

JAMAICA

No. // - 2021

I assent,

[L.S.]

*Sgd. P. D. Allen*  
Governor-General.  
30th day of June 2021

AN ACT to Amend the Trade Marks Act.  
[ 30th June 2021 ]

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, Short title and construction. 2021, and shall be read and construed as one with the Trade Marks Act (hereinafter referred to as the "principal Act") and all amendments thereto.

2. Section 2 of the principal Act is amended by—

- (a) deleting the definition of “Trade Marks Journal”; and
- (b) inserting the following definitions in the appropriate alphabetical sequence—

““basic application” means an application for the registration of a trade mark filed with the Registrar under section 16, and used as a basis for filing an application under section 26A;

“basic registration” means a trade mark registered by the Registrar pursuant to section 24, and used as a basis for filing an application under section 26A;

“Contracting Party” means Contracting States or Contracting Organizations who are signatories to the Madrid Agreement or the Madrid Protocol, as the case may be;

“date of subsequent designation” is the date of subsequent designation determined by the International Bureau;

“designation” means the request for extension of protection (“territorial extension”) under section 26D and such extension as may be recorded in the International Register;

“holder” means the individual or legal entity in whose name the international registration is recorded in the International Register;

“Intellectual Property Journal” means the Intellectual Property Journal published by the Office;

“international application” means an application made under section 26A;

“International Bureau” means the International Bureau of the World Intellectual Property Organization;

“International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau;

“international registration” means the registration of a trade mark effected by the International Bureau under the Madrid Agreement or the Madrid Protocol, as the case may be;

“international registration date” is the date of an international registration, as determined by the International Bureau;

“Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891 (as revised or amended from time to time);

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid on June 27, 1989 (as revised or amended from time to time);

“national application” means an application made in accordance with section 16;

“national registration” means a registration made in accordance with section 24;

“Office” means the Jamaica Intellectual Property Office”;

3. Section 9 of the principal Act is amended in subsection (5)(a), by inserting immediately after the words “that are not” the words “identical or”.

4. Section 11 of the principal Act is amended in subsection (4)(f) by—

(a) deleting the word “or” at the end of sub-paragraph (i);

Amendment of section 11 of the Principal Act.

Amendment of section 9 of the Principal Act.

- (b) deleting the full stop at the end of sub-paragraph (ii) and substituting therefor the word “; or”;
- (c) inserting next after sub-paragraph (ii), the following sub-paragraph—
  - “(iii) misrepresents, or misappropriates, the traditional knowledge or traditional cultural expressions of indigenous or local communities.”;

5. Section 12 of the principal Act is amended by deleting subsection (1) and inserting the following as subsections (1) and (1A)—

“(1) Where a trade mark consists of or contains a representation of—

- (a) the Coat of Arms of Jamaica;
- (b) the National Flag of Jamaica; or
- (c) any other Jamaican national emblem or symbol,

the trade mark shall not be registered unless the Registrar is satisfied that consent has been given by or on behalf of the Government of Jamaica.

(1A) Where a trade mark which is the subject of an application or registration contains—

- (a) the name “Jamaica” or the name of another country or abbreviations or homonyms thereof;
- (b) a map of Jamaica or national colours of Jamaica, a map of another country or national colours of another country; or
- (c) a national emblem or symbol of Jamaica or national emblem or symbol of another country,

the Registrar may impose a condition or a limitation on the trade mark in the Register, to the effect that goods or services for which the trade mark is registered, shall originate in Jamaica or in another country, as the case may be.”;

6. Section 14 of the principal Act is amended in subsection (1) by deleting from paragraph (c), the words "paragraph (b)" and substituting therefor the words "paragraph (a)":

7. Section 22 of the principal Act is amended in subsection (1) by—  
(a) deleting the words "Trade Marks Journal" and substituting therefor the words "Intellectual Property Journal"; and  
(b) deleting the words ", and the date of publication shall be reckoned as the date of acceptance".

8. The principal Act is amended by inserting next after section 26, the following heading and sections—

“ Part IIIA.—International Applications in Respect of which Jamaica is the Country of Origin

26A.—(1) An international application may be filed with the Registrar where—

(a) a national application has been filed or a national registration exists;

(b) the person in whose name the international application will be filed is the same person in whose name the national registration exists;

(c) the owner of the national application or national registration is a national of Jamaica, is domiciled in Jamaica or has a real and effective industrial or commercial establishment, in Jamaica;

Insertion of new sections 26A through 26C in principal Act.

Amendment of section 22 of principal Act.

Amendment of section 14 of principal Act.

International application procedure.

- (d) the mark which is the subject matter of the international application is the same mark referred to in like manner in the national application or the national registration; and
- (e) the goods and services indicated in the international application are covered by the list of goods and services indicated in the national application or national registration.
- (2) An application made under this section shall be in the form prescribed and accompanied by the prescribed fees.
- (3) The applicant shall indicate on an application filed under this section, the specific goods or services in respect of which international protection is sought including—
  - (a) the corresponding class or classes to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of June 15, 1957; and
  - (b) any request for extension of the protection resulting from the international registration to a Contracting Party.
- (4) The Registrar shall not forward to the International Bureau an international application that does not meet the requirements set out in subsections (1) to (3).

(5) The Registrar shall provide reasons in writing to the applicant as to why an application made under this section was not sent to the International Bureau.

(6) Where there is a disagreement between the Registrar and the International Bureau in respect of the classification of goods and services in an international application, the opinion of the International Bureau shall prevail.

(7) Where an international application is filed pursuant to subsection (1), the Registrar shall verify that the relevant particulars appearing in the application submitted under subsection (1) correspond to the relevant particulars appearing in the basic application or basic registration, as the case may be.

(8) The failure by the applicant to indicate the class or classes, shall not prevent the International Bureau from indicating the appropriate class or classes with respect to the international application.

(9) Where the requirements for registration of a mark in an international application are met, the Registrar shall transmit the international application to the International Bureau and certify to the International Bureau—

(a) the date the Office received the international application;

(b) that the particulars appearing in the international application correspond to the particulars appearing at the time of the certification, in the basic application or basic registration, as the case may be;

- (c) in the case of a basic application the date and number of the basic application; and
- (d) in the case of a basic registration the date and number of the basic registration.

(10) Where the requirements for an international application are met and after the Registrar has transmitted the international application to the International Bureau in accordance with subsection (9), and the mark is registered in the International Register by the International Bureau, the International Bureau shall publish the relevant details of the international registration in a periodical gazette issued by the International Bureau.

Communications to International Bureau shall—

- (a) be transmitted through the Registrar; and
- (b) be in the English Language.

26C.—(1) A request for territorial extension—

- (a) may be made directly to the International Bureau subsequent to an international registration granted under this Act; and
- (b) shall be in the form prescribed.

(2) A territorial extension granted under subsection (1), shall be effective from the date such extension is recorded in the International Register.



(3) The validity of the territorial extension shall expire on the date the corresponding international registration expires.

26LD.—(1) An international registration of a mark shall be valid for ten years from the date of its registration.

Validity of international registration.

(2) Subject to the provisions of this section, upon the expiry of five years from the date of registration, the international registration shall become independent of the basic application or registration resulting therefrom or basic registration, as the case may require.

(3) The protection resulting from the international registration, whether or not the international registration has been the subject of a transfer, may no longer be invoked if before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom or the basic registration, as the case may be—

- (a) has been withdrawn;
- (b) has lapsed;
- (c) has been renounced; or
- (d) has been the subject of a final decision of—

- (i) rejection;
- (ii) revocation;
- (iii) cancellation; or
- (iv) invalidation,

in respect of all or some of the goods and services listed in the international registration.

- (4) The protection resulting from an international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, after the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration resulting therefrom, or the basic registration, as the case may be, results from—
- (a) an appeal against a decision refusing the effects of the basic application, provided that such appeal began before the expiry of the five-year period;
  - (b) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, provided that such action began before the expiry of the five-year period; or
  - (c) an opposition to the basic application, provided that such opposition began before the expiry of the five-year period.
- (5) The protection resulting from the international registration, whether or not the international registration has been the subject of a transfer, may no longer be invoked if, after the

expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be—

(a) the basic application is withdrawn; or

(b) the registration resulting from the basic application or the basic registration is renounced,

provided that, at the time of withdrawal or renunciation the application or registration was the subject of a proceeding under subsection (4)(a), (b) or (c) and that such proceeding began before the expiry of the five-year period.

(6) The Registrar shall notify the International Bureau of the facts and decisions relevant under subsections (3), (4) and (5), and where applicable request the International Bureau to cancel to the extent applicable, the international registration.

Part III B.—*International Registrations in which Jamaica is Designated*

26F.—(1) In the case where the Registrar is notified by the International Bureau that an international registration contains a designation of Jamaica, the Registrar shall publish the international registration in the Intellectual Property Journal and proceed to examine the international registration on substantive grounds only, and in accordance with section 21(1).

(2) For the avoidance of doubt, an examination done pursuant to subsection (1), shall not include an examination as to formalities or priority claims.

Registrar shall examine international registration on substantive grounds only.

(3) Every international registration designating Jamaica shall enjoy the right of priority provided for in section 19, without the requirement to comply with formalities required under rule 6 of the Trade Marks Rules, 2001.

(4) Any person who opposes the protection of an international registration designating Jamaica, may file with the Registrar a notice of opposition within two months from the date of publication.

(5) Opposition to an international registration designating Jamaica shall be governed by the provisions of this Act, and any rules made hereunder shall apply *mutatis mutandis*.

26F.—(1) Where the Registrar upon examination under section 26F, determines that the mark which is the subject of an international registration designating Jamaica cannot be accepted, or can be accepted with conditions, the Registrar shall before the expiration of eighteen months from the date on which the notification of the extension of protection is sent from the International Bureau, notify the International Bureau of its refusal together with a statement of the grounds of provisional refusal.

(2) Where an opposition is filed with the Registrar in respect of an international registration designating Jamaica, the Registrar shall before the expiration of eighteen months from the date on which the notification of the extension of protection is sent from the International Bureau, notify the International Bureau of a provisional refusal of protection, together with a statement of the grounds of provisional refusal.

Provisional  
refusal of  
international  
registration.

(3) Notwithstanding subsections (1) and (2), the holder of the international registration designating Jamaica shall enjoy the same remedies, as if the mark had been filed for registration directly with the Registrar.

(4) The holder of the international registration designating Jamaica may respond to a provisional refusal under subsection (1), by requesting, in writing, a review of the decision within two months from the date the notification of the provisional refusal was sent by the International Bureau to the holder.

(5) Where the holder of the international registration designating Jamaica has no address for service in Jamaica, the request for review shall be submitted in writing through a duly appointed agent domiciled in Jamaica together with a power of attorney.

(6) Where the holder of the international registration designating Jamaica does not respond to the provisional refusal within the period prescribed in subsection (4), the designation of Jamaica shall be deemed abandoned.

26G. Where the Registrar has notified the International Bureau of a provisional refusal of protection and all the procedures before the Registrar are completed, and such provisional refusal has been either totally or partially withdrawn, the Registrar shall send to the International Bureau—

(a) in the case of a total withdrawal of provisional refusal, a statement to the effect that the provisional refusal is withdrawn and that protection of the

mark is granted for all the goods and services for which protection has been requested; or

(b) in the case of a partial withdrawal, a statement indicating the goods and services for which protection of the mark is granted.

26H. Where the Registrar has sent to the International Bureau, a notification of provisional refusal and all the procedures before the Registrar are completed, and the Registrar has decided to confirm such refusal of protection of the mark for all the goods and services for which protection has been requested, the Registrar shall send to the International Bureau a statement to that effect.

Confirmation of provisional refusal of international protection of mark.

26I. Where all procedures before the Registrar are completed, and there is no ground for the Registrar to refuse protection, the Registrar shall within eighteen months send to the International Bureau a statement to the effect that protection is granted to the mark.

Statement of grant of protection.

26J. Where after the sending of a statement under section 26G, 26H or 26I, there is a further decision which affects the protection of a mark, the Registrar shall to the extent that the Registrar is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected.

Further decision affecting protection of a mark.

26K.—(1) An international registration designating Jamaica shall have the same effect as from the date of the international registration or the subsequent designation of Jamaica, as the case may be, as if the application for the registration of the mark had been filed directly with the Registrar.

Effect of an International Registration.

(2) The date of filing is the date of the international registration where Jamaica is designated in the international registration or the date of the

subsequent designation, where Jamaica is designated subsequently to the international registration.

(3) Where—

- (a) no refusal is notified by the Registrar to the International Bureau;
- (b) a refusal has been so notified, but has been subsequently withdrawn; or
- (c) a statement of grant of protection is sent by the Registrar,

the protection of the mark shall be the same as if the mark had been registered directly by the Registrar on the date of the international registration or the date of subsequent designation as the case may be.

26L.—(1) Where an international registration designating Jamaica is cancelled by the International Bureau, in respect of all or some of the goods and services listed in the international registration, the person who was the holder of the international registration, may file an application for the registration of the same trade mark directly with the Registrar pursuant to section 16.

(2) The application made under subsection (1), shall be treated as if it had been filed on the date of the international registration or on the date of recording of the territorial extension of protection and if the international registration enjoyed priority, the application shall enjoy the same priority provided that—

- (a) the application is filed within three months from the date on which the international registration was cancelled;

Transformation  
of an  
international  
registration.

(b) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of Jamaica;

(c) the application includes—

(i) a statement that the application is made by way of transformation;

(ii) the international registration number for the international registration which was cancelled;

(iii) the date of the international registration, or the date of recording of the territorial extension of protection made subsequent to the international registration, as the case may determine;

(iv) the date on which international registration was cancelled;

(v) if applicable, the date of any priority claimed in the international registration and recorded in the International Register; and

(vi) the prescribed fee; and

(d) the application complies with all the requirements of this Act and any rules made hereunder.



(3) Subject to subsections (1) and (2), an application resulting from transformation shall be treated the same as an application for registration filed directly with the Registrar.

(4) Where an international registration is not protected in Jamaica on or before the date the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purpose of the application resulting from transformation.

26M.—(1) An international registration designating Jamaica, may be renewed for a period of ten years from the date of expiry of the international registration.

(2) An application to renew an international registration shall be—

(a) filed directly with the International Bureau; and

(b) accompanied by any applicable fee.

(3) A period of grace of six months shall be allowed for renewal of the international registration, subject to the payment of a surcharge to the International Bureau.

26N.—(1) Subject to subsection (2) where an international registration designating Jamaica is a collective mark or a certification mark, such registration shall be subject to the provisions of the First and Second Schedules.

(2) Where the regulations governing the use of collective or certification marks have not been submitted directly to the Registrar, in accordance with subsection (1), the Registrar shall issue an *ex officio* provisional refusal.

Request to  
take note of  
an  
international  
registration.

260.—(1) Where a mark that is the subject of a national registration in Jamaica is also the subject of an international registration and both registrations are in the name of the same person, the international registration shall be deemed to replace the national registration, without prejudice to any rights acquired by virtue of the latter, provided that—

(a) the protection resulting from the international registration extends to Jamaica in accordance with section 26C;

(b) all the goods and services listed in the national registration in Jamaica are also listed in the international registration in respect of Jamaica; and

(c) the extension of protection of that international registration to Jamaica took effect after the date of national registration of the mark in Jamaica.

(2) The holder of the international registration may in the form prescribed and accompanied by the prescribed fee, request the Registrar to take note of that international registration in the Register.

(3) The Registrar may before approving the request, examine the request referred to in subsection (2) in order to be satisfied that the conditions under subsection (1) have been established.

(4) Where the Registrar has taken note of an international registration under this section, the Registrar shall notify the International Bureau accordingly.

(5) Where the Registrar has taken note of an international registration under this section, such notification shall state—

- (a) the number of the international registration in question;
- (b) the goods and services listed in the international registration;

(c) the filing date and number of the application for registration of the mark in Jamaica;

(d) the date and number of the registration in Jamaica;

(e) the priority date, if any, of the registration in Jamaica; and

(f) any information relating to any other rights acquired by virtue of that registration in Jamaica.

(6) A national registration shall not be cancelled or otherwise affected by virtue—

(a) of being deemed to be replaced by an international registration; or

(b) that the Registrar has taken note in its Register of the replacement.

(7) Where all the goods and services listed in the national registration are not listed in the international registration, the scope of replacement shall be limited to the goods and services listed in the international registration.”

9. The principal Act is amended by inserting next after section 55, in new section 55A in the following as section 55A—

55A. A person may request the Registrar to conduct a preliminary search, and advise in respect of the registrability of a trade mark.”

“Preliminary search and advice.”

Amendment of section 58 of the principal Act.

10. Section 58 of the principal Act is amended in subsection (3) by deleting the words "Jamaica Intellectual Property Office" and substituting therefor the word "Office".

Amendment of section 59 of the principal Act.

11. Section 59 of the principal Act is amended in subsection (2)(c) by deleting the words "Jamaica Intellectual Property Office" and substituting therefor the word "Office".

Amendment of section 60 of the principal Act.

12. Section 60 of the principal Act is amended by—  
(a) renumbering subsection (2) as subsection (4); and  
(b) inserting next after subsection (1) the following subsections—

“(2) Any appeal that may be filed under this Act against a decision, shall be filed within twenty-eight days after the date of the decision.

(3) Any decision, judgment or order of the Court, following an appeal concerning an international registration, shall be communicated to the International Bureau as a further decision, which shall include a further statement indicating the goods and services for which the mark is protected in Jamaica.”

Insertion of new sections 61A, 61B and 61C in principal Act.

13. The principal Act is amended by inserting next after section 61, the following as sections 61A, 61B and 61C—

“Recordings in the International Register shall have the same effect as if recorded in the Register of Trade Marks.

61A.—(1) Subject to sections 61B, 61C and 62A, any recording made in the International Register in respect of an international registration, shall to the extent that it applies to Jamaica as a designated Contracting Party, have the same effect as if it had been recorded by the Registrar, in the Register of Trade Marks.

(2) Where, pursuant to the Act or Rules made hereunder, the Registrar considers that the recording referred to in subsection (1) has no effect in Jamaica, the Registrar shall, within eighteen months from the date on which the notification of the recording

was sent to the Registrar from the International Bureau, send a communication in writing to the International Bureau to that effect.

(3) The communication referred to in subsection (2) shall state—

(a) the reasons for the decision;

(b) the relevant provision of the law which informed the decision;

(c) in the case where the decision does not affect all the goods and services, those which are affected or those which are not affected by the decision; and

(d) whether the decision is subject to review or appeal.

(4) Section 30 shall apply *mutatis mutandis* in respect of recording of a licence in an international registration with effect for Jamaica.

61B.—(1) Where the Registrar is notified by the Registrar may declare that the change in ownership shall have no effect in Jamaica.

(2) The declaration referred to in subsection (1) shall set out—

(a) the reasons the change in ownership is of no effect;

(b) the corresponding essential provisions of the law; and

(c) whether such declaration may be subject to review.

Change in  
ownership of  
an  
international  
registration.

(3) Where a declaration is made under subsection (1), the effect of such a declaration is that, with respect to Jamaica as the designated Contracting Party, the international registration shall remain in the name of the transferor.

(4) The holder of the international registration may request a review by the Registrar, of the declaration made under subsection (1), within a period of twenty-eight days after the date of the notification sent by the International Bureau to the holder.

(5) Where the holder has no address for service in Jamaica, the request for review shall be submitted in writing through a duly appointed agent domiciled in Jamaica, together with a power of attorney.

(6) The Registrar shall notify the International Bureau of the final decision in relation to a declaration made in accordance with subsection (1).

(7) The declaration made under subsection (1) shall be sent to the International Bureau before the expiration of eighteen months after the date on which the notification referred to in subsection (1) was sent to the Registrar.

Limitation of goods and services in an international registration.

61C.—(1) Where the Registrar is notified by the International Bureau of a limitation of goods and services in an international registration affecting Jamaica, the Registrar may declare that the limitation has no effect in Jamaica.

(2) Where a declaration of a limitation is made under subsection (1), the effect of such a declaration in Jamaica is that the limitation shall not apply in respect of goods and services stated in the declaration.

(3) The declaration referred to in subsection (1) shall set out—

- (a) the reasons the limitation is of no effect;
- (b) the corresponding essential provisions of the law; and
- (c) whether such declaration may be subject to review.

(4) The holder of the international

registration may request a review by the Registrar, of the declaration made under subsection (1), within a period of twenty-eight days after the date of the notification sent by the International Bureau to the holder.

(5) Where the holder has no address for service in Jamaica, the request for review shall be submitted in writing through a duly appointed agent domiciled in Jamaica, together with a power of attorney.

(6) The Registrar shall notify the International Bureau of the final decision in relation to a declaration made in accordance with subsection (1).

(7) The declaration made under subsection (1) shall be sent to the International Bureau before the expiry of eighteen months after the date on which the notification referred to in subsection (1), was sent to the Registrar.”

14. The principal Act is amended by inserting next after section 62, the following as section 62A—

62A.—(1) The Registrar may, upon receipt from the International Bureau of a notification of a correction of an international registration where Jamaica is designated, declare in a notification of refusal to the International Bureau, that the Registrar

“Correction of international registration.

In section of new section 62A in principal Act.

considers that protection cannot or can no longer continue to be granted to the international registration as corrected.

(2) Where a declaration of a correction is made under subsection (1), the effect of such a declaration in Jamaica is that the correction shall not apply in respect of goods and services stated in the declaration.

(3) The declaration referred to in subsection (1) shall set out—

(a) the reasons the correction is of no effect;

(b) the corresponding essential provisions of the law; and

(c) whether such declaration may be subject to review.

(4) The holder of the international registration may request a review by the Registrar, of the declaration made under subsection (1), within a period of twenty-eight days after the date of the notification sent by the International Bureau to the holder.

(5) Where the holder has no address for service in Jamaica, the request for review shall be submitted in writing through a duly appointed agent domiciled in Jamaica, together with a power of attorney.

(6) The Registrar shall notify the International Bureau of the final decision in relation to a declaration made in accordance with subsection (1).

(7) The Registrar shall send the declaration made under subsection (1) to the International Bureau within eighteen months from the date the notification



of the correction was sent to the Registrar by the International Bureau.;

15. Section 78 of the principal Act is amended in paragraph (g) by deleting the words "Jamaica Intellectual Property Office" and substituting therefor the word "Office";

16. The Third Schedule of the principal Act is amended by deleting paragraphs 7(2), 7(4), 8(3), 8(4), 8(5), 8(6), 9(1), 9(3), 10, 14, 15(1) and 17(2).

Passed in the Honourable House of Representatives this 1st day of June, 2021.

JULIET A. HOLNESS

Deputy Speaker.

Passed in the Honourable Senate this 11th day of June, 2021.

THOMAS TAVARES-FINSON, CD, QC, JP

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.

Sgt. Valerie H. Currie  
Clerk to the Houses of Parliament.

