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## New Trade Mark Law now in force in Jamaica

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**T**RADEMARKS ACT 1999 The Trade Marks Act, 1958 and Trade Marks Rules, 1958, have been succeeded by the Trademarks Act, 1999 and Trademark Rules 2001, which conform to obligations under the WTO-TRIPS Agreement as well as obligations under the USA/Jamaica Bilateral Agreement on Intellectual Property Rights.

Already several applications have been filed under the weeks-old Act, which came into force upon the promulgation of the Trade Mark Rules on September 3, 2001.

**NEW PROVISIONS** The new Trademarks law has the effect of expanding the definition of a trademark to include the shapes of goods and their packaging. A trademark is protected for a period of 10 years (renewable).

In addition the new law introduces new substantive and procedural provisions as outlined below.

### Multi-class applications:

An applicant for a registered trademark is now able to apply for the registration of one mark in several classes under a single application, with a reduced fee for the additional classes. The Multi-class facility will mean considerable savings on statutory fees for applicants.

### Registration of Service Marks:

Proprietors can now register their service marks in various classes including financial, business, construction and repair, transportation, education, telecommunications, entertainment, insurance, advertising, travel and other matters.

### Right of Priority for Overseas Registrations:

The Law recognizes the right of priority in respect of trademark applications from nationals of countries that are members of the Paris Convention. Such an applicant can claim the right of priority within 6 months of the date of filing in Jamaica. With a priority claim the filing date in Jamaica becomes the effective filing date for the applicant's overseas registrations.

### Other Changes:

The Law now allows for the registration of collective marks and the registration of charges on trade-

marks. Well-known marks and emblems of international organizations are also now protected. Registration can take place in electronic form.

**ENFORCEMENT PROVISIONS** The Merchandise Marks Act (1888) imposes sanctions on certain actions in connection with Trademarks such as forgery of trademarks and false description of goods. The Merchandise Marks Act provides for fines and forfeiture of goods. It is expected that the sections of the Merchandise Marks Act relating to trademark enforcement will be repealed in light of the enforcement provisions under the new Trade Marks Act of 1999.

The Trademarks Act of 1999 empowers the Commissioner of Customs to seize goods infringing registered or well-known trademarks and provides a number of remedies including an order for forfeiture of infringing items, destruction of infringing items, damages, injunctions, and account of profits.

**FEES** The statutory fees for registration of a Trademark under the new Trademark Act have been increased by \$1000 Jamaican dollars. The total fee for one application in one class is \$7000 Jamaican plus publication cost which is in the region of \$1,320. In a multi-class application the statutory fee for each additional class is \$1000.

**ADMINISTRATION** The Registrar of Industrial Property of the Jamaica Intellectual Property Office (JIPO) administers the Trademark Act, 1999. Until JIPO becomes a Statutory Corporation, however, applications are to be addressed to the Registrar of Companies c/o Holborn House, 1b Holborn Road, Kingston 5.

**THINGS YOU SHOULD KNOW ABOUT TRADEMARKS** A trademark is a distinctive sign (including words, numbers, symbols, letters, shapes and in some jurisdictions, colours and smells), which identifies products/services as those produced or provided by a specific person or enterprise.

### Valuable Intellectual Property Rights (IPRs):

Trademarks are very valuable IPRs. They play a pivotal role in the marketplace by identifying and dis-

tinguishing the products/services of one trademark owner from the products/ services of another. Trademarks are key to developing a company's goodwill and reputation on the marketplace.

**Branding:**

• ***Branding is a marketing strategy, which addresses an entire product or product line of a proprietor.***

Trademarks add an important element to branding, which involves the use of trademarks, trade dress and advertising to promote a particular commodity or line of products. One trademark owner may use several brand names on similar products to appeal to different types of consumers or different types of markets.

**Rights of a registered Trademark Owner:**

Registration of a trademark affords the trademark owner legal protection against infringing acts by prohibiting a competitor from using a similar mark for a similar product/service, which confuses consumers as to whose product/service it is.