

WORLD TRADE ORGANIZATION

RESTRICTED

IP/C/W/266/Add.3

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Council for Trade-Related Aspects
of Intellectual Property Rights

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REVIEW OF LEGISLATION

Responses from Jamaica to follow-up questions posed by
the European Communities and their member States and Switzerland

Addendum

By means of communications from the Permanent Delegation of Jamaica dated 1 and 5 October 2001, the Secretariat has received the following responses to follow-up questions posed by the European Communities and their member States and Switzerland, as circulated in documents IP/C/W/274/Add.1 and 263/Add.1, respectively.

EUROPEAN COMMUNITIES AND THEIR MEMBER STATES¹

C. TRADEMARKS

Follow-up to response to question 11:

Please confirm that there is no legal definition of use for the purposes of trademark registration. Please provide such definition if existing via case-law.

Section 16(2) provides that an application for registration of a trademark shall 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.

See also section 11(2) which states that evidence of use must relate to use before the date of filing. In practice continuous use over a period of at least three years within Jamaica together with turnover and nature of advertising is usually requested.

See section 2(2) of the Trade Marks Act which also states that references in this Act to use (or any particular description of use) of a trademark or of a sign identical with or similar to or likely to be mistaken for a trademark, include use of that description of use, otherwise than by means of a graphic representation.

¹ Jamaica's responses to initial questions posed by the European Communities and their member States were circulated in documents IP/C/W/266/Add.1 and Add.2.

D. INDUSTRIAL DESIGNS

Follow-up to response to question 19:

Please explain whether the requirement of "commonplace" is determined in relation to the world or simply to the territory of Jamaica.

"Commonplace" will be determined in relation to the world and not simply to the territory of Jamaica.

Follow-up to response to question 20:

Please clarify how your legislation protects right holders of a design against importing or articles bearing embodied or special design.

Section 72 of the Patents and Designs Act confers on a registered owner of an industrial design the same rights as a patentee to bring proceedings in respect of an act which constitutes the exploitation of a design. Exploitation includes importation of articles incorporating the design.

Section 80 contains the power to institute infringement proceedings. The owner of a design may apply for:

- (a) an injunction;
- (b) damages;
- (c) an account of profits;
- (d) an order for delivery up or destruction of the article the subject of infringement; and
- (e) a declaration that the design has been infringed.

In addition to civil remedies, provision is also made for criminal offences in section 111.

H. PROTECTION OF UNDISCLOSED INFORMATION

Follow-up to questions 43, 44 and 45:

Please explain whether Jamaican authorities have any specific legislative project/draft aimed to implement those provisions of the TRIPS Agreement and, if so, in what manner.

There is no specific legislation governing undisclosed information. Reliance is placed on common law principles and contractual arrangements.

SWITZERLAND²

A. PATENTS

Follow-up to response to question 3:

You mention that Article 51 excepts from non-voluntary licensing the importation of the patented product from specified countries. Please specify these countries and explain how such regulation complies with Article 4 of the TRIPS Agreement.

The specified countries have not yet been named. These will appear in the Regulations under the Act. In keeping with Article 4 of the TRIPS Agreement these will include:

- (a) States parties to the Paris Convention and the TRIPS Agreement;
- (b) countries with which Jamaica had signed Agreements prior to the entry into force of the WTO Agreement.

B. PROTECTION OF UNDISCLOSED INFORMATION

Follow-up to response to question 6:

You mention that there is no legislation governing undisclosed information in your country. Does this mean that the obligations contained in Article 39 of the TRIPS Agreement are directly applicable in your legislation?

Although at present there is no specific legislation governing undisclosed information, trade secrets are protected by common law principles and through contractual arrangements.

² Jamaica's responses to initial questions posed by Switzerland were circulated in document IP/C/W/266/Add.1.