

# International Comparative Legal Guides



TM

## Trade Marks 2021

A practical cross-border insight into trade mark work

**10<sup>th</sup> Edition**

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# Jamaica

DunnCox



Joanne Wood Rattray



Kelly Akin

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Jamaica Intellectual Property Office (“JIPO”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Trade Marks Act, 1999 (as amended) (“the Act”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

The Act, Section 2(1) defines a “trade mark” as “any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking”. The definition is broad enough to include logos and other “non-traditional” signs such as smell, sound and colour marks. However, the JIPO remains conservative in its approach to accepting non-traditional marks as capable of being sufficiently distinguishing, adhering to the criteria laid down by the European Court of Justice (“ECJ”) in *Sieckmann v German Patent and Trademark Office* (Case C-273/00) requiring graphical representation that is “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

### 2.2 What cannot be registered as a trade mark?

Signs which fall within the categories of the absolute grounds for refusal prescribed under the Act cannot be registered as trade marks.

### 2.3 What information is needed to register a trade mark?

The following information is needed to complete an application for registration:

- 1) the mark, or if a device or logo, an image of the mark;
- 2) the applicant’s name, address and country or state of nationality;

- 3) the relevant class or classes based on the Nice Classification;
- 4) the specific goods and/or services for which the mark is used or intended to be used;
- 5) for a device/logo mark filed in colour, the Pantone number of any colour(s) in relation to which a colour limitation claim should be made; and
- 6) for any priority claim, the country, date of initial filing and application number (a priority certificate must be filed within 90 days of the application in Jamaica).

### 2.4 What is the general procedure for trade mark registration?

In April 2020, as a response to the COVID-19 pandemic, JIPO began accepting electronic filing of applications. The date of electronic filing is the official filing date. The electronic filing must be confirmed by the filing of a hardcopy of the application within seven days of the electronic filing. JIPO issues the official filing particulars electronically within 10 to 14 days of the official filing date. The examiner’s report issued electronically follows within three to six months of filing. That report indicates whether the mark has been provisionally accepted for publication or refused based on absolute or relative grounds. If the mark is refused, the applicant has two months within which to respond by way of written arguments or submissions to JIPO. Failure to respond or request an extension of time to respond (request must be filed within the response period) will cause the application to be withdrawn.

If the mark is provisionally accepted for registration, the publication cost and balance registration fee must be paid within a statutorily prescribed period of two months following the date of the notice of acceptance. JIPO publishes the application in an official Trade Marks Journal usually within two to three months of payment. A statutorily prescribed period of two months from the publication date follows for the filing of third-party oppositions. If there is no opposition, the Certificate of Registration will be issued, usually within two to three months of the expiry of the opposition period.

### 2.5 How is a trade mark adequately represented?

Adequate representation of a trade mark varies according to the type of mark. Word marks are represented in standard typed block letters. Stylised lettering, design or logo marks including colours must be represented in a clear, precise and self-contained image. If a colour limitation claim is made, the Pantone numbers of the colours are required. Five images of the mark applied for (including word marks) must be filed with each application. The images can be filed electronically.

An adequate graphic representation of non-traditional marks is very challenging. The Jamaican practice remains unsettled though JIPO is likely to follow the practice of the UK Intellectual Property Office (“UKIPO”) and other established common law jurisdictions in these cases.

#### 2.6 How are goods and services described?

Goods and services are described according to the international Nice Classification system. The goods and services must be clearly identified together with the appropriate class number(s). JIPO largely follows the practice of the United States Patent and Trademark Office (“USPTO”) by examining specifications along the lines laid out in the USPTO’s Trademark ID Manual, which specifies approved descriptions. Applicants may list only the goods or services that are actually in use or intended for use. Whole class headings or broad descriptions will be rejected as “vague and unacceptable”.

#### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

There are no special measures prescribed by the registering authority for filing “exotic” or unusual trade marks.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations and/or renewal purposes.

#### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade mark rights extend only within the territory of Jamaica.

#### 2.10 Who can own a trade mark in your jurisdiction?

Any individual (a natural person) or legal person or entity capable of owning property in its own name can own a trade mark. The legal status of the applicant must be stated at the time of filing the application. Non-legal persons such as unregistered charities cannot own a trade mark in the name of the charity.

#### 2.11 Can a trade mark acquire distinctive character through use?

A mark can acquire distinctive character through use. Three to five years of substantially exclusive and continuous use, including advertising and promotional activity at the national level or within the ambit of the mark’s specific market sector, may qualify as *prima facie* evidence of acquired distinctiveness.

#### 2.12 How long on average does registration take?

On average, a straightforward registration takes 12 to 18 months from filing to the issuance of the registration certificate. Office actions will lengthen the registration process depending on complexity.

#### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for a straightforward trade mark registration in one class is USD 750 with the cost for each additional class being approx. USD 150.

#### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

There is currently only one route to obtaining a registration in Jamaica, i.e. via a national application.

#### 2.15 Is a Power of Attorney needed?

A Power of Attorney is not needed. A notice of change of agent signed by the applicant is required if a change occurs after filing.

#### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

The Power of Attorney is not applicable. The notice of change of agent does not require notarisation or legalisation.

#### 2.17 How is priority claimed?

Priority is claimed by providing the following details of the priority application in the Jamaican application:

- a) the application number;
- b) the country where the application was filed; and
- c) the date of the application.

A certified copy of the priority application (priority certificate) must be filed within 90 days of the filing date of the application in Jamaica.

#### 2.18 Does your jurisdiction recognise Collective or Certification marks?

Collective and Certification marks are recognised in Jamaica.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

The Act, Section 11(1) prescribes the following absolute grounds:

- a) signs which do not satisfy the definition of “trade mark” under Section 2(1);
- b) marks which are devoid of any distinctive character;
- c) marks which consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
- d) marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- e) signs that consist exclusively of:
  - i) the shape which results from the nature of the goods themselves;

- ii) the shape of goods which is necessary to obtain a technical result; or
- iii) the shape which gives substantial value to the goods;
- f) if it is contrary to public policy or to accepted principles of morality;
- g) it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services or otherwise;
- h) it consists of or contains a representation of the Coat of Arms of Jamaica, national flag of Jamaica and other national symbols;
- i) its use is prohibited in Jamaica by any law;
- j) the application is made in bad faith; and
- k) it is of such a nature as to:
  - i) disparage persons (living or dead) or institutions or beliefs; or
  - ii) falsely suggest a connection with such persons, institutions or beliefs.

### 3.2 What are the ways to overcome an absolute grounds objection?

Save for signs prohibited by Section 11(1)(f), (h), (i), (j) or (k) of the Act, the applicant may overcome the objection on absolute grounds by:

- Filing a limitation or dividing the application: if the objection is raised against some of the goods and/or services, deleting these goods and services will overcome the objection or divide the application so that the application may proceed for the approved goods or services and respond to the examiner in relation to the objection for the remainder of the goods/services.
- Filing arguments with supporting evidence to persuade the examiner that the objections should be waived, and the sign registered.
- Filing evidence of acquired distinctiveness showing that, due to the extensive use of the mark in the years preceding the application date, the relevant public has come to recognise the applied-for mark as an indicator of origin and that the goods and/or services under that mark originate from the applicant.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal under the Act from any decision of the Registrar in its entirety.

### 3.4 What is the route of appeal?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are:

- a) where the mark applied for is identical or so similar to an earlier (existing) trade mark that it is likely to be confused with that earlier trade mark;
- b) where the owner of an unregistered mark which is being used in Jamaica can show that the use of the mark applied for would be likely to deceive or cause confusion amongst consumers in relation to the prior mark;
- c) where the mark applied for is identical or confusingly similar to a mark which is entitled to protection as a well-known trade mark under the terms of the Paris Convention which is used for goods or services identical or similar to the goods or services for which the mark is applied for (whether or not the well-known mark is registered or used in Jamaica); and
- d) where use of the applied-for mark in Jamaica is liable to be prevented by virtue of an earlier right relating to copyright or rights in designs.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds of objection can be overcome by:

- presenting written arguments to the Registrar or requesting an informal hearing before the Registrar;
- limiting the specification (description) of the goods and/or services to distinguish the use of the mark from that of an earlier conflicting trade mark;
- agreement with the owner of a trade mark which is in conflict, thereby obtaining a letter of consent to registration; or
- applying to revoke the earlier trade mark on the ground that it was not entitled to be registered in the first place, or that it should be cancelled either entirely or partially due to non-use.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal under the Act from any decision of refusal of registration in its entirety.

### 4.4 What is the route of appeal?

Appeals are sent to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed on absolute or relative grounds as follows:

- a) the mark does not constitute a trade mark as defined in the Act;
- b) the mark is inherently deceptive or use thereof would be likely to deceive or cause confusion among consumers;
- c) the mark is not capable of distinguishing the goods/services, for which registration is sought, from the same goods/services covered by an earlier trade mark;
- d) the mark consists solely of a sign or indication which may serve in trade to designate the kind, quality and quantity, intended purpose, value, geographical origin or other characteristics and/or method or time of production of the goods/services for which registration is sought;
- e) the mark consists exclusively of a sign or indication which has become customary in the current language or the *bona fide* established trade practices of the trade;
- f) the applicant is not the *bona fide* proprietor of the mark;
- g) the mark consists of the shape which results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods;
- h) the mark is identical or confusingly similar to a mark which is entitled to protection as a well-known trade mark under the terms of the Paris Convention, which is used for goods or services identical or similar to the goods or services for which the mark is applied for;
- i) the mark contains national symbols;
- j) use of the mark is contrary to law or public policy;
- k) the mark conflicts with an earlier right in an unregistered mark or an earlier right relating to copyright or rights in designs; or
- l) the application was made in bad faith.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested party can oppose the registration of a trade mark. The opponent must be the owner of the prior right on which the opposition is based.

### 5.3 What is the procedure for opposition?

The opposition procedure is as follows:

- a) The opponent files a notice of opposition supported by a statement of grounds on which it intends to rely within two months of the publication of notice of the provisional acceptance of the mark.
- b) The applicant files a counterstatement supported by a statement of grounds on which it intends to rely within two months of receiving the opponent's notice and statement of grounds of opposition.
- c) The opponent files evidence on which it intends to rely within two months of receiving the counterstatement and supporting grounds.
- d) The applicant files evidence on which it intends to rely within two months of receiving the opponent's evidence.

- e) The opponent may file evidence strictly in reply to the applicant's evidence (leave is required for the filing of fresh evidence) within two months of receiving the applicant's evidence.
- f) At the closure of the evidentiary phase of the proceedings, the hearing officer contacts the parties to agree a formal hearing date.
- g) The matter proceeds to a formal hearing at which time the parties present arguments both orally and in writing.
- h) A decision is made by the hearing officer, usually after taking some time to consider the arguments put forward by the parties.
- i) The decision is communicated to the parties in writing.

On the filing of a notice of opposition, parties can agree to a two-month "cooling-off period", for the filing of the counterstatement to facilitate settlement discussions. The application must be supported by a declaration that the other party has agreed in writing to it and that agreement should be attached to the application. The cooling-off period may be extended by the Registrar for up to six months after the expiration of the initial two months, upon application by the applicant supported by a declaration that the opponent has agreed to it. If no counterstatement is filed within the cooling-off period granted, the application will be deemed withdrawn.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration certificate will automatically be issued usually within two to three months following the end of the opposition period. No additional fee is payable for the issuing of the registration certificate.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence from the application/filing date or from an earlier priority date, if claimed.

### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years from the application/filing date (even where an earlier priority date is claimed), which is effectively the registration date.

### 6.4 How is a trade mark renewed?

A trade mark is renewed by filing a renewal application accompanied by a fee of approximately USD 90 for the first class and USD 18 for each additional class to be renewed. Late renewals can be filed after the renewal date with an additional late renewal fee of USD 18.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

An individual can apply to register (record) the assignment of a trade mark. Registering an assignment is not mandatory.



## 7.2 Are there different types of assignment?

An assignment can be made with or without the goodwill of a business. It may be full or partial, that is, limited so as to apply in relation to:

- a) some but not all of the goods or services for which it is registered; or
- b) the use of the trade mark in a particular manner or a particular locality.

## 7.3 Can an individual register the licensing of a trade mark?

The application may be filed by either the assignor or the assignee accompanied by the original assignment. A certified or notarised copy of the assignment or other suitable evidence of the assignment may be filed under a statutory declaration sworn to by either the assignor or the assignee.

## 7.4 Are there different types of licence?

A licence may be exclusive or non-exclusive, general or limited. A limited licence may apply in relation to:

- a) some but not all of the goods or services for which the trade mark is registered; or
- b) the use of the trade mark in a particular manner or a particular locality.

## 7.5 Can a trade mark licensee sue for infringement?

The Act gives an exclusive licensee the right to sue for infringement in the licensee's own name. A non-exclusive licensee cannot sue initially but must call upon the registered trade mark owner (proprietor) to take infringement proceedings. If the proprietor: (a) refuses to do so; or (b) fails to do so within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor. Where infringement proceedings are brought by a licensee in these circumstances, the licensee may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant. In all cases, a trade mark licensee can sue for infringement only if the licence has been recorded.

## 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence. However, such clauses are highly advisable to protect against use that might render the trade mark vulnerable to revocation for deceptive or invalid use or loss of its ability to distinguish the goods/services due to generic use.

## 7.7 Can an individual register a security interest under a trade mark?

An individual can register (record) a security interest over a registered trade mark or any right in or under it. Registering a security interest is not mandatory. To be effective, the security interest must also be registered under the Security Interest in Personal Property Act.

## 7.8 Are there different types of security interest?

A security interest may be fixed or floating.

# 8 Revocation

## 8.1 What are the grounds for revocation of a trade mark?

The Act, Section 43(1) provides that the registration of a trade mark may be revoked on any of the following grounds:

- a) within the period of five years prior to the date of application for revocation, the trade mark has not been used for *bona fide* purposes in Jamaica in relation to the goods or services for which the trade mark is registered and there are no proper reasons put forward by the proprietor for its non-use;
- b) the *bona fide* use of the trade mark has been suspended for a continuous period of five years prior to the date of the application for revocation, and there are no proper reasons put forward by the proprietor for its disuse;
- c) as a result of the act or failure to act on the part of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which the trade mark is registered; or
- d) the trade mark is likely to deceive or confuse the public as to the nature, quality or geographical origin of goods or services or on account of its use by the proprietor, or with his consent, in relation to the goods or services for which it is registered.

## 8.2 What is the procedure for revocation of a trade mark?

An application for revocation is filed by a third party citing the ground(s) for revocation. The registered proprietor responds by filing evidence of use or arguments relating to the other grounds cited for revocation. The applicant will then file arguments and evidence in reply. At the conclusion of the evidentiary phase of the proceedings, the parties will be consulted and a hearing date agreed. Following the hearing of arguments and receiving written submissions, the hearing officer will consider and make a decision which will be communicated to the parties in writing. The trade mark may be revoked entirely in relation to all the goods/services covered or only partially. Revocation takes effect from the date of the application for revocation.

## 8.3 Who can commence revocation proceedings?

Revocation proceedings may be commenced by any person to the Registrar or the Supreme Court. If proceedings are pending in court concerning the trade mark, an application for revocation must be made to the court. If, in any other case, the application is made to the Registrar, he may at any stage refer the application to the court.

## 8.4 What grounds of defence can be raised to a revocation action?

Possible grounds of defence are use of the trade mark (supported by evidence proving same) that has commenced or resumed after the expiry of the five-year period but before the application for revocation is made, and/or rebuttal evidence against any other grounds for revocation alleged.

### 8.5 What is the route of appeal from a decision of revocation?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact, or that the exercise of discretion was patently wrong.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The Act, Section 45(1) provides that the registration of a trade mark may be declared invalid on the ground that:

- a) it was disqualified from registration under Section 11 (absolute grounds); or
- b) there is an earlier trade mark or an earlier right in relation to which the conditions specified in Section 13 are obtained and satisfied (relative grounds), and the proprietor of that earlier trade mark or earlier right has not consented to the registration.

Where a trade mark was registered despite being disqualified under Section 11, it shall not be declared invalid if through use it has acquired a distinctive character in relation to the goods or services for which it is registered.

### 9.2 What is the procedure for invalidation of a trade mark?

An application for invalidation is filed by way of notice together with evidence supporting the grounds for invalidation to the Registrar or the Supreme Court. If proceedings are pending in court concerning the trade mark, an application must be made to the court and if in any other case the application is made to the Registrar, he may at any stage refer any matter arising from the application to the court.

Where the registration of a trade mark is declared invalid to any extent, then the registration shall to that extent be deemed to have never been made, but without prejudice to any transaction past and closed.

### 9.3 Who can commence invalidation proceedings?

Invalidation proceedings may be commenced by any person to the Registrar or the Supreme Court. The Registrar may apply to the court for a declaration of the invalidity of the registration of a trade mark in the case of bad faith or error in the registration.

### 9.4 What grounds of defence can be raised to an invalidation action?

Where the basis for invalidation is on absolute grounds, a trade mark owner can provide evidence in support of the defence that the mark is capable of distinguishing or has acquired distinctiveness in relation to the goods and/or services for which it was registered through use.

Where the basis for invalidation is on relative grounds, the action can be defended where the trade mark has been used for a continuous period of three years with the knowledge and

acquiescence of the proprietor of the earlier trade mark or other earlier right, unless the registration of the later trade mark was applied for in bad faith.

Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark will be declared invalid in regards to those goods or services only.

### 9.5 What is the route of appeal from a decision of invalidity?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A claim for trade mark infringement is actionable by the proprietor (and in some cases the licensees) and relief can be sought in the Supreme Court of Jamaica in the same way as with the infringement of any other property rights.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Typically, once a suit is filed in the Supreme Court of Jamaica, the parties must attend a Case Management Conference, Mediation and Pre-Trial Review before the claim can proceed to trial. It is difficult to estimate a timeframe for the completion of these pre-trial steps as it will vary on a case-by-case basis as well as with the scheduling of the parties and the court. However, parties should expect that the pre-trial process should take no less than one year.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary and final injunctions are available.

Preliminary (interim) injunctions may be granted where a party establishes that:

- a) there is a serious question to be tried and the claim is merely frivolous or vexatious, but has some prospect of proceeding;
- b) the applicant would not be adequately compensated by damages as in the case where the defendant is unable to pay the damages, damage is pecuniary, the loss suffered is irreparable or the quantum of damages would be difficult to assess; or
- c) the balance of convenience weighs in favour of the applicant.

Final injunctions may be granted by the Supreme Court of Jamaica under Section 49(h) of the Judicature (Supreme Court) Act. The Court may grant this injunction where it appears to be just or convenient. The injunction can be made either conditionally or upon such terms and conditions as the court thinks just, to prevent any trespass.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under Part 28.4 of the Civil Procedure Rules of Jamaica (“CPR”), a court may order “standard disclosure”. Under standard disclosure, each party has the duty to disclose all documents which are directly relevant to the matters in question in the proceedings. Standard disclosure may be limited or dispensed with by the court or by agreement between the parties. “Directly relevant” is defined, for these purposes, as a document that is in the party’s control that they intend to rely on, a document that adversely affects a party’s case, or a document that supports another party’s case.

Under Part 28.6, the court may make an order for “specific disclosure”, which requires a party to disclose a document(s) or classes of documents specified in the order, or carry out a search for documents to the extent stated in the order, and disclose any documents located as a result of that search.

Where any party claims a right to withhold a document from disclosure, the party must state the grounds on which he is claiming such a right. A party may withhold documents from inspection on the basis that they are privileged documents. The main types of privileged documents are:

- a) communication between attorney/solicitor and client; and
- b) documents prepared with a view of litigation.

In addition to privileged documents, a party may withhold documents that would be self-incriminating. The duty to disclose documents is ongoing throughout the proceedings.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

At trial, submissions are generally made orally, unless otherwise ordered by the judge hearing the matter. Generally, any fact that needs to be proved by the evidence of a witness is to be proved at trial orally, and at any other hearing by affidavit.

Witness statements are written statements by a witness containing evidence which is intended to be given orally at trial. Where a party intends to rely on a witness statement at trial, that party must call the witness to give evidence, unless the court orders otherwise. Witnesses whose witness statements are relied on by a party at trial may be cross-examined.

The court may require or permit that evidence be given by affidavit instead of, or in addition to, oral evidence.

There is nothing in Jamaican law that dictates a party’s choice of witness, which will be dependent on the preference of each client and vary from case to case.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Supreme Court of Jamaica has the discretion to stay proceedings under CPR Rule 26.1(2)(e) and Section 49(e) of the Judicature (Supreme Court) Act.

CPR Rule 26.1(2)(e) allows the court to stay the whole or part of any proceedings generally or until a specified date or event, as part of its general powers of case management.

The Judicature (Supreme Court) Act allows the court to stay proceedings as it deems fit. A party may apply to the court for a stay of proceedings under this Section, either generally or so far as may be necessary for the purposes of justice.

In practice, the Jamaican courts have exercised this discretion where the current matter would be obtuse or moot if proceedings were not stayed, the current matter would be impaired if prior/other proceedings were not completed, and the other proceedings have a material impact on the proceedings.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

Generally, an action for the infringement of property rights is statute-barred after the expiration of seven years since the date of infringement. However, where the proprietor is seeking an order for delivery up under Section 36 of the Act, an application for such an order may not be made after a period of six years.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Unauthorised use of a trade mark is a criminal offence which is punishable by:

- i) summary conviction before a Resident Magistrate to a fine not exceeding one million Jamaican dollars (approx. USD 8,000.00) or to a term of imprisonment not exceeding 12 months, or both fine and imprisonment; or
- ii) conviction before the Supreme Court of Jamaica to a fine or to imprisonment not exceeding five years or to both such fine and imprisonment.

#### 10.9 If so, who can pursue a criminal prosecution?

Typically, it is only the Crown, through the Office of the Director of Public Prosecutions (“DPP”), that can commence criminal proceedings. However, where the proprietor of a trade mark wishes to initiate criminal proceedings themselves, they may ask the DPP for a fiat so that they may actively associate themselves with the prosecution.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions in Jamaica for unauthorised threats of trade mark infringement.

## 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Section 69(5) of the Act states that where a person is charged with unauthorised use of a trade mark, it is a defence if the defendant “believed on reasonable grounds that the use of the sign in the manner in which it was used or was intended to be used was not an infringement of the registered trade mark”.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

- a) Honest concurrent use – Under Section 15 of the Act, the Registrar shall not refuse an application to register a mark where the applicant satisfies the Registrar that there is

honest concurrent use of the trade mark and the proprietor of an earlier trade mark does not raise objection on any such ground during opposition proceedings.

- b) Acquiescence – Under Section 47 of the Act, where a registered trade mark has been used in Jamaica for a continuous period of three years with the knowledge and acquiescence of the proprietor of an earlier trade mark, then with the exception of bad faith, such proprietor will not be entitled to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in connection with the goods and services in relation to which it has been used.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

All remedies available for the infringement of any other property rights are available to a proprietor for trade mark infringement including damages, costs and injunctions.

In addition to these typical remedies, the Act provides for the following remedies:

- Order for Erasure (Section 35) – causing the offending sign to be erased, removed or obliterated from infringing goods or, where it is not reasonably practicable, to secure the destruction of the infringing goods.
- Order for Delivery up (Section 36) – causing the delivery up to the proprietor, or to such other person, of any infringing goods, materials or articles which a person has in his possession, custody or control in the course of business.
- Order for Disposal (Section 38) – that the infringing goods delivered up under Section 36 be destroyed or forfeited to such person as the court thinks fit.
- Declaration of Invalidity (Section 46) – application may be made by any person to the Registrar or the court.
- Order for Forfeiture (Section 72) – of infringing goods.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs are awarded at the discretion of the court. Generally, the costs that are payable by the unsuccessful party are those that are reasonably incurred and reasonable in amount. Where parties cannot agree on what costs are reasonable or what costs are reasonably incurred, they may ask the Supreme Court to assess the amount to be paid by the unsuccessful party. The Registrar will assess the costs in a matter and, taking into account the complexity and value of the claim, vary the amount to be paid by the unsuccessful party accordingly.

Where an attorney wastes the time of the parties and the court, he may be ordered to pay costs incurred in that particular aspect of the case (i.e. a wasted costs order).

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal from a decision made by the Supreme Court of Jamaica may be made to the Court of Appeal, and an appeal from the Court of Appeal may be made to the UK Judicial Committee of the Privy Council. No further appeal can be made.

The right to appeal can be automatic or, in some instances, a party can apply to the court for leave to appeal. Decisions from the Supreme Court and Court of Appeal may be appealed based on an error of law, finding of fact or the exercise of discretion by the judge of first instance. Appeals against the judge's finding of fact or exercise of discretion will be successful only where it is demonstrated that there was no basis for the finding of fact, or that the exercise of discretion was patently wrong.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

An application can be made to the court to adduce fresh evidence during appellate proceedings. Fresh evidence is usually only admitted under extenuating circumstances and, in any event, the party wishing to rely on the fresh evidence will have to show that:

- the evidence was not available at the trial;
- the evidence is relevant to the issue; and
- the evidence is credible.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Under the Act, Section 66, the proprietor or licensee of a registered trade mark may give written notice to the Commissioner of Customs stating:

- that he is the proprietor or licensee of the registered trade mark;
- the time and place at which the infringing goods are expected to arrive in Jamaica; and
- a request that the Commissioner treat them as prohibited goods under the Customs Act.

The Jamaica Customs Agency (“JCA”) also requires that proprietors provide a letter of indemnity in addition to the notice which would indemnify the JCA on any costs or charges related to the enforcement action taken (this may include legal challenges).

Under the Merchandise Marks Act, Section 11, where someone is charged with forging a registered trade mark and a Justice of the Peace has reasonable cause to suspect that infringing goods are being stored on any premises of the defendant, or are otherwise in his possession or under his control, the Justice may issue a warrant for the search of the said premises and seize the infringing goods.

Both procedures described above apply to identical and similar marks and goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Jamaica is a “first to use” jurisdiction, where unregistered rights are enforceable against third parties under the common law action of passing off. The unregistered rights holder must demonstrate the following for a claim to succeed:

- goodwill or reputation attached to the claimant's business, goods or services;
- misrepresentation by the defendant to the public (whether intentional or not) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the claimant; and

- c) damage to the claimant caused by the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the claimant.

The claimant may also have recourse to remedies available under the Fair Competition Act for activities such as misleading advertising.

#### 15.2 To what extent does a company name offer protection from use by a third party?

The Companies Office of Jamaica will not allow a third party to register a company name that is identical or similar to an existing company name. The owner of the company name may have rights in an action for passing off against a third-party user of a name that is identical or confusingly similar to his company name. The requirements for a successful claim are similar to those outlined in the answer to question 15.1 above.

#### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

IP protection for related rights may be conferred under the Copyright Act, the Designs Act and the Protection of Geographical Indications Act.

## 16 Domain Names

#### 16.1 Who can own a domain name?

Any party can own a domain name. The country code top level domain ("ccTLD") for Jamaica is ".com.jm" and is open to individuals and companies.

#### 16.2 How is a domain name registered?

Registry and operation of the ".com.jm" domain is handled by the Mona campus of the University of West Indies in Jamaica. If the domain is available, the applicant completes an online form with the applicant's details and pays a fee.

#### 16.3 What protection does a domain name afford *per se*?

A domain name registration affords limited protection in its own right, other than to reserve the particular domain for the exclusive use of the registrant. However, a domain name that has been used to the extent that it has created a reputation in the market, and certainly one that incorporates a mark to which goodwill already attaches, can be relied upon for a claim in passing off.

#### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The ccTLD available in Jamaica is ".jm".

#### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There are no dispute resolution procedures for ccTLDs in Jamaica. However, persons can access the Uniform Dispute Resolution Procedure ("UDRP") administered by the World Intellectual Property Organization ("WIPO").

## 17 Current Developments

#### 17.1 What have been the significant developments in relation to trade marks in the last year?

The initiating and continuing development of electronic filing procedures is a significant development in relation to trade marks in the past year in Jamaica.

#### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

There have been no significant judgments in the trade marks and brands sphere in the last 18 months.

#### 17.3 Are there any significant developments expected in the next year?

While acceding to the Madrid Protocol remains a live issue, there are no indications that this will occur in the coming year.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

JIPO continues to follow a policy of strictly examining the designation of goods and services for descriptions it considers to be "vague and unacceptable". With increasing awareness, applicants for registration are adapting to a practice of precisely specifying goods and services to be covered by a trade mark, which has resulted in a general levelling-off of the number of office actions.



**Joanne Wood Rattray's** practice focuses on corporate and commercial law, with a specialist practice in intellectual property, information technology, and related rights and issues.

Joanne has acted for significant interests in the hotel and tourism sector; and dealt with and advised on numerous corporate and commercial matters involving financial loan documentation, securities and related legal opinions, cross-border transactions and related tax consequences. Her specialist experience uniquely equips her to advise on matters such as: cross-border acquisitions and project financing; loan and security documentation; mergers and acquisitions; joint ventures and shareholders' agreements; public private partnerships and corporate finance; prosecution and enforcing of intellectual property interests and rights for major industrial interests and sectors. She routinely advises national and international clients with respect to large commercial transactions and everyday commercial and business issues.

Joanne is one of the Caribbean's most-respected trade mark experts and has been repeatedly selected for inclusion in the independent publication *World's Leading Trademark Professionals*, published by *World Trademark Review*. She is a member of the Intellectual Property Law Committee of the Jamaican Bar Association and is DunnCox's designee to the International Trademark Association ("INTA") where she is an active member, having served on the Internet and Geographical Indications Committees.

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Kelly obtained her Bachelor of Laws Degree from the University of the West Indies and her Legal Education Certificate from Norman Manley Law School and was called to the Jamaican Bar in January 2016. Kelly holds a Master of Laws degree in International Business Law from York University covering international commercial law issues.

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DunnCox is a full-service Jamaican law firm that offers solutions to the most challenging legal issues in virtually every area of financial and corporate law, civil litigation, intellectual property, real estate and estate planning. We act for local and international clients in all major commercial sectors, with an inter-disciplinary approach to solving clients' legal and business problems.

The IP group sits within the broader commercial practice but is by no means just a support unit; with strong standalone skills, managing and mitigating risks, prosecuting and enforcing IP rights with poise while seizing on monetisation opportunities so that clients get the best return on their investment. We aim to provide full service and support of the highest quality in all ventures involving IP including protection and enforcement, covering trade and service marks, patents, industrial designs, copyright, domain names, rights to confidential information, and all related rights, including advising on issues arising from new technologies, digital communication and social media.

*"When it comes to brands, Jamaican full-service firm DunnCox displays good business sense; this chimes with clients who want to leverage IP assets for commercial ends, rather than just accumulate IP rights. The ensemble shines when enforcing and monetising trademarks thanks to excellent negotiation skills."*  
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