

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Jamaica

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

Copyright and related rights

The Resident Magistrates Court in respect of a claim for damages of a sum not exceeding \$250,000; the Supreme Court in respect of larger sums and injunctive relief. Both courts are empowered to grant other ancillary relief such as delivery up, destruction, and account of profits.

Trademarks and designs

In respect of trademarks, industrial designs and patents infringement cases, the courts which would have jurisdiction would be courts for the enforcement of law in general. These are the Resident Magistrates Court, the Supreme Court, the Court of Appeal, the Revenue Court, the Commercial Court.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Copyright and related rights

Right holders, their heirs, assigns and licensees have such right. Attorneys-at-law may represent them. If an attorney has not been retained because of financial constraints then an attorney on the legal aid roster may be assigned to the case. Personal appearance is mandatory.

Trademarks and designs

Right holders, assigns and licensees have standing to assert intellectual property rights.

These persons may be represented by an attorney-at-law, and if because of financial reasons, they are not able to afford one privately, an attorney may be obtained through the legal aid facilities.

Personal appearance before the court by the right holder or the plaintiff in the action is not mandatory. A defendant, however, is compelled by the law to enter an appearance to a writ of

¹ Document IP/C/5.

summons within fourteen days from the service of such either by himself or through his attorney. This is supported by Sections 52, 55 and 56 of the "Consolidated Judicature (Civil Procedure Code) Law Chapter 177".

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence that lies within its control?

Copyright and related rights

The Copyright Act of 1993 provides that a court may grant an order for delivery up in respect of infringing copies of the protected work (Section 33) or the illicit recording of the performance (Section 133).

Trademarks and designs

Judicial authorities are empowered to order at the request of the opposing party, a party to a proceeding to produce evidence which lies within its control. This is provided for under Section 35 of the Trademarks Act. Note also that: The Consolidated Judicature (Civil Procedure Code) Law, Chapter 177" which governs all civil proceedings to be conducted before the courts of Jamaica, confers this authority.

This is supported by Section 286 which states:

"It shall be lawful for the Court or a Judge, at any time during the pendency of any cause or matter, to order the production by any party thereto, upon oath, of such of the documents in his possession or power, relating to any matter in question in such case or matter, as the Court or Judge shall think right; and the Court may deal with such documents, whether produced, in such manner as shall appear just."

and Section 374 which states:

"The Court or a Judge may in any cause or matter, at any stage of the proceedings, order the attendance of any person for the purpose of producing any writing or other documents named in the order which the Court or Judge may think fit to be produced.

Provided that no person shall be compelled to produce, under any such order, any writing or other document which he could not be compelled to produce at the hearing or trial."

4. What means exist to identify and protect confidential information brought forward as evidence?

Copyright and related rights

Evidence produced during the course of a trial is labelled and kept by the court in a secured area or vault.

Trademarks and designs

Confidential information brought forward as evidence is usually labelled by the judge and the judge usually instructs the Registrar of the Supreme Court to have custody of such matter. In situations where proceedings relate primarily to confidential information, the proceedings can be held *in camera* which excludes public attendance.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use;

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Copyright and related rights

Section 32 of the Copyright Act provides that an infringement of copyright shall be actionable at the suit of the copyright owner for such relief as damages, injunction, accounts or otherwise as is available for the infringement of other proprietary rights. Further where the infringement is flagrant, the court has a discretion to award additional damages. It is important to note that while *mens rea* of the existence of copyright in the work is a prerequisite for an award of damages, this does not prejudice the plaintiff in successfully getting any other remedy.

- Injunctions

The court has a discretionary power to grant interlocutory and Anton Pillar injunctions.

- Damages, including recovery of profits, and expenses, including attorney's fees

The court has discretionary powers to grant a request for an account of profits, and an award of damages. The court also has a discretionary power to order the unsuccessful litigant to a suit to pay the attorney's fees of the successful litigant. However, Section 35 of the Copyright Act provides that where an action is brought by an exclusive licensee and the copyright owner is joined in the suit in order to avail himself of a remedy which would have been available to the copyright owner only, the copyright owner would not be liable for any costs in the action unless he takes part in the proceedings.

- Destruction or other disposal of infringing goods and materials/implements for their production

Section 137 of the Copyright Act provides that the Court may make an order for the destruction of a infringing copy or article specifically designed or adapted for making copies of a particular protected work or an illicit recording of a performance.

Trademarks, Patents and Designs

- Trademarks

In an action for infringement of a trademark, the court may order remedies such as damages, injunctions, accounts or otherwise.

Section 31 (2) of the Trademarks Act, 1999 supports this:

"In an action for infringement all such relief by way of damages, injunction, accounts or otherwise is available in respect of the infringement of any other property rights."

The court may apply other remedies such as order for erasure, order for delivery up; and order for disposal. These provisions are stipulated in the Trademarks Act, 1999 (not yet enacted).

Section 35 of the Trademarks Act, 1999, specifies the criteria where an order for erasure can be made. It states:

- "(1) The Court may make an order requiring the person who is found to have infringed a registered trademark,
 - (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, materials or articles in his possession, custody or control; or
 - (b) where it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles".

Section 36 of the Trademarks Act, 1999, specifies the criteria for issuance of an order for delivery up by the court. It states:

- "(1) The proprietor of a registered trademark may apply to the court for an order for the delivery up to him or to such person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of business."

Section 38 of the Trademarks Act, 1999, specifies the criteria for issuance of an order for disposal by the court. It states:

- "(1) An application may be made to the court,
 - (a) for an order that infringing goods material or articles delivered up pursuant for an order under Section 36 be destroyed or forfeited to such person as the court may think fit; or
 - (b) for a decision that no such order be made.
- (2) In determining what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the proprietor and any licensee and to protect their interests."

- Patents

Under the Patent Act 1857, a court can also grant remedies in respect of an infringement action, such as injunction, inspection or account, or other remedies.

This is evidenced by Section 45 which states:

"In an action for infringement of a patent, the court or a judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms, and give such directions respecting the same and the proceedings thereon. As the court or judge may see fit".

- Industrial designs

Under the Designs Act, 1937, the court by virtue of Section 21 can grant such remedies in infringement proceedings, such as orders for an injunction, inspection, or account, or any other as the court sees fit.

Section 21 states:

"In any proceedings under this Act, the court or a judge, as the case may be, may at any time make such orders for an injunction, inspection, or account, impose such terms, and give such directions as to the order in which the parties shall be heard, and the procedure under this Act generally, as the court or judge shall see fit".

- Draft Patent and Designs Act 2001

In relation to a patent, under this legislation, the owner of a patent who brings infringement proceedings may apply to the court for an injunction, damage, account of profits, order for the delivery up or destruction, or declaration that the patent is invalid; which in effect signifies that the court has power to grant these remedies as it sees fit.

Section 80 (1) states:

"(1) Subject to the following provision of this section and to Section 83, the patentee may bring proceedings in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) may apply for,

- (a) an injunction restraining the defendant from any acts of infringement;
- (b) damages in respect of the infringement;
- (c) an account of profits derived from the infringement;
- (d) an order for the delivery up or destruction of any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
- (e) a declaration that the patent is valid and has been infringed by the defendant."

In respect of an industrial design, under the Draft Patent and Designs Act 2001, the court can grant the same remedies to the registered owner with respect to infringement as those applicable to a patent under Section 80 (1) of the said legislation.

This is evidenced by Section 72 (2) which states:

"(2) The registered owner of an industrial design may, subject to the provision of Subsection (3), bring proceedings in respect of any act done without his consent which constitutes the exploitation of the design or which makes it likely that such exploitation will occur, and without affecting any other jurisdiction of the court, may make the same claims *mutatis mutandis* as those applicable under Section 80 in relation to an infringement of a patent".

The provisions governing the length and cost of proceedings

Note that no application for civil remedies can be made after the end of the period of six years from the date on which the infringing copy or article, or illicit recording in question was made (Section 138 of the Act). Save that, in the event of disability, fraud or concealment, the six years would begin to run from the date on which the disability ceased or discovery of the fraud or concealment could with reasonable diligence have been made.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods of services found to be infringing and of their channels of distribution?

Copyright and related rights

The court has an inherent jurisdiction under the Civil Procedure Code to order discovery of documents within the possession of the parties to the suit but there is no obligation to disclose information that may implicate third parties or disclose the identity of third parties believed to be accomplices. The court will not allow the disclosure process to be used as a fishing expedition.

Trademarks and designs

The court has an inherent jurisdiction under the Consolidated Judicature (Civil Procedure Code) Law, Chapter 177, at the application of any party to order discovery of documents and full disclosure of information relating to any proceedings, if he deems it appropriate.

Section 284 of the Code states:

"Any party may, without filing any affidavit apply to the court or a judge for an order, directing any other party to any cause or matter to make discovery on oath of the documents which are or have been in his possession or power relating to any matter in question therein.

On the hearing of such application the court or judge may refuse or adjourn the same, if satisfied that such discovery is not necessary, or not necessary at that stage of the cause or matter, or make such order either generally or limited to certain classes of documents, as may, in their or his discretion, be thought fit"

"Provided that discovery shall not be order when and so far as the court or judge shall be of the opinion that it is not necessary either for disposing fairly of the cause or matter or for saving costs."

- 7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

Copyright and related rights

Defendants who have been wrongly enjoined may demand reimbursement of costs incurred from the principal defendant(s). Public authorities are not empowered to intervene in civil proceedings brought against a defendant for redress of an infringement of a private right.

Trademarks and designs

The Consolidated Judicature (Civil Procedure Code) Law, Chapter 177, makes provisions for redress of defendants who have been wrongfully enjoined in a matter. This power lies with the court or a judge and the type of remedial measure granted is at the discretion of the court or judge.

The relevant provision is Section 93, which states:

"It shall not be necessary that every defendant shall be interested as to all the relief prayed for, or as to every cause of action included in any proceeding against him; but the court or a judge may make such order as may appear just to prevent any defendant from being embarrassed or put to expense by being required to attend any proceedings in which he may have no interest."

Further under Section 100 of the said Code, the court judge may order that the name of such defendants improperly joined, be struck out upon application of such defendants.

- 8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

The Supreme Court

The length of proceedings: Civil proceedings in the Supreme Court are governed by the Judicature (Civil Procedure Code) Law. The length of proceedings, that is the period from the commencement of the action to its conclusion, depends on the method of the commencement of the action, which is determined by the nature of the relief being sought.

Civil actions in the Supreme Court involve the filing of various documents by the parties involved in the matter. The Code stipulates the time-frame within which parties should operate but also allows for extensions of the stipulated time periods.

The writ of summons is the usual mode of commencing litigation where intellectual property rights have been infringed and monetary relief is being sought. At a minimum, the time for pleadings could take approximately two months, in the absence of delays or interlocutory applications.

Thereafter the matter awaits a date for trial. It is difficult to estimate the time-frame in which a matter will actually be heard as it must await its place on the trial list, which could take years.

It is expected however that this time-period will be tremendously shortened given the recent establishment of a Commercial Court.

Cost: The costs of proceedings are governed by the Rules of the Supreme Court (attorneys-at-law) Costs. The Rules allow for the recovery of costs either by way of taxation or without taxation in accordance with a schedule of costs.

They outline the basic costs for the various procedures involved in the litigation of a matter.

The Rules also make provision for the consideration of factors such as the complexity of the matter, the value of the property or the quantum of money in issue, and the standing of the attorney at the bar.

Data on the actual duration and cost of proceedings: The duration of the matters listed below must be considered within the context of what transpired. A synopsis of each case is given.

- McDonalds v. McDonalds

This involved a dispute between a Jamaican restaurant named McDonalds and the American owned company which established a branch in Jamaica. Both entities filed suits – the Jamaican company claiming passing off whilst the American company claimed a breach of its trademark. This occurred in October 1994.

The trial judge ruled on the injunction on 7 June 1996. The matter was appealed in the Court of Appeal and heard on 30 September 1996. The judgement was delivered on 20 December 1996.

Following the ruling of the Court of Appeal (which refused both injunctions) the matter was settled.

- The Marley case

The Marley Foundation claimed ownership to the name and likeness of Bob Marley and brought an action against a company that was making T-shirts bearing the image. The Foundation argued the existence of a new tort - the tort of appropriation of personality - and the court approved of this.

In this matter the suit was filed on 6 July 1992. The trial began on 7 February 1994 and judgement was delivered on 12 May 1994.

- K-Mart Corporation v. Kay Mart Limited

In this matter the proprietors of K-Mart, a foreign based company, filed suit against a Jamaican imitator of its trademark, and succeeded in obtaining an interlocutory injunction on the basis of trademark infringement and the tort of passing off.

The writ was filed on 2 November 1995. The application for an interlocutory injunction was heard on 22, 23 and 24 July 1996 and judgement was delivered on 27 June 1997.

The matter was appealed and was heard on 27, 28 and 29 May and 1, 2 and 4 June 1998. The Court of Appeal delivered judgement on 23 November 1998.

- Cost: It would not be possible for the Attorney General's Department to provide information on the cost of proceedings not having participated in the matters. The parties involved would have to be contacted. We can revert to you on this issue if necessary.

The Resident Magistrates Court

The length of proceedings: Proceedings in the Resident Magistrates Court are governed by the Judicature (Resident Magistrates Court) Act.

The commencement of actions is by the filing of a plaint by the plaintiff. Within a matter of days thereafter the relevant documentation is served on the defendant indicating the day on which he is required to appear before the court at which time a date for trial will be set. There are no provisions regarding the period within which the trial should commence. It is therefore difficult to estimate a time-frame within which the matter will actually be completed as this hinges on various factors such as the number of matters awaiting trial, as well as the state of readiness of the attorneys involved.

Cost: The cost of proceedings is largely within the discretion of the magistrate who is guided by the Judicature (Resident Magistrates) Act, Tariff of Fees which sets out the basic costs for various proceedings.

(b) *Administrative procedures and remedies*²

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

There are no administrative or non-judicial avenues through which the aforementioned matters can be addressed

There are provisions for case management by judges which will assist in expeditious disposal of matters.

The Judicature (Civil Procedure Code) (Amendment) (Judicial Review) Rule, 1998, allows for the review of the acts and decisions of administrative bodies in the Supreme Court.

Provisional Measures

(a) *Judicial measures*

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

Copyright and related rights

The court has discretionary powers to order interlocutory injunctions pending the final outcome of a case. The court will only grant an interlocutory injunction if the applicant can show:

- there is a serious issue to be tried;
- damages alone will not be an adequate remedy; for example the applicants reputation will suffer if immediate intervention is not made;

² Please see the responses to the European Commission.

- on a balance of convenience, the applicant would stand to lose more if the injunction were not granted.

Trademarks and designs

The type of provisional measures that may be ordered by the court are as follows:

- Preservation of custody of subject-matter of the contract

This measure is applicable where by any contract *prima facie* a case of liability is established.

Section 459 of the Consolidated Judicature (Civil Procedure Code) Law, Chapter 177, speaks to this:

"When by any contract a *prima facie* case of liability is established, and there is alleged as matter of defence a right to be relieved wholly or partially from such liability, the court or a judge may make an order for the preservation or interim custody of the subject-matter of the litigation, or may order that amount in dispute be brought into court or otherwise secured.

- Order for sale for perishable articles

Section 460 of the Civil Procedure Code, speaks to this:

"It shall be lawful for a court or a judge on the application by any party, to make any order for the sale, by any person or persons named in such order, and in such manner and on such terms as the court or judge may think desirable, of any goods, wares or merchandise, which may be of a perishable nature, or likely to injure from keeping, or which for any other just and sufficient reason it may be desirable to have sold at once".

- Order for detention, preservation, or inspection, of any property the subject of the cause

Section 461 of the Civil Procedure Code speaks to this:

"It shall be lawful for the court or a judge, upon the application of any party to a cause or matter, and upon such terms as may be just, to make any order for the detention, preservation or inspection, of any property or thing, being the subject of such cause or matter, or as to which any question may arise therein, and for all or any of the purpose aforesaid, to authorise any person to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid to authorise any sample to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient to the purpose of obtaining full information or evidence"

- Order for recovery of property subject to claim for lien on terms

Section 466 of the Civil Procedure Code speaks to this:

"Where an action is brought to recover, or a defendant in his defence seeks by way of counter-claim to recover, specific property other than land, and the party from whom such recovery is sought does not dispute the title of the party seeking to recover the same, but claims to retain the property by virtue of a lien, or otherwise, as security for any sum of money, the court or a judge may, at any time after such last-mentioned claim appears from the pleading, or, if there be no pleadings, by affidavit or otherwise to the satisfaction of such court or judge, order that the party claiming to recover the property be at liberty to pay into the court, to abide the event of the action, the amount of the money in respect of which the lien or security is claimed, and such further sum (if any) for interest and costs as such court or judge may direct, and upon such payment into court being made the property claimed to be given up to the party claiming it."

- Allowance out of income of property *pendente lite*

Section 467 of the Civil Procedure Code speaks to this:

"Where any real or personal estate forms the subject to any proceedings in equity, and the judge is satisfied that the same will be more than sufficient to answer all the claims thereon which ought to be provided for in such proceedings, the judge may, at any time after the commencement of the proceedings, allow to the parties interested therein, or any one or more of them, the whole or part of the income of the real estate, or a part of the personal estate, or the whole part of the income thereof, up to such time as the judge shall direct."

- Conduct of sale of trust property

Section 468 of the Civil Procedure Code speaks to this:

"Whenever in an action for the administration of the estate of a deceased person, or execution of the trusts of a written instrument, a sale is ordered of any property vested in any executor, administrator or trustee, the conduct of such sale be given to such executor, administrator or trustee, unless the court or a judge shall otherwise direct."

- Injunction (by judgement or order)

Section 469 of the Civil Procedure Code states:

". . . . an injunction shall be by a judgement or order, and any such judgement or order shall have the effect which a writ of injunction previously had."

"An injunction against a corporation may be enforced either by attachment against the directors or other officers thereof as in the case of a *mandamus* or by a writ of sequestration against their property and effects to be issued in such form and tested "and returnable in like manner as writs of *venditioni exponas* and to be proceeded upon and executed like manner as writs issuing order of the Supreme Court."

- Injunction against continuance or repetition of wrong

Section 470 of the Civil Procedure Code speaks to this:

"In any cause or matter in which an injunction has been or rights have been claimed, the plaintiff may, before or after judgement, apply for an injunction restraining the defendant or respondent from the repetition or continuance of the wrongful act or breach of contract complained of, or from the commission of an injury or breach of contract of a like kind relating to the same contract; and the court or judge may grant the injunction, either upon or without terms as may be just."

11. In what circumstances may such measures be ordered *inaudita altera parte*?

This order may be made in favour of one party in the absence of another where the applicant can show urgency and or great difficulties in effecting service on the respondent. However, the court is unlikely to grant the order for a duration longer than seven (7) days.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

Proceedings involving the infringement of intellectual property rights are generally commenced by way of writ of summons and would include a claim for an injunction. The obtaining of an interlocutory injunction would proceed by way of summons supported by *affidavit*.

In instances where time is of the essence, the application may be made *ex parte*, in which case the order of the court would be temporary pending the appearance and submissions of the parties involved.

The party applying for the injunction is required to file the documentation in the Supreme Court, whereupon a date is set for hearing and the parties involved are served. Such applications are generally given early dates for hearing.

The Judicature (Civil Procedure Code) Law provides that the injunction shall be by a judgement or order and further stipulates that it may be granted by the judge upon or without such terms as may be just.

The protection of the interest of the defendant is therefore within the discretion of the judge. Injunctions are normally granted to the plaintiff where he gives an undertaking to make good any damage suffered by the defendant from the injunction would he fail at trial. Where an injunction has been breached, the applicant may seek redress before the court.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The Supreme Court

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- Cost: It would not be possible for the Attorney General's Department to provide information on the cost of proceedings not having participated in the matters. The parties involved would have to be contacted. We can revert to you on this issue if necessary.

The Resident Magistrates Court

The length of proceedings: Proceedings in the Resident Magistrates Court are governed by the Judicature (Resident Magistrates Court) Act.

The commencement of actions is by the filing of a plaint by the plaintiff. Within a matter of days thereafter the relevant documentation is served on the defendant indicating the day on which he is required to appear before the court at which time a date for trial will be set. There are no provisions regarding the period within which the trial should commence. It is therefore difficult to estimate a time-frame within which the matter will actually be completed as this hinges on various factors such as the number of matters awaiting trial, as well as the state of readiness of the attorneys involved.

Cost: The cost of proceedings is largely within the discretion of the magistrate who is guided by the Judicature (Resident Magistrates) Act, Tariff of Fees which sets out the basic costs for various proceedings.

(b) *Administrative measures*

14. Reply to the above questions in relation to any administrative provisional measures.

We are not sure what is meant by administrative provisional measures in the context. However, under the Trade Marks Act (Section 66) and also under the Copyright Act an application can be made for the Commissioner of Customs to treat goods as prohibited and to disclose information for investigation and prosecution of offences.

Special Requirements Related to Border Measures

15. **Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51)

The suspension of goods by customs is considered only in the Copyright Act and in the Trade Marks Act. The owner of goods that are subject to copyright may apply to the Customs Department in the manner outlined for the suspension of these items. The Trade Marks Act, 1999, provides for the suspension of goods which are the subject of counterfeit trade marks as is stipulated in the Agreement on Trade-Related Aspects of Intellectual Property Rights.

Criteria for suspension

Once the owner of the copyright or trademark has complied with the stipulations of the Act, the Customs Department may suspend the entry of such items save for importation intended for private or domestic use.

Are there any imports excluded from suspension (such as goods from another member of a customs union, goods in transit or *de minimis* imports)

There is no indication that there are exemptions of this nature.

Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

The legislation is silent on the scenario posed.

16. **Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

The existing response to this question fails to address the query as regards the implementation of the provisions of Articles 53 (security and equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information).

As regards Article 53: Section 50(6) of the Copyright Act provides that the person making the application to the Commissioner of Customs shall give security in respect of any liability or

expense which the Commissioner may incur as a consequence of the notice by reason of the detention of any article or anything done to the article detained.

As regards Article 56: Section 50(6) of the Copyright Act provides that the owner of the copyright who applies to the Customs Department for the suspension of goods must indemnify the Commissioner of Customs against any liability which may be incurred. Under Section 67 of the Trade Marks Act regulations may be made providing for security.

As regards Article 57: there is no indication that provisions have been made in relation to the right of inspection.

Copyright and related rights

Section 50 of the Act provides that the owner of the copyright in any published literary, dramatic or musical work may give notice in writing to the Commissioner of Customs,

- that he is the owner of the copyright in the work; and
- that he requests the Commissioner to treat as prohibited goods under the Customs Act, during a period specified in the notice, printed copies of the work which are infringing copies.

Likewise, the owner of the copyright in a sound recording or film may give notice in writing to the Commissioner of Customs,

- that he is the owner of the copyright in the work; and
- that infringing copies of the work are expected to arrive in Jamaica at a time and place specified in the notice; and
- that he requests the Commissioner to treat the copies as prohibited goods under the Customs Act thus subject to forfeiture.

Under this "application" system, the period specified in the notice shall not exceed five years and shall not extend beyond the end of the period for which the copyright may subsist. In addition, the notice must conform with the rules and regulations issued by the Commissioner of Customs in the Jamaica Gazette Volume CXVIII of Thursday 9 March 1995, number 28c, wherein, the requisite details are to be contained in the notice and the form it should take are outlined.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

No data is available at this time.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?

Neither the Copyright Act nor the Customs Act empowers customs authorities to act *ex officio* in any instance. In the absence of a notice received from the copyright owner, customs authorities are powerless to seize goods being imported or in transit that it suspects to be prohibited goods.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

Section 50(4) of the Copyright Act provides that a person will be subject to the penalty of forfeiture of the goods under the Customs Act. The authorities are not empowered otherwise to prescribe remedies.

Criminal Procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

Copyright and related rights

The Resident Magistrate Courts and the Supreme Court/Circuit Court.

Trademarks and designs

In respect of trademarks, industrial designs and patents, the courts which would have jurisdiction for related criminal acts of infringement, are the Resident Magistrates Court, the Supreme Court/Circuit Court and the Court of Appeal.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

Copyright and related rights

The unlawful exercise and or exploitation of the economic and moral rights of the copyright owner.

The Trade Marks Act, 1958

Under the Trade Marks Act, 1958, the following acts of infringement of trademarks attract criminal procedures and penalties:

- Falsification of entries in the Trade Marks Register is a misdemeanor. This is set out in Section 57, which states:

"If any person makes or causes to be made a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor, and on conviction shall be liable to be imprisoned for a term not exceeding two years with or without hard labour."

- Falsely representing a trademark as registered, attracts a fine. This is set out in Section 55 (1), which states:

"(1) any person who makes a representation,

- (a) with respect to a mark not being a registered trademark, to the effect it is a registered trademark, or

- (b) with respect to a part of a registered trademark not being a part separately registered as a trademark, to the effect that it is so registered, or
- (c) to the effect that the registration of a trademark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the Register, the registration does not give that right,

shall be liable on summary conviction to a fine not exceeding ten dollars and in default of payment to imprisonment with or without hard labour for a term not exceeding two months."

NB: Fine and length of imprisonment have been amended to longer term.

The Trademarks Act, 1999

Under the Trademarks Act, 1999, the following acts of infringement of trademark which attract criminal penalties, are as follows:

- unauthorised use of a trademark under different circumstances as stipulated in Section 69;
- falsification of entry in the Register, which is stipulated in Section 70;
- falsely representing a trademark as a registered mark, which is stipulated in Section 77.

Draft Patents and Designs Act, 2001

Under this legislation, the acts of infringements which attract criminal sanctions are as follows:

- Falsification of Register

Section 110 of the draft legislation stipulates:

"Any person who,

- (a) makes or causes to be made, a false entry in any Register under this Act or a writing falsely purporting to be copy of an entry in any such Register; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, commits an offence and shall be liable on conviction before a Resident Magistrate to a fine not exceeding (dollars) or to imprisonment of a term not exceeding (years) or both such fine and imprisonment for a term not exceeding (years).

- False claim as to patent rights and industrial designs rights

Section 111 of the draft legislation stipulates:

- "(1) Any person who falsely represents,
- (a) that he or another person is the patentee of an invention or the owner of a registered industrial design;
 - (b) that he or another person has applied for a patent for and invention or the registration of an industrial design,
- commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars).
- (2) A person who falsely represents that an article sold by him is patented or incorporates any industrial designs registered in Jamaica or is the subject of an application for a patent or the registration of an industrial design in Jamaica, commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars)."

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

Copyright and related rights

The Jamaica Constabulary Force (the police) may initiate criminal proceedings on the basis of a complaint or on his own initiative pursuant to Section 140 of the Copyright Act. Under Section 140 a police officer of the rank or above the rank of Inspector may, if he is satisfied that there is reasonable cause to believe that an offence against the Copyright Act is being committed, give directions to any constable in writing authorising him to:

- enter or search any premises or place;
- stop, board and search any vessel (other than a ship of war) or any aircraft (other than a military aircraft);
- stop and search any vehicle, in which the constable reasonably suspects there is an infringing copy of a work or an illicit recording or any article used or intended to be used for making infringing copies or illicit recordings;
- seize, remove or detain:
 - any article which appears to the constable to be an infringing copy of an illicit recording or any other article which appears to him to be intended for the use of making such copies or recordings;
 - anything which appears to him to be or to contain evidence of an offence under this Act.

The existing response should include the provisions under the Copyright Act which allow for the owner of a copyright work to apply to the Commissioner of Customs for copies of his work to be treated as prohibited goods. The Customs Act provides that "any officer" may prosecute and conduct

any information or other proceeding under the customs laws in respect of any offence or penalty. An officer includes any person employed to the Department of Customs and Excise, the Revenue Protection Division, police officers and persons acting in the aid of an officer acting in the execution of his office.

The Trade Marks Act does impose criminal sanctions where an infringement occurs (Sections 69-71).

As regards the infringement of a patent, the proposed Patents and Designs Act prescribes the penalty to be imposed on the perpetrator (Sections 110-111).

The general authority of the police to act is derived from the Constabulary Force Act which prescribes the general duties and powers of the police. These include the detection of crime and the apprehension of persons found committing or reasonably suspected of having committed any offence.

Trademarks and designs

The Jamaica Constabulary Force (the Police) may initiate criminal proceedings on their own initiative and/or on the basis of a complaint by virtue of the powers given under Sections 13 and 15 of the Constabulary Force Act, 1935.

Section 13 of the Act sets out the duties of the Police as follows:

"The duties of the Police under this Act shall be to keep watch by day and by night, to preserve the peace, to detect crime, apprehend or summon before a Justice, persons found committing any offence or whom they may reasonably suspect of having committed any offence, or who may be charged with having committed any offence, to serve and to execute all summonses, warrants, subpoenas, notices and criminal Justice or by any Justice in a criminal matter and to do and perform all the duties appertaining to the office of a constable,"

Section 15 stipulates that members of the police force may arrest without warrant in certain cases. It states:

"It shall be lawful for any Constable, without warrant, to apprehend any person found committing any offence punishable upon indictment or summary conviction and to take him forthwith before a Justice who shall enquire into the circumstances of the alleged offence, and either commit the offender to the nearest jail, prison or lock-up to be thereafter dealt with according to law, or to take bail by recognisance, with or without security in such amount as such Justice shall direct, for his appearance on such day as he shall appoint, before a court of competent jurisdiction, to be dealt with according to law."

The Director of Public Prosecutions (the DPP) may also initiate criminal proceedings on its own initiative and/or on the basis of complaint by virtue of the powers given under Section 94 of the Constitution of Jamaica.

Section 94 states:

"There shall be a Director of Public Prosecutions, whose office shall be a public office."

"....."

"(3) The Director of Public Prosecutions shall have power in any case in which he considers it desirable so to do,

- (a) to institute and undertake criminal proceedings against any person before any court other than a court martial in respect of any offence against the law of Jamaica;
- (b) to take over and continue any such criminal proceedings that may have been instituted by any other person or authority; and
- (c) to discontinue at any stage before judgement is delivered any such criminal proceedings instituted or undertaken by himself or any other person or authority.

(4) The power of the Director of Public Prosecutions under Subsection (3) of this section may be exercised by him in person or through other persons acting under and in accordance with his general or special instructions."

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Copyright and related rights

A copyright owner, his heirs, assigns and licensees may initiate criminal proceedings in respect of infringement of intellectual property rights by making a complaint to the police. Note that no prosecution for an offence under the Act shall be commenced after the expiration of five years after the commission of the offence or one year after the discovery thereof, whereof, whatever date last occurs (Section 139).

Trademarks and designs

Right holders of trademarks, patents and industrial designs, their licensees and assigns, have standing to initiate criminal matters, by making a complaint to the police, who would then take the necessary steps to have the matter brought before the courts.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Copyright and related rights

Dealing with any article, knowingly or having reason to believe, that it is an infringement copy, Section 46 (1). Penalties:

- summary conviction before a Resident Magistrate:
 - \$100,000 fine, or
 - two years imprisonment.
- Conviction before a Circuit Court:
 - undetermined fine and/or
 - five years imprisonment.

Possession of an article designed or adapted to make copies knowing that it is to be used for making infringing copies for sale or hire or for use in the course of business, Section 46 (2). Penalties:

- summary conviction before a Resident Magistrate:
 - \$50,000 fine and/or
 - one year imprisonment.
- conviction before a circuit court:
 - undetermined fine and/or
 - three years imprisonment

Other remedies available are:

- delivery up of infringing copies or article designed or adapted to make copies, Section 48;
- destruction of infringing copies or article or illicit recording of as performance, Section 137.

Performing, playing or showing protection work knowing or having reason to believe that to do so constitutes an infringement, Section 46 (3). Penalties:

- summary conviction for a Resident Magistrate:
 - \$50,000 fine and/or
 - one year imprisonment.
- conviction before a circuit court:
 - undetermined fine and/or
 - three years imprisonment

Other remedies available are:

- delivery up of infringing copies or article designed or adapted to make copies, Section 48;
- destruction of infringing copies or article or illicit recording of as performance, Section 137.

Making for sale or for hire importing into Jamaica otherwise than for private domestic use, distributing, showing in public, broadcasting or otherwise dealing with or using illicit recordings of a performance in the course of business, Section 134. Penalties:

- \$100,000 fine and/or
- two years imprisonment.

Other remedies include delivery up, Section 135; and destruction, Section 137.

False representation of authority to give consent in respect of recording performance, Section 136. Penalties:

- \$50,000 fine and/or
- six months imprisonment.

Obstruction of the police in the exercise of their powers under Section 140 is an offence punishable on summary conviction by a fine not exceeding \$10,000 and/or to a term of imprisonment not exceeding one year.

Giving false information to the police in the exercise of their powers, under Section 140 of the Act, is an offence punishable on summary conviction before a Resident Magistrate to a fine not exceeding \$5,000 and/or to a term not exceeding six months, Section 142.

Trademarks and designs

- Under the Trademarks Act, 1958
 - Falsification of entries in the Register, a misdemeanor. See Section 57.

Penalties: two years imprisonment with or without hard labour.

- Falsely representing a trade mark as registered.

Penalties: on summary conviction to a fine not exceeding ten dollars and in default of payment to imprisonment with or without hard labour for terms not exceeding two months (*amended*).

- Under the Trademarks Act, 1999

Unauthorised use of a trade mark in the following circumstances as set out in Section 69 of the Act.

Section 69 states as follows:

- "(1) Subject to Subsection (4), a person commits an offence if with intent to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor of the trademark he,
 - (a) applies to goods a sign identical with or likely to be mistaken for, a registered trademark; or
 - (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or
 - (c) has in his possession, custody or control in the course of business, any goods referred to in paragraph (b) with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (2) Subject to subsection (4), a person commits an offence if, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor he,
 - (a) applies a sign identical to or likely to be mistaken for a registered trade mark to material intended to be used for labelling or packaging goods or as business paper in relation to goods or for advertising goods; or
 - (b) uses in the course of a business material bearing such a sign for labelling or packaging goods as a business paper in relation to goods, or for advertising goods; or
 - (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).
- (3) Subject to Subsection (4) a person commits an offence who with a view to gain for himself or another or with intent to cause loss to another, and without the consent of the proprietor he,
 - (a) makes an article specifically designed or adapted for making copies of a sign identical to or likely to be mistaken for a registered trade mark; or

- (b) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been or is to be used to reproduce goods or material for labelling or packaging goods, as a business paper in relation to goods or for advertising goods."

Penalties

Section 69 (6) states:

"A person who commits an offence under this Section is liable,

- (a) on summary conviction before a Resident Magistrate to a fine not exceeding one million dollars or to a term of imprisonment not exceeding twelve months or to both such fine and imprisonment;
- (b) on conviction before the Circuit Court to a fine or to imprisonment not exceeding five years or to both such fine and imprisonment."

Patents and industrial designs

Under the Draft Patent and Designs Act, 2001:

- Falsification of the Register, see Section 110.

Penalty: liable on conviction before a Resident Magistrate to a fine of (dollars) or to imprisonment, or on conviction on indictment to imprisonment for a term not exceeding (years).

- False claim as to patent rights and/or industrial designs rights, see Section 111.

Penalties – see Section 111

- Where a person falsely represents that he or another is the patentee of an invention or has applied for such or is the owner of a registered industrial design or has applied for such commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars).
- where a person falsely represents that an article sold by him is patented or incorporates an industrial design registered in Jamaica, or is the subject of an application for a patent or the registration of an industrial design he commits an offence and shall be liable on summary conviction to a fine not exceeding (dollars).

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

Section 139 of the Copyright Act stipulates that offences must be prosecuted within five years after the commencement of the act or one year after the discovery thereof, whatever date last occurs.

The Customs Act states that proceedings under this Act must commence within seven years of the date of the offence.

The Trade Marks Act and proposed Patent and Designs Act are silent in this regard.

There are no provisions which impact on the length of a criminal hearing, nor are there provisions regarding cost.
