pending trademark in the country where protection is sought. For example, a trademark which contains or consists of a GI may be subject to revocation or refusal of registration where the use of the GI in the trademark is misleading as to the true place of origin, or where the trademark identifies wines or spirits as being of the origin denoted by the GI when it is not the true place of origin.

However, if the trademark has been applied for or registered in good faith, or if the proprietor acquired rights in the trademark through using it in good faith before TRIPs became applicable in Jamaica or before the GI was protected in its country of origin, the validity or registrability of the trademark in question will not be prejudiced by the act; nor will the right to use the trademark be prejudiced on the basis that it is identical or similar to a GI.

Further, Jamaica applies a five-year limitation on the remedy of revocation or refusal of a mark. Therefore, proceedings to prevent misleading uses of a GI, or non-misleading but wrongful uses of a GI relating to wines and spirits, regarding the use or registration of a trademark containing or comprising a GI must be initiated within five years of the adverse use of the GI becoming generally known in Jamaica or five years of the date of trademark registration in Jamaica. However, the mark must have been published by the date of registration, if this is earlier than when the adverse use became generally known in Jamaica, and the GI must not have been used or registered in bad faith.

Exceptions

The act contains other exceptions relating to prior and good-faith use of a GI, as well as the use of a GI which has become generic in Jamaica. For example, in accordance with Article 24(4) of TRIPs, where a Jamaican party has used a GI of a WTO member state to identify wines and spirits in connection with goods or services that it produced continuously in Jamaica for at least 10 years before April 1 1994, or in good faith at any time before that date, the act does not prevent continued use of the GI by that party.

Further, the act does not apply where a GI of a WTO member state is identical to:

- a term that has been in customary use in Jamaica;
- a term that has been used as the common name for particular goods or services in Jamaica; or
- the customary name of a grape variety existing in Jamaica since January 1 1995.

These exceptions effectively bar from protection GIs that have become generic terms in the country where protection is sought. Finally, a person's right to use his or her own name in the course of trade, or the name of that person's predecessor in business, is unaffected by act, except where that name is used in a misleading manner.

Remedies and penalties

Interested parties are entitled to civil remedies (eg, injunction and damages) against false, misleading or wrongful uses of a GI. The wilful false and misleading use of a GI in respect of any product and the wilful improper use of a GI in respect of wines and spirits amount to criminal offences punishable by fines or imprisonment, ranging from 12 months and/or a fine of J\$1 million before the lower courts to five years and/or a fine set by the court before the Supreme Court. Where the offender benefited from the offence, the amount of the penalty to be determined by the court must be equivalent to the total value of the benefits derived by the offender from the offence.

Acquisition and registration formalities

Under the act, an interested party need not take formal measures to acquire the right to prevent false or misleading uses of a GI. The act establishes a registration system, but protection applies to both registered and unregistered GIs. Only producers, groups of producers or competent authorities, as defined by the act, may apply to register a GI. The application process is similar to that for trademarks and is administered by the registrar of industrial property (who also administers the trademark system), with the applicable procedures, forms and fees being prescribed by the GI Regulations.

An application for registration of a GI must be made on the prescribed form to the registrar and must specify the particulars of the applicant, including:

- the capacity in which the applicant is applying;
- the GI to be registered;
- the goods to which it applies;
- the quality, reputation or other definable characteristic of the goods in relation to which the GI is used; and
- the geographical area to which the GI applies.

The application should be accompanied by the prescribed fee of J\$30,000. Once the registrar confirms that the application complies with the conditions specified in the act and regulations, it will be published in the *Jamaica Gazette* or a daily newspaper.

Once the application has been published, anyone

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with an interest in the GI may, within three months of the date of publication, oppose its registration on specified grounds. The opposition proceedings are similar to opposition proceedings under the Trademarks Act; however, the opposition period may be extended by up to one month.

A GI will be registered if the application is accepted and unopposed or, where opposed, if the opposition is unsuccessful. Once registered, any producer or group of producers of goods to which the GI relates may use it provided that the genuine link specified in the GI Register exists between the goods in question and the geographic origin. A registered GI is presumed to have met the definition of a ‘GI’ under the act.

The regulations require the registrar to publish from time to time, in the *Jamaica Gazette* or in the *Geographical Indications Journal*, a list of GIs registered in accordance with the GI Act. The journal may be published annually. Where certain details have been omitted from or errors made on the register, one may apply for such errors and/omissions to be corrected.

Cancellation and revocation

Any interested person may, in accordance with the regulations, apply for cancellation of a registered GI on the grounds that it does not qualify or no longer qualifies for protection based on the requirements of the act. Such requests must be published in a daily newspaper at the expense of the person making the request or application, and are subject to a hearing of all interested parties before the registrar. A person may also request that the registrar refuse or revoke the registration of a trademark that is misleading as to the origin of goods or which inaccurately identifies the origin of wines or spirits. Any such revocation shall be

published by the registrar in the *Jamaica Gazette* or a daily newspaper. The registrar’s decision is subject to appeal to a judge in chambers within two months of the decision.

Deficiencies

Although the GI legislation is modern, it is perceived to be deficient in terms of the standard of protection that it offers to products other than wines and spirits. The fact that protection extends only to goods and not to services has also been perceived as a deficiency by some interest groups.

In relation to the standard of protection, although the act defines ‘GIs’ broadly to cover indications identifying any natural or agricultural product or any product of industry or handicraft, it implements the two-tiered protection outlined by TRIPs by affording wines and spirits stronger protection than other products. Therefore, the use of the GI ‘champagne’ alongside the designation ‘Jamaican-style’ would be objectionable under the act, even though a wine connoisseur, seeing a bottle of sparkling wine labelled ‘Jamaican-style champagne’, would not be misled into thinking that it actually originated in the Champagne region, France. However, a trader could use the designation ‘Jamaican jerk seasoning, Mexican-style’ if it conveyed the actual origin to the consumer. In other words, in order to be protected an interested party must prove that the use of ‘Jamaican jerk seasoning, Mexican-style’ is in fact misleading as to the actual origin of the product.

The standard of protection now accorded to products other than wines and spirits will not prevent the ongoing abuse of indigenous GI products from imitators which indicate the true origin of the product. Therefore, local stakeholder groups have sought to lobby for the

amendment of the act in order to upgrade the protection standard for food GIs to that granted to GIs for wines and spirits.

Progress

The Jamaica/Swiss GI project has gone a long way towards facilitating the development of a proper GI protection system in Jamaica through training and building the capacity of producers, industry associations and relevant government offices, and assisting with the identification of Jamaican products which can be protected by the act. These products include Jamaica blue mountain coffee (already a registered certification mark in Jamaica and the United States, and a protected designation of origin in the United Kingdom), Jamaican rum, jerk sauce, scotch bonnet pepper and Jamaican cocoa. However, no GIs have yet been registered under the act.

Even where a robust GI system exists, producers will not necessarily be afforded the level of protection that they require in foreign markets due to the varying levels of protection granted under several laws, despite wide adherence to TRIPs. A number of countries have entered into bilateral and multilateral arrangements in order to secure a desirable level of protection for products that

are significant to their markets.

Jamaica appears to view this approach as essential and is in the process of concluding the negotiation of a bilateral agreement with Switzerland on the mutual protection of GIs in order to cement more effective protection. In addition, Jamaica is among the CARIFORUM countries that concluded the economic partnership agreement (EPA) with the European Union and its member states in October 2008. Notably, the EPA goes beyond TRIPs by requiring uniform protection against false, misleading and non-misleading uses of GIs, irrespective of the class of goods in relation to which the GI is used.

Jamaica has already submitted a list of prospective GIs as required by the EPA, which also requires parties to establish a system of protection for GIs in their respective territories by January 1 2014 and is preparing revisions to the act and regulations to accord the same level of GI protection irrespective of the class of goods. With a strategic alliance with Switzerland, a country renowned for its record of protecting GIs, Jamaica is well on the way to complying with its various multilateral obligations, as well as fulfilling the expectations of producers, exporters and distributors of products that are uniquely Jamaican.



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