

JAMAICA

No. 17 - 2013

I assent,

[L.S.]


Governor-General.

31st day of August 2013

AN ACT to Amend the Trade Marks Act; and
for connected matters.

[31st day of August 2013]

BE IT ENACTED by The Queen's Most Excellent Majesty, by and with the advice and consent of the Senate and House of Representatives of Jamaica, and by the authority of the same, as follows:—

1. This Act may be cited as the Trade Marks (Amendment) Act, 2013. Short title.

2.—(1) The provisions of the enactments specified in the first column of the Schedule are amended in the manner specified in the respective amendments in the second column thereof. Amendment of enactments and construction. Schedule.

(2) Each amendment shall be construed as one with the enactment specified in relation thereto.

SCHEDULE

Amendment of Enactments

First Column

Second Column

Provision

Amendment

Trade Marks Act

Section 2 (1)

1. Insert the following definitions in their appropriate alphabetical sequence—

“Convention country” means a country, other than Jamaica, that is a party to the Paris Convention;

“the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised or amended from time to time;

“Trade Marks Journal” means the Trade Marks Journal published by the Jamaica Intellectual Property Office; and

“WTO Agreement” means the Agreement establishing the World Trade Organization signed at Marrakesh on April 15, 1994.

2. In the definition of “sign”—

- (a) insert a closing bracket immediately after the word “name”; and
- (b) delete the bracket appearing after the word “packaging”.

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
Section 6	Delete— <p>(a) from subsection (1), the words “registered joint proprietors of a trade mark” and substitute therefor the words “joint proprietors of a registered trade mark”;</p> <p>(b) subsection (2).</p>
Section 7	Delete the section and substitute therefor the following— <p>“Application of the “registered trade mark as property” provisions.</p> <p>7. The provisions of sections 4, 6, 27, 30 and 75 (which relate to a registered trade mark as an object of property) shall apply, with the necessary modifications in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.”.</p>
Section 9	<p>1. Delete from subsection (5)(b) the word “sign” wherever it appears and substitute therefor in each case the words “the trade mark”.</p> <p>2. Delete from subsection (7) the word “partly” and substitute therefor the word “party”.</p>
Section 10	Insert next after subsection (2) the following as subsection (3)— <p>“ (3) Nothing in this Act shall be construed as entitling the proprietor of a registered trade mark to—</p> <p>(a) interfere with or restrain the use by any person of an un-</p>

First ColumnProvisionSecond ColumnAmendment

registered trade mark that is identical with or nearly resembling such registered trade mark, in relation to goods or services in connection with which that person or his predecessor in title has continuously used that unregistered trade mark, from a date prior to—

- (i) the use of the registered trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or
 - (ii) the registration of the registered trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his,
- whichever is earlier; or
- (b) object (on such use, as described in paragraph (a), being proved) to that person being put on the Register for that unregistered trade mark, in respect of those goods.”.

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
Section 12(1)	Insert immediately after the word “registered” the words “, unless the Registrar is satisfied that consent has been given by or on behalf of the Government”.
Section 14	<ol style="list-style-type: none">1. Delete from paragraph (b) of subsection (1) all the words appearing after the words “the application” and substitute therefor the words “, was entitled to protection, under the Paris Convention or the World Trade Organization Agreement, as a well-known trade mark; or”.2. In subsection (2) delete the words “as defined in subsection (1)(b) whose registration expires” and substitute therefor the words “referred to in subsection (1)(a), the registration of which expires,”.
Section 16	In subsection (1) delete the word “accompanies” and substitute therefor the word “accompanied”.
Section 22	Delete subsection (1) and substitute therefor the following— “ (1) On acceptance of the application along with the specified registration fee and advertisement fee, the Registrar shall cause the application to be published in the Trade Marks Journal in such manner as may

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
	be prescribed, and the date of publication shall be reckoned as the date of acceptance.”.
Section 30	In subsection (1) insert immediately after the words “this Act” the words “and shall be construed as notice to the Registrar of those particulars”.
Section 38	<p>1. Delete subsection (6) and substitute therefor the following—</p> <p style="padding-left: 40px;">“ (6) If the Court decides that an order shall not be made under this section, the person who was in possession, custody or control of the goods, material or articles before they were delivered up, is entitled to regain possession.”.</p> <p>2. Insert in subsection (7), immediately after the words “the Copyright Act” the words “or any other law as it relates to intellectual property, in force for the time being”.</p>
Section 43	<p>1. Delete subsections (1) and (2) and substitute therefor the following—</p> <p style="padding-left: 40px;">“ (1) The registration of a trade mark may be revoked on any of the following grounds—</p> <p style="padding-left: 80px;">(a) within the period of five years prior to the date of application for revocation, the trade mark has not been used for <i>bona fide</i> purposes in Jamaica in relation to the goods or services for which the trade</p>

First Column

Second Column

Provision

Amendment

mark is registered and there are no proper reasons put forward by the proprietor for its non-use;

- (b) the *bona fide* use of the trade mark has been suspended for a continuous period of five years prior to the date of the application for revocation, and there are no proper reasons put forward by the proprietor for its disuse;
- (c) as a result of the act or failure to act on the part of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which the trade mark is registered; or
- (d) the trade mark is likely to deceive or confuse the public as to the nature, quality or geographical origin of goods or services or on account of its use by the proprietor, or with his consent, in relation to the goods or services for which it is registered.

(2) For the purposes of subsection (1)—

- (a) “use of a trade mark” includes use in a form differing in

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
	<p>elements which do not alter the distinctive character of the mark in the form in which it was registered; and</p> <p>(b) “use in Jamaica” includes affixing the trade mark to goods or to their packaging in Jamaica where those goods are solely for export.”.</p> <p>2. In subsection (3) —</p> <p>(a) insert immediately after the words “subsection (1)(a)” the words “or (b)”.</p> <p>(b) delete the words—</p> <p style="padding-left: 40px;">(i) “three years” and substitute therefor the words “five years”; and</p> <p style="padding-left: 40px;">(ii) “three year period” and substitute therefor the words “five year period”.</p>
Section 44(2)	Delete the words “and where” and substitute therefor “and if in any other case”.
Section 46	Delete the section and substitute therefor the following—
	<p>“Application for declaration of invalidity.</p> <p>46.—(1) Subject to subsection (2), an application for a declaration of invalidity may be made by any person to the Registrar or the Court.</p>

First Column

Second Column

Provision

Amendment

(2) If proceedings are pending in Court concerning the trade mark in question, an application under this section shall be made to the Court and if in any other case the application is made to the Registrar, he may at any stage refer any matter arising from the application, to the Court.

(3) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(4) The Registrar may apply to the Court for a declaration of the invalidity of the registration of a trade mark in the case of bad faith or error in the registration.

(5) Where the registration of a trade mark is declared invalid to any extent, then the registration shall, to that extent be deemed to have never been made, but without prejudice to any transaction past and closed.”.

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
Section 48	Delete subsection (1) and renumber subsections (2) and (3) as subsections (1) and (2), respectively.
Section 49(2)	<p>Delete the subsection and substitute therefor the following—</p> <p style="padding-left: 40px;">“ (2) A trade mark is entitled to protection under the Paris Convention if it is well known in Jamaica as being the mark of a person who is—</p> <p style="padding-left: 80px;">(a) a citizen of a Convention country; or</p> <p style="padding-left: 80px;">(b) habitually resident in, or has a real and effective industrial or commercial establishment in, a Convention country,</p> <p style="padding-left: 40px;">whether or not that person carries on business or has any goodwill in Jamaica and any reference to the proprietor of such a mark shall be construed accordingly.”.</p>
Section 58(3)	Delete the words “Office of the Registrar of Companies” and substitute therefor the words “Jamaica Intellectual Property Office”.
Section 59(2)(c)	Delete the words “Office of the Registrar of Companies” and substitute therefor the words “Jamaica Intellectual Property Office”.
Section 78(g)	Delete the words “Office of the Registrar of Companies” and substitute therefor the words “Jamaica Intellectual Property Office”.

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
New section 81	<p>The principal Act is amended by renumbering section 81 as section 82 and inserting next after section 80, the following as section 81—</p> <p style="margin-left: 40px;">“Minister may amend monetary penalties. 81. The Minister may, by order, subject to affirmative resolution, amend the monetary penalties specified in this Act.”</p>
Third Schedule	<ol style="list-style-type: none">1. Delete paragraph 2(1) and substitute therefor the following—<p style="margin-left: 40px;">“ (1) All existing registered marks registered in Part A or B of the old register shall be deemed to have been transferred to the Register on the appointed day and shall have effect, subject to the provisions of this Schedule, as if registered under this Act.”</p>2. In paragraph 9(2) delete the number “79” and substitute therefor the number “78”.3. In paragraph 13(1) and (2) delete the number “7” wherever it appears and substitute therefor in each case the number “8”.4. Delete paragraph 15(2) and substitute therefor the following—<p style="margin-left: 40px;">“ (2) An application under section 43(1)(a) or (b) of this Act may be made at any time after the appointed day, in relation to an existing registered mark other than an existing registered mark</p>

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
	registered by virtue of section 29 of the 1958 Act.
	5. In paragraph 18, delete the number “66” and substitute therefor the number “65”.
Trade Marks Rules, 2001	
Rule 2(1)	Delete from the definition of “the Office” the words “Office of the Registrar of Companies” and substitute therefor the words “Jamaica Intellectual Property Office”.
Rule 12	1. Insert next after paragraph (3) the following as paragraph (3A)— <p style="margin-left: 40px;">“ (3A) At any time before the two month period referred to in paragraph (3) expires, the parties may agree to a two month extension of time for the filing of Form TM5 (hereinafter in this rule referred to as the “cooling-off period”).”.</p> 2. Delete paragraph (4) and substitute therefor the following— <p style="margin-left: 40px;">“ (4) At any time before the expiry of the cooling-off period, the Registrar may, as he sees fit; grant such further extensions of time as may be— <p style="margin-left: 80px;">(a) requested in writing by the applicant accompanied by the payment by the applicant of the cooling-off fee prescribed in the First Schedule; and</p> </p>
	First Schedule.

First Column

Second Column

Provision

Amendment

(b) agreed to in writing by the opponent, up to a period of six months following on the expiration of the cooling-off period.”.

3. Renumber paragraphs (5) to (16) as paragraphs (7) to (18) and insert the following as paragraphs (5) and (6)—

“ (5) Within one month of the expiry of the cooling-off period, the applicant may submit a counter-statement on Form TM5, to the Registrar who shall send a duplicate of the counter-statement to the opponent.

(6) If the applicant fails to file a counter-statement referred to in paragraph (5) within one month after the expiry of the cooling-off period, his application for the registration of the trade mark shall be deemed to be withdrawn.”.

Rule 26(2)

Delete the paragraph and substitute therefor the following—

“ (2) Where any application is made under paragraph (1) by a person other than the proprietor of the registered trade mark—

(a) it shall be accompanied by two copies of the application and statement; and

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
	(b) the copies referred to in subparagraph (a) shall be transmitted forthwith by the Registrar to the registered proprietor.”.
Rule 26(3)	Delete the paragraph and substitute therefor the following— <p style="text-align: center;">“ (3) Within two months of the date of receipt of the application and statement by the proprietor, the proprietor may file in duplicate a counter-statement together with Form TM5 and the Registrar shall send the duplicate thereof to the applicant.”.</p>
Rule 30(2)	Delete the paragraph and substitute therefor the following— <p style="text-align: center;">“ (2) An application made under paragraph (1) shall—</p> <p style="text-align: center;">(a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment; or</p> <p style="text-align: center;">(b) where the transaction is within the scope of subparagraph (b), (c) or (d) of paragraph (1), be signed by or on behalf of the grantor of the licence or security interest,</p> <p style="text-align: center;">and be accompanied by such supporting documentation as the Registrar considers to be sufficient to verify the transaction.”.</p>

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
Rule 39(3)(f)	Delete the number “41” and substitute therefor the number “40”.
Rule 52	Delete the rule and substitute therefor the following— “Correction of irregularities in procedure. 52. Subject to rule 54, any irregularity in procedure in or before the Office or the Registrar may be rectified on such terms as the Registrar may direct.”.
Rule 53	Delete the rule and substitute therefor the following— “Excluded days. 53.—(1) The Registrar shall, where the time for doing anything under these Rules expires on an excluded day, extend that time to the next following day not being an excluded day. (2) In this Rule “excluded day” means a day on which— (a) the Office is not open; or (b) there is a general interruption and subsequent dislocation of the postal services of Jamaica.”.

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
Rule 54	<p>Delete the rule and substitute therefor the following—</p> <p style="margin-left: 2em;">“Alteration of time limits or periods upon request, etc.</p> <p style="margin-left: 2em;">54. —(1) The times or periods—</p> <p style="margin-left: 4em;">(a) prescribed by these Rules, other than times or periods prescribed by the rules mentioned in paragraph (6); or</p> <p style="margin-left: 4em;">(b) specified by the Registrar for doing any act or taking any proceedings,</p> <p style="margin-left: 2em;">may, at the written request of the person or party concerned, or on the initiative of the Registrar, be extended by the Registrar as he thinks fit and upon such terms as he may direct.</p> <p style="margin-left: 2em;">(2) The following provisions apply where a request for the extension of a time or period prescribed by these Rules has been made—</p> <p style="margin-left: 4em;">(a) if the request is filed after the application has been published under rule 12, it</p>

First Column

Second Column

Provision

Amendment

Second
Schedule.

shall be on Form TM25 in the Second Schedule, and shall in any other case be on that form if the Registrar so directs;

(b) if the request is sought in respect of a time or periods prescribed by rule 12(1), 12 (3), 12(4), 14, 19, 21(1), 24 or 26(3), the party seeking the extension shall send a copy of the request to each affected person.

(3) Subject to paragraph (4), a request for extension under paragraph (1), shall be made before the expiration of the time period in question.

(4) Where a request for extension is made after

First ColumnProvisionSecond ColumnAmendment

the time period referred to in paragraph (3), the Registrar may extend such time period if the Registrar is satisfied with the reason given for the delay in requesting the extension.

(5) Where—

- (a) the period in which any party to any proceedings before the Registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence; and
- (b) that other party notifies the Registrar that he does not wish to file any, or any further, evidence,

the Registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in

<u>First Column</u>	<u>Second Column</u>
<u>Provision</u>	<u>Amendment</u>
	the direction and shall notify all parties to the proceedings of that date.
	(6) The rules excepted from paragraph (1) are rules 9(7), 10 and 25.”.
First Schedule	Renumber items 1(b) to (d) as items 1(c) to (e) and insert in the appropriate columns the following as item 1(b)— “(b) cooling off period ... 12(4) \$6,000.00”
Second Schedule	1. Delete the words “Full name, address and postcode of the applicant” wherever they appear and substitute therefor, in each case, the words “Full name, address, Taxpayer Registration Number (TRN) (in the case where the person is resident in Jamaica) and postal code of the applicant”. 2. In Form TM1— (a) delete from item 6 the third column headed “Being used/ <i>Bona Fide</i> intention to use”; and (b) insert in item 10 immediately before the word “Signature” the words— “I hereby declare that the trade mark is being used by the applicant or with his consent, in relation to the goods or services stated, or

First ColumnSecond ColumnProvisionAmendment

there is a *bona fide* intention that it will be so used.”.

3. In Form TM3—

- (a) in the heading delete the words “Request to appoint an agent or to enter change of address for service” and substitute therefor the heading, “Request to appoint or change an agent or enter or change an address for service”; and
- (b) delete item 4 and substitute therefor the following—

“4. On behalf of the proprietor, licensee or opponent, I/ we notify you that I am/we are—

- (a) authorized to receive service at my/our address;
- (b) the authorized agent.

(Indicate as appropriate).”.

4. In item 6 of Form TM6, insert next after sub-paragraph (b) the following as sub-paragraph (c)—

“(c) obvious mistakes”.

Form TM25

Insert next after Form TM25 the following—

“
 Form TM25A
 TRADE MARKS ACT
Request for a Cooling-off Period

1. Trade Mark number	
2. Opposition number	
3. Full name of person or company making this request	
4. Taxpayer Registration Number	
5. Is this the applicant or the opponent?	
6. Name and address (including postcode) of the agent (if any)	
7. Declaration	I confirm that the other party to these proceedings has agreed to this request for a cooling-off period.
Your signature	
Date	
8. Name and daytime phone number of the person we should contact in case of query	
9. Your Reference	
Number of sheets attached to this form	

Note: You shall get the other party’s written agreement to this request before you sign the declaration in question 6. Please attach the agreement to this Form.”.

Fourth Schedule Insert next after Class 42 the following—

- “Class 43 Services for providing food and drink; temporary accommodation.
- Class 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- Class 45 Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.”.

Passed in the House of Representatives this 16th day of July 2013.

MICHAEL A. PEART
Speaker.

Passed in the Senate this 26th day of July 2013.

FLOYD E. MORRIS
President.

This printed impression has been carefully compared by me with the authenticated impression of the foregoing Act, and has been found by me to be a true and correct printed copy of the said Act.

Clerk to the Houses of Parliament.