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Significant IP progress...on the horizon

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Jamaica

Significant IP progress...on the horizon

With a Patent and Designs Bill, a discussion draft Copyright Amendment Bill and trademark amendments on the government's agenda, the Jamaican IP community is preparing for significant changes in domestic IP law and practice. For some rights holders, the thought that everything is pending is rather frustrating. Although the changes have been slow in coming, there is an expectation that the revised laws will bring stronger IP rights, greater certainty on issues such as ownership and royalty entitlements, and some form of internet-proof protection. Meanwhile, rights holders continue actively to test the strength of existing laws on copyright and trademarks and the effectiveness of the judicial system.

Patents and designs

The Patents and Designs Bill, which proposes to implement the standards required by the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) together with elements of the Paris Convention on Industrial Property and the Patent Cooperation Treaty, which were all on the 2004 to 2005 legislative agenda, has been carried forward to the 2005 to 2006 agenda. The bill has provisions on ownership of inventions made by employees, which is not addressed by the existing Patents Act 1857.

Although archaic, the existing Patents Act 1857 has been useful to foreign and local inventors and assignees by affording the grant of a 14-year patent monopoly, with the possibility of a seven-year extension. However, it still presents some drawbacks.

Under the Patents Act 1857 letters patents are granted on the basis of local novelty as opposed to universal novelty, leaving it possible for a patent to be granted in Jamaica for an invention which already forms part of the state of the art elsewhere. Further, although Jamaica has been a signatory to the Paris Convention since 2000, in the absence of implementing legislation foreign applicants have not yet been able to take advantage of

priority filings. Under the Paris Convention applicants have up to 12 months after first filing for a patent in one country to file in other convention countries and thereby claim the earliest filing date. As the international patent system is increasingly becoming a first-to-file system, priority filings are particularly desirable for applicants seeking to file in several countries.

Under the existing Designs Act 1937 a design must be new and original, with the novelty criterion being based on local novelty. In other words, the design must not have been previously published in Jamaica. The Paris Convention priority filing period of six months from the first filing date is not yet applicable to industrial design registrations in Jamaica.

Developments brought about by the Doha Declaration on the TRIPs Agreement and Public Health should prompt Jamaica to re-examine its proposed patent provisions, especially as they relate to compulsory licences and the exhaustion of rights, in order to ensure that the laws include the flexibilities contemplated by the Doha Decision of August 30 2003. The decision provides waivers to countries that experience health crises but lack sufficient manufacturing capacity for necessary pharmaceuticals. The decision waives the requirement for an importing country to remunerate a patent holder for use of an invention under a compulsory licence where the patent holder has already been paid by the exporting country, as well as the requirement that use of an invention under a compulsory licence be limited for the supply of predominantly the domestic market.

Copyright and related rights

The Copyright Amendment Bill has been drafted to implement the World Intellectual Property Organisation (WIPO) Internet Treaties. Jamaica acceded to the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty in March 2002, and although its membership became effective in June 2002 the treaties have not yet been implemented.

The draft bill proposes to include provisions guarding technological protection measures and electronic rights management information, and granting the right of making available to the public of protected works and performances.

The bill proposes to make it an offence to manufacture, import or distribute a circumvention device knowing that such a device will be used to circumvent or facilitate the circumvention of a copyright technological protection measure. The unauthorised removal or alteration of rights management information attached to or embodied in a protected work or performance will also be deemed an offence. Performers can look forward to the upgrading of their performance rights from the possibility of preventing certain activities such as the recording and broadcasting of their performances without their consent to exclusive proprietary rights, as well as to asserting moral rights in respect of their performances.

Trademarks

The Trademarks Act 1999, together with the Trademark Rules 2001, is fairly modern and is TRIPs compliant. The proposed amendments currently under discussion seek to address mainly omissions and typographical errors in the legislation, although some substantive amendments are being contemplated.

One of the substantive amendments proposed will have the effect of expanding the grounds of revocation to include circumstances where a mark, even though previously used, has not been used for a period of three years without any proper reasons for this non-use. Furthermore, the existing ground for revocation, being “that the trademark is likely to deceive or confuse the public on account of its use by the proprietor or with his consent in relation to the goods or services or which it is registered”, will be expanded to include express reference to the situation where the public is deceived or confused as to the nature, quality or geographical origin of the goods or services.

It is also proposed that Rule 12 of the Trademark Rules 2001, which concerns opposition proceedings, be amended to provide for a cooling-off period to allow for the suspension, by agreement of the parties, of the time period within which to file the counterstatement to enable them to pursue a settlement.

Other proposed amendments concern:

- the treatment of assignments and registrable transactions;
- the requirement for additional information in relation to applications for the registration of registrable transactions;

- the payment of registration and publication fees as a prerequisite for the publication of a trademark; and
- the simplification of the rules regarding correction of irregularities, calculation and extension of time.

Trademark rulings

The rules regarding correction of irregularities, calculation and extension of time (Rules 52 to 54 of the Trademark Rules 2001) have been considered ambiguous and in need of revision.

Rule 52(2) gives the registrar of industrial property the discretion to direct that the period of time specified for compliance with any procedure or formality be altered to account for irregularities or prospective irregularities that:

- consist of a failure to comply with any limitation as to times or periods specified in the act or rules;
- have occurred or appear to the registrar as likely to occur in the absence of a direction under this rule; or
- are partly or entirely attributable to an error, default or omission on the part of the Jamaica Intellectual Property Office (JIPO) or the registrar, where it appears to the registrar that this should be rectified.

This rule was tested when the registrar determined that the proprietor of the CELESTIAL trademark had failed to meet the deadline for filing a counterstatement to an application for revocation of the mark, even though the proprietor had submitted to the JIPO before the deadline the grounds of counterstatement and a request for an extension of time within which to file the counterstatement, together with a cheque to cover the statutory fees. The cheque had been made out to the incorrect payee and by the time the JIPO brought this error to the attention of the proprietor the deadline for filing had passed. The JIPO treated the documents as having been received on the day the corrected cheque was submitted, thereby disregarding the proprietor’s application for an extension of time.

The proprietor applied to and obtained from the Supreme Court a stay of execution of the registrar’s decision and consequently applied for an extension of time within which to file the counterstatement and affidavit of evidence of use, and sought a hearing before the registrar to consider the application.

The registrar, applying Rule 52(2), exercised his discretion in favour of the proprietor, based on the grounds that:

- there is no specific direction under the Trademark Rules to deal with the payment of statutory fees by way of a cheque:

- the registrar had failed to alert the proprietor's agents to the error on the cheque in good time; and
- the proprietor, having acted in good faith, ought not to be penalised in such circumstances.

In another matter, the registrar's decision to withdraw marks that had been previously accepted for registration on the basis that they had been accepted in error pursuant to Section 24(1)(b) of the Trademarks Act was successfully challenged on appeal to the Supreme Court by the proprietor of the trademark SOY & JOY.

The registrar's initial decision to accept the marks had been made on the basis that an earlier application by another proprietor to register a similar mark, SOY JOY, had been withdrawn as the prescribed fee for completion of the registration process was not paid within the prescribed time. After provisional acceptance of the SOY & JOY trademark application, it came to the registrar's notice that the earlier application had not been properly withdrawn as the notice required under the act to be issued was never received by the proprietor. Therefore, the registrar withdrew the acceptance of the SOY & JOY mark, ruling that the earlier pending registration of the SOY JOY mark would have acted as a bar to the registration of the SOY & JOY mark.

The Attorney General's Chambers advised that, in light of Section 9 of the Interpretation Act, which provides that "where no time is prescribed or allowed within which anything shall be done, such thing shall be done with all convenient speed", the proprietor of the earlier trademark should have paid the fees "with all convenient speed", failing which its application was to be deemed withdrawn. On the basis of this advice a settlement was agreed between the parties and a consent order was entered before the court, further to which certificates of registration were issued in respect of the SOY & JOY mark.

The JIPO now routinely issues notices of acceptance prescribing a two-month period from the date of the notice within which to pay fees for publication of the mark in the *Gazette*, failing which the application will be deemed to be withdrawn pursuant to Section 24(2).

Copyright cases

Civil action

On July 20 2005 Business Software Alliance (BSA) member Microsoft Corporation obtained an *ex parte* court order against a computer retail outlet that was allegedly infringing Microsoft's copyright in its computer programs. The action was the first civil suit in respect of copyright infringement initiated by a BSA member in Jamaica.

The court issued an Anton Piller order, which allowed Microsoft, to enter and search the outlet and seize items that appeared to infringe its software copyright without prior warning to the alleged infringer. Computers and sales data were seized for further inspection. At a hearing on July 29 2005 it was ordered by consent that the retail outlet would, without admitting liability, give a written undertaking to the Supreme Court that it would not offer for sale or sell any Microsoft software programs without the proper licences from Microsoft, and that it would pay an agreed sum in full and final settlement of the claim. The undertaking was given on August 2 2005.

The BSA, which has an anti-piracy programme in Jamaica, was pleased with the outcome of the court action and viewed it as an indication of a recognition of and respect for IP rights in Jamaica.

Criminal action

Reacting to the pervasive and crippling nature of IP piracy and counterfeiting in Jamaica, criminal prosecutions against alleged pirates and counterfeiters have risen sharply in recent years. Since January 2005 12 criminal prosecutions have been initiated, the majority of which concern the piracy of music CDs. In a criminal action in respect of piracy of copyright in literary works the complainant, a music teacher and author of a textbook for the recorder entitled "Tu Tu Tu Tu", noticed that a local music shop had significantly reduced its order for copies of her books. She subsequently discovered that the shop was selling copies of her book that did not bear her special security stamp. The author's report to the police resulted in a raid of the store and the arrest of its owner in June 2004. Lawyers for the author obtained an order enabling them to appoint a private prosecutor in place of the crown prosecutor. The judge, ruling in favour of the accused on October 31 2005, was not satisfied from the evidence that the store knew or had reason to believe that it was dealing with infringing copies. Such knowledge or belief is a requirement in copyright offences.

Other copyright developments

Regional steering committee for reproduction rights management

A regional steering committee for the management of photocopying and other reprographic rights has been formed to pave the way for the establishment of a collecting society representing authors and publishers in the Caribbean. The committee was created during a regional consultation organised jointly by WIPO and the International Federation of Reproduction Rights Organisations in cooperation with the JIPO and the

Jamaican Copyright Licensing Agency held in Jamaica in September 2005. A legal and feasibility study commissioned by the federation, Access Copyright of Canada and the agency formed the basis of the consultation.

Thirteen member countries of the Caribbean Community and Common Market (CARICOM) participated in the consultation and recommended that a regional entity be established to lead, coordinate and undertake appropriate functions on behalf of rights holders in the region in the area of reprography. Representatives from Barbados, Belize, Jamaica, Trinidad & Tobago and the Organisation of Eastern Caribbean States have been nominated to the steering committee, which has been mandated to facilitate the timely implementation of the recommendations adopted by the regional consultation.

Free trade area of the Americas and CARICOM

The negotiations of the Free Trade Area of the Americas (FTAA), with its proposed IP chapter and the promise of greater market access and special considerations for small and medium-sized economies, have stalled, leaving Jamaica and other CARICOM countries to

recalibrate their trade strategies while seeking to secure continued market access to the United States.

Although CARICOM countries have been hesitant to negotiate greater IP protection in the FTAA than that provided in TRIPs, CARICOM (which is chaired by Jamaica) sought to jumpstart the dormant FTAA negotiations by calling for a meeting of the FTAA trade negotiations committee before the Fourth Summit of the Americas in November 2005. Hoping for a move towards an FTAA consensus text for the summit declaration, and noting that the countries have committed considerable time and resources to the process, CARICOM wrote to the committee outlining its concerns and reaffirming its commitment to the FTAA.

This was not the first attempt by CARICOM to wake the sleeping giant. With the future of the FTAA still uncertain and the United States proceeding with bilateral and sub-regional trade agreements akin to the objectives of the FTAA, these countries may be left to find other avenues such as the CARICOM single market and economy, CARICOM free trade agreements and the World Trade Organisation Doha Round negotiations to realise their development agendas.

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