

WORLD TRADE ORGANIZATION

RESTRICTED

IP/C/W/266/Add.1

9 August 2001

(01-3957)

**Council for Trade-Related Aspects
of Intellectual Property Rights**

Original: English

REVIEW OF LEGISLATION

Responses from Jamaica to the questions posed by Canada, the European Communities and their member States, Switzerland and the United States

Addendum

By means of communications from the Permanent Delegation of Jamaica dated 17 July 2001, the Secretariat has received the following responses to the questions posed by Canada, the European Communities and their member States, Switzerland and the United States as circulated in documents IP/C/W/261, IP/C/W/274, IP/C/W/263 and IP/C/W/268, respectively.

CANADA

1. *Please describe how the enforcement obligations (Articles 41-61 of the TRIPS Agreement and throughout) have been implemented.*

Copyright and Related Rights

The Jamaican government has put in place necessary legal infrastructure to secure compliance with the enforcement obligations of the TRIPS Agreement outlined in Articles 41-61. The primary statutory instruments which achieve this objective, are:

- The Copyright Act of 1993
- The Civil Procedure Code
- The Customs Act

Article 41

(1) The Copyright Act provides for expeditious remedies to prevent infringement:

- (a) Civil Remedies include:
 - Injunction (section 32)
 - Order for delivery up (section 33 and 133)
 - Order for destruction (section 137)

- Account of profits (section 32)
- Damages (section 32)

These remedies are complemented by the general provisions of the Civil Procedure Code (CPC) which provide checks and balances in the application and award process of these remedies to avoid abuse. Accordingly, injunctions will not be granted unless the applicant can show that there is a serious issue to be tried, damages alone would not suffice and that he would stand to lose more if the order was not made. Further, such an order will only be made *ex parte* if the applicant can show urgency, for example, the high risk of the goods being destroyed if immediate action is not taken; and the great difficulty in serving notice of the application on the respondent. In addition the respondent must as soon as possible thereafter be given notice and the order is never usually made for a period longer than seven working days. The Court also has a statutory discretion under the CPC to make such orders as Discovery of Documents and Payment into Court (a security sum) to ensure that the proceedings are carried out in a manner that is fair and equitable.

(b) Customs

Section 50 of the Copyright Act empowers Customs, on the authority of a Notice provided by the copyright owner to suspend the release into free circulation of pirated goods. Details of what Customs requires in order to accept the Notice are outlined in The Jamaica Gazette Supplement Proclamations Rule and Regulations, volume CXVIII Thursday, March 9, 1995, number 28c. Measures that were designed to prevent abuse include limiting the duration of the Notice and ensuring that the Notice provides adequate details in respect of evidence of ownership of copyright and a sufficient description of the protected work. The copyright owner may also be requested to give security in respect of liability incurred by the Commissioner of Customs in consequence of the Notice by reason of detention of the article(s), or anything done to the article(s) while detained.

- (2) The Copyright Act also provides for remedies, which constitute a deterrent to further infringement. These include authorising the judiciary to impose monetary fines and or terms of imprisonment, to make an order for the destruction of infringing goods or articles used primarily for the fabrication of such goods or the commission of the offence. To ensure that the Court exercise its powers in a fair and equitable manner, the Act also offers guidelines which the court must take into consideration when making such orders. The Court must have regard to all the circumstances of the case and in particular, whether other remedies available to the copyright owner would adequately protect his interests.
- (3) See the notes under Trademarks.
- (4) The Copyright Act provides that an appeal of an order made under section 135(3) should be made to the Court of Appeal. Section 137 (3) provides that appeals may be made by third parties in respect of orders made under that section, whether or not they appeared.
- (5) The general laws of Jamaica do cover a lot of the requirements stipulated by article 41 and it was not necessary to create special IP enforcement laws. The passing of a modern Copyright Act and minor amendments to pre-existing statutes (such as the Customs Act) was sufficient.

Article 42

See the notes under Trademarks.

Article 43

See the notes under Trademarks.

Article 44

The Court has a discretionary power to grant an injunction where an IP infringement is alleged to have been committed, inter alia, to prevent the entry into circulation of the infringing goods and articles after they have been cleared by customs. However, injunctions will only be granted where damages would not be an adequate remedy.

Article 45

Section 32 of the Copyright Act give the Court the authority to award damages, injunction, accounts or otherwise. Having regard to all the material circumstances and the flagrancy of the infringement committed the Court may also award such additional damages as it deems fit. However, the defendant did not know and had no reason to believe that copyright subsisted in the work to which the action for infringement relates, then, the plaintiff is not entitled to damages but without prejudice, to any other remedy. The Court may also order the infringer to pay the copyright owners expenses, which may include attorney's fees.

Article 46

Section 137 of the Copyright Act authorises the Court to grant an order for the destruction of an infringing copy, illicit recording or article. In considering what order to make (if any), the Court must have regard to all the circumstances of the case and in particular whether other remedies available in an action for copyright infringement would be adequate to compensate the copyright owner and protect his interest. Further, provision is made for the notification of third parties having an interest in the infringing copy, illicit recording or other articles as the case may be. Such persons are entitled to appear in proceedings for an order under the section, whether or not he was served with notice and to appeal against any order made, whether or not he appeared.

Article 47

See the notes under Trademarks.

Article 48

See the notes under Trademarks.

Article 49

The Copyright law as it relates to administrative procedures relied on for the award of civil remedies conforms with the regulations stipulated in Part III of the TRIPS Agreement.

Article 50

- (1) The Copyright act empowers the Court to order prompt and effective provisional measures to prevent infringement of copyright from occurring. In particular, an injunction may be granted to prevent the entry into the channels of commerce immediately after customs clearance; and the delivery up of infringing copies, articles or illicit recordings with a view to preserving evidence.

See also the note under Trademarks.

Article 51

Section 50 of the Copyright Act give the copyright holder the right to apply for a suspension of release of pirated good into free circulation. This must be done by way of a Notice to the Commissioner of Customs. Whilst there is no corresponding provision in respect of goods for export, it may be possible to seek the intervention of the police who have the power under section 140 of the Copyright Act to enter, search, seize, remove or detain any place, vessel or vehicle if he has reasonable cause to believe an offence against the Copyright act is being committed.

Article 52

The Copyright Act establishes an "application" system whereby the copyright owner is required to give notice to the Commissioner of Customs, section 140. The Notice must include a detailed description of the goods accompanied by a copy of the work to which the Notice relates and the fee specified. The Commissioner may request the copyright owner to show evidence of ownership of copyright in the work concerned, that the goods detained are infringing copies and that the person who has signed the notice is duly authorised. Further, the copyright owner shall keep the Commissioner of Customs indemnified against liability or expense which he may incur as a result of detaining any article or anything done to an article detained because of the Notice. He may also need to provide the Commissioner with security to cover this indemnity. The duration of the period of Notice may not exceed five years and shall not extend beyond the period for which copyright is to subsist. The Commissioner must be advised within fourteen days of any change in ownership of copyright or of any other change affecting the Notice, after which period the Notice will be deemed to have been withdrawn. The Notice will also be deemed to have withdrawn if the Notice fails to comply with any of the requirements of the regulations.

Article 53

See the note under Trademarks.

Article 54

See the note under Trademarks.

Article 55

See the notes under Trademarks.

Article 56

See the note under Trademarks.

Article 57

See the note under Trademarks.

Article 58

- (a) The Copyright Act authorises the police to act *ex officio* where there is reasonable cause to believe that an offence against the Act is being committed. The police are obligated to contact the copyright owner to assist in the exercise of their powers. Obstruction of the police in the exercise of these powers is an offence punishable on summary conviction before a Resident magistrate Court to a fine not exceeding \$10,000 or to a term of imprisonment not

exceeding one year. As a corollary to this, persons who give false or misleading information to the police in the exercise of these powers are also liable on summary conviction to a fine not exceeding \$5,000 or to a term of imprisonment not exceeding six months, section 142. However, the section also provides protection against self-incrimination.

(b) See the notes under Trademarks.

(c) See the notes under Trademarks.

Article 59

Section 137 of the Copyright Act give the Court authority to make an order that an infringing copy, illicit recording or article be destroyed or otherwise dealt with as the Court thinks fit.

Article 60

Section 50(5) of the Copyright Act provides that the importation of any article by a person for his private and domestic use is not prohibited.

Article 61

The Copyright Act does provide for criminal procedures and penalties including delivery up, destruction, fines and imprisonment which do provide a sufficient deterrent, sections 46, 134 and 136. Section 140 of the Act also give the police adequate powers of entry, search, seizure, removal and detention to facilitate the prosecution process.

Offences include:

- Dealings with any article, knowingly or having reason to believe, that it is an infringing copy. Penalties:
 - RM Court conviction, \$100,000/two years imprisonment
 - Supreme Court conviction, undetermined fine/five years imprisonment
- Possession of an article designed or adapted to make copies knowing that it is to be used for making infringing copies for sale or hire or for use in the course of business. Penalties:
 - RM Court conviction, \$50,000/one year imprisonment
 - Supreme Court conviction, undetermined fine/three years imprisonment

Trademarks and Designs

The enforcement obligations in Articles 41-61 of the TRIPS Agreement have been implemented in the following manner.

(1) The courts of enforcement in general, that is, the Resident Magistrates Court, the Supreme Court, the Court of Appeal and the Revenue Court, have jurisdiction over infringement cases in intellectual property rights matters.

(2) Under the Intellectual Property Law, right holders, assigns and licensees have standing to assert IPRs. These persons may be represented by an Attorney-at-Law.

(3) Judicial authorities have the authority to order, at the request of the opposing party, a party to a proceeding to produce evidence which lies within its control. This authority is conferred by the Consolidated Judicature (Civil Procedure Code) Law, Chapter 177 which governs all civil proceedings conducted before the courts.

This is supported by Section 286 which states:

"It shall be lawful for the Court or a Judge, at any time during the pendency of any cause or matter, to order the production by any party thereto, upon oath, of such of the documents in his possession or power, relating to any matter in question in such case or matter, as the Court of Judge shall think right; and the Court may deal with such documents, whether produced, in such manner as shall appears just.";

and Section 374 which states:

"The Court or a Judge may in any cause or matter, at any stage of the proceedings, or the attendance of any person for the purpose of producing any writing or other document named in the order which the Court or Judge may think fit to be produced.

Provided that no person shall be compelled to produce, under any such order, any writing or other document which he could not be compelled to produce at the hearing or trial.

(4) Procedures are put in place in the Court system to identify and protect confidential information brought forward as evidence.

Confidential information brought forward as evidence is usually labelled by the Judge and the Judge usually instructs the Registrar of the Supreme Court to have custody of such matter. In situations where proceedings relate primarily to confidential information, the proceedings can be held "in camera" which excludes public attendance.

(5) The various legislation provide for different remedies that may be ordered by the judicial authorities. These are as set out in the various legislation as follows:

Trademarks

(a) In an action for infringement of a Trademark, the Court may order remedies such as damages, injunctions, accounts or otherwise. Section 31 (2) of the Trade Marks Act, 1999" supports this:

"In an action for infringement all such relief by way of damages, injunction, accounts or otherwise is available to him as is available in respect of the infringement of any other property rights".

(b) The Court may apply other remedies such as order for erasure, order for delivery up; and order for disposal. These provisions are stipulated in the Trade Marks Act, 1999 (not yet enacted). Section 35 of the Trade Marks Act, 1999 specifies the criteria where an order for erasure can be made. It states:

"(1) The Court may make an order requiring the person who is found to have infringed a registered trademark -

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, materials or articles in his possession custody or control; or
- (b) where it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles".

Section 36 of the Trade Marks Act, 1999 specifies the criteria for issuance of an order for delivery up by the Court. It states:

"(1) The proprietor of a registered trademark may apply to the Court for an order for the delivery up to him or to such person as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business."

Section 38 of the Trade Marks Act, 1999 specifies the criteria for issuance of an order for disposal by the Court. It states:

- (1) An application may be made to the Court -
 - (a) for an order that infringing goods material or articles delivered up pursuant for an order under Section 36 be destroyed or forfeited to such person as the Court may think fit; or
 - (b) for a decision that no such order be made.
- (2) In determining what order (if any) should be made, the Court shall consider whether other remedies available in an action for infringement of registered trademark would be adequate to compensate the proprietor and any licensee and to protect their interests."

Patents

Under the Patent Act 1857, a Court can also grant remedies in respect of an infringement action, such as injunction, inspection or account, or other remedies. This is evidenced by Section 45 which states:-

"In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms, and give such directions respecting the same and the proceedings thereon. As the court or Judge may see fit".

Industrial Designs

Under the Designs Act, 1937, the court by virtue of Section 21 can grant such remedies in infringement proceedings, such as orders for an injunction, inspection, or account, or any other as the court sees fit. Section 21 states:-

"In any proceedings under this Act, the Court or a Judge, as the case may be, may at any time make such orders for an injunction, inspection, or account, impose such terms, and give such directions as to the order in which the parties shall be heard, and the procedure under this Act generally, as the Court or Judge shall see fit".

Draft Patent and Designs Act, 2001

In relation to a Patent, under this legislation, the owner of a patent who brings infringement proceedings may apply to the court for an injunction, damage, account of profits, order for the delivery up or destruction, or declaration that the patent is invalid; which in effect signifies that the court has power to grant these remedies as it sees fit. Section 80(1) states:

"(1) Subject to the following provision of this section and to Section 83, the Patentee may bring proceedings in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court,) may apply for -

- (a) an injunction restraining the defendant from any acts of infringement;
- (b) damages in respect of the infringement;
- (c) an account of profits derived from the infringement;
- (d) an order for the delivery up or destruction of any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
- (e) a declaration that the patent is valid and has been infringed by the defendant."

In respect of an industrial design, under the draft Patent and Designs Act 2001:

"the Court can grant the same remedies to the registered owner with respect to infringement as those applicable to a Patent under Section 80(1) of the said legislation".

This is evidenced by Section 72 (2) which states:

"(2) The registered owner of an industrial design may, subject to the provision of subsection (3), bring proceedings in respect of any act done without his consent which constitutes the exploitation of the design or which makes it likely that such exploitation will occur, and without affecting any other jurisdiction of the Court, may make the same claims mutatis mutandis as those applicable under Section 80 in relation to an infringement of a patent".

(6) The Laws make provision for Judicial authorities to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing, and of their channels of distributions.

This is supported by the fact that the Court has an inherent jurisdiction under "The Consolidated Judicature (Civil Procedure Code) Law Chapter 177", at the application of any party to order discovery of documents and full disclosure of information relating to any proceedings, if he deems it appropriate. The implication therefore is that the Court can also order the infringer to inform the right holder of third parties involved in any infringement act and any related documents in their possession.

This is evidenced by Section 284 of the Code which states:

"Any party may, without filing any affidavit apply to the court or a Judge for an order, directing any other party to any cause or matter to make discovery on oath of the documents which are or have been in his possession or power relating to any matter in question therein.

On the hearing of such application the court or Judge may refuse or adjourn the same, if satisfied that such discovery is not necessary, or not necessary at that stage of the cause or matter, or make such order either generally or limited to certain "classes of documents, as may, in their or his discretion, be thought fit ...

Provided that discovery shall not be ordered when and so far as the court or Judge shall be of the opinion that it is not necessary either for disposing fairly of the cause or matter or for saving costs."

(7) The Laws also make provisions relating to the indemnification of defendants wrongfully enjoined. The following supports this:

The Consolidated Judicature (Civil Procedure Code) Law, Chapter 177 makes provisions for redress of defendants who have been wrongfully enjoined in a matter. This power lies with the Court or a Judge and the type of remedial measure granted is at the discretion of the Court of Judge. The relevant provision is Section 93 which states:-

"It shall not be necessary that every defendant shall be interested as to all the relief prayed for, or as to every cause of action included in any proceeding against him; but the court or a Judge may make such order as may appear just to prevent any defendant from being embarrassed or put to expense by being required to attend any proceedings in which he may have no interest."

Further, under Section 100 of the said Code, the Court Judge may order that the name of such defendants improperly joined, be struck out upon application of such defendants.

(8) The Laws make provisions for various types of provisional measures that judicial authorities, i.e. the Court, may order. These are as follows

(i) Preservation of custody of subject matter of the contract

This measure is applicable where by any contract *prima facie* a case of liability is established. Section 459 of the Consolidated Judicature (Civil Procedure Code) Law Chapter 177, speaks to this:

"When by any contract a "prima facie" case of liability is established, and there is alleged as matter of defence a right to be relieved wholly or partially from such liability, the Court or a Judge may make an order for the preservation or interim custody of the subject matter of the litigation, or may order that amount in dispute be brought into Court or otherwise secured".

(ii) Order for sale of perishable articles

Section 460 of the Civil Procedure Code speaks to this:

"It shall be lawful for a Court or a Judge on the application by any party, to make any order for the sale, by any person or persons named in such order, and in such manner and on such terms as the Court of Judge may think desirable, of any goods, wares or merchandise, which may be of a perishable nature, or likely to injure from keeping, or which for any other just and sufficient reason it may be desirable to have sold at once".

- (iii) Order for detention, preservation, or inspection, of any property the subject of the cause.

Section 461 of the Civil Procedure Code speaks to this:

"It shall be lawful for the Court or a Judge, upon the application of any party to a cause or matter, and upon such terms as may be just, to make any order for the detention, preservation or inspection, of any property or thing, being the subject of such cause or matter, or as to which any question may arise therein, and for all or any of the purpose aforesaid, to authorise any person to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or an any of the purposes aforesaid to authorise any sample to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient to the purpose of obtaining full information or evidence ..."

- (iv) Order for recovery of property subject to claim for lien on terms

Section 466 of the Civil Procedure Code speaks to this:

"Where an action is brought to recover, or a defendant in his defence seeks by way of counter-claim to recover, specific property other than land, and the party from whom such recovery is sought does not dispute the title of the party seeking to recover the same, but claims to retain the property by virtue of a lien, or otherwise, as security for any sum of money, the Court or a Judge may, at any time after such last-mentioned claim appears from the pleading, or, if there be no pleadings, by affidavit or otherwise to the satisfaction of such Court or Judge, order that the party claiming, to recover the property be at liberty to pay into the Court, to abide the event of the action, the amount of the money in respect of which the lien or security is claimed, and such further sum (if any) for interest and costs as such Court or Judge may direct, and that upon such payment into Court being "made the property claimed to be given up to the party claiming it."

- (v) Allowance out of income of property *pendente lite*

Section 467 of the Civil Procedure Code speaks to this:

"Where any real or personal estate forms the subject to any proceedings in equity, and the Judge is satisfied that the same will be more than sufficient to answer all the claims thereon which ought to be provided for in such proceedings, the Judge may, at any time after the commencement of the proceedings, allow to the parties interested therein, or any one or more of them, the whole or part of the annual income of the real estate, or a part of the personal estate, or the whole or part of the income thereof, up to such time as the Judge shall direct".

- (vi) Conduct of sale of trust property

Section 468 of the Civil Procedure Code speaks to this:

"Whenever in an action for the administration of the estate of a deceased person, or execution of the trusts of a written instrument, a sale is ordered of any property vested in any executor, administrator or trustee, the conduct of such sale be given to such executor, administrator or trustee, unless the Court or a Judge shall otherwise direct".

(vii) Injunction (by judgement or order)

Section 469 of the Civil Procedure Code states:

"an injunction shall be by a judgement or order, and any such judgment or order shall have the effect which a writ of injunction previously had."

An injunction against a corporation may be enforced either by attachment against the directors or other officers thereof as in the case of a mandamus or by a writ of sequestration against their "property and effects to be issued in such form and tested and returnable in like manner as writs of *venditioni exponas* and to be proceeded upon and executed like manner as writs issuing out of the Supreme Court."

(viii) Injunction against continuance or repetition of wrong

Section 470 of the Civil Procedure Code speaks to this:

"In any cause or matter in which an injunction has been or right have been claimed, the plaintiff may, before or after judgment, apply for an injunction restrain the defendant or respondent from the repetition or continuance of the wrongful act or breach of contract complained of, or from the commission of an injury or breach or contract of a like kind relating to the same contract; and the Court or Judge may grant the injunction, either upon or without terms as may be just."

(9) The Laws provide for criminal procedures and penalties in respect of various types of infringements of intellectual property rights. These are as follows:

Trademarks

- Under the Trade Marks Act, 1958

(a) Falsification of entries in the Register, a misdemeanour see Section 57.

Penalties- Two years imprisonment with or without hard labour

(b) Falsely representing a trademark as registered,

Penalties- On summary conviction to a fine not exceeding ten dollars and in default of payment to imprisonment with or without hard labour for terms not exceeding two months (amended).

- Under the Trade Marks Act, 1999

Unauthorised use of a Trademark in the following circumstances as set out in Section 69 of the Act. Section 69 states as follows:

"(1) Subject to subsection (4), a person commits an offence if with intent to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor of the Trademark he -

(a) applies to goods a sign identical with or likely to be mistaken for, a registered trademark; or

- (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bears, or the packaging of which bears, such a sign; or
 - (c) has in his possession, custody or control in the course of business, any goods referred to in paragraph (b) with a view to the doing of anything, by himself or another, which would be an offence under paragraph (6).
- (2) Subject to subsection (4), a person commits an offence if, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor he -
 - (a) applies a sign identical to or likely to be mistaken for a registered trade mark to material intended to be used for labelling or packaging goods or as business paper in relation to goods or for advertising goods; or
 - (b) uses in the course of a business material bearing such a sign for labelling or packaging goods as a business paper in relation to goods, or for advertising goods; or
 - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b)
- (3) Subject to subsection (4) a person commits an offence who with a view to gain for himself or another or with intent to cause loss to another, and without the consent of the proprietor he -
 - (a) makes an article specifically designed or adapted for making copies of a sign identical to or likely to be mistaken for a registered trade mark; or
 - (b) has such an article in his possession, custody or control in the course of a business, knowing or having reason to believe that it has been or is to be, used to reproduce goods or material for labelling or packaging goods, as a business paper in relation to goods or for advertising goods."

- Penalties

Section 69(6) states:

"A person who commits an offence under this Section is liable -

- (a) on summary conviction before a Resident Magistrate to a fine not exceeding one million dollars or to a term of imprisonment not exceeding twelve months or to both such fine and imprisonment;
- (b) on conviction before the Circuit Court to fine or to imprisonment not exceeding five years or to both such fine and imprisonment."

Patents and Industrial Designs

- Under the Draft Patent and Design Act, 2001:
 - (a) Falsification of the Register see Section 110 Penalty liable on conviction before a Resident Magistrate to a fine (dollars) or to imprisonment, or on conviction on indictment to imprisonment for a term not exceeding (years).
 - (b) False claim as to patent rights and/or Industrial designs rights, see Section 111.
- Penalties

See Section 111:

- (a) Where a person falsely represents that he or another is the patentee of an invention or has applied for such or is the owner of a registered industrial design or has applied for such commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars).
- (b) where a person falsely represents that an article sold by him is patented or incorporates an industrial designs registered in Jamaica, or is the subject of an application for a patent or the registration of an industrial design commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars).

2. *What protection does your Copyright legislation afford to "foreign works"?*

Section 144 of the Copyright Act makes for provision for the reciprocity of national treatment to be given to foreigners who are citizens of countries listed in the schedule of "specified countries", that is, a convention country or a country in respect of which the Minister (of Industry Commerce and technology) is satisfied, has or will be making provisions under its law giving adequate protection to the owners of copyright, or as the case may be to Jamaican copyright owners.

EUROPEAN COMMUNITIES AND THEIR MEMBER STATES

A. GENERAL PROVISIONS

1. *Please describe if your legislation includes measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to your socio-economic and technological development as mentioned under Article 8 of the TRIPS Agreement. If yes, please explain how such measures are consistent with the provisions of the TRIPS Agreement.*

Our legislation includes measures necessary to protect public health and nutrition, and to promote the public interest and our legislation promotes the public interest in socio-economic and technological development as mentioned under Article 8 of the TRIPS Agreement. This legislation is consistent with the TRIPS Agreement in numerous ways in that it contributes to the promotion of technical innovation in the fields of medicine, pharmacology, nutrition, and related fields and is conducive to social and economic welfare.

B. COPYRIGHT AND RELATED RIGHTS

2. *Please state how your legislation provides for the protection of the exclusive rights of authors in relation to their literary and artistic works, as specified in Article 9 of the TRIPS Agreement which requires Members to comply with Articles 1-21 of the Berne Convention and the Appendix to the Berne Convention (1971)).*

The Copyright Amendment Act of 1999 expands the definition of "literary work" provided for in the principal Act of 1993 to mean: "...any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes: (a) a written table or compilation; (b) a computer programme, and for the purpose of paragraph (a) of this definition, "compilation" means "a collection of works, data or other material, whether in machine-readable form or any other form, which constitutes an intellectual creation by reason of the selection or arrangement of the works, data or other material comprised in it".

3. *Please describe the protection accorded to authors of computer programs, databases or compilations of data.*

Section 9 of the Copyright Act states that by virtue of and subject to the provisions of the Act, the owner of the copyright in a work (which includes computer programs, databases or compilations of data) has the exclusive right to do or authorize other persons to do any of the following acts in Jamaica:

- (a) to copy the work;
- (b) to issue copies of the work to the public;
- (c) to perform the work in public or, in the case of a sound recording, film, broadcast or cable programme, to play or show the work in public;
- (d) to broadcast the work or include it in a cable programme service; or
- (e) to make an adaptation of the work and, in relation to such adaptation, to do any or all of the foregoing acts.

4. *Please state whether your legislation provides for a rental right and, if so, the works to which it applies.*

Pursuant to section 78 of the Copyright Act the Minister may order, subject to negative resolution, provide that in such case as may be satisfied in the order, the rental to the public of copies of sound recordings, films or computer programmes shall be treated as licensed by the copyright owner subject only to the payment of such reasonable royalty or other payment as may be agreed or determined in default of agreement by the Copyright Tribunal. Further, copyright in a computer programme is not infringed by the rental of copies to the public after the end of the period of fifty years from the end of the calendar year in which copies of it were first issued to the public in electronic form.

5. *Please describe the rights granted to performers, producers of phonograms (sound recordings) and broadcasting organisations under your legislation.*

Section 107 of the Act confers rights on performers, namely:

- his consent is required to exploit his performance. Any person who makes, otherwise than for his private and domestic use, a recording of the whole or any substantial part of a qualifying performance infringes the performers rights.

Section 108

- a person having recording rights in relation to a performance, must get the performer's consent to make the recording of that performance. Any person who shows or plays in public, broadcasts live, or includes live in a cable programme service, the whole or any substantial part of a qualifying performance by means of a recording which was made without the performer's consent, knowingly or having reason to believe that it was so made, infringes the rights of the performer.

Section 110

- A performer's rights are infringed by a person who, without his consent and payment of royalty at the prescribed rate, uses an original recording of a qualified performance (whether authorised or not) for the purpose of making an adaptation of the recording.

Section 111

- A performer's rights are infringed by a person who, without his consent imports into Jamaica otherwise than for his private and domestic use or, in the course of a business possesses, sells or lets for hire or distributes, a recording of a qualifying performance which is, and which that person knows or has reason to believe, is an illicit recording.

These rights are conferred independently of any copyright in or moral rights relating to any work used or performed in that performance, and any other right or obligation otherwise arising.

6. *Please state whether your legislation provides for any limitation or exception in relation to each of the rights described above in accordance with the relevant provisions of the Berne and Rome Conventions and in light of Articles 13 and 14.6 of the TRIPS Agreement.*

Sections 115-128 of the Copyright Act provide for limitations or exceptions to infringement.

7. *Please state the terms of protection of each right described above and the work or subject matter to which it applies.*

The rights in relation to a performance and in relation to phonograms subsist until the end of the period of 50 years from the end of the calendar year in which the performance takes place.

8. *Please state how your legislation grants the retroactive protection provided pursuant to Article 18 of the Berne Convention (the obligation of which derives from Article 9 of the TRIPS Agreement) and Article 14.6 of the TRIPS Agreement.*

We will revert to you on this issue.

C. TRADEMARKS

9. *Please give the definition of a sign under your national legislation and explain under what conditions it is protectable.*

Under the Trade Marks Act, 1999, the subject matter that can comprise a trademark under the trademark law, is set out in section 2 (1) in the interpretation of the word "sign".

A "sign" includes "a word (including a personal name), design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging;"

A Trademark under this Act, is defined in Section 2(1) as "any sign that is capable of distinguishing the goods or services of one undertaking from those of another undertaking".

Under the Trade Marks Act, 1999, the owner of a registered trademark has property right in the mark and is entitled to the rights and remedies under the Act. See section 4(1)

- (i) the owner of a registered trademark has property in the mark and is entitled to the rights and remedies under the Act. See section 4(1)
- (ii) The proprietor also has exclusive rights in the registered trademark, and any use of the mark in Jamaica, without the proprietor consent constitutes an infringement of such rights (specified in Section 9). See section 5(1)
- (iii) The proprietor has a right to either civil remedies for infringement under sections 31(2), 35, 36, 38 of the Act.

10. *Please confirm whether or not services are a protectable subject matter in your trademark law. Please confirm if signs, such as trade names, are protectable. Please describe if elements such as sound, perfumes and containers are protectable.*

Under the Trade Marks Act, 1999 well known service marks are given the same protection as well known trademarks.

This is evidenced by the following:

- (i) The definition of a trademark under Section 2(1) of the Act includes services. "Trade mark" means "any sign that is capable of being graphically represented and capable of distinguishing the goods or service of one undertaking from those of another undertaking."
- (ii) Section 49 of the Act provides for protection of well known marks under the Paris Convention, which in essence extends to well known service marks.

Section 49 states:

"(1) The proprietor of a well-known mark which is entitled to protection under the Paris Convention, as mentioned in subsection (2), is entitled to restrain by injunction the use in Jamaica of a trademark which, or the essential part of which, is identical with or similar to his mark in relation to identical or similar goods or services where the mark is likely to cause confusion."

We shall revert to you on the question of whether sound, perfumes and containers are protectable.

11. *Please explain what the requirements of use are, if any, as a condition for a trademark registration. Please explain the definition of use and the conditions of maintenance of a registration in that respect.*

An application for registration of a trademark is required under Section 16 of the Act to state that the trademark is being used by the applicant or with his consent in relation to the goods or services or that he has a bona fide intention that it should be so used.

Section 43 of the Act deals with the conditions of maintenance of registration as they relate to use and bona fide use of the trademark. See also Section 14 which deals with the time of bona fide use of a mark in relation to the registrability of a later mark.

12. *Please confirm whether or not your legislation permits that the registration of trademarks be indefinitely renewable.*

Under Section 8 of the Act, the initial period of registration of a trademark is for 10 years, and under section 40, the registration may be renewed for periods of 10 years. There are no limitations on the number of renewals and therefore the registration is indefinitely renewable.

13. *Please describe the special requirements, if any, prescribed by your legislation concerning the use of a trademark.*

[No reply received.]

D. GEOGRAPHICAL INDICATIONS

14. *Please explain whether or not your trademark registration authority refuses a trademark application if it contains a geographical indication.*

Our trademark registration authority (the Registrar of Companies) may refuse a trademark application if it contains a geographical indication.

Under Clause 11(4)(b) a trademark is not registrable if it is of such as to deceive the public as to the nature, quality or geographical origin of the goods or services or otherwise.

15. *Please give the definition of a geographical indication in your legislation.*

"Geographical indication" means an indication which identifies a product 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 product is essentially attributable to its geographical origin.

See the proposed Protection of Geographical Locations Act - Definition Clause 2.

16. *Please describe and explain the provisions of your legislation establishing a link, if any, between the characteristics of an indication and its geographical origin.*

See Clause 3(1) (a) of the proposed Act.

17. *Please describe how additional protection is granted by your legislation to wines and spirits. Please mention other types of products, if any, covered by this additional protection.*

See Clauses 3(1) (c), 18 and 19(1) of the proposed Act.

18. *Please explain how exceptions under Article 24 of the TRIPS Agreement are used in your jurisdiction. Please provide examples of the use of the exceptions by courts or lists of names considered as generic in your jurisdiction.*

See Clause 19 of the proposed Act. As the Bill has not yet become law we are unable at this time to provide examples of the use of the exceptions by courts or lists of names considered as generic in our jurisdiction.

E. INDUSTRIAL DESIGNS

19. Please explain whether or not your legislation extends to the protection of designs dictated essentially by technical or functional considerations. Please explain how textile designs are protected.

Under the Draft Patents and Designs Act, 2001, provision is made for the protection of textile designs in the definition of an "industrial design".

Clause 60 of the Act states:

"For the purposes of this Act, an industrial design is any composition of lines and colours or any three dimensional form, whether or not associated with lines or colours, which -

- (a) give a special appearance to a product of industry or handicraft and can serve as a pattern for a product;
- (b) does not serve solely to obtain a technical or functional result and leaves no freedom as regards arbitrary features of appearance."

Thus, based on the definition, everything which gives rise in the appearance of a product, to an aesthetic impression (i.e. an impression received by the sense of sight) can be an industrial design.

This definition would also apply to so-called "textile designs".

The proposed procedure to register or to obtain protection of textile designs is also set out in the draft legislation. It states:

- (1) An industrial design is registrable if it is original and not contrary to public order or morality; and originality in this context means that it should not be commonplace in the design filed in question at the [time of its creation] - [filing date] -[where applicable] or the priority date of application for registration] see Clause 61.
- (2) An application for the registration of an industrial design may be made by any person claiming to be the creator of it, or any person who is an assignee of the creator of the design who also has the option to apply alone or jointly with any other person; or by the personal representative or the assignee of the personal representative of any deceased person who, immediately before his death, was entitled to make an application. - See Clause 62.
- (3) The application for registration of an industrial design shall be filed with the Registrar and every application shall contain:-
 - (a) a request for the registration of the design;
 - (b) drawings, photographs or other adequate graphic representation of the article or articles embodying the design;
 - (c) an indication of the kind of products for which the industrial design is to be used;

- (d) where the design is two (2) dimensional or three (3) -dimensional, the application may be accompanied by a specimen of the article embodying the industrial design;
 - (e) an application may also contain a request that upon registration, the publication of the industrial design be deferred for a period not exceeding twelve (12) months from the date of filing, or, where priority is claimed, from the date of priority;
 - (f) Two or more industrial designs which relate to the same class of the international classification, or to the same set or composition of articles may be the subject of the same application - see Clause 63.
- (4) The filing date of an application for the registration of an industrial design shall be the [earliest] date on which an application is submitted to the Registrar containing the requirements set out in Section 63; with the relevant filing fee - see Clause 66.
 - (5) The Registrar shall then assign a filing date and examine whether the application satisfies the requirements of Clauses 60, 67 and 63 and any related regulations.
 - (6) If the Registrar is satisfied that the necessary requirements have been met then he shall publish the application in the prescribed manner - see Clause 67.
 - (7) Upon this publication, any party may oppose the registration within the prescribed period and prescribed manner - see Clause 68.
 - (8) If the registration is not opposed then the Registrar shall register the industrial design and publish a reference to the registration and issue to the applicant a Certificate of Registration of the industrial design - see Clause 68(5).
 - (9) An industrial design shall be valid for a period of five (5) years upon initial registration (i.e. from the filing date); and may be renewed upon payment of the prescribed fee and within the prescribed time, for two (2) consecutive occasions. See Clause 69.

20. *Please explain how your legislation protects right holders of a design against importing of articles bearing embodied or copied design.*

Clause 72 may be relevant in that regard.

21. *Please state whether or not your legislation provides for the right to issue a compulsory licence for industrial designs.*

It does not appear that the proposed legislation in its existing form provides for the right to issue a compulsory licence for industrial designs.

22. *Please indicate for what period of time your legislation grants protection for industrial designs.*

Protection is proposed for industrial designs for an initial period of 5 years, renewable up to 15 years - Section 69.

F. PATENTS

23. *Please describe how your legislation defines the notions of: novelty, inventiveness and industrial application.*

Novelty, invention and industrial application are defined in clauses 5, 6 and 7 of the proposed Act.

24. *Please explain whether or not in your legislation, patent or otherwise, patent rights are enjoyed without any exclusions. If exclusions are provided for, please describe in detail how these exclusions are applied in legal as well as practical terms.*

Clause 4 of the proposed Act provides for exclusions. We would not be able to describe in legal or practical terms how these exclusions are applied until the Bill becomes Law.

25. *Please explain whether your legislation provides for the exclusion of inventions from patentability based on ordre public or morality. If so, please explain the relevant section of your legislation and explain its formulation. Please also explain if it has been applied in practice.*

Clause 4(2) (a) provides for the exclusion of inventions from patentability based on public order or morality or where the invention would cause serious prejudice to the environment.

26. *Please explain whether or not diagnostic, therapeutic and surgical methods are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.*

Clause 4(2)(b) excludes diagnostic, therapeutical and surgical methods from patentability.

27. *Please explain whether or not plants, animals and essentially biological processes are excluded from patentability in your legislation. If so, please explain the relevant section of your legislation and explain its formulation.*

Clause 4(1)(b) excludes plants, animals and essentially biological processes from patentability.

28. *Please describe how micro-organisms, non-essentially biological processes, microbiological processes and plant varieties are protected in your legislation. Please explain, in this respect, the relevant sections of your legislation.*

Clause 4(1)(b) saves non-biological and micro-biological processes from exclusion from patentability.

29. *Please explain how your legislation protects patent right holders against the importing and against the offering for sale of a patented invention.*

Clause 30 gives the patentee the exclusive rights to exploit the Invention. Clause 2 defines "to exploit" as including offering for sale and importation. Clause 78(1)(a) constitutes the unauthorized importation or disposal of a patented product as an infringing act against the patent.

30. *Please state if your legislation provides for patent product protection of pharmaceutical and agricultural chemical products. In the affirmative, please indicate the legal reference.*

In so far as pharmaceutical and agricultural chemical products are not excluded from patentability under clause 4, then they can be protected.

31. *Please clarify if the patent protection of a process, as provided for in your legislation, covers the product obtained directly by that process.*

Yes. See clause 2 and paragraph (b) of the definition of the right of the patentee "to exploit". Also clause 78 (1) (c) (ii).

32. *Please explain the additional conditions, if any, in your legislation other than the sufficient disclosure of the invention in Article 29 of the TRIPS Agreement (e.g. submission of justification for access to genetic material or prior informed consent to its use). If such additional conditions exist, please point out the relevant legislations and describe the additional conditions in detail.*

We are not able to respond fully. See clauses 9 to 11. It is also the case that rules are to be developed.

33. *Please describe if your legislation provides for limited exceptions to the exclusive rights conferred by a patent. If affirmative, please make a reference to relevant legislation.*

Clause 30, which grants exclusive patent rights, provides that the grant is subject to the provisions of the Act. Accordingly, see clauses 52 and following, relating to use of a patented invention in the service of the Crown.

34. *Please explain whether or not your legislation provides for compulsory licensing. If so, please explain in detail the conditions under which a compulsory licence may be granted. In particular, please explain how your national legislation considers individual merits in the authorization of such use.*

Yes. See in particular clauses 44 to 47.

35. *Please explain how your legislation explicitly ensures that a proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. In this context, how do you define "reasonable period of time". Please also explain how your legislation ensures that the use of a compulsory licence shall be authorised predominantly for the supply to the domestic market of the Member authorizing such use.*

See clause 44(d) and clause 45(1).

36. *Please state if your legislation grants additional protection for innovations after the 20 years of patent protection has lapsed.*

No. See clause 26.

37. *Please explain how your legislation provides for the enhanced patent protection of patents or patent applications pending on 1st January 1995.*

This is not clear and we will revert to you on this point if necessary.

38. *Please explain how your legislation provides for the reversal of the burden of proof in relation to process patents.*

No such provisions appear to be made. Article 34 of the TRIPS Agreement refers. However, clause 81 may be of some relevance to that issue.

39. *Please describe how your legislation protects Topographies.*

The relevant statute is the Layout-Designs (Topographies) Act of 1999. Original layout-design embodied in the integrated circuits are eligible for protection under this Act. Section 4 provides that a layout-design shall be regarded as original only if it is the result of the intellectual efforts of its creator: and is not at the time of its creation, commonplace among creators or layout-designs or manufacturers of integrated circuits. Where a layout-design consists of a combination of elements and interconnections that are commonplace, it shall be eligible for protection only if the combination taken, as a whole is original as already described. It must be noted that protection under the Act does not extend to an idea, concept, process, principle, system or discovery.

40. *Please explain what protection your national legislation grants to right holders against the unlawful importation, sale or distribution for commercial purposes of topographies including integrated circuits or other articles in which a topography is incorporated in accordance with Article 36 of the TRIPS Agreement.*

The owner of the right in the layout-design by virtue of Section 6 of the Act has the exclusive right to do or authorise another person to do any or all of the following:

- to reproduce the whole or part of the layout-design by any means, whether by its embodiment in an integrated circuit or otherwise, except to the extent that the layout design is not regarded as original
- to import, distribute or otherwise commercially exploit the layout-design or the integrated circuit in which it is embodied

It must be noted that the permitted acts established by the Copyright Act are mirrored in this Act, that is, reproduction solely for private purpose, research teaching, analysing or evaluating concepts, Section 12. Likewise, the remedies provided for are similar, that is, damage, injunction, profits, royalties, delivery up, disposal or otherwise as the Court shall see fit, Sections 14, 15 and 16.

41. *Please explain how your legislation provides for the derogation from Article 36 as specified in Article 37 of the TRIPS Agreement where a person has no knowledge or reasonable grounds to know when acquiring an integrated circuit or an article incorporating such an integrated circuit that it contains an unlawful topography.*

In an action brought under this section, a person who shows that he was an innocent-

- (a) shall incur no liability under this Act with respect to the acquisition, importation, distribution or other commercial exploitation of units of the infringing integrated circuit that occurred before the time when he knew or ought reasonably to have known of the rights with respect to the layout-design embodied in the integrated circuit; and
- (b) shall-
 - (i) have the right to dispose of any inventory of the items of which the layout-design forms a part, that was acquired or imported by him before he had that knowledge;
 - (ii) pay a reasonable royalty in respect of that inventory in such amount and at such time as the court may determine

42. *Please state the term of protection granted by your legislation to topographies.*

Section 7 of the Act limits the enjoyment of the layout-design right to ten years commencing on the date on which the layout-design is first commercially exploited and runs to the end of the calendar year in which the right expires.

H. PROTECTION OF UNDISCLOSED INFORMATION

43. *Please explain whether or not your legislation grants a defined period of time for the protection of undisclosed information. If so, please give the time span.*

It does not appear that our legislation deals with this question. However, see Clause 102(3) proposed Patents and Designs Act and the 18 month confidentiality period there mentioned.

44. *Please explain how your legislation defines undisclosed information.*

It is not clear that our legislation defines undisclosed information.

45. *Please explain how your legislation defines data submitted to governments or governmental agencies.*

We are not in a position to answer this question at this time.

I. ENFORCEMENT

46. *Please describe how your legislation provides for effective action against infringement of intellectual property rights.*

See answers to questions 49, 50, 51, 52, 54, 55, 57, 59.

47. *Please explain whether or not your legislation provides for a mechanism to appeal to judicial bodies of final administrative decisions.*

Our legislation provides mechanisms to appeal to judicial bodies in respect of final administrative decisions in the area of intellectual property.

48. *Please describe how your legislation authorizes judges to order production of evidence by the opposing party. Please give precise information on what measures are taken to ensure the protection of confidential information.*

Judicial authorities are empowered to order at the request of the opposing party, a party to a proceeding to produce evidence which lies within its control.

"The Consolidated Judicature (Civil Procedure Code) Law, Chapter 177 which governs all civil proceedings to be conducted before the Courts of Jamaica, confers this authority.

This is supported by Section 286 which states:

"It shall be lawful for the Court or a Judge, at any time during the pendency of any cause or matter, to order the production by any party thereto, upon oath, of such of the documents in his possession or power, relating to any matter in question in such case or matter, as the Court or Judge shall think right; and the Court may deal with such documents, whether produced, in such manner as shall appear just";

and Section 374 which states:

"The court or a Judge may in any cause or matter, at any stage of the proceedings, order the attendance of any person for the purpose of producing any writing or other documents named in the order which the court or Judge may think fit to be produced.

Provided that no person shall be compelled to produce, under any such order, any writing or other document which he could not be compelled to produce at the hearing or trial."

Our Courts possess wide powers for ordering discovery and inspection. In addition, there are new rules being proposed which provide for the exchange of witness statements.

As regards confidential information, such information can be labelled and kept by the Court in a secured area or vault. See also section 55 of the Trade Marks Act where some measure of control over publication of information relating to an application for registration of a trademark before the publication of the application is exerted.

49. *Please quote provisions of your legislation that authorize judges to order a defendant to desist from an infringement*

[No reply received].

50. *Please quote what provisions of your legislation authorize judges to order the payment to the right holder of adequate damages to compensate the injury he suffered.*

The Jamaican government has put in place necessary legal infrastructure to secure compliance of the enforcement obligations of the TRIPS Agreement outlined in Articles 41-61. The primary statutory instruments which achieve this objective, are:

- the Civil Procedure Code
- the Copyright Act of 1993
- the Customs Act
- the Trade Marks Act 1999

See also clause 80 of the proposed Patents and Designs Act.

Copyright

The Copyright Act provides for expeditious remedies to prevent infringement. Civil remedies include:

- Injunction (section 32)
- Order for delivery up (section 33 and 133)
- Order for destruction (section 137)
- Account of profits (section 32)
- Damages (section 32)

Trademarks

- (a) In an action for infringement of a Trademark, the Court may order remedies such as damages, injunctions, accounts or otherwise.

Section 31(2) of the Trade Marks Act, 1999 supports this:

"In an action for infringement all such relief by way of damages injunction, accounts or otherwise is available to him as is available in respect of the infringement of any other property rights".

- (b) The Court may apply other remedies such as order for erasure, order for delivery up and order for disposal, Trade Marks Act, 1999.

Section 35 of the Trade Marks Act, 1999 specifies the criteria where an order for erasure can be made. It states:

"(1) The Court may make an order requiring the person who is found to have infringed a registered trademark -

- (a) to cause the offending sign to be erased, removed or obliterated from any Infringing goods, materials or articles in his possession custody or control; or
- (b) where it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles".

Section 36 of the Trade Marks Act, 1999, specifies the criteria for issuance of an order for delivery up by the Court. It states:-

"(1) The proprietor of a registered trademark may apply to the Court for an order for the delivery up to him or to such persons as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business."

Section 38 of the Trade Marks Act 1999 specifies the criteria for issuance of an order for disposal by the Court. It states:

"(1) An application may be made to the Court -

- (a) for an order that infringing good material or articles be delivered up pursuant for an order under Section 36 be destroyed or forfeited to such person as the Court think fit; or
- (b) for a decision that no such order be made.

"(2) In determining what order (if any) should be made the Court shall consider whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the proprietor and any licensee and to protect their interest."

Patents

Under the Patent Act 1857, a Court can also grant remedies in respect of an infringement action, such as injunction, inspection or account, or other remedies.

This is evidenced by Section 45 which states:-

"In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms, and give such directions respecting the same and the proceedings thereon. As the court or Judge may see fit."

Industrial Designs

Under the Designs Act, 1937, the court by virtue of Section 21 can grant such remedies in infringement proceedings, such as orders for an injunction, inspection, or account, or any other as the court sees fit.

Section 21 states:-

"In any proceedings under this Act. the Court or a Judge, as the case may be, may at any time make such orders for an injunction, inspection, or account, impose such terms, and give such directions as to the order in which the parties shall be heard, and the procedure under this Act generally, as the Court or Judge shall see fit".

Draft Patent and Designs Act, 2001

In relation to a Patent, under this legislation, the owner of a patent who brings infringement proceedings may apply to the court for an injunction, damage, account of profits, order for the delivery up or destruction, or declaration that the patent is invalid; which in effect signifies that the court has power to grant these remedies as it sees fit.

Section 80(1) states:

- "(1) Subject to the following provision of this section and to Section 83, the Patentee may bring proceedings in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court,) may apply for -
- (a) an injunction restraining the defendant from any acts of infringement;
 - (b) damages in respect of the infringement;
 - (c) an account of profits derived from the infringement;
 - (d) an order for the delivery up or destruction of any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
 - (e) a declaration that the patent is valid and has been infringed by the defendant."

In respect of an Industrial Design, under the Draft Patent and Designs Act 2001, the Court can grant the same remedies to the registered owner with respect to infringement as those applicable to a Patent under Section 80(1) of the said legislation.

These remedies are complimented by the general provisions of the Civil Procedure Code (CPC) which provide checks and balances in the application and award process of these remedies to avoid abuse. Accordingly, injunctions will not be granted unless the applicant can show that there is a serious issue to be tried, damages alone would not suffice and that he would stand to lose more if the order was not made.

51. *Please quote what provisions of your legislation authorize judges to order the payment of the right holder's expenses by the infringer.*

There are general provisions and Rules of Court which allow for orders for costs to be made. See also clause 88 of the proposed Patents and Designs Act which provides for an award of costs on an attorney-and-client basis (as opposed to party-and-party basis).

52. *Please explain if and how judges have the authority to order that infringing goods are placed outside channels of commerce or destroyed.*

See Trade Marks Act - Sections 35, 38.

Copyright Act - Sections 33 and 133.

Proposed Patents and Designs Act - Clause 80.

53. *Please quote what provisions of your legislation authorize judges to indemnify a defendant in the event of abuse by the plaintiff.*

Under the Court's inherent jurisdiction, there is power to indemnify the Defendant in the event of abuse by the Plaintiff and to award damages to the Defendant in the event that it proves at trial that an interlocutory injunction was wrongly granted against him and he establishes his losses arising therefrom.

54. *Please explain how your legislation implements Article 50 of the TRIPS Agreement.*

Provisional Measures.

See the sections of the above Acts referred to above. The Court has power in cases of emergency to grant interim orders and to make orders *ex parte* in cases of emergency. In the case of *ex parte* orders, these are usually granted for short periods 7 - 10 days, and interlocutory orders are made up until trial of the substantive issues.

55. *Please identify the competent authorities in your jurisdiction who receive requests from right holders for an application to suspend the release of counterfeit goods by the customs authorities.*

Customs

Section 50 of the Copyright Act empowers the Commissioner of Customs, on the authority of a Notice provided by the copyright owner, to suspend the release into free circulation of pirated goods. Details of what Customs requires in order to accept the Notice are outlined in the Jamaica Gazette Supplement, Proclamations Rule and Regulations, Volume CXVIII Thursday, 9 March, 1995, number 28c. Measures that were designed to prevent abuse include limiting the duration of the Notice and ensuring that the Notice provides adequate details in respect of evidence of ownership of copyright and a sufficient description of the protected work. The copyright owner may also be requested to give security in respect of liability incurred by the Commissioner of Customs in consequence of the Notice by reason of detention of the article(s) or anything done in the article(s) while detained.

Similar powers are set out in Sections 66 - 68 in the Trade Marks Act in relation to trademarks.

56. *Please indicate whether or not procedures are available to suspend the exporting of counterfeit goods.*

It is not clear whether the procedures apply to exportation.

57. *Please quote what provisions of your legislation authorize the competent authorities to order the destruction or disposal of infringing goods.*

Answer at 52 above.

58. *Please indicate whether or not your legislation provides for a de minimis imports exception.*

Our legislation does not provide for a de minimis imports exception.

59. *Please explain how your legislation implements Article 61 of the TRIPS Agreement.*

The Laws provide for criminal procedures and penalties in respect of various types of infringements of intellectual property rights. These are as follows:

Trademarks

- Under the Trade Marks Act, 1999

Unauthorised use of a Trademark in the following circumstances as set out in Section 69 of the Act.

Section 69 states as follows:-

- "(1) Subject to subsection (4), a person commits an offence if with intent to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor of the Trademark he -
- (a) applies to goods a sign identical with or likely to be mistaken for a registered trademark; or
 - (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bears, or the packaging or which bears, such a sign; or
 - (c) has in his possession, custody or control in the course of business, any goods referred to in paragraph (b) with a view to the doing of anything, by himself or another, which would be an offence under paragraph (6).
- (2) Subject to subsection (4), a person commits an offence if, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor he-
- (a) applies a sign identical to or likely to be mistaken for a registered trade mark to material intended to be used for labelling or packaging goods or as business paper in relation to goods or for advertising goods; or

- (b) uses in the course of a business material bearing such a sign for labelling or packaging goods as a business paper in relation to goods, or for advertising goods; or
 - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- "(3) Subject to subsection (4) a person commits an offence who with a view to gain for himself or another or with intent to cause loss to another and without the consent of the proprietor he -
- (c) makes an article specifically designed or adapted for making copies of a sign identical to or likely to be mistaken for a registered trademark; or
 - (d) has such an article in his possession, custody or control in the course of a business, knowing or having reason to believe that it has been or is to be, used to reproduce goods or material for labelling or packaging goods, as a business paper in relation to goods or for advertising goods."
- Penalties
- Section 69(6) states:
- "A person who commits an offence under this Section is liable-
- (c) on summary conviction before a Resident Magistrate to a fine not exceeding one million dollars or to a term of imprisonment not exceeding twelve months or to both such fine and imprisonment;
 - (d) on conviction before the Circuit Court to fine or to imprisonment not exceeding five years or to both such fine and imprisonment."

Copyright

The Copyright Act provides for criminal procedures and penalties including sections 46, 134 and 136. Section 140 of the Act also give the Police adequate powers of entry, search, seizure, removal and detention to facilitate the prosecution process. Offences include:

- Dealings with any article, knowingly or having reason to believe, that it is an infringing copy. Penalties:
 - RM Court conviction, \$100,000/two years imprisonment
 - Supreme Court conviction, undetermined fine/five years imprisonment
- Possession of an article designed or adapted to make copies knowing that it is to be used for making infringing copies for sale or hire or for use in the course of business. Penalties:
 - RM Court conviction, \$50,000/one year imprisonment
 - Supreme Court conviction, undetermined fine/three years imprisonment.

Draft Patents and Designs Act 2001

Under the proposed Patent and Designs Act, 2001, falsification of the Register and falsely representing oneself to be a patentee of an invention are also to be made criminal offences with sanctions of fine and imprisonment.

SWITZERLAND

A. GEOGRAPHICAL INDICATIONS

1. *Please explain in detail how your legislation provides protection for geographical indications.*

At present no legislation exists but a bill has been prepared along the guidelines and main provision of the draft prepared by the World Intellectual Property Organization (WIPO) for Jamaica.

B. PATENTS

2. *Does your legislation grant patent protection to all categories of products or are there any exceptions? If so, please explain in detail what kind of exceptions exist and how they comply with Article 27 of the TRIPS Agreement.*

No. See clauses 4 (1) (a) and (2)(a) which relate to Article 27.2 and 27.3(b) of the TRIPS Agreement.

3. *Does your legislation, in accordance with Article 27.1 in combination with Article 31 of the TRIPS Agreement, consider importation as "working" a patent (and therefore preclude compulsory licensing, if a product is being imported)?*

Yes. Clause 2 defines "to work" a patent as including, its importation. Clauses 44 and 51 provide for non-voluntary (compulsory) licensing. However the latter clause excepts from non-voluntary licensing the importation of the patented product from specified countries (described as relevant countries).

4. *Does your legislation make the granting of a compulsory license subject to all the conditions enumerated in Article 31 of the TRIPS Agreement? Please cite the relevant provisions of law.*

No, but provision is made in relation to the following sub-paragraphs of Article 31:

- (b) Clause 45 (1) (b)
- (d) Clause 52 (5) (a)
- (e) Clause 52 (5) (b)
- (f) Clause 52 (5) (c)
- (g) Clause 46
- (h) Clause 45 (1) (b)
- (l) Clauses 49 and 112

(k) Clause 48

(1) Clause 44 (d) (ii)

5. *Does your legislation provide for the principle of the reversal of burden of proof in a process patent litigation? Please cite the relevant provisions of law.*

It does not appear so, but see Clause 81.

C. PROTECTION OF UNDISCLOSED INFORMATION

6. *Please explain in detail if your legislation ensures that undisclosed test or other data submitted by an applicant to the responsible State agency in the procedure for market authorisation of a pharmaceutical or of an agricultural chemical product is protected against disclosure and against unfair commercial use by a competitor, for example by prohibiting a second applicant from relying on, or from referring to the original data of the first applicant, when applying subsequently for market authorisation for his own product. Does your legislation provide for exceptions to this? If yes, under what conditions would such exceptions apply? Does your legislation set a specific term of protection for undisclosed test or other data of the first applicant?*

There is no legislation governing undisclosed information.

D. ENFORCEMENT

7. *Please indicate remedies provided by your legislation, which constitute effective deterrents to infringements of intellectual property rights.*

Copyright and Related Rights

The Copyright Act of 1993 provides for a suit of offences punishable by fines and or imprisonment which pose an effective deterrent to the infringement of IPRs. The Resident Magistrates Court (lower court) may impose a maximum fine of \$100,000 and or a maximum term of imprisonment of five years. Note that although the Act puts a ceiling on the fine that may be imposed by the Resident Magistrate Court, the Court has discretion to augment the amount payable by a defendant by making an award of damages. However, the total amount awarded must not exceed \$250,000. The Act gives the Supreme Court / Circuit Court discretion to determine the quantum of damages that would adequately compensate the defendant. However the Court's power to impose imprisonment is limited to a term not exceeding five years. In all the circumstances, fines and terms of imprisonment may be awarded separately or in conjunction.

Industrial Property – Civil remedies

In respect of civil remedies the following are provided in relation to the different IPR rights:

Trademarks

(a) In an action for infringement of a Trademark, the court may order remedies such as damages, injunctions, accounts or otherwise.

Section 31(2) of the Trade Marks Act, 1999 supports this:

"In an action for infringement all such relief by way of damages, injunction, accounts or otherwise is available to him as is available in respect of the infringement of any other property rights".

- (b) The Court may apply other remedies such as order for erasure, order for delivery up; and order for disposal. These provisions are stipulated in the Trade Marks Act, 1999 (not yet enacted)

Section 35 of the Trade Marks Act, 1999 specifies the criteria where an order for erasure can be made. It states:

- "(1) The Court may make an order requiring the person who is found to have infringed a registered trademark -
 - (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, materials or articles in his possession custody or control; or
 - (b) where it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles.

Section 36 of the Trade Marks Act, 1999 specifies the criteria for issuance of an order for delivery up by the Court. It states:-

"The proprietor of a registered trademark may apply to the Court for an order for the delivery up to him or to such person as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business."

Section 38 of the Trade Marks Act 1999 specifies the criteria for issuance of an order for disposal by the Court. It states:

An application may be made to the Court -

- "(1) (a) for an order that infringing goods material or articles delivered up pursuant for an order under Section 36 be destroyed or forfeited to such person as the Court may think fit; or
- (b) for a decision that no such order be made.

In determining what order (if any) should be made, the Court shall consider whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the proprietor and any licensee and to protect their interests."

Patents

Under the Patent Act 1857, a Court can also grant remedies in respect of an infringement action, such as injunction, inspection or account, or other remedies. This is evidenced by Section 45 which states:

"In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms, and give such directions respecting the same and the proceedings thereon. As the court or Judge may see fit".

Industrial Designs

Under the Designs Act, 1937, the court by virtue of Section 21 can grant such remedies in infringement proceedings, such as orders for an injunction, inspection, or account or any other as the court sees fit.

Section 21 states:

"In any proceedings under this Act, the Court or a Judge, as the case may be, may at any time make such orders for an injunction, inspection, or account, impose such terms, and give such directions as to the order in which the parties shall be heard, and the procedure under this Act generally, as the Court or Judge shall see fit".

Draft Patent and Designs Act, 2001

In relation to a Patent, under this legislation, the owner of a patent who brings infringement proceedings may apply to the court for an injunction, damage, account of profits, order for the delivery up or destruction, or declaration that the patent is invalid; which in effect signifies that the court has power to grant these remedies as it sees fit.

Section 80(1) states:

- "(1) Subject to the following provision of this section and to Section 83, the Patentee may bring proceedings in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court,) may apply for -
- (a) an injunction restraining the defendant from any acts of infringement;
 - (b) damages in respect of the infringement;
 - (c) an account of profits derived from the infringement;
 - (d) an order for the delivery up or destruction of any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
 - (e) a declaration that the patent is valid and has been infringed by the defendant."

In respect of an Industrial Design, under the Draft Patent and Designs Act 2001, the Court can grant the same remedies to the registered owner with respect to infringement as those applicable to a Patent under Section 80(1) of the said legislation. This is evidence by section 72 (2) which states:

- "(2) The registered owner of an industrial design may, subject to the provision of subsection (3), bring proceedings in respect of any act done without his consent which constitutes the exploitation of the design or which makes it likely that such exploitation will occur, and without affecting any other jurisdiction of the Court, may make the same claims mutatis mutandis as those applicable under Section 80 in relation to an infringement of a patent".

Industrial property – criminal sanctions and penalties

In respect of criminal sanctions and penalties, the following are provided in relation to the different IPR rights:

The Trade Marks Act, 1958

Under the Trade Marks Act, 1958 the following acts of infringements of trademarks attracts criminal procedures and penalties:

- (a) Falsification of entries in the Trademarks Register is a misdemeanor. This is set out in Section 57 which states:

"If any person makes or cause to be made a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor, and on conviction shall be liable to be imprisoned for a term not exceeding two years with or without hard labour."

- (b) Falsely representing a trademark as registered, attracts a fine. This is set out in section 55 (1) which states:

"(1) any person who makes a representation-

- (a) with respect to a mark not being a registered trademark, to the effect it is a registered trademark, or
- (b) with respect to a part of a registered trademark not being a part separately registered as a trademark, to the effect that it is so registered, or
- (c) to the effect that the registration of a trademark gives an exclusive right to the use thereof in any circumstances in which, having regards to limitations entered on the Register, the registration does not give that right,

shall be liable on summary conviction to a fine not exceeding ten dollars and in default of payment to imprisonment with or without hard labour for a term not exceeding two months."

NB (Fine and length of imprisonment have been amended to longer term.)

The Trade Marks Act, 1999

Under the Trade Marks Act, 1999, the following acts of infringement of a Trademark which attracts criminal penalties are as follows:

Unauthorised use of a Trademark under different circumstances as stipulated in Section 69. Section 69 states as follows:

- "(1) Subject to subsection (4), a person commits an offence if with intent to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor of the Trademark he -

- "(a) applies to goods a sign identical with or likely to be mistaken for, a registered trademark; or

- (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bears, or the packaging of which bears, such a sign; or
 - (c) has in his possession, custody or control in the course of business, any goods referred to in paragraph (b) with a view to the doing of anything, by himself or another, which would be an offence under paragraph (6).
- (2) Subject to subsection (4), a person commits an offence if, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor he -
- (a) applies a sign identical to or likely to be mistaken for a registered trade mark to material intended to be used for labelling or packaging goods or as business paper in relation to goods or for advertising goods; or
 - (b) uses in the course of a business material bearing such a sign for labelling or packaging goods as a business paper in relation to goods, or for advertising goods; or
 - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b)
- (3) Subject to subsection (4) a person commits an offence who with a view to gain for himself or another or with intent to cause loss to another, and without the consent of the proprietor he -
- "(a) makes an article specifically designed or adapted for making copies of a sign identical to or likely to be mistaken for a registered trade mark; or
 - (b) has such an article in his possession, custody or control in the course of a business,
- knowing or having reason to believe that it has been or is to be, used to reproduce goods or material for labelling or packaging goods, as a business paper in relation to goods or for advertising goods."

- Penalties

Section 69 (6) states:

"A person who commits an offence under this Section is liable-

- (a) on summary conviction before a Resident Magistrate to a fine not exceeding one million dollars or to a term of imprisonment not exceeding twelve months or to both such fine and imprisonment.
- (b) on conviction before the Circuit Court to fine or to imprisonment not exceeding five years or too both such fine imprisonment."

Falsification of Entry in the Register, which is stipulated in Section 70. Section 70 states:

- "(1) A person commits an offence if he makes or cause to be made a false entry in the Register or makes or cause any writing or document purporting to be a copy of an

entry in the register, or produce d or tendered in evidence any such writing knowing or having reason to believe that the entry or writing to be false.

- (2) A person guilty of an offence under section (1) is liable-
 - (a) on summary conviction before a Resident Magistrate to a fine not exceeding two hundred and fifty thousand dollars, or imprisonment for a term not exceeding six months;
 - (b) on conviction before a Circuit Court to a fine or to imprisonment not six years or to both such fine and imprisonment

Falsely representing a trademark as a registered mark which is stipulated in section 77. Section 77 states:

- "(1) A person commits an offence if he -
 - (a) represents that a mark is registered trademark; or
 - (b) makes a representation as to the good or service for which a trademark is registered, knowing or having reason to believe that the representation is false.
- (2) The use in Jamaica in relation to a trademarks of the word "registered" or of any other word or symbol importing a reference (expressed or implied) to registration, shall be deemed to be a representation as to registration under this Act, unless it is shown that the reference is to registration in another country and that the trademark is intact, so registered for the goods or service in question
- (3) A person guilty of an offence under this section is liable on summary conviction before a Resident Magistrate to a fine not exceeding two hundred and fifty thousand dollars or to imprisonment for a term not exceeding six months."

8. *Please describe any new initiatives that are planned to improve enforcement of intellectual property rights in your country, particularly initiatives related to criminal enforcement.*

The Jamaican Government is presently receiving assistance from the World Intellectual Property Organisation in its efforts to put in place an anti-piracy system. Jamaica is considering implementing the banderole system, possibly in conjunction with a hologram. the banderole would be made a mandatory attachments to all sound recordings being sold in the country. WIPO consultant, Mrs. Funkazi Koroye-Crooks, has greatly contributed to this process by way of several successful missions to Jamaica to meet with the stakeholders of the music industry and top government officials. A national working group was founded to garner the feedback of the stakeholders, to invite dialogue and to explore the feasibility of the proposal. It is expected that Jamaica will forge ahead with preparatory steps for the implementation of the programme in the shortest possible delay.

Trademarks and designs

The impending automation of the Jamaica Intellectual Property Office (JIPO) with the assistance of the World Intellectual Property Organisation (WIPO) and the proposed database link with the Customs department will facilitate the search procedure and thus expedite the enforcement process.

UNITED STATES

A. GENERAL

1. *Please describe, in relation to each form of intellectual property covered by the TRIPS Agreement, including plant variety protection, the manner in which nation treatment and most favoured nation treatment are provided to nationals of other WTO Members.*

Copyright - Section 144 of the Copyright Act makes provision for the reciprocity of national treatment to be given to foreigners who are citizens of countries listed in the schedule of "specified countries", that is, a convention country or a country in respect of which the Minister (of Industry Commerce and Technology) is satisfied, has or will be making provisions under its law giving adequate protection to the owners of copyright, or as the case may be to Jamaican copyright owners.

B. COPYRIGHT AND RELATED RIGHTS

2. *Please explain how the copyright law of Jamaica protects computer programs as literary works and complications of data as required by Article 10 of the TRIPS Agreement.*

Copyright and Related Rights

The Copyright Amendment Act of 1999 expands the definition of "literary work" provided for in the principal Act of 1993 to mean:

"... any work, other than a dramatic or musical work, which is written, spoken or sung, and accordingly includes -

- (a) a written table or compilation;
- (b) a computer programme,

and for the purpose of paragraph (a) of this definition, 'compilation' means a collection of works, data or other material, whether in machine-readable form or any other form, which constitutes an intellectual creation by reason of the selection or arrangement of the works, data or other material comprised in it"

3. *Article 11 of the TRIPS Agreement requires that rental rights for computer programs and cinematographic works be available. Please cite to the corresponding provision of the copyright law of Jamaica.*

Copyright and Related Rights

Pursuant to section 78 of the Copyright Act the Minister may order, subject to negative resolution, provide that in such case as may be satisfied in the order, the rental to the public of copies of sound recordings, films or computer programmes shall be treated as licensed by the copyright owner subject only to the payment of such reasonable royalty or other payment as may be agreed or determined in default of agreement by the Copyright Tribunal. Further, copyright in a computer programme is not infringed by the rental of copies to the public after the end of the period of fifty years from the end of the calendar year in which copies of it were first issued to the public in electronic form.

4. *Please describe the protection the copyright law of Jamaica provides for performers, and the term of the protection*

.

Copyright and Related Rights

Section 107 of the Act confers rights on performers, namely:

- his consent is required to exploit his performance. Any person who makes, otherwise than for his private and domestic use, a recording of the whole or any substantial part of a qualifying performance infringes the performers rights. Section 108;
- a person having recording rights in relation to a performance, must get the performers consent to make the recording of that performance. Any person who shows or plays in public, broadcasts live, or includes live in a cable programme service, the whole or any substantial part of a qualifying performance by means of a recording which was made without the performers consent, knowingly or having reason to believe that it was so made, infringes the rights of the performer. Section 108;
- A performer's rights are infringed by a person who, without his consent and payment of royalty at the prescribed rate, uses an original recording of a qualified performance (whether authorised or not) for the purpose of making an adaptation of the recording. Section 110;
- A performer's rights are infringed by a person who, without his consent imports into Jamaica otherwise than for his private and domestic use; or in the course of a business possess, sells or lets for hire or distributes, a recording of a qualifying performance which is, and which that person knows or has reason to believe, is an illicit recording. Section 111.

These rights are conferred independently of any copyright in or moral rights relating to any work used or performed in that performance; and any other right or obligation otherwise arising.

The aforesaid rights continue to subsist in relation to a performance until the end of the period of fifty years from the end of the calendar year in which the performance takes place. Section 129.

5. *Article 14.2 of the TRIPS Agreement provides that producers of phonograms are to enjoy the right to authorize or prohibit the direct or indirect reproduction of their phonograms. Article 14.2 requires that producers of phonograms are to have the right to authorize or prohibit the commercial rental to the public of originals or copies of their phonograms. Please describe how the copyright law of Jamaica implements these obligations and indicate the term of protection.*

Copyright and Related Rights

Section 112 of the Copyright Act stipulates that the rights of a person having recording rights in relation to a performance are infringed where a recording of the whole or substantial part of the performance is made without his consent for a non-private and domestic use. Section 114 also provides that the said rights are infringed where a person imports into Jamaica otherwise than for his private use; or in the course of business, possess, sells or lets for hire, offers or exposes for sale or hire, or distributes, a recording of the performance which is, and which that person knows or has reason to believe is, an illicit recording. The duration stipulated in section above likewise applies.

C. TRADEMARKS

6. *Please describe the subject matter that can comprise a trademark under the trademark law of Jamaica.*

Trademarks and Designs

- (a) Under the Trade Marks Act, 1958 the subject matter that can comprise a trademark, is set out in section 21 (1) in the interpretation of the word "mark".

A "Mark" includes a devices brand, heading, label, ticket, name, signature, word, letter, numerical or any combination thereof;

A Trademark as under this Act is defined in Section 2 (1) as "a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods, and some person having the right either as proprietor or as registered user to use the mark ... "

- (b) Under the Trade Marks Act, 1999, the subject matter that can comprise a trademark under the trademark law, is set out in section 2(1) in the interpretation of the word "sign".

A "sign" includes a word (including a personal name), design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging;"

A Trademark under this Act, is defined in Section 2(1) as "any sign that is capable of distinguishing the goods or services of one undertaking from those of another undertaking."

7. *Please describe the procedure that must be followed to register a trademark in Jamaica, citing the relevant provisions of the law, and describe the rights that the owner of a registered mark can exercise.*

Procedure to Register a Trademark under the Trade Marks Act, 1958 and Trade Marks Rules, 1958

- (i) An application may be made to register a mark in Part A or Part B of the Register. See Section 3(2).

A mark is registrable in part A, if it distinguishes the goods of the trader from goods of another trader (i.e. the mark is strongly distinctive of the goods). A mark is registrable in Part B if it is capable of distinguishing the goods in the course of trade (The remedies for infringement of a mark vary according to whether the mark is registered in Part A or B of the Register. See sections 6 and 7.

- (ii) Applications are made in duplicate on a standard form (Form No. 2). The specification of goods must be stated on the form. See section 21 (1).

- (iii) An application to register the mark may be made by:

- (a) the proprietor of the mark
- (b) his duly authorised agent. See Rule 21(1).

- (iv) An application form must be completed for each class of goods for which the mark will be registered. There are 34 classes of goods and 8 classes for service. (Only trademarks or marks for goods are registrable under the Trade Marks Act, 1958).

- (v) Six copies of representation of the mark should accompany each application form. See Rule 24.
- (vi) The total fee to register a trademark is payable over different stages of the registration process. Fees are charged for each class in which the mark is to be registered.

Jamaican dollars

Application	\$3,500
Advertisement	\$1,320
Registration	\$2,500
Amendments	\$1,250 (for each amendment, if any)

The fees are due and payable at the different stages in the process. See 1999 Amended Schedule 1 of the Trade Marks Rules, 1958.

- (vii) On receipt of an application, a letter of acknowledgement is sent to the applicant.
- (vi) The applicant will be advised in writing of the acceptance or now acceptance of the mark for registration. See Rules 32-34.
- (vii) If the mark is accepted, the registration fees and fee for advertisement become payable.
- (viii) The mark is then advertised in the Jamaican Gazette. See Rule 42(1).
- (ix) If no objection is taken within one month of the advertisement, the mark is registered. See Rule 42 (1).
- (x) A Certificate of registration of the mark is then issued. The mark is then protected in the class and in relation to the goods for which the application was made with effect from the date of application. See Rule 63.

Procedure Under the Trade Marks Act, 1999 and Trade Marks Rules, 2000

Under this new legislation the following changes will take place in the procedure to register a trademark.

- (i) An application to register a trademark may only be made in one Part of the Register i.e. Part A. See Section 2 (1) of the Third Schedule to the Act.
- (ii) Applications are to be made in duplicate on a standard form TM 1 (which will make provision for such features as rights of priority, and address for service etc.
- (iii) An application may be made for registration of a mark in more than one class of goods at one instances on form TM 1. This is the provision called multi-class application. See Rule 8(1).
- (iv) The fee payment will be collected in two parts as existing, but the fee structure will differ see First Schedule (Regulation 3) of Trade Marks Rules, 2000.

The structure will be as follows:

Application for registration of a Trademark or a service of mark in one class:

Jamaican Dollars

Upon application	\$3,500
Upon acceptance of registration	\$3,500
Class fee for each class over one	\$1,000
Certificate re Claim to priority	\$1,000
Address for service	\$1,000

- (v) The period of opposition applicable for the registration of a trademark has been extended to two months. See Rule 12(1).

Rights that can be exercised under the Trade Marks Act, 1958

The owner of a registered trademark can under the 1958 Act exercise the following rights:

- (i) It gives him exclusive right to the use of the nominated good(s) subject to the Act and any conditions imposed by the office.
- (ii) The proprietor is able to sue in the Courts or bring other civil action for infringement of his mark if some other trader uses a substantially or deceptively similar mark. See sections 6 and 7.

Rights that can be exercised under the Trade Marks Act, 1999

Under the Trade Marks Act, 1999, the owner of a registered trademark has property right in the mark and is entitled to the rights and remedies under the Act. See section 4(1).

- (i) the owner of a registered trademark has property in the mark and is entitled to the rights and remedies under the Act. See section 4(1).
- (ii) The proprietor also has exclusive rights in the registered trademark, and any use of the mark in Jamaica, without the proprietor consent constitutes an infringement of such rights (specified in Section 9) . See section 5(1).
- (iii) The proprietor has a right to either civil remedies for infringement under section 31 (2), 35, 36, 38 of the Act.

Infringement of the proprietor's right can also attract criminal sanctions and penalties by virtue of section 69 of the Act, in respect to unauthorised use of the Trademark.

8. *Please provide the length and terms of protection the trademark law of Jamaica provides for a trademark.*

- (i) Under the 1958 Act, a Trademark is protected for a period of 7 years upon registration in the first instance, and thereafter subject to renewal every 14 years after the expiration of the previous registration. See Section 22.
- (ii) Under the 1999 Act, a trademark is protected for a period of 10 years upon registration, and thereafter subject to renewal, every 10 years after the expiration of the previous registration. See Sections 8 and 40.

9. *Please explain whether well-known service marks are given the same protection as well-known trademarks under Article 6bis of the Paris Convention, as required by Article 16.2 of the*

TRIPS Agreement.

Under the Trade Marks Act, 1999 well known service marks are given the same protection as well known trademarks.

This is evidenced by the following:

- (i) The definition of a trademark under Section 2(1) of the Act includes services:

"trademark means any sign that is capable of being graphically represented and capable of distinguishing the goods or service of one undertaking from those of another undertaking."
- (ii) Section 49 of the Act provides for protection of well-known marks under the Paris Convention, which in essence extends to well-known service marks. Section 49 states:

"(1) The proprietor of a well-known mark which is entitled to protection under the Paris Convention, as mentioned in subsection (2), is entitled to restrain by injunction the use in Jamaica of a trademark which, or the essential part of which, is identical with or similar to his mark in relation to identical or similar goods or services, where the mark is likely to cause confusion."

D. GEOGRAPHICAL INDICATIONS

10. *Please describe in detail how the laws of Jamaica provide for the recognition and protection of geographical indications required by Article 22.2 of the TRIPS Agreement, citing to the relevant provisions of law or regulation, and provide examples of geographical indications so protected.*

[No reply received]

11. *Please describe in detail the manner in which the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement is implemented, citing to the relevant provisions of law or regulation, and provide examples of geographical indications for such products.*

[No reply received]

12. *Are preexisting trademarks protected, under Jamaican law, against usurpation by geographical indications?*

[No reply received]

E. INDUSTRIAL DESIGNS

13. *Please describe the procedure that must be followed to obtain protection for textile designs and cite to the relevant provisions of law or regulation.*

The Draft Patents and Designs Act, 2001, provision is made for the protection of textile designs in the definition of an "industrial design". Section 60 of the Act states:

"For the purposes of this Act, an industrial design is any composition of lines and colours or any three - dimensional form, whether or not associated with lines or colours, which -

- (a) give a special appearance to a product of industry or handicraft and can serve as a pattern for a product;
- (b) does not serve solely to obtain a technical or functional result and leaves no freedom as regards arbitrary features of appearance."

Thus, based on the definition, everything which gives rise in the appearance of a product, to an aesthetic impression (i.e. an impression received by the sense of sight) can be an industrial design. This definition would also apply to a so-called "textile design".

The proposed procedure to register or to obtain protection of textile designs is also set out in the draft legislation. It states:

- (1) An industrial design is registrable if it is original and not contrary to public order or morality; and originality in this context means that it should not be commonplace in the design filed in question at the [time of its creation] - [filing date] - [where applicable] or the priority date of application for registration] see Section 61
- (2) An application for the registration of an industrial design may be made by any person claiming to be the creator of it, or any person who is an assignee of the creator of the design who also has the option to apply alone or jointly with any other person; or by the personal representative or the assignee of the personal representative of any deceased person who, immediately before his death, was entitled to make an application. See Section 62.
- (3) The application for registration of an industrial design shall be filed with the Registrar and every application shall contain:
 - (a) a request for the registration of the design;
 - (b) drawings, photographs or other adequate graphic representation of the article or articles embodying the design;
 - (c) an indication of the kind of products for which the industrial design is to be used;
 - (d) where the design is two (2) dimensional or three (3) - dimensional, the application may be accompanied by a specimen of the article embodying the industrial design
 - (e) an application may also contain a request that upon registration, the publication of the industrial design be ' deferred for a period not exceeding twelve (12) months form the date of filing, or, where priority is claimed, form the date of priority.
 - (f) Two or more industrial designs which relate to the same class of the international classification, or to the same set or composition or articles may be the subject of the same application - see Section 63
- (4) The filing date of an application for the registration of an industrial design shall be the [earliest] date on which an application is submitted to the Registrar containing the requirements set out in Section 63; with the relevant filing fee - see Section 66.

- (5) The Registrar shall then assign a filing date and examine whether the application satisfies the requirements of Section 60,67 and 63 and any related regulations.
- (6) If the Registrar is satisfied that the necessary requirements have been met then he shall publish the application in the prescribed manner - see Section 67.
- (7) Upon this publication, any party may oppose the registration within the prescribed period and prescribe manner - see Section 68.
- (8) If the registration is not opposed then the Registrar shall register the industrial design and publish a reference to the registration and issue to the applicant a Certificate of Registration of the industrial design. - see Section 68(5).
- (9) An industrial design shall be valid for a period of five (5) years upon initial registration (i.e. from the filing date); and may be renewed upon payment of the prescribed fee and within the prescribed time, for two (2) consecutive occasions. See Section 69.

14. *Please describe in detail the way in which the patent law of Jamaica implements Article 27 of the TRIPS Agreement, indicating any exceptions provided for, and including details regarding the protection for micro-organisms and non-biological and microbiological processes and plant varieties. Please cite to the relevant provisions of the law.*

See clause 4 of the draft Patents and Designs Act 2001.

15. *Please describe in detail the rights provided patent holders under the patent law of Jamaica and cite to the relevant provisions of law.*

See clause 29 and 30.

16. *Please describe in detail any provisions in the laws of Jamaica permitting unauthorized use of a patent, citing to the relevant provisions of law, and describe in detail the conditions under which such use can occur.*

Provision is made for non-voluntary licences and for Crown (Government) use. See clause 44 and following and clause 52 and following.

17. *What term of protection does the patent law of Jamaica provide for patents? Please describe any provisions for extension of the term of protection and cite to the relevant provisions of the law.*

The term is 20 years. See clause 26. No provision appears relating to extension of term of protection.

G. LAYOUT-DESIGNS (TOPOGRAPHIES) OF INTEGRATED CIRCUITS

18. *Please describe in detail the protection for layout-designs of integrated circuits provided under the laws of Jamaica, including the term of protection, and cite to the relevant provisions of law.*

The relevant statute is the Layout-Designs (Topographies) Act of 1999. Original layout-designs embodied in integrated circuits are eligible for protection under this Act. Section 4 provides that a layout-design shall be regarded as original only if it is the result of the intellectual efforts of its creator; and is not at the time of its creation, commonplace among creators or layout-designs or manufacturers of integrated circuits. Where a layout-design consists of a combination of elements and interconnections that are commonplace, it shall be eligible for protection only if the combination

taken, as a whole is original as already described. It must be noted that protection under the Act does not extend to an idea, concept, process, principle, procedure, system or discovery.

The owner of the right in the layout-design by virtue of section 6 of the Act has the exclusive right to do or authorise another person to do any or all of the following -

- to reproduce the whole or part of the layout-design by any means, whether by its embodiment in an integrated circuit or otherwise, except to the extent that the layout design is not regarded as original;
- to import , distribute or otherwise commercially exploit the layout-design or the integrated circuit in which it is embodied.

Section seven of the Act limits the enjoyment of the layout-design right to ten years commencing on the date on which the layout-design is first commercially exploited and runs to the end of the calendar year in which the right expires.

It must be noted that the permitted acts established by the Copyright Act are mirrored in this Act, that is, reproduction solely for private purposes, research teaching, analysing or evaluating concepts, section 12. Likewise, the remedies provided for are similar, that is, damages, injunction, profits, royalties, delivery up, disposal or otherwise as the Court shall see fit. Sections 14, 15 and 16.

H. PROTECTION OF UNDISCLOSED INFORMATION

19. *Please describe in detail how the laws of Jamaica provide for the protection of undisclosed information as required by Article 39.2 of the TRIPS Agreement and provide citations to the relevant provisions of law.*

There is no legislation governing undisclosed information at this time. However, see clause 102(3) in the draft Patents and Designs Act 2001 which provides for an 18 month confidentiality period.

20. *Please describe in detail the manner in which protection is provided test data regarding pharmaceutical and agricultural chemical products submitted to the government in order to obtain marketing approval in Jamaica and cite to the relevant provisions of law.*

There is no legislation governing undisclosed information at this time. However, see clause 102(3) in the draft Patents and Designs Act 2001 which provides for an 18 month confidentiality period.

21. *Are other applicants for marketing approval for their own versions of a previously approved pharmaceutical or agricultural chemical products permitted to rely on data submitted by the earlier applicant? If so, how long a period of exclusivity is given the earlier applicant before such reliance becomes possible.*

There is no legislation governing undisclosed information at this time. However, see clause 102(3) in the draft Patents and Designs Act 2001 which provides for an 18 month confidentiality period.

I. ENFORCEMENT

22. *Please describe in detail the manner in which the laws of Jamaica provide for effective action against infringement of intellectual property rights as required by Article 41.1 of the TRIPS Agreement.*

Article 41

(1) The Copyright Act provides for expeditious remedies to prevent infringement:

(a) Civil Remedies include:

- Injunction (section 32)
- Order for delivery up (sections 33 and 133)
- Order for destruction (section 137)
- Account of profits (section 32)
- Damages (section 32)

These remedies are complemented by the general provisions of the Civil Procedure Code (CPC) which provide checks and balances in the application and award process of these remedies to avoid abuse. Accordingly, injunctions will not be granted unless the applicant can show that there is a serious issue to be tried, damages alone would not suffice and that he would stand to lose more if the order was not made. Further, such an order will only be made ex parte if the applicant can show urgency, for example, the high risk of the goods being destroyed if immediate action is not taken; and the great difficulty in serving notice of the application on the respondent. In addition the respondent must as soon as possible thereafter be given notice and the order is never usually made for a period longer than seven working days. The Court also has a statutory discretion under the CPC to make such orders as Discovery of Documents and Payment into Court (a security sum) to ensure that the proceedings are carried out in a manner that is fair and equitable.

(b) Customs

Section 50 of the Copyright Act empowers Customs, on the authority of a Notice provided by the copyright owner to suspend the release into free circulation of pirated goods. Details of what Customs requires in order to accept the Notice are outlined in The Jamaica Gazette Supplement Proclamations Rule and Regulations, volume CXVIII Thursday, March 9, 1995, number 28c. Measures that were designed to prevent abuse include limiting the duration of the Notice and ensuring that the Notice provides adequate details in respect of evidence of ownership of copyright and a sufficient description of the protected work. The copyright owner may also be requested to give security in respect of liability incurred by the Commissioner of Customs in consequence of the Notice by reason of detention of the article(s), or anything done to the article(s) while detained.

(2) The Copyright Act also provides for remedies, which constitute a deterrent to further infringement. These include authorising the judiciary to impose monetary fines and or terms of imprisonment, to make an order for the destruction of infringing goods or articles used primarily for the fabrication of such goods or the commission of the offence. To ensure that the Court exercise its powers in a fair and equitable manner, the Act also offers guidelines which the court must take into consideration when making such orders. The Court must have regard to all the circumstances of the case and in particular, whether other remedies available to the copyright owner would adequately protect his interests.

The Court has a discretionary power to grant an injunction where an IP infringement is alleged to have been committed, inter alia, to prevent the entry into circulation of the infringing goods

and articles after they have been cleared by customs. However, injunctions will only be granted where damages would not be an adequate remedy.

Section 32 of the Copyright Act give the Court the authority to award damages, injunction, accounts or otherwise. Having regard to all the material circumstances and the flagrancy of the infringement committed the Court may also award such additional damages as it deems fit. However, the defendant did not know and had no reason to believe that copyright subsisted in the work to which the action for infringement relates, then, the plaintiff is not entitled to damages but without prejudice, to any other remedy. The Court may also order the infringer to pay the copyright owners expenses, which may include attorney's fees.

Section 137 of the Copyright Act authorises the Court to grant an order for the destruction of an infringing copy, illicit recording or article. In considering what order to make to make (if any), the Court must have regard to all the circumstances of the case and in particular whether other remedies available in an action for copyright infringement would be adequate to compensate the copyright owner and protect his interest. Further, provision is made for the notification of third parties having an interest in the infringing copy, illicit recording or other articles as the case may be. Such persons are entitled to appear in proceedings for an order under the section, whether or not he was served with notice and to appeal against any order made, whether or not he appeared.

23. *Article 43.1 of the TRIPS Agreement requires that judges be authorized to order production of evidence necessary to substantiate a party's claims where that party has been unable to obtain such evidence from the opposing party. Please describe how the laws or regulations of Jamaica provide this authorization, citing to the relevant provisions of law or regulation.*

See responses to Canada.

24. *Please describe in detail all of the civil remedies that are available to right holders under the laws of Jamaica, citing to the relevant provisions of law or regulation.*

Section 32 of the Copyright Act provides that a Court may award damages, injunction, and accounts or otherwise to a copyright owner whose rights have been infringed. He can also get delivery up under section 33 and disposal of an infringing copy, article or illicit recording under section 137. A performer can also get delivery up of an illicit recording under section 133 and destruction under section 137.

25. *Please describe in detail the provisional procedures and remedies available to right holders under the laws of Jamaica, citing to the relevant provisions of law and regulation, and indicate any condition under which a right holder may avail itself of those procedures and remedies.*

[No reply received].

J. SPECIAL REQUIREMENTS RELATED TO BORDER MEASURES

26. *Please describe in detail the procedures under the laws of Jamaica that provide for border enforcement at least for trademark counterfeiting and copyright piracy, identifying the competent authority and citing to the relevant provisions of law or regulation.*

[No reply received].

27. *Please indicate if border enforcement is available to owners of other forms of intellectual property and, if so, please describe the procedures and remedies available in relation to each form of intellectual property, citing the relevant provisions of law.*

[No reply received].

28. *Article 58 of the TRIPS Agreement specifies procedures to be followed where the competent authorities can act ex officio. Please explain whether the competent authorities in Jamaica are empowered to act ex officio and, if so, please identify the intellectual property areas subject to ex officio action.*

[No reply received].

K. CRIMINAL PROCEDURES

29. *Please describe in detail how the laws of Jamaica implement Article 61 of the TRIPS Agreement that requires Members to have criminal procedures and penalties, including imprisonment and/or monetary fines sufficient to act as a deterrent, at least for cases of wilful trademark counterfeiting and copyright infringement on a commercial scale. Please cite to the relevant provisions of law and regulation.*

[No reply received].

30. *Article 61 also requires that remedies in appropriate cases include the seizure, forfeiture and destruction of infringing goods and any materials and implements the predominant use of which has been the commission of the offence. Please describe the provisions in the laws of Jamaica that provide for such remedies, and describe the circumstances in which those remedies would be imposed, citing to the relevant provisions of law or regulation.*

See responses to Canada.

31. *Article 61 also indicates that Members may provide for criminal procedures and penalties in cases of wilful infringement of other forms of intellectual property. Please describe any provisions of the laws of Jamaica that provide for such procedures and remedies, citing to the relevant provisions of law or regulation.*

See responses to Canada.

L. STATISTICAL QUESTIONS

32. *Please provide statistical information related to civil copyright, trademark, geographical indication, industrial design, patent, integrated circuit layout-design, and trade secret enforcement for 2000, including the number of cases filed; injunctions issued; infringing products seized; infringing equipment seized; cases resolved (including settlement); and the amount of damages awarded.*

[No reply received].

33. *Please provide statistical information related to criminal enforcement in the area of copyright piracy and trademark infringement for 2000, including the number of raids, prosecutions, convictions, and the amount of fines and/or jail terms (including whether the fines were paid and whether the jail term was actually served or was suspended) and any other information establishing that the criminal system operates effectively to deter copyright piracy and trademark counterfeiting.*

[No reply received].
