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### Jamaica

### A growing awareness of IP value

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# Jamaica

## A growing awareness of IP value

Since the early 1990s, Jamaica has steadily revised and replaced outdated intellectual property laws. Jamaica has new and modern legislation in copyright, trademarks, layout designs of integrated circuits and most recently, geographical indications.

The business community has also displayed a heightened awareness of the role of IP in business profitability and consequently, businesses and entrepreneurs have been more intensively using the IP system and adhering to best practices in IP management. Similarly, academic and professional institutions as well as trade associations recognising the importance of IP have begun to reform their policies accordingly.

The Jamaica Intellectual Property Office (JIPO) was established as a statutory body on 1st February 2002. JIPO has responsibility for all IP laws, some of which were previously administered through various government departments. As the focal point for IP administration in Jamaica, JIPO has made it more convenient for trademark and patent agents to conduct matters on behalf of their clients and for the general public to access information on the laws and systems.

### Trademark system enhanced

The World Intellectual Property Organisation (WIPO), in collaboration with the government of Jamaica, is providing JIPO with technical assistance to automate the trademarks, patents and industrial designs registration system. Already, the automation of the trademarks system is at an advanced stage and is expected to be fully operational before the end of 2004. This should lead to improvements in efficiency in conducting searches that are currently done manually, and enable the electronic filing of applications.

Prior to the enactment of the Trade Marks Act of 1999, trademark registration was available only in respect of goods. Service-oriented companies had to fit their trademark applications into categories of goods. With the coming into effect of the Act in September 2001, service marks could be registered as Jamaica adopted the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) (8th Edition). Certification marks are now also protected. Consequent on the enactment of the Act, businesses in the service industries such as finance, broadcasting, telecommunications, legal, retail, tourism, cultural, educational, entertainment and sports have significantly increased their utilisation of the system to better protect their service marks.

### Use of the trademark system

There has been an increase in use of the system by both foreign and local enterprises, owing to greater penetration of foreign businesses into Jamaica and an awakening of indigenous businesses and individuals to the value of trademarks. A growing trend among Jamaican performing artists and popular musicians is registering their images and stage names as trademarks. Similarly, broadcast houses are increasingly protecting their station identifiers and programme names as trademarks. In the 2002 case of *Radio Jamaica Limited v Bodley*, the plaintiff media house successfully obtained an interim injunction preventing the defendant from continuing to use the programme name The Ultimate Factor after the defendant moved to another radio station.

In relation to the value of IP to the media house, Stephen Greig, attorney of law and company secretary for the RJR Communications Group, has said: "The Group has always recognised the importance of intellectual property. As one of the largest media companies in the English-speaking Caribbean it is well appreciated that content and the rights associated with it has intrinsic value and should be afforded all its due recognition.

Intellectual property is featured in almost every facet of our operations from the trademarks in our brands to the copyright in the various local and international programmes broadcast on the stations."

Another growing trend is for individuals and enterprises to double protect their trademarks as domain names on the internet. Currently, domain names for the country-level domain .jm are registered at no cost by the University of the West Indies, Mona Campus, Jamaica.

Trademark proprietors are beginning to use the criminal courts to prosecute trademark offences. Two businessmen were arrested in October 2004 on breaches of the Trade Marks Act in connection with the Puma® and Green Pack® marks, bringing the number of such criminal actions to around four in 12 months.

### New Civil Procedure Rules

The Supreme Court of Judicature of Jamaica adopted new Civil Procedure Rules, effective January 2003, which have positively transformed the process of adjudication of civil cases.

Prior to the new rules, the process for having a matter heard was both tedious and protracted, and several would-be intellectual property litigants opted to settle matters out of court just to avoid the delays in the court system. The result has been an underdeveloped local jurisprudence in the area of IP and

much of the interpretation of IP statutes has been left up to legal opinions rather than court judgments. The new rules have institutionalised mediation. This has led to more matters being satisfactorily determined in less time, although jurisprudence is still sparse.

### Actions in the Commercial Court

Established in March 2001, the Commercial Court, an arm of the Supreme Court, has dealt with copyright administration and royalty determination, trademark infringement and counterfeiting, passing-off and copyright infringement. Most of these matters have been determined in favour of the rights holder at the interlocutory stage and have not proceeded to trial.

For example, in an effort to protect their brand from counterfeit in Jamaica, the proprietors of the popular DIESEL® trademark, in July and August 2003, launched civil actions against three store owners for selling counterfeit DIESEL® products. The judge decided in favour of the trademark proprietors, giving them the right to raid the establishments without prior knowledge of the store owners, seize the products and then have the marks erased/obliterated and the products destroyed or donated to charity.

### Copyright prosecutions

Jamaica's robust and fairly modern copyright law dates back to 1993 with an amendment in 1999 which gave effect to provisions protecting original databases and penalising unauthorised decryption of programme-carrying satellite signals in accordance with the TRIPs Agreement and a Bilateral Agreement on Intellectual Property Protection and Enforcement between Jamaica and the United States signed in 1994.

The law lay on the books untested by the criminal courts for years. The police were hesitant to enforce their powers under the law due in part to its novelty and right holders were often reluctant to follow through with a complaint. Additionally, the perception existed that copyright piracy was not really a crime. Massive public sensitisation on the negative impact of copyright piracy, coupled with the recent formation of the Intellectual Property Branch of the Organised Crime Division within the police force, has resulted in copyright holders, such as the Jamaica Association of Composers, Authors and Publishers, the Jamaican Copyright Licensing Agency and the Business Software Alliance, being more vigilant in enforcing their rights and the police being more proactive.

In the past 12 months at least 20 alleged offenders have been brought before the criminal courts to answers to charges of

breaches of the Copyright Act and 12 of them have already been sentenced.

Most offenders were caught by the section of the law which penalises the selling or offering or exposing for sale or hire, public exhibition and distribution, in the course of a business, of infringing copies of protected works, knowing that the copies are not legitimate. The type of work most pirated was music and the format of copies mainly CDs, cassettes and DVDs. A few of the criminal actions have concerned piracy of computer software, books and merchandise.

These offences have been prosecuted before the lower courts and carry a maximum fine of J\$100,000 (approximately US\$1,640) and/or a maximum prison term of two years. In practice, most offenders are convicted on multiple counts and receive in the region of J\$30,000 or six months in prison for the first count, a lower fine for the second, plus 18 months hard labour, usually suspended for a couple years. The seized items are confiscated and ultimately destroyed.

A historic public destruction of pirated works, confiscated by the courts, was staged on 23rd June 2004 by JIPO, in association with copyright industry groups and the courts. More than 4,000 CDs, 700 cassettes and 14 DVDs were crushed in full view of the media. The government and industry are hoping to convey to the public a strong signal of their lack of tolerance for piracy and their intention to prosecute offenders to the full extent of the law.

### **New copyright regulations**

The Copyright (Designation of National Cultural Events) Order 2003 was promulgated on 24th December 2003. Creative works and performances at the national cultural events outlined in the regulations are to be subject to royalty rates fixed by the Copyright Tribunal and licensing bodies administering public performance rights will not have the right to negotiate or require royalties directly from the organisers of these events.

The national cultural events designated under the regulations are events organised by a public body including commemorative events in recognition of:

- The birthday of a national hero.
- The birthday and the anniversary of the death of the Honourable Robert Nesta Marley, OM (Bob Marley).
- Jamaica's independence, emancipation and Labour Day.

### **Broadcasting regulations**

On 4th November 2003, a directive was passed under the Television and Sound Broadcasting Regulations of 1996

requiring all broadcast licensees to obtain prior authorisation from respective copyright owners before transmitting feature films and other programmes in which they do not own the broadcast rights. The directive followed on from the Broadcasting Commission's observation that some broadcasters were transmitting films and programmes without the permission of the copyright owner, contrary to the regulations.

### **New patent law slated for next year**

The Jamaica Patent Law dates back to 1857, with minor amendments made in 1974 and 1975. The old law is being revamped for TRIPs compliance by a draft bill on patents and designs, which is now being discussed. The bill is slated to be addressed during this legislative year (2004-2005). It is intended to incorporate provisions implementing the Paris Convention on Industrial Property to which Jamaica is a party as well as the Patent Corporation Treaty (PCT), which Jamaica intends to sign when the new law is passed. Jamaica has been placed on the US Trade Representative's Watch List for the lack of a modern patent law.

### **Use of the patent system**

The existing patent system is used by an overwhelming majority (over 90 per cent) of foreign entities and mainly as a means of re-registering existing foreign patents. Because Jamaica's Patent Act is based on local novelty, inventions which have already been patented in a foreign country can still be patented in Jamaica so long as the:

- Invention is new to Jamaica (ie, not introduced into public and common use).
- Foreign patent holder is the same as the local patent applicant.
- Subject of the application is the same as the invention under patent.
- Period of patent protection in the foreign country has not expired.

In the above case, the Jamaican patent would last as long as the foreign patent remains valid.

Despite the law being archaic, interest in the patent system by local inventors has been growing. Between 2001 and 2003 seven patents were granted to Jamaican inventors in the fields of pharmaceuticals, furniture building, and construction and information technology. In 2004, businesswoman Georgia Jefferson was granted letters patent for her invention of a natural preservative called NEUTRAGUARD® and entrepreneur

Audrey Marks was granted letters patent for her invention of an online, real-time multi-payment system branded PAYMASTER®. Designated local patent examiners are the Bureau of Standards and the Government Chemist.

### **New Geographical Indications Act**

A law for the protection of geographical indications was passed on 20th February 2004. The law seeks to comply with Articles 22 and 23 of the TRIPs Agreement. Regulations under the Act are pending.

### **Regional developments impacting Jamaica**

The 15-member Caribbean Community & Common Market (CARICOM), of which Jamaica is a founding member, is being transformed into a Caribbean Single Market and Economy (CSME) by January 2005. This will have far-reaching implications in the area of intellectual property rights protection and enforcement.

The Treaty establishing CARICOM, revised in 2001 to include the CSME, is the first Caribbean instrument expressly to provide for intellectual property rights issues to be addressed in the CARICOM. Article 66 of the CARICOM Treaty provides that the Council for Trade and Economic Development (COTED) should promote, among other things, the strengthening of regimes for the protection of IPRs and the simplification of registration procedures in the member states and the establishment of a regional administration for intellectual property rights except copyright.

It is clear that the establishment of a regional trademark and patent or industrial property office is contemplated by CARICOM, although it is not yet known what form such an office would take. This would be a major development for the region. The revised CARICOM Treaty also obliges member states to harmonise their laws and administrative practices in respect of, among other things, companies or other legal entities, intellectual property rights, standards and technical regulations, competition policy and commercial arbitration.

The revised Treaty also establishes the Caribbean Court of Justice (CCJ) which will, in its appellate jurisdiction, replace the role of the Privy Council and in its original jurisdiction interpret

provisions of the revised Treaty. Jamaica has already passed implementing legislation for the CSME and, in particular this year, the CCJ, and is working towards enacting the CCJ Constitutional Amendment Bill and the Judicature Appellate Jurisdiction Act. It is likely that a regional industrial property office could fall under the jurisdiction of the CCJ.

### **Corporate and institutional perspectives**

Corporate Jamaica has the imperative to survive and succeed in an increasingly competitive global environment, and is boldly moving towards adopting best practices in IPRs and actively lobbying the government to create better environments for increased global competitiveness.

Universities in the region have also come to recognise the benefit of the commercialisation of products of academic research and other creative endeavours, and as such have recently begun to develop IP policies with a view to acquiring IPRs as a springboard for such commercialisation.

Sandra Glasgow, former Executive Director of the Technology Innovation Centre (TIC), University of Technology, Jamaica, states that: "As a technology business incubator, TIC recognises the critical importance of addressing intellectual property issues as part of its roster of business support services provided to our clients. We have therefore addressed these issues in a number of ways such as identifying IP issues in the business plans of start-ups and organising training seminars on intellectual property."

Meanwhile, scientist and Director of GenoPro (Jamaica) Company Ltd Dr Gregory Simpson says: "Having an appropriately structured intellectual property framework within Jamaica is not only a prerequisite for our own business platform, but a necessity for the formulation of long-term alliances between our company and other players in the biotech sector internationally."

More so now than ever before, this sentiment resonates with corporate Jamaica, which is seeking to leverage its intellectual property to re-align itself competitively in the global marketplace.

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Previous appointments include special adviser on intellectual property, head, Jamaica's Copyright Unit, deputy chairman, Copyright Tribunal, vice president, WIPO Diplomatic Conference on the Protection of Audiovisual Performances.

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She holds a Master of Laws in commercial law from Aberdeen University, Scotland and Bachelor of Laws and Arts degrees from the University of the West Indies. She is Deputy Chairman of Jamaica's Copyright Tribunal. Previous appointments include General Counsel, Office of Utilities Regulation, special adviser on telecommunications and Crown Counsel.

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