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INTRODUCTION

In recent times, the trafficking in counterfeit goods has become the subject of much media attention in Jamaica as a proliferation of counterfeit goods (colloquially termed “knock-offs”) continue to inundate local markets and are increasingly the targets of numerous anti-counterfeiting operations.¹ The World Trade Organization (WTO) defines counterfeiting as “[the] unauthorized representation of a registered trademark carried on goods identical or similar to goods for which the trademark is registered, with a view to deceiving the purchaser into believing that he/she is buying the original goods”.² Whilst counterfeiting invariably results in trademark infringement, it can also result in breaches of copyright.

The illicit trade in counterfeit goods has become alarmingly prevalent across the world owing to its extremely lucrative nature, and low risk of detection, prosecution and penalties.³ In fact, one recently published study projects that the trade in counterfeit (and pirated) goods could be worth approximately \$991 Billion by the year 2022.⁴ The buoyancy of this illicit trade across the globe is sustained by consumer demand for inexpensive imitations of status goods and, to a lesser yet no less significant extent, the enduring public perception that counterfeiting is a “victimless crime”.⁵ Still, the deleterious social and economic impacts of counterfeiting speak compellingly to the need for this issue to be given priority attention by governments and other key stakeholders across the world.

¹ Jamaica Gleaner, ‘Police Destroy \$2.6 Billion Worth of Counterfeit Goods’ (Kingston, April 25 2019) <<http://jamaica-gleaner.com/article/news/20190425/police-destroy-26-billion-worth-counterfeit-goods>> accessed August 1, 2019; Jamaica Gleaner, ‘\$9 Million Worth Of Counterfeit Goods Seized In Downtown Kingston’ (Kingston, December 18 2018) <<http://jamaica-gleaner.com/article/news/20181218/9-million-worth-counterfeit-goods-seized-downtown-kingston>> accessed August 1, 2019; Jamaica Observer, ‘Customs seize over J\$250m in counterfeit goods’ (Kingston, July 27 2015) <<http://www.jamaicaobserver.com/news/Customs-seize-over-J-250m-in-counterfeit-goods>> accessed August 1, 2019.

² World Trade Organization glossary: <https://www.wto.org/english/thewto_e/glossary_e/counterfeit_e.htm> accessed August 1, 2019.

³ Brandon A. Sullivan, Jeremy M. Wilson and Rodney Kinghorn, ‘Illicit trade in counterfeit products: an examination of the opportunity— risk connection’ in Peggy E. Chaudhry (ed), *Handbook of Research on Counterfeiting and Illicit Trade* (Edward Elgar Publishing 2017) 19.

⁴ Frontier Economics, *The Economic Impacts of Counterfeiting and Piracy* (Frontier Economics 2017) 9. Available at: <<https://www.iccwbo.be/wp-content/uploads/2017/02/ICC-BASCAP-INTA-2016-report.pdf>>.

⁵ Catherine Seville, *EU Intellectual Property Law and Policy* (Edward Elgar Publishing Limited 2009) 416.

Against this background, this essay broadly explores the issue of counterfeiting in Jamaica. In particular, endeavours to critically examine the legal and administrative measures that are currently utilized in tackling the issue. In setting the context for the discussion, Part I of the essay briefly outlines some social and economic impacts of counterfeiting as documented by influential studies on the issue. Part II of the essay thereafter provides a concise overview of the existing legal and administrative measures that are utilized by law enforcement, IP rights holders and other relevant actors within the local IP labyrinth to tackle counterfeiting in Jamaica. Part III conducts an assessment of these measures, and identifies any gaps in the local response to counterfeiting as they may arise. And, Part IV, in concluding the essay offers, where appropriate, succinct recommendations for improvement having regard to the assessment conducted in the foregoing section.

I. **“HIDDEN VICTIMS”, HAMPERED DEVELOPMENT : THE SOCIAL AND ECONOMIC IMPACTS OF COUNTERFEITING**

A. SOCIAL IMPACTS OF COUNTERFEITING

By definition, a “victimless crime” is one which is said to have no direct victim.⁶ The almost instinctive categorization of counterfeiting as a “victimless crime” is attributable to the prevailing public perception that it is a minor offence against wealthy multinational concerns who can easily afford the loss.⁷ In truth, however, and despite its veneer of innocuity, counterfeiting victimizes— in both direct and indirect ways — many more persons than may be readily apparent and therefore has serious implications for social development.

To begin with, counterfeit goods are typically manufactured in unsanitary conditions using substandard and hazardous substances which raise legitimate concerns about their safety, quality and general suitability for consumption by consumers. The case of counterfeit drugs is perhaps the best exemplification of this reality. Indeed, counterfeit

⁶ Jocelyn M. Pollock, *Crime & Justice in America: An Introduction to Criminal Justice* (Elsevier Inc 2012) 27.

⁷ USAID, *Intellectual Property and Developing Countries: An Overview* (USAID 2003) 5.

drugs are often contaminated, contain the wrong or no active ingredient at all or contain insufficient quantities of the correct ingredient.⁸ In Jamaica, for example, there has been a marked upsurge in the quantity of counterfeit drugs and medicines penetrating the domestic markets as of late. In response to this worrying development, the Pharmaceutical Society of Jamaica has warned the public of the inherent dangers of counterfeit drugs,⁹ which, if proven to be ineffective, may not only erode an individual's confidence in health care professionals and the pharmaceutical industry¹⁰, but can even cause death.

Secondly, counterfeiting has been found to have strong links to organized crime with the proceeds from the sale of counterfeit products oftentimes being used to fund criminal and, in extreme cases, terrorist activities.¹¹ Innocent civilians may be the targets and indeed victims of such criminal activities which severely compromise citizen security, peace and social cohesion.

Finally, the production of counterfeit goods in some countries has been said to rely heavily on the forced labour and exploitation of vulnerable groups, including children and migrant workers.¹² In fact, one author recalled having witnessed at first-hand young children being forced to assemble counterfeit leather bags at an assembly plant in Thailand.¹³ The abovementioned categories of persons are examples of "hidden victims" who, whilst not readily identifiable as casualties of this illicit trade, suffer greatly because of it.

B. ECONOMIC IMPACTS OF COUNTERFEITING

⁸ See US Food & Drug Administration, 'Counterfeit Medicine' : <<https://www.fda.gov/drugs/buying-using-medicine-safely/counterfeit-medicine>> accessed August 11, 2019.

⁹ Jamaica Gleaner, 'Beware of Counterfeit Drugs, Pharmacists Warn' (Kingston, February 2 2019) <<http://jamaica-gleaner.com/article/lead-stories/20190202/beware-counterfeit-drugs-pharmacists-warn>> accessed August 12, 2019.

¹⁰ Dr. Cameil Wilson-Clarke and Dr. Jacqueline Campbell, 'Counterfeit drug threat' (Kingston, June 10 2018), Jamaica Observer < http://www.jamaicaobserver.com/your-health-your-wealth/drug-threat_135283?profile=1470> accessed August 12, 2019.

¹¹ Sullivan, Wilson and Kinghorn, 'Illicit trade in counterfeit products' (n 3).

¹² Certilogo, 'The True Cost of Counterfeiting Includes Human Trafficking': <<https://blog.certilogo.com/en/unemployment-and-modern-day-slavery-in-the-counterfeit-trade>> accessed August 14, 2019.

¹³ See generally Dana Thomas, *Deluxe: How Luxury Lost Its Luster* (Penguin Books Ltd 2008).

The economic impacts of counterfeiting have been well-documented by a number of studies over the years. In fact, as recently as March of this year, 2019 one particularly influential study published jointly by Organization for Economic Cooperation and Development (**OECD**) and the European Union Intellectual Property Office (**EUIPO**) concluded that counterfeiting precipitated, among other things, "...higher unemployment; lost tax revenues; and greater expenses incurred— both to ensure compliance with anti-counterfeiting legislation and react to public safety threats and labour market distortions."¹⁴ Higher levels of unemployment coupled with reduced tax revenues to fund the provision of essential services (e.g. education, health care, etcetera) seriously undermine the stability of a country's social infrastructure.

In addition, another influential study found that among the "wider of economic impacts" of counterfeiting were: reduced inflows of foreign direct investment (**FDI**); crippled innovation both within and across key manufacturing and creative industries; and decreased levels of competitiveness within local business environments.¹⁵ Indeed, foreign producers of reputable products tend to be less inclined to invest in countries where counterfeiting flourishes unchecked as there may be concerns about their ability to protect their IP and enforce any rights arising therefrom.¹⁶

II. THE LEGAL AND ADMINISTRATIVE MEASURES FOR TACKLING COUNTERFEITING IN JAMAICA

A. LEGAL MEASURES

i. The Trade Marks Act

The Trade Marks Act (**TMA**) was passed in 1999 and came into effect in 2001.¹⁷ It offers statutory protection to trademark proprietors and licensees against the unauthorized

¹⁴ OECD and EUIPO, *Trends in Counterfeit and Pirated Goods* (OECD/EUIPO 2019) 17.

¹⁵ See generally, Frontier Economics, *The Economic Impacts of Counterfeiting and Piracy* (Frontier Economics 2017). Available at: <<https://www.iccwbo.be/wp-content/uploads/2017/02/ICC-BASCAP-INTA-2016-report.pdf>>.

¹⁶ OECD, *The Economic Impact of Counterfeiting* (OECD 1998) 22.

¹⁷ The Trade Marks Act 1999.

use of their trademarks providing that they were registered.¹⁸ ‘By virtue of a valid registration, the trademark owner and, by extension, a registered licensee has a fairly extensive legal right to enforce against the unauthorized use or infringement of its trademark’.¹⁹

Pursuant to section 9 of the TMA, an “infringing act” refers, general terms, to any act (done in the course of trade) which involves the unauthorized use of a sign that is identical with a trade mark in relation to goods or services that are identical with the goods or services for which the trade mark is registered. As such, counterfeiting would constitute an “infringing act” within the meaning of section 9.²⁰ This would, in turn, entitle the trademark proprietor to institute legal proceedings in respect of the trademark infringement.²¹

Under section 32 (1), goods qualify as “infringing goods” where, among other things, they or their packaging bear a sign that is identical with or similar to a registered trade mark and the application of the sign to the goods or their packaging was an infringement of the registered trade mark.²² Since counterfeit goods or their packaging oftentimes bear some representation of a registered trademark or a sign that is identical to it, such goods would qualify as “infringing goods” within the meaning of this provision.²³ In such a case, the registered proprietor of the infringed trademark could give notice to the Commissioner of Customs requesting that the counterfeit goods be treated as “prohibited goods” under the Customs Act.²⁴ This would facilitate the seizure of the goods at the relevant point of entry after which time they may be forfeited or disposed of on the instructions of the Commissioner.

Where the trademark proprietor elects to institute legal proceedings for trademark infringement, he can avail himself of all the traditional civil remedies (i.e. damages, injunction, etcetera) because a property right would have been created upon the registration of the trade mark.²⁵ However, quite apart from the more traditional civil remedies, the TMA empowers the Court to order that: i. the offending sign be erased, removed or obliterated from “infringing goods”, or where it is not reasonably

¹⁸ *ibid.*, section 16 (1).

¹⁹ Fanta Punch, ‘Tackling Trademark Infringement’ Hamel-Smith Forum, Volume 8 Issue 7 (November 2014) 1.

²⁰ *ibid.*, section 9.

²¹ *ibid.*, section 24 (1).

²² *ibid.*, section 32 (1)(a)

²³ *ibid.*, section 32 (1)(b).

²⁴ *ibid.*, section 66(1).

²⁵ *ibid.*, section 4.

practicable, that they be destroyed;²⁶ ii. any “infringing goods”, materials or articles that a person has in his possession, custody or control in the course of business be delivered up to the proprietor; or iii. “infringing goods”, which were delivered up pursuant to section 36, be destroyed or forfeited to such person as the court thinks fit.²⁷ Under the TMA, criminal proceedings may also be instituted against counterfeiters at the instance of the crown with penalties mostly consisting of fines.

It should also be noted here that even where a trademark is not registered under the TMA, the proprietor would still be entitled to sue for trademark infringement under the doctrine of “passing off”.²⁸ “Passing off” occurs where ‘an offending party uses a trademark or some distinguishing feature such as the packaging of goods to confuse a consumer into believing that the goods belong to the trademark owner’.²⁹ The trademark proprietor would, as such, be required to prove this to the satisfaction of a Court in order for their action in “passing off” to succeed.

ii. **The Merchandise Marks Act**

The Merchandise Marks Act (**MMA**) was promulgated in 1908 and offers complementary protection to that which is provided by the Trade Marks Act in respect of counterfeit goods.³⁰ Among other things, section 3 of the MMA proscribes: i. the forging of any trade mark;³¹ ii. falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive;³² and iii. causing any of the abovementioned acts to be committed.³³ Moreover, where a person sells, or exposes for sale or has in their possession any goods of the kind referenced above will be guilty of an offence unless they prove that they had no reason to suspect the marks were not genuine and provides the prosecutor with information in respect of how they obtained the goods,³⁴ or otherwise proves that he acted innocently.³⁵

²⁶ *ibid.*, section 35.

²⁷ *ibid.*, section 36.

²⁸ Punch, ‘Tackling Trademark Infringement’ (n 19).

²⁹ *ibid.*

³⁰ The Merchandise Marks Act 1908.

³¹ *ibid.*, section 3 (1)(a).

³² *ibid.*, section 3 (1)(b).

³³ *ibid.*, section 3 (1)(f).

³⁴ *ibid.*, section 3 (2)(a)

³⁵ *ibid.*, section 3 (2)(b).

iii. **The Copyright Act**

The Copyright Act (CA) was promulgated in 1993³⁶ and applies to original literary, dramatic, musical or artistic works, sound recordings, films, broadcasts or cable programmes.³⁷ The CA explicitly recognizes the exclusive right of the owner of the copyright to do or give authorization for the work to be copied,³⁸ and issue copies of the work to the public.³⁹ Under section 31(1), the copyright in a work is infringed when a person, without the license of the copyright holder, does in relation to the work any of the acts which the copyright owner has the exclusive right to do.⁴⁰ As such, where dramatic, music or artistic works in which copyright subsists (e.g. CDs and DVDs) are counterfeited, the copyright would be infringed and the owner of the copyright would be entitled to institute legal proceedings in respect of the infringement.⁴¹

Section 50(1) also empowers the owner of the copyright in any literary, dramatic or musical work to formally request that the Commissioner of Customs treat as “prohibited goods” under the Customs Act, printed copies of their work which are infringing copies.⁴²

iv. **The Customs Act**

The Customs Act was passed in 1941 with a view to facilitating the regulation of imported and exported goods as well as to make provision for the collection of commercial taxes and duties on such goods.⁴³ Section 40 of the Act outlines various categories of goods which qualify as “prohibited goods”, and cannot therefore be lawfully imported.⁴⁴ One such category encompasses ‘all goods which if sold would be liable for forfeiture under the Merchandise Marks Act...’⁴⁵ Any flouting of this prohibition will invite a sanction of “not less than treble the import duties payable on the

³⁶ The Copyright Act 1993.

³⁷ JIPO website, ‘About Copyright and Related Rights’ <<https://www.jipo.gov.jm/node/47>> accessed August 14, 2019.

³⁸ (n 36), section 9(1)(a).

³⁹ *ibid.*, section 9(1)(b).

⁴⁰ *ibid.*, section 31(1).

⁴¹ *ibid.*, section 32 (1).

⁴² *ibid.*, section 50(1).

⁴³ The Customs Act 1941.

⁴⁴ *ibid.*, section 40.

⁴⁵ *ibid.*, section 40(1)(ii).

goods nor more than treble the value of the goods”, and all such “prohibited goods” are liable to be forfeited.⁴⁶

As mentioned previously, counterfeit goods would be liable to forfeiture under the Merchandise Marks Act. Accordingly, counterfeit goods would qualify as “prohibited goods” within the meaning of section 40, and could not therefore be lawfully imported. In addition, the Act invests customs officers with the power to apply to a Resident Magistrate or Justice of the Peace for a special warrant where they have reasonable cause to suspect that any uncustomed or prohibited goods are harbored, kept or concealed in any house or other place in the Island.⁴⁷

v. **The Proceeds of Crime Act**

The Proceeds of Crime Act (**POCA**) was passed in 2007⁴⁸ to provide for the “investigation, identification, and recovery of the proceeds of crime and connected matters”.⁴⁹ Pursuant to section 5(3) of POCA the Court can, on the application of the Assets Recovery Agency or the Director of Public Prosecutions, make an order for the forfeiture of property that represents a defendant’s benefit from criminal conduct to be where it is satisfied that the defendant has in fact benefited from his criminal conduct.⁵⁰ As such, under the POCA the proceeds from a defendant’s involvement in counterfeiting activities, once conclusively established, would also be liable to forfeiture.⁵¹

vi. **The Consumer Protection Act**

⁴⁶ *ibid.*, section 210(1).

⁴⁷ *Ibid.*, section 203 (1)(a).

⁴⁸ The Proceeds of Crime Act 2007.

⁴⁹ See Ministry of Justice website:< <https://moj.gov.jm/laws/proceeds-crime-act>>accessed August 14, 2019.

⁵⁰ (n 48), section 5(3).

⁵¹ See Jamaica Observer, ‘Gov’t seeks \$203m forfeiture from businesswoman over counterfeit goods’ (Kingston, July 2 2018)

<[http://www.jamaicaobserver.com/latestnews/Gov%26%238217;t_seeks_\\$203m_forfeiture_from_businesswoman_over_counterfeit_goods?src=ilaw&profile=1373](http://www.jamaicaobserver.com/latestnews/Gov%26%238217;t_seeks_$203m_forfeiture_from_businesswoman_over_counterfeit_goods?src=ilaw&profile=1373)> accessed August 14, 2019.

In 2005 the Consumer Protection Act (CPA)⁵² was implemented to provide, *inter alia*, for “the promotion and protection of consumer interest in relation to the supply of goods and the provision of services in order to ensure the protection of life, health and safety of consumers and others”.⁵³ Section 28(1) of the CPA prohibits a person in the course of a trade from engaging in conduct that is “misleading or deceptive or is likely to mislead or deceive”.⁵⁴ As such, to the extent that counterfeit goods would mislead consumers or are likely to do so, section 28 (1) can be construed as prohibiting their sale and distribution. Section 29(1) goes further by proscribing conduct that “is likely to mislead the public as to the nature, manufacturing process, characteristics, suitability for a purpose or quantity of goods or services in the course of a trade”.⁵⁵ In the same vein, this provision would arguably proscribe the manufacture, sale and distribution of counterfeit goods given their considerable potential to mislead the (consuming) public as to, among other things, “their nature, manufacturing process and characteristics”.

vii. **The Food and Drugs Act**

The Food and Drugs Act (FDA) is a critical component of the legal framework for the regulation of foods, drugs, cosmetics and medical devices.⁵⁶ When considered within the context of counterfeit drugs specifically, sections 8, 9 (1), 10 and 25 of the FDA assume particular significance. More specifically, section 8 prohibits the sale of any drug that was manufactured, prepared, preserved, packaged or stored under insanitary conditions; is adulterated; or is stale.⁵⁷ Section 9(1) provides that “[a] person shall not label, package, treat, process, sell or advertise any drug in a manner that is false, misleading or deceptive or is likely to create an erroneous impression regarding its character, value, quantity, composition, merit or safety.”⁵⁸ And, section 10 prohibits the manufacture, preparation, preservation, packaging or storage or sale of any drug under insanitary conditions.⁵⁹

⁵² The Consumer Protection Act 2005.

⁵³ See Ministry of Justice website: < <https://moj.gov.jm/laws/consumer-protection-act> > accessed August 14, 2019.

⁵⁴ (n 52), section 28(1).

⁵⁵ *ibid.*, section 29(1).

⁵⁶ The Ministry of Health and Wellness, ‘Legislative Framework’ <[https://www.moh.gov.jm/divisions-agencies/divisions/standards-and-regulation-division/legislative-framework/#targetText=The%20Food%20and%20Drugs%20Regulation,as%20products%20imported%20for%20use.&targetText=The%20registration%20and%20licensing%20C%20importation,designated%20products%20are%20also%20covered](https://www.moh.gov.jm/divisions-agencies/divisions/standards-and-regulation-division/legislative-framework/#targetText=The%20Food%20and%20Drugs%20Regulation,as%20products%20imported%20for%20use.&targetText=The%20registration%20and%20licensing%20C%20importation,designated%20products%20are%20also%20covered.)> accessed August 14, 2019.

⁵⁷ The Food and Drugs Act 1975, section 8.

⁵⁸ *ibid.*, section 9 (1).

⁵⁹ *ibid.*, section 10.

Accordingly, the manufacture of counterfeit pharmaceuticals under “insanitary conditions” which also bear the same labels and packaging as legitimate drugs thereby creating “an erroneous impression regarding their character, value, quantity, composition, merit or safety”, would amount to a breach of the FDA.

B. ADMINISTRATIVE MEASURES

i. **The Jamaica Intellectual Property Office**

The Jamaica Intellectual Property Office (**JIPO**) is an agency of the now Ministry of Industry, Commerce, Agriculture and Fisheries which has the exceptionally important mandate of administering intellectual property systems locally.⁶⁰ JIPO facilitates the registration of trademarks, which confer upon registered proprietors the exclusive right to use and benefit from their trademarks in Jamaica. This right is justiciable and trademark proprietors may elect to commence legal proceedings where it has been demonstrably infringed. Recognizing the sheer magnitude of counterfeit goods currently inundating local markets, the organization works to educate individuals about the importance of being proactive in registering their trademarks so as to receive maximum legal protection under the Trade Marks Act.⁶¹

It also collaborates with partners within the local IP labyrinth to increase public awareness and understanding of counterfeiting.⁶² In fact, just last year during intellectual property week JIPO collaborated with the Counter-Terrorism and Organized Crime Branch of the Jamaica Constabulary Force to host a joint press conference aimed at raising awareness about the issue as well as its implications for the social and economic development of the country.⁶³ Quite significantly, the importance of educating citizens about the “ills and dangers of counterfeit goods” was strongly emphasized by key stakeholders present as being indispensable to the success of intervention strategies and efforts to combat the illicit trade.⁶⁴

⁶⁰ Jamaica Intellectual Property Office, ‘About us’: <<http://www.jipo.gov.jm/node/1>> accessed August 18, 2019.

⁶¹ Interview with Ms. Adrienne Thompson, Trademarks Manager, JIPO (August 14, 2019 — Kingston, Jamaica).

⁶² *ibid.*

⁶³ *ibid.*

⁶⁴ Jamaica Gleaner, ‘\$1.2 Billion In Counterfeit Goods Destroyed’ (Kingston, April 26 2018) <<http://jamaica-gleaner.com/article/lead-stories/20180426/12-billion-counterfeit-goods-destroyed>> accessed August 18, 2019.

ii. **The Counter-Terrorism and Organized Crime Branch of the Jamaica Constabulary Force**

The Counter- Terrorism and Organized Crime Investigation Branch of the Jamaica Constabulary (C-TOC) was formed in 2015. Its mandate is to “strengthen the country’s security framework to effectively combat terrorism and organized crime in all forms”.⁶⁵ It is comprised of multiple units whose work spans a gamut of areas ranging from counter terrorism and special investigations to intelligence and covert evidence gathering.⁶⁶ However, given the focus of this essay the work of its IP Unit assumes great importance. In particular, the unit executes numerous anti-counterfeiting operations upon receiving information, usually from brand owners, about the existence of suspected counterfeit goods which are in breach of the Trade Marks Act. After receiving such information, without which it cannot take enforcement action, the intellectual property unit verifies with JIPO whether the trademark alleged to have been infringed because of its use in connection with the counterfeit goods had in fact been registered.⁶⁷

Upon receiving confirmation from JIPO that the trademark alleged to have been used in connection with the suspected counterfeit products was registered, the IP unit seizes the infringing goods.⁶⁸ In addition to seizing counterfeits, C-TOC also organizes seminars aimed at sensitizing the public to the issue in the hopes of increasing public awareness of the dangers associated with counterfeit goods and drugs/medicines.⁶⁹ Among the partners with whom it works towards this end are the Jamaica Customs Agency; the Jamaica Intellectual Property Office; the Ministry of Health as well as prominent corporate entities whose products are favorite targets of counterfeiters. As recently as April of this year, C-TOC destroyed counterfeit goods with an estimated value of \$2.6 billion.⁷⁰

iii. **The Jamaica Customs Agency**

⁶⁵ Jamaica Observer, ‘JCF officially forms Counter-Terrorism and Organised Crime Investigation (CTOC) Branch’ (Kingston, January 24 2015) <<http://www.jamaicaobserver.com/news/JCF-forms-Counter-Terrorism-and-Organised-Crime-Investigation--C-TOC--Branch>> accessed August 14, 2019.

⁶⁶ *ibid.*

⁶⁷ Interview with Ms. Patricia Robinson, Sub-officer in charge of the IP Unit, C-TOC (August 15, 2019 — Kingston, Jamaica).

⁶⁸ *ibid.*

⁶⁹ *ibid.*

⁷⁰ *ibid.*

The Jamaica Customs Agency (**JCA**) is an executive agency in the now Ministry of Finance and the Public Service with responsibility for facilitating the equitable collection of revenue, **protection of Jamaica’s borders from illicit trade** and the promotion of trade.⁷¹ The work of the Border Protection Unit (which spans six (6) sections)⁷² is of particular significance in the context of the local battle against counterfeiting. In particular, this Unit ensures that consignments of counterfeit, and other IP infringing items, are interdicted at the ports with a view to stemming the flow of such items across national borders. The JCA also conducts joint operations with C-TOC to counteract the trade in counterfeits on the basis of information received from brand owners (and other rights-holders) as well as intelligence gathering and analysis.

III. GAPS

Jamaica, as a member of the WTO, is obliged to give effect to the minimum standards articulated in the Agreement on Trade- Related Aspects of Intellectual Property (**TRIPS Agreement**) in its laws, policies and administrative mechanisms.⁷³ Quite significantly, both the Trade Marks and Copyright Acts were found in 2001 by the TRIPS Council to be compliant with the TRIPS Agreement.⁷⁴ Notwithstanding this, however, gaps do exist in the legislative and administrative mechanisms utilized by key stakeholders in the response to counterfeiting locally. They will be highlighted in turn.

A. LEGAL MEASURES

Whilst offering, primarily to the proprietors of registered trademarks, some statutory protection against counterfeiting, the Trade Marks and Merchandise Marks Acts in particular do not prescribe penalties that are stringent enough to serve as strong deterrents against counterfeiting. Indeed, as noted earlier in this essay, participation in this illicit

⁷¹ Jamaica Customs Agency, ‘About us’: <<https://www.jacustoms.gov.jm/about-us>> accessed August 19, 2019. [emphasis added]

⁷² Jamaica Customs Agency, ‘Border Protection Unit’: <<https://www.jacustoms.gov.jm/branch/border-protection-unit>> accessed August 19, 2019.

⁷³ The TRIPS Agreement effect on January 1, 1995 and is regarded as the most comprehensive multilateral agreement on intellectual property, and applies to all members of the WTO. See WTO, ‘Overview: The TRIPS Agreement’: <https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm> accessed August 20, 2019.

⁷⁴ Dr. Natalie G.S. Corthesy, ‘Challenges to Combatting Piracy and Counterfeiting in Jamaica’, WIPO—WTO Colloquium Papers for Teachers of Intellectual Property Law (WIPO/WTO 2011) 77.

trade is especially appealing because of the low risk of detection, prosecution and punishment juxtaposed with the tremendous profits it yields for unscrupulous traders.⁷⁵ Moreover, notwithstanding that the TMA makes available to registered trademark proprietors the usual civil remedies (which are useful), litigation can be expensive and the trademark proprietor may not stand to recover much where "...transient peddlers and fly-by night retailers are the offenders...and can vanish from the streets without a paper trail or an entity behind it from which [they can] recover damages."⁷⁶

Another discernible gap concerns the Customs Act. More particularly, while the Act empowers the trademark proprietor to request that the Commissioner treat counterfeit goods as "prohibited goods" and order their seizure at the port of entry, the same is unfortunately not true for counterfeit goods manufactured locally. In addition, where the infringing trademark was affixed to the goods after their importation, Customs would again be precluded from taking any type of enforcement action respecting the goods. Furthermore, the Customs, Act, as currently drafted, offers very little to no productive opportunities for addressing the challenges that considerable developments in e-commerce have presented for the detection and interdiction of counterfeit goods at the island's ports of entry and exit.⁷⁷ These limitations may serve to undermine the efficacy of the Act as potent tool in the fight against counterfeiting locally, and must therefore be addressed.

B. ADMINISTRATIVE MEASURES

Commendably, the organizations identified above as key players in the local fight against counterfeiting (i.e. C-TOC, JCA and JIPO) have forged collaborative partnerships with one another for the purpose of bolstering the impact of their individual efforts to address the issue. However, in the face of significant resource constraints the important work of entities like C-TOC will necessarily be hampered.⁷⁸ Additionally, whilst a number of organizations mandated to address this issue have incorporated public education and sensitization as a critical component of their operational strategy, there is somewhat of a

⁷⁵ Sullivan, Wilson and Kinghorn (n 3).

⁷⁶ Hilary Reid, 'The Response to Trade Mark Counterfeiting', Jamaica Bar Association (1999) 5-6.

⁷⁷ See Loop Jamaica, 'E-commerce beating Jamaica Customs badly with counterfeit goods' (Kingston, July 31 2017) <<http://www.loopjamaica.com/content/e-commerce-beating-jamaica-customs-badly-counterfeit-goods>> accessed August 25, 2019.

⁷⁸ Interview with Ms. Patricia Robinson (n 66).

deficit in the capacity and technical expertise of local IP enforcement officers with respect to some areas of enforcement.⁷⁹

These deficits are only compounded by the paucity of readily available and accessible empirical research/data on the issue which provide critical insights into the nature, magnitude and scope of counterfeiting in Jamaica. Unquestionably, this would have implications for the efficacy of any strategic interventions undertaken by local enforcement agencies as information of that kind would be critical to informing the substance, direction and logistical execution of such strategic interventions as well as influencing in important ways the development of useful policies in the area of IP protection.

IV. THE WAY FORWARD

A. LEGAL MEASURES

In light of the deficits highlighted above, it is recommended that the monetary penalties prescribe by the relevant statutes utilized in tackling counterfeiting locally be increased so as to serve as a stronger deterrent to actual counterfeiters and prospective counterfeiters, as well as to more clearly reflect the gravity or seriousness of the act. This, together with comprehensive and robust public education, may very well prove indispensable to transforming public perceptions about the “harmlessness” of the act.

There is also a need for the Customs Act to be amended so as to ensure that customs officers are legally empowered to respond to all eventualities or situations that will necessitate the taking of enforcement action— mere technicalities in the law should not preclude them from carrying out their work effectively. Further, and in connection with this point, the Customs Act itself is in urgent need of modernization so that they JCA will be sufficiently well positioned to keep apace of and effectively respond to new and emerging developments in the underground world of counterfeiting.

⁷⁹ Ibid.

B. ADMINISTRATIVE MEASURES

In addition to being better resourced, the key players involved in tackling the issue of counterfeiting locally should have their capacities built and technical skill-sets expertise developed so that they are better able respond to the challenges presented by an illicit trade which is becoming increasingly more sophisticated and complex owing to rapid technological advancements.⁸⁰

Moreover, while there is some level of collaboration between the relevant entities, partnerships could always be strengthened through the development of Memorandums of Understanding (MOUs), which will clearly define the roles and technical competencies of each entity with a view to strengthening partnerships between the entities, and systematizing information-sharing among the entities thereby enhancing the efficacy of their collective response to the issue locally. Of considerable importance as well is the need for comprehensive empirical research to be done into the nature, scope and prevalence of the issue locally.

The lack of locally relevant research on the issue is most unfortunate especially in a context where concerted efforts are being made to educate the public about the seriousness of counterfeiting in the hopes that, despite Jamaica's very strong brand culture, they will desist from willfully purchasing counterfeit goods. In the absence of credible research that is tailored to and reflective of local realities, reorienting the mindset of increasingly cost-conscious Jamaican consumers will continue to be an uphill battle. Institutional actors like JIPO, JCA and C-TOC among others should lead this charge with technical, logistic and resource support from leading international organisations like the WIPO, INTA, among others , as well as local brand owners (both local and international) whose products are favorite targets of counterfeiters.

⁸⁰ *ibid.*