

The Role of JIPO in Brand Protection



POLICY DIALOGUE ON ANTICOUNTERFEITING
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March 19, 2019

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JIPO

Jamaica Intellectual Property Office

Overview

- Enforcement of registered Trade Mark rights
- Enforcement of Copyright
- Enforcement of registered Design rights
- Enforcement of unregistered Trade Mark & unregistered Design rights (passing off)
- Enforcement of Geographical Indications rights
- Civil enforcement
- Criminal enforcement



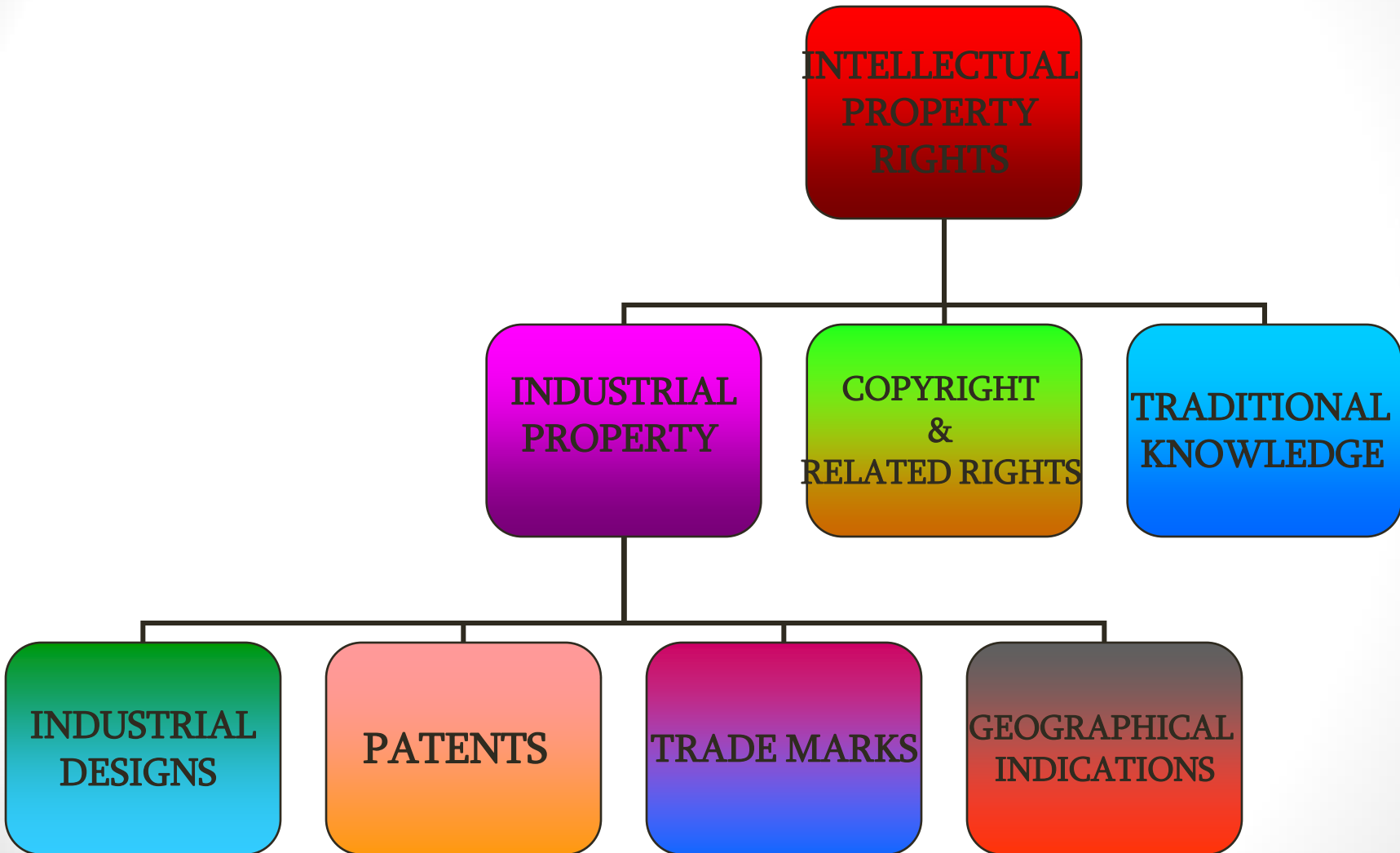
Jamaica Intellectual Property Office

Government agency responsible for administering Intellectual Property laws in Jamaica

- Public Education
- Registration –Trademarks, Designs, Patents, GIs, ©
- Liaising with interest groups
- Policy development
- Updating laws



Intellectual Property (IP) Rights



Property Rights / Exclusive Rights

- **S. 4.(1)** The registration of a trade mark under this Act confers a property right on the proprietor of the trade mark who is entitled to the rights and remedies provided by this Act.
- **S. 5.** Subject to section 10, the proprietor of a registered trade mark has exclusive rights in the trade mark; and any use of the mark in Jamaica without the proprietor's consent, constitutes an infringement of such rights

Commencement of Rights

- **S. 5(2)** - The rights of the proprietor have effect from the date of registration (which is the date of filing in accordance with section 24(4) **BUT**
- no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- no offence under section 70 is committed by anything done before the date on which it was in fact registered.
- **S. 17** - The date of filing of an application for registration is the date on which the applicant furnishes documents containing everything required under section **16**.
- **S. 24(4)** - The registration of a trade mark shall take effect as of the date of filing of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

Trade Mark infringement

- uses in the course of trade
- Identical mark for identical goods/services
- Identical mark for similar goods/services
 - + likely to deceive or confuse the public
- Similar mark for identical goods/services
 - + likely to deceive or confuse the public
- Identical/similar mark for dissimilar goods/services
 - + the sign has a reputation in Jamaica and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark

Trade Mark Infringement

- a person uses a sign if he does anything which associates or purports to associate the sign with any goods or services, in particular if he-
 - (a) affixes it to goods or the packaging thereof;
 - (b) offers or exposes goods for sale, puts them on the market or stocks them for the those purposes under the sign or offers or supplies services under the sign;
 - (c) imports or exports goods under the sign; or
 - (d) uses the sign on business papers or in advertising.

Defences to Infringement

- **S. 9(8)** - Nothing in the foregoing provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of **identifying goods or services as those of the proprietor or a licensee**, so, however, that any such use otherwise than **in accordance with honest practices in industrial or commercial matters**, shall be treated as infringing the rights in the registered trade mark if the use without due cause takes unfair advantage of or is detrimental to, the distinctive character or the reputation of the trade mark.

Defences to Infringement

- **S. 10(2)** - A registered trade mark is not infringed by the use of the mark in any of the following circumstances, so long as such use is in accordance with **honest practices in industrial or commercial matters**:
 - (a) the use by a person of his **own name or address**;
 - (b) the use of indications concerning the **kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services**; or
 - (c) the use of the trade mark where it is **necessary to indicate the intended purpose of a product or service**, in particular, as accessories or spare parts.

Criminal Offences - TM

s.69

- Use a sign identical or likely to be mistaken for registered TM
- Sell, expose for sale, hire, distribute goods with such sign
- Applied on material to be used as labelling or packaging or business papers
- In possession, custody, control, use in course of business such goods, business papers, labels
- Have intent to gain or cause loss to other and apply sign without consent of owner

Criminal offences - TM

s. 69

- Make article specifically designed /adapted to make copies of identical sign
- In possession, custody, control of such article
- Know, have reason to believe that article is to be used to reproduce goods, material for labelling, packaging, business paper
- Have intent to cause loss to another and without consent of proprietor

Criminal offences - TM

s.69(5)

- Defence: belief on reasonable grounds that use of sign was not infringement

Punishment: *per offence*

- Parish Court - \$1M, 12 months imprisonment
- Circuit Court – fine, 5 years imprisonment

Copyright

Literary Works



typographical arrangements
of published editions

Musical Works



Dramatic Works



Sound Recordings (music and
words)

Artistic Works



**Films,
Broadcasts
Cable Programmes**

Qualifying for Copyright

- Written or recorded in tangible form
- Arises automatically. No requirement to register
- ©, name, date of creation – ‘Notice to the world’
- “Poor Man’s” Copyright
- JIPO Voluntary Copyright Registration System

Copyright – rights of owner

Economic rights:

1. Copy the work
2. Issue copies of the work to the public
3. Perform, play or show the work in public
4. Broadcast the work to the public
5. Adapt the work

Moral Rights:

1. Be identified as the author
2. Not to have your work treated in a derogatory manner
3. Not to have a work falsely attributed to you as the author

Neighbouring or Related Rights

Rights of persons who communicate the copyrighted work to the public:

- **Performers:** singers, dancers, musicians, actors
- **Producers of sound recordings:** record companies
- **Broadcast organisations:** e.g. radio and TV stations

Term of Copyright protection

- Literary, musical, dramatic, artistic works:
Author's Lifetime + 95 years
- Sound recordings, broadcasts, films, cable programmes: 95 years from when made or 1st published
- Typographical arrangements: 50 years
- **After expiry – Public Domain**

Collective Management Organisations or Copyright Licensing Bodies in Jamaica

Jamaican Copyright Licensing Agency



licenses the reproduction of text &
image based works

Jamaica Association of Composers, Authors and Publishers



licenses public performance and reproduction
rights of songwriters and music publishers

Jamaica Music Society

licenses the public performance
rights of phonogram producers



Infringement – Economic rights

[s.31]

If anyone does any of the exclusive activities without the permission/ licence of the copyright owner

Civil and Criminal action

Infringement - Moral Rights

- [s.36] Failure to identify author of work / director of film
- [s.38] commercial use of derogatory work
- [s.40] falsely attributing authorship of work to a person

ENFORCEMENT OF COPYRIGHT

© Criminal Offences : s.46(1)

Any person:

- making for sale or hire
- in course of business sells, offers, exposes for sale, exhibits in public
- imports for other than private or domestic use
- non-commercial distribution prejudicial to copyright owner

any article which he knows/has reason to believe is an infringing copy



© Criminal Penalties : s.46(1)

- On summary conviction before Parish Judge
Fine not exceeding \$100,000 *per infringement* or
Term not exceeding 2 years or both

OR

- On conviction before Circuit Court
Fine (not specified) or
Term not exceeding 5 years or both

© Criminal Offences: s.46(2) & (3)

- Makes /has in possession article specifically designed for making copies
- Knowledge that to be used in making copies
- Any person who causes the work to be performed in public, played, shown
- Knowledge that public performance is an infringement

© Criminal Penalties : s.46(2) & (3)

On Summary conviction before Parish Judge

- Fine not exceeding \$50,000 *per infringement* or
Term not exceeding 1 years or both

OR

On conviction before Circuit Court

- Fine (not specified) or
Term no exceeding 3 years or both

Criminal Offences: s.134

- Sell, import for non-private use, possess in course of business, distribute illicit recording
- Causes an illicit recording to be shown / played in public, broadcast/included in cable programme

Criminal Penalties: s.134(6)

On summary conviction before Parish Judge

- Fine not exceeding \$100,000 or
- Term not exceeding 2 years or both

OR

On conviction before Circuit Court

- Fine (not specified) or
- Term not exceeding 5 years or both

Criminal Offences & Penalties

[s.136]

- Falsely stating that authorised to give consent for recording of performance, unless believes on reasonable grounds that he is authorized
- Parish Court: \$50,000 or 6 months

Criminal Offence & Penalties : s.136A

Unauthorised transmission of satellite-carrying signals

- Dealing in unauthorised decoders

(Making, importing for commercial purposes, advertising for sale/hire)

- Parish Court: \$250,000 , 12 months

Defense: did not know/had no reasonable ground for believing that the decoder was an unauthorised decoder

Civil Action : s.136B

Unauthorised transmission of satellite-carrying signals

Anyone who without lawful authority;

- Receives or
- Distributes programmes from an encrypted transmission for the purpose of distributing the programmes to other persons under commercial arrangements with them

Civil action

Civil Action : s.136B

Unauthorised transmission of satellite-carrying signals

[s.136B]

Person who,

- charges for reception of programme (broadcast/cable)
- sends encrypted transmission from a place in Jamaica
- has rights in the content (programme) transmitted encrypted or otherwise

Same rights as copyright owner in relation to infringement

- Can bring action against the person who deals in unauthorised decoders (*see s.32*)
- Apply for delivery up of unauthorised decoder

Warrants / Police Powers

[s.140]

- Police officer of / above rank of Inspector
- reasonable cause an offence being committed
- **May give direction** to any constable to:
 - Enter and search any premises
 - Stop/ board/search vessel, aircraft, vehicle
 - Seize, remove, detain articles, evidence

[s.140(2)]

- Constable given powers to break open doors, forcibly enter vessel

Warrants / Police Powers

[s.141]

Magistrate Warrant to enter domestic premises and search

- satisfied by information on oath
- reasonable ground for suspecting
- any article which may be seized, removed, detained under the Act
- located on any domestic premises

Warrant authorises officer above rank of Sergeant

Criminal Enforcement of Registered Design Rights

- **S. 12(1) - Penalty on Piracy**
- Any person who
- (a) for purposes of sale, applies or causes to be applied a registered design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, to any article of manufacture, or to any substance
- (b) publishes or exposes for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof was applied, knowing that the same has been so applied without the consent of the registered proprietor
- shall be liable for every offence to pay up to J\$100

Civil Enforcement of Registered Design Rights

- **S. 12** - The registered proprietor may, by action brought in the Court, recover either that sum (J\$100 per offence) as a simple contract debt, or damages arising from any breach of the section.
- **S. 21** -
 - Injunction
 - Inspection
 - Account

Tort of Passing Off

- Unregistered trade marks
- Unregistered designs
- Trade dress, get up etc
- Must show:
 1. Goodwill
 2. Misrepresentation
 3. Damage suffered or likely to be suffered

Civil Enforcement of GIs

- **S. 3 Protection of Geographical Indications Act**
- Any interested party may apply **to the Court** to prevent, in respect of a GI
- (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good;
- (b) any use which constitutes an act of unfair competition within the meaning of the Fair Competition Act; or
- (c) any use which identifies wines or spirits, as the case may be, that do not originate in the place indicated by the GI as wines or spirits of that origin (even where (i) the true origin' of those wines or spirits is indicated; or (ii) the GI is used in translation or accompanied by such expressions as "kind", "type", "style", "imitation", "comparable to" or other similar expressions.)

Criminal Enforcement of GIs

- S. 7(1) Any person who knowingly or wilfully uses a GI in a manner specified in section 3 (1) (a) or (c), commits an offence and, subject to subsection (2), is liable
- (a) on summary conviction in a Parish Court to a fine not exceeding J\$1,000,000.00 dollars or to imprisonment for a term not exceeding 12 months or both;
- (b) on conviction before a Circuit Court, to a fine or to imprisonment for up to 5 years or both
- (2) where the Court is satisfied that any benefits were derived by or accruing to the person convicted, the Court may order the person convicted to pay to the Crown such pecuniary penalty as the Court determines to be equivalent to the total value of such benefits.

Refusal & revocation of GIs

- S. 17
- The Registrar shall, on his own initiative or at the request of any interested party, refuse or revoke a trademark that:
 - (a) contains or consists of a GI relating to a good which does not originate in the territory indicated by the GI, if the use of the GI in the trademark in Jamaica is of such a nature as to mislead the public as to the true place of origin.
 - (b) contains or consists of a GI which identifies wines or spirits as originating from a territory, region or locality indicated by the GI which is not the true place of origin of such wines or spirits.

Thank You for Your Attention !



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