

TRADE MARKS

THE TRADE MARKS ACT
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THE TRADE MARKS ACT

Acts
32 of 1999,
25 of 2001
3rd Sch.

[3rd September, 2001.]

PART I. *Preliminary*

1. This Act may be cited as the Trade Marks Act.

Short title.

2.—(1) In this Act—

Interpreta-
tion.

"appointed day" means the 3rd September, 2001;

"business" includes trade or profession;

"certification mark" means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance services, quality, accuracy or other characteristics;

"collective mark" means a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings;

"Court" means the Supreme Court;

"exclusive licence" means a licence, whether general or limited, authorizing the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorized by the licence; and the expression "exclusive licensee" shall be construed accordingly;

"infringing proceedings" in relation to a registered trade mark includes proceedings under section 36;

"prescribed" means prescribed by rules made under this Act;

"published" means making available to the public;

"Registrar" means the Registrar of Industrial Property, designated as such pursuant to the Jamaica Intellectual Property Office Act;

25/2001
3rd Sch.

"register" means the register referred to in section 61;

"registered trade mark" means a trade mark that is actually on the register;

"sign" includes a word (including a personal name, design, letter, numeral, colour, combination of colours or a combination of the foregoing or the shape of goods or their packaging);

"trade" includes any business or profession;

"trade mark" means any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking.

(2) References in this Act to use (or any particular description of use) of a trade mark or of a sign identical with or similar to or likely to be mistaken for a trade mark, include use or that description of use, otherwise than by means of a graphic representation.

PART II. *Property Rights in Registered Marks*

Collective marks;
Certification marks.
First Schedule.
Second Schedule.

3. Unless the context otherwise requires, references in this Act to a trade mark include references to a collective mark and a certification mark; and the provisions of this Act shall apply to collective marks, subject to the provisions of the First Schedule and to certification marks, subject to the provisions of the Second Schedule.

Property right in registered trade marks.

4.—(1) The registration of a trade mark under this Act confers a property right on the proprietor of the trade mark who is entitled to the rights and remedies provided by this Act.

(2) Registration of a trade mark shall be in accordance with the provisions of Part III.

(3) Proceedings may not be instituted under this Act to prevent the infringement of an unregistered trade mark or to recover damages in respect of such infringement, but nothing in this Act shall be construed to affect the law relating to passing off.

Rights referred.

5.—(1) Subject to section 10, the proprietor of a registered trade mark has exclusive rights in the trade mark; and any use of the mark in Jamaica without the proprietor's consent, constitutes an infringement of such rights, as specified in section 9.

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(2) The rights of the proprietor have effect from the date of registration (which is the date of filing in accordance with section 24 (4)) but—

- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 70 is committed by anything done before the date on which it was in fact registered.

6.—(1) Where two or more persons are registered joint ^{Joint} proprietors of a trade mark, each of them is entitled to an equal undivided share in the registered trade mark, unless there is an agreement to the contrary. ^{proprietors.}

(2) Where two or more persons are registered as joint proprietors, the following provisions of this section shall apply.

(3) Unless there is an agreement to the contrary, each joint proprietor by himself or his agent, and without the consent of the other joint proprietors or any obligation to account to them, is entitled to do any act which would otherwise amount to an infringement of the registered trade mark.

(4) A joint proprietor shall not, without the consent of the other joint proprietor or proprietors—

- (a) grant a licence to use the registered trade mark; or
- (b) assign or charge his share in the registered trade mark.

(5) One joint proprietor may institute infringement proceedings in relation to a registered trade mark, but he shall not, without the leave of the Court, proceed with the action unless the other proprietor or each of the other proprietors, as the case may be, is joined as a plaintiff or added as a defendant.

(6) Unless he takes part in the proceedings, a joint proprietor who is added as a defendant shall not be made liable for any costs in the action.

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- (7) Nothing in this section affects—
- (a) the granting of interlocutory relief on the application of one joint proprietor; or
 - (b) the mutual rights or obligations of trustees or personal representatives or their rights and obligations in those capacities.

Property right in application for registration of trade mark.

7. The provisions of section 4 (which relate to property right in a registered trade mark) shall apply with necessary modifications, in relation to an application for the registration of a trade mark, as it applies to a registered trade mark.

Duration of rights.

8. A trade mark shall be registered for a period of ten years from the date of registration and may be renewed in accordance with section 40.

Acts of infringement.

9.—(1) References in this Act to the infringement of a registered trade mark are references to the infringement of the rights of the proprietor in the trade mark.

(2) A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade a sign that is identical with the trade mark, in relation to goods or services that are identical with the goods or services for which the trade mark is registered.

(3) A registered trade mark is infringed by a person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade a sign which is likely to deceive or confuse the public for the reason that—

- (a) the sign is identical with the trade mark and is used in relation to goods or services that are similar to the goods or services for which the trade mark is registered; or
- (b) the sign is similar to the registered trade mark and is used in relation to goods or services that are identical

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with or similar to the goods or services for which the trade mark is registered.

(4) A registered trade mark is infringed by any person who, not being the proprietor of the trade mark or a person authorized by him, uses in the course of trade, a sign that is identical with or similar to the registered trade mark in the circumstances referred to in subsection (5).

(5) The circumstances mentioned in subsection (4) are that—

- (a) in relation to goods or services that are not similar to the goods or services for which the trade mark is registered; and
- (b) the sign has a reputation in Jamaica and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.

(6) For the purposes of this section, a person uses a sign if he does anything which associates or purports to associate the sign with any goods or services, in particular if he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for the those purposes under the sign or offers or supplies services under the sign;
- (c) imports or exports goods under the sign; or
- (d) uses the sign on business papers or in advertising.

(7) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services shall be treated as a party to any use of the material which infringes the registered trade mark if, when he applied the mark, he knew or had reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee.

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(8) Nothing in the foregoing provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, so, however, that any such use otherwise than in accordance with honest practices in industrial or commercial matters, shall be treated as infringing the rights in the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.

Limitation
of rights.

10.—(1) Subject to section 46, registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter trade mark is registered.

(2) A registered trade mark is not infringed by the use of the mark in any of the following circumstances, so long as such use is in accordance with honest practices in industrial or commercial matters, that is to say—

- (a) the use by a person of his own name or address;
- (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular, as accessories or spare parts.

PART III. *Registration of Trade Marks*
. Disqualification from Registration

Nonregis-
trable marks.

11.—(1) Subject to subsection (2) the following are not registrable under this Act—

- (a) signs which do not satisfy the definition of "trade mark" appearing in section 2 (1);
- (b) trade marks which are devoid of any distinctive character;

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- (c) trade marks which consist exclusively of signs or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) of subsection (1) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) A trade mark is not registrable if—

- (a) it is contrary to public policy or to accepted principles of morality;
- (b) it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services or otherwise;
- (c) it is a trade mark to which section 12 refers;
- (d) its use is prohibited in Jamaica by any law;
- (e) the application is made in bad faith;

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- (f) it is of such a nature as to—
- (i) disparage persons (living or dead) or institutions or beliefs; or
 - (ii) falsely suggest a connection with such persons, institutions or beliefs.

Protected
emblems.

12.—(1) A trade mark which consists of or contains a representation of the Coat of Arms of Jamaica, national flag of Jamaica and other national symbols shall not be registered.

(2) A trade mark shall not be registered in the cases specified in sections 50 and 51.

Existence of
earlier
mark.

13.—(1) A trade mark shall not be registered if—

- (a) it is identical with an earlier trade mark; and
- (b) the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if—

- (a) it is identical with an earlier trade mark and the goods or services in relation to which application for registration is made are similar to those for which the earlier trade mark is registered; or
- (b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected,

and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark.

(3) A trade mark which is identical with or similar to an earlier trade mark and is to be registered in relation to goods or services that are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that,

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the earlier trade mark has a reputation in Jamaica and the use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Jamaica is liable to be prevented—

- (a) by virtue of any law (in particular the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) of this subsection, in particular, by virtue of the law relating to copyright or rights in designs.

(5) A person who is entitled under this section to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(6) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

14.—(1) In this Act "earlier trade mark" means—

- (a) a registered trade mark; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well known trade mark; or
- (c) a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (b), subject to its being so registered.

Meaning of
earlier
trade mark.

(2) A trade mark as defined in subsection (1) (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

Honest concurrent use of mark.

15. Where on an application for the registration of a trade mark it appears to the Registrar that—

- (a) there is an earlier trade mark to which section 13 (1), (2) or (3) applies; or
- (b) there is an earlier right in relation to which section 13 (4) applies,

then, unless the proprietor of the earlier trade mark or other right raises objection on any such ground in opposition proceedings, the Registrar shall not refuse the application by reason of the earlier trade mark or earlier right, if the applicant satisfies the Registrar that there has been honest concurrent use of the trade mark for which registration is sought.

Application for Registration of Mark

Application.

16.—(1) An application for registration of a trade mark shall be made to the Registrar in such form as may be required pursuant to section 54 and be accompanied by the prescribed fees.

(2) The application shall contain—

- (a) the name and address of the applicant;
- (b) a request for registration of a trade mark;
- (c) a statement of the goods or services in relation to which registration of the mark is sought;
- (d) a representation of the trade mark; and
- (e) such other particulars as may be prescribed.

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(3) The application shall state that the trade mark is being used by the applicant or with his consent in relation to the goods or services or that he has a *bona fide* intention that it should be so used.

17.—(1) The date of filing of an application for registration of a trade mark is the date on which the applicant furnishes the documents containing everything required under section 16; and where documents are furnished on different days, the date of filing is the last of those dates.

Date of filing.

(2) References in this Act to the date of application for registration are to the date of filing of the application.

18.—(1) For the purposes of the registration of trade marks, goods and services shall be classified in accordance with the prescribed system of classification.

Classifica-
tion of
goods and
services.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final.

19.—(1) A person who has duly filed an application for the protection of a trade mark in a Convention country ("a Convention application") or his successor in title, has a right to priority for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

Right to
priority.

(2) If the application for registration under this Act is made within that six-month period—

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application; and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in Jamaica in the period between that date and the date of the application under this Act.

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(3) Any filing which, in a Convention country is equivalent to a regular national filing under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(4) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority) if at the time of the subsequent application—

- (a) the previous application has been withdrawn, abandoned or refused without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) it has not yet served as a basis for claiming a right of priority.

(5) A right of priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently; and the reference in subsection (1) to the applicant's successor in title shall be construed accordingly.

(6) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(7) In this section—

- (a) "Convention country" means a country, other than Jamaica, which is a party to the Paris Convention as described in section 48; and
- (b) "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

20.—(1) The Minister may, by order, subject to negative resolution, make provision for conferring on a person who has

Claim of
priority by
overseas
applicant.

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duly filed an application in a specified country for the protection of a trade mark in relation to goods and services, a right of priority for the purpose of registering the same trade mark under this Act for some or all of such same goods or services, for a specified period from the date of filing that application.

(2) An order made under subsection (1) may make provision corresponding to that made under section 48 in relation to Convention countries or such other provision as appears to the Minister to be appropriate.

Registration Procedure

21.—(1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of the Act and rules, and for that purpose shall carry out a search of earlier trade marks to such extent as the Registrar considers necessary.

Examination
of applica-
tion.

(2) Where it appears to the Registrar that the requirements for registration are not met, the Registrar shall inform the applicant and give him an opportunity, within such period (being not less than thirty days) as the Registrar may specify, to make representations or to amend the application.

(3) Where the applicant—

- (a) fails to satisfy the Registrar that those requirements are met or to amend the application so as to meet them; or
- (b) fails to respond before the end of the specified period,

the Registrar shall refuse to accept the application.

(4) The Registrar shall accept the application if it appears to him that the requirements for registration are met.

22.—(1) On the acceptance of an application, the Registrar shall cause it to be published in the *Gazette* or in such other manner as may be prescribed.

Publication,
opposition,
etc.

(2) Any person may, within the prescribed time from the date of the publication of the application and in the prescribed

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manner, give to the Registrar written notice of opposition to the registration, stating the grounds of opposition.

(3) Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the Registrar as to whether the trade mark should be registered; and the Registrar shall inform the applicant of any such observations.

(4) A person who makes observations does not thereby become a party to the proceedings on the application.

Actions by
applicant
respecting
application.

23.—(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application; and if the application has been published, such withdrawal or restriction shall be published in like manner.

(2) An application may be amended otherwise than under subsection (1), at the request of the applicant, but only by the correction of—

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

and so long as the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(3) Rules may make provision for the publication of any amendment affecting the representation of the trade mark or the goods or services covered by the application and the making of objections by any person claiming to be affected by the amendment.

Registration.

24.—(1) Where an application has been made for the registration of a trade mark and—

- (a) no notice of opposition is given within the period referred to in section 22 (2); or

- (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the Registrar shall register a trade mark unless it appears to the Registrar, having regard to matters coming to the Registrar's notice since the acceptance of the application, that it was accepted in error or unless the prescribed fee has not been paid within the prescribed period.

(2) Where the prescribed fee is not paid within the prescribed period, the application shall be deemed to be withdrawn.

(3) Where the registration of a trade mark is not completed within six months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in the notice.

(4) The registration of a trade mark shall take effect as of the date of filing of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(5) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate of registration.

25.—(1) Rules may make provision with respect to—

- (a) the division of an application for the registration of a trade mark into several applications;
- (b) the merging of separate applications or registrations;
- (c) the registration of a series of trade marks.

Further provisions re registration, series, etc.

(2) The rules may include provision as to—

- (a) the circumstances in which and the conditions subject to which division, merger or registration of a series is permitted; and

- (b) the purposes for which an application to which the rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

(3) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

Registration
subject to
disclaimer.

26.—(1) If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains any matter common to the trade or otherwise of a non-distinctive character,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain on the register shall act in accordance with subsection (2).

(2) The Registrar or the Court may require, as a condition of the trade mark being on the register, that the proprietor—

- (a) shall disclaim any right to the exclusive use of any part of the trade mark or any portion of any matter referred to in subsection (1), to the exclusive use of which they hold him not to be entitled;
- (b) shall make such other disclaimer as they consider necessary for the purpose of defining the proprietor's right under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

(3) An applicant for registration of a trade mark or the proprietor of a registered trade mark may by notice in writing given to the Registrar—

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- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

(4) Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 5 are restricted accordingly, and a disclaimer properly made may not be revoked.

(5) Rules shall provide for the publication and entry in the register of a disclaimer or limitation.

PART IV. Dealings with Registered Trade Marks Assignment and Transmission

27.—(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property, and is so transmissible either in connection with the goodwill of a business or otherwise.

Assignment,
etc., of
trade mark.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to—

- (a) some but not all of the goods or services for which it is registered; or
- (b) use of the trade mark in a particular manner or a particular locality.

(3) Notwithstanding anything in subsection (1) or (2), but subject to subsection (4), a registered trade mark is not transmissible where its transmission would be likely to deceive or confuse the public by reason of the conferment of exclusive rights on more than one person, to use identical or similar trade marks in relation to identical or similar goods or services.

(4) An assignment of a registered trade mark is not effective unless it is in writing signed by or on behalf of the assignor,

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or, as the case may be, a personal representative; and where the assignor or personal representative is a body corporate, this requirement may be satisfied by the affixing of its seal.

(5) The foregoing provisions of this section and such provisions as may be prescribed apply to assignment by way of security as in relation to any other assignment.

(6) A registered trade mark may be the subject of a charge in the same way as other personal or moveable property.

(7) An assignment may be registered as provided in section 30.

(8) Rules may make provision in relation to the assignment of a trade mark and as respects any trade mark which is or is to be the subject of a charge.

(9) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

Licensing

Provisions as
to licences.

28.—(1) A licence to use a registered trade mark may be general or limited; and a limited licence may apply, in particular, in relation to—

- (a) some but not all of the goods or services for which the trade mark is registered; or
- (b) use of the trade mark in a particular manner or a particular locality.

(2) A licence is not effective unless it is in writing signed by or on behalf of the grantor; and where the grantor is a body corporate, this requirement may be satisfied by the affixing of its seal.

(3) Unless the licence otherwise provides, it is binding on a successor in title to the grantor's interest; and references in this

Act to the doing of anything with or without the consent of the proprietor of the registered trade mark shall be construed accordingly.

(4) A licensee may grant a sub-licence if the licence so permits; and references in this Act to a licence or licensee shall include a sub-licence or sub-licensee.

29.—(1) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence. Rights of exclusive licensee.

(2) An exclusive licence may provide that, in relation to any matter occurring after the grant of the licence, the licensee shall have, to the extent specified in the licence, the rights and remedies which would apply if the licence had been an assignment.

(3) Where provision is made in an exclusive licence pursuant to subsection (2), then, subject to the provisions of the licence, subsection (4) and section 33, the licensee is entitled to bring infringement proceedings in his own name against any person other than the proprietor.

(4) The rights and remedies available to an exclusive licensee pursuant to this section are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

Registration of Transactions

30.—(1) The following are registrable transactions for the purposes of this Act— Registrable transactions.

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant of a licence under a registered trade mark;
- (c) the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;

- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;
- (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

(2) Any person claiming to be entitled to an interest in or under a registered trade mark arising from a registrable transaction, or any other person claiming to be affected by such a transaction, may apply to the Registrar for the entry on the register of the prescribed particulars of the transaction.

(3) Until an application has been made under subsection (2)—

- (a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark without knowledge of the transaction; and
- (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 33 or 34.

(4) Subject to subsection (5), where, by virtue of a registrable transaction a person becomes the proprietor or a licensee of a registered trade mark, then, unless he applies for the registration of the prescribed particulars of the transaction within a period of six months of the date of the transaction or such later period thereafter as appears to the Court reasonable in the circumstances, he shall not be entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the registration of the prescribed particulars.

(5) Subsection (4) shall not apply if the proprietor or licensee can show that the person who infringed the registered trade mark had actual knowledge of the registrable transaction.

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(6) Rules may provide for—

- (a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence;
- (b) the removal of such particulars from the register—
 - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or
 - (ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of the Registrar's intention to remove the particulars from the register;
- (c) the amendment or removal from the register of particulars relating to a security interest, on the application of, or with the consent of, the person entitled to the benefit of that interest.

PART V. *Infringement Proceedings*

31.—(1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

Infringement
actionable
by proprietor.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

32.—(1) In relation to a registered trade mark, goods are infringing goods under this Act where they or their packaging bear a sign that is identical with or similar to the registered trade mark and—

Meaning of
infringing
goods, etc.

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark; or

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- (b) the goods are proposed to be imported into Jamaica and the application of the sign in Jamaica to them or their packaging would be an infringement of the registered trade mark; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(2) In relation to a registered trade mark, material is infringing material if it bears a sign identical with or similar to the registered trade mark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or
- (b) it is intended to be so used and such use would infringe the registered trade mark.

(3) In relation to a registered trade mark, articles are infringing articles if they—

- (a) are specifically designed or adapted for making copies of a sign identical with or similar to the registered trade mark; and
- (b) are in the possession, custody or control of a person who knows or has reason to believe that the articles have been or are to be used to produce infringing goods or material.

Special provisions
re exclusive
licensee.

33.—(1) In an action brought by an exclusive licensee by virtue of section 29, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(2) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the Court,

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proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(3) The provisions of subsection (2) do not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(4) A person who is added as a defendant as mentioned in subsection (2) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(5) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or have had concurrent rights of action—

- (a) in assessing damages the Court shall take into account the terms of the licence and any pecuniary remedy already awarded or available to either of them in respect of the infringement;
- (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
- (c) the Court shall, if an account of profits is directed, apportion the profits between them as the Court considers just, subject to any agreement between them.

(6) Subsection (5) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the order.

(7) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 38; and the Court may on

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application of the licensee make such order under that section, as it thinks fit, having regard to the terms of the licence.

(8) The provisions of subsections (2) to (7) have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

(9) Where and to the extent that an exclusive licensee has the rights and remedies of an assignee by virtue of section 33, then the provisions of this section shall apply as if he were the proprietor of the registered trade mark.

Rights of
other
licensees in
infringement
proceedings.

34.—(1) Subject to the provisions of this section, unless his licence or any licence through which his licence is derived provides otherwise, a licensee is entitled to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(2) If the proprietor refuses to take infringement proceedings or fails to do so within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor.

(3) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(4) The provisions of subsection (3) do not affect the granting of interlocutory relief on an application made by a licensee alone.

(5) A proprietor who is added as a defendant as required under subsection (3) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) Where infringement proceedings are taken by a proprietor of a registered trade mark, any loss suffered or likely to be suffered by licensees shall be taken into account in such

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proceedings; and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(7) This section shall not apply where or to the extent that a licensee has a right to bring proceedings in his own name.

35.—(1) The Court may make an order requiring the person who is found to have infringed a registered trade mark—

Order for
erasure, etc.,
of sign.

- (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.

(2) If an order under subsection (1) is not complied with or it appears to the Court likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered to such person as the Court may direct for erasure, removal or obliteration of the sign or for destruction, as the case may be.

36.—(1) The proprietor of a registered trade mark may apply to the Court for an order for the delivery up to him or to such other 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.

Order for
delivery up,
etc.

(2) An application shall not be made after the end of the period specified in section 37 and no order shall be made unless the Court also makes or it appears to the Court that there are grounds for making, an order under section 38.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 38 is not made, retain them pending

the making of an order, or the decision not to make an order under that section.

(4) Nothing in this section affects any other power of the Court.

Limitation of
time for order
for delivery
up

37.—(1) Except in the circumstances specified in subsection (2), an application for an order under section 36 may not be made after the period of six years from—

- (a) the date on which the trade mark was applied to the goods or their packaging, in the case of infringing goods;
- (b) the date on which the trade mark was applied to the material, in the case of the infringing material; or
- (c) the date on which the articles were made, in the case of infringing articles.

(2) If during the whole or part of such period the proprietor of the registered trade mark was—

- (a) under a disability; or
- (b) prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

he may make an application at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

Order for
disposal.

38.—(1) An application may be made to the Court—

- (a) for an order that infringing goods, material or articles delivered up pursuant to 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 should be made.

(2) In determining what order (if any) should be made, the Court shall consider whether other remedies available in an

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action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and to protect their interests.

(3) Provision shall be made by rules of court as to the service of notice on persons having an interest in goods, material or articles and any such person is entitled—

- (a) to appear in proceedings for an order under this section, whether or not he was served with notice; and
- (b) to appeal against any order made, whether or not he appeared.

(4) An order made under subsection (3) shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(5) Where there is more than one person interested in the goods, material or articles, the Court shall make such order as it thinks just.

(6) If the Court decides that no order should be made under this section, the person who is in possession, custody or control of the goods, material or articles before they were being delivered up is entitled to their return.

(7) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under section 137 of the Copyright Act.

39. In any civil proceedings, if a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

Burden of proving use of mark.

PART VI. *Actions Affecting Registered Trade Mark*

40.—(1) On the expiration of the initial period of registration of a trade mark as specified in section 8, the registration may be

Renewal.

TRADE MARKS

renewed for periods of ten years; and the renewal shall take effect from the expiration of the previous registration.

(2) A request for renewal shall be made to the Registrar in the prescribed form and accompanied by the prescribed renewal fee paid and shall be made before the expiry of the registration, failing which—

- (a) the request may be made and the fee paid within such further period as may be prescribed, being not more than six months; and
- (b) a prescribed additional renewal fee shall also be paid within that period.

(3) Where the registration of a trade mark is not renewed as provided in the foregoing provisions of this section, the Registrar shall remove the trade mark from the register.

(4) Rules may make provision for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions, including the payment of fees, as may be prescribed.

(5) Rules shall make provision for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(6) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

Alteration
of registered
trade mark.

41.—(1) A registered trade mark shall not be altered in the register during the period of registration or on renewal.

(2) Notwithstanding subsection (1), the Registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to the alteration of that name or address and does not substantially affect the identity of the mark.

(3) Rules shall make provision for the publication of any alteration allowed and for the making of objections by any person claiming to be affected by it.

42.—(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered. Surrender of registered trade mark.

(2) Rules may make provision for—

- (a) the manner and effect of a surrender; and
- (b) for protecting the interests of other persons having a right in the registered trade mark.

43.—(1) The registration of a trade mark may be revoked on any of the following grounds— Grounds for revocation.

- (a) that within the period of three years following the date of completion of the registration procedure and up to one month before the date of application for revocation, the trade mark has not been put to *bona fide* use in Jamaica by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that in consequence of acts or inactivity 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;
- (c) that the trade mark is likely to deceive or confuse the public 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) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Jamaica includes affixing the trade mark to goods or to their packaging in Jamaica solely for export purposes.

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(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1) (a) if use of the mark is resumed or commenced after the expiry of three years but before the application for revocation is made, except that, any such commencement or resumption of use after the expiry of the three year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) The registration of a trade mark shall not be revoked where the Registrar is satisfied that the proprietor intends to use the trade mark before the expiration of the period for which it is registered.

Application
for revo-
cation.

44.—(1) Subject to subsection (2), an application for revocation may be made by any person to the Registrar or the Court.

(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 where the application is made to the Registrar, he may at any stage refer the application to the Court.

(3) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(4) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

- (a) the date of the application for revocation; or
- (b) an earlier date, if the Registrar or the Court is satisfied that the grounds for revocation existed at that earlier date.

Invalidity of Registration

Grounds for
invalidity.

45.—(1) Subject to subsection (2) the registration of a trade mark may be declared invalid on the ground that—

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- (a) it was disqualified from registration under section 11 or any of the provisions referred to in that section;
- (b) there is an earlier trade mark in relation to which the conditions specified in section 13 (1), (2) and (3) obtain or an earlier right in relation to which the conditions set out in section 13 (4) are satisfied, and the proprietor of that earlier trade mark or earlier right has not consented to the registration.

(2) Where a trade mark was registered despite being disqualified under section 11 (1) (a) (b) or (c), it shall not be declared invalid if through use, it has acquired a distinctive character in relation to the goods or services for which it is registered.

46.—(1) An application for a declaration of invalidity may be made by any person to the Registrar or the Court.

Application
for declara-
tion of
invalidity.

(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 where the application is made to the Registrar, the Registrar may at any stage of the proceedings refer to the Court any matter arising from the application which involves a question of law of public importance.

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

(4) 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.

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

Effect of
acquie-
scence.

47.—(1) Where a registered trade mark has been used in Jamaica for a continuous period of three years with the knowledge and acquiescence of the proprietor of an earlier trade mark or other earlier right, then, unless the registration of the later trade mark was applied for in bad faith, such proprietor shall not be entitled to apply for a declaration that the registration of the later trade mark is invalid or to oppose the use of the later trade mark in connection with the goods or services in relation to which it has been used.

(2) In the circumstances specified in subsection (1), the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

PART VII. *Provisions to Implement International Conventions*

The Paris Convention: Supplementary Provisions

Paris
Convention.

48.—(1) In this Act—

- (a) "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; and
- (b) "Convention country" means a country, other than Jamaica, which is a party to that Convention.

(2) The Minister may by order make such amendments to this Act and rules as appear to him appropriate on account of any revision or amendment of the Paris Convention occurring after the appointed day.

(3) An order made under subsection (1) is subject to affirmative resolution.

Well-known
marks.

49.—(1) The proprietor of a well-known mark which is entitled to protection under the Paris Convention, as mentioned in subsection (2), is entitled to restrain by injunction the use in Jamaica of a trade mark which, or the essential part of which, is identical

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with or similar to his mark in relation to identical or similar goods or services, where the use of the mark is likely to cause confusion.

(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—

- (a) a citizen of a Convention country; or
- (b) is habitually resident, in or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business or has any goodwill in Jamaica; and references to the proprietor of such a mark shall be construed accordingly.

(3) The right conferred by subsection (1) is subject to section 47.

(4) Subsection (1) shall not be construed to affect the continuation of any *bona fide* use of a trade mark, begun before the appointed day.

50.—(1) The Registrar shall not register a trade mark consisting of or containing the flag of a Convention country, without the authorization of the competent authority of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization.

National
emblems of
Convention
countries.

(2) The Registrar shall not register a trade mark consisting of or containing the armorial bearings or any other state emblems of a Convention country which is protected under the Paris Convention, without the authorization of the competent authorities of that country.

(3) Where a trade mark consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty, being a sign or hallmark protected under the Paris Convention, the Registrar shall not register the trade mark in relation to goods or services of the same or a similar kind as those

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in relation to which the sign or hallmark indicates control or warranty, without the authorization of the competent authority of the country concerned.

(4) The provisions of this section as to national flags, armorial bearings and other state emblems and official signs or hallmarks, apply equally to anything, the heraldic elements of which, in the opinion of the Registrar, imitates any such flag, armorial bearings or other emblem or sign or hallmark.

(5) This section does not prevent the registration of a trade mark on the application of a national of a country who is authorized to make use of a state emblem, or official sign or hallmark of that country, notwithstanding that it is similar to that of another country.

(6) The competent authorities whose authorization for registration of a trade mark is or would be required under this section may restrain by injunction any use of the mark in Jamaica without their authorization.

Other state emblems.

51.—(1) For the purposes of section 50 state emblems of a Convention country (other than the national flag) and other official signs or hallmarks, shall be regarded as protected under the Paris Convention only if or to the extent that—

- (a) the country in question has notified the Government of Jamaica in accordance with Article 6ter (3) of the Convention that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) the Government of Jamaica has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

(2) For the purposes of section 52 the emblems, abbreviations and names of an international organization shall be

regarded as protected under the Paris Convention only if or to the extent that—

- (a) the organization in question has notified the Government of Jamaica in accordance with Article 6ter (3) of the Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) the Government of Jamaica has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of—

- (a) state emblems and official signs or hallmarks; and
- (b) the emblems, abbreviations and names of international organizations which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter (3).

52.—(1) The Registrar shall not register a trade mark consisting of or containing any emblem to which this section applies, without the authorization of the international organization concerned, unless it appears to the Registrar that the use of the symbol in the manner proposed—

Emblems of
inter-
national
organiza-
tions.

- (a) is not such as to suggest to the public that a connection exists between the organization and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organization.

(2) The emblems to which this section applies are—

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names of international inter-governmental organizations of which one or more Convention countries are members.

(3) The provisions of this section as to emblems apply equally to anything, the heraldic elements of which, in the opinion of the Registrar, imitate any such emblem.

(4) The international organization whose authorization for registration of a trade mark is or would be required under this section may restrain by injunction any use of the mark in Jamaica without its authorization.

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(5) Nothing in this section affects the rights of a person whose *bona fide* use of the trade mark in question began before the specified date.

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(6) In subsection (5), the specified date means the date when the relevant provisions of the Paris Convention enter into force in relation to Jamaica.

Acts of
Agents.

53.—(1) The provisions of this section apply where an application for registration of a trade mark is made by a person who is the agent or representative of the proprietor of the mark in a Convention country.

(2) The Registrar shall refuse to register the trade mark if the proprietor opposes the application.

(3) If the application (not being so opposed) is granted, the proprietor may—

- (a) apply for a declaration of the invalidity of the registration; or
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

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(4) The proprietor of a trade mark may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in Jamaica which is not authorized by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representatives justifies his action.

(6) An application under subsection (3) (a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor acquiesced for a continuous period of three years or more.

PART VIII. *Administration*

Functions of the Registrar

54. The Registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act and shall cause the forms and directions for their use to be published in the prescribed manner. Forms.

55.—(1) Subject to such restrictions as may be prescribed, after the publication of an application for registration of a trade mark, the Registrar shall provide information relating to the application to any person who makes a request in the prescribed manner and pays the prescribed fee (if any) and shall permit him to inspect any documents relating to the application or to any registered trade mark resulting from it, as may be specified in the request. Supply of information.

(2) The Registrar shall not publish any documents or communicate any information relating to an application for registration of a trade mark before the publication of the application except—

(a) in such cases and to such extent as may be prescribed;

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- (b) with the consent of the applicant; or
- (c) in the circumstances set out in subsection (3).

(3) Where a person has been notified that an application for registration of a trade mark has been made and that the applicant will, if the application is granted, bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has not been published; and subsection (1) shall apply accordingly.

Power to
award costs,
etc.

56.—(1) Rules may make provision—

- (a) empowering the Registrar in any proceedings before the Registrar—
 - (i) to award any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid;
 - (ii) in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal; and
- (b) as to the consequences if security is not given.

(2) An order under subsection (1) (a) is enforceable in the same way as an order of the Court.

Evidence
before
Registrar.

57. Rules may make provision for—

- (a) the giving of evidence in proceedings before the Registrar under this Act by affidavit or statutory declaration;
- (b) the conferment on the Registrar of the powers to examine witnesses on oath and to require the discovery and production of documents;
- (c) the attendance of witnesses in proceedings before the Registrar.

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58.—(1) The Registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention or arrangement to which Jamaica is a party. Exclusion of liability.

(2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorized by this Act, or any such treaty, convention or arrangement or any report or other proceedings consequent upon such examination.

(3) No proceedings shall lie against an officer of the Office of the Registrar of Companies in respect of any matter for which, by virtue of this section, the Registrar is not liable.

59.—(1) The Registrar is entitled to appear and be heard in the proceedings before the Court in an application for— Registrar's appearance in proceedings.

- (a) the revocation of the registration of a trade mark;
- (b) a declaration of the invalidity of the registration of a trade mark; or
- (c) the rectification of the register,

and shall appear if the Court so directs.

(2) Unless otherwise directed by the Court, the Registrar may, instead of appearing, submit to the Court a statement in writing signed by him giving particulars of—

- (a) any proceedings before him in relation to the matter in issue;
- (b) the grounds of any decision given by him affecting it;
- (c) the practice of the Office of the Registrar of Companies in like cases; or
- (d) such matters relevant to the issues and within his knowledge, as the Registrar thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

(3) Anything required to be done by the Registrar under this section may be done by an officer authorized by him.

Appeal
against
decisions
of Regis-
trar.

60.—(1) Except where otherwise expressly provided by rules, an appeal lies to the Court from any decision of the Registrar under this Act and on any such appeal the Court shall have and exercise the same discretionary powers as are conferred on the Registrar under this Act.

(2) For the purpose of this section "decision" includes any act done by the Registrar in exercise of a discretion vested in him by or under this Act.

The Register

Register
to be kept.

61.—(1) The Registrar shall maintain a register of trade mark in which shall be entered in accordance with this Act—

- (a) registered trade marks;
- (b) such particulars as may be prescribed of registrable transactions affecting the registered trade mark; and
- (c) such other matters relating to the registered trade marks as may be prescribed.

(2) The register shall be kept in such manner as may be prescribed and provision shall be made by rules for public inspection of the register and the supply of certified or uncertified copies or extracts of entries in the register, upon payment of the prescribed fee.

Correction
of register.

62.—(1) The proprietor, a licensee or any other person having a sufficient interest, may apply in the prescribed manner for the correction of an error or omission in the register, but an application under this section may not be made in respect of a matter affecting the validity of the registration.

(2) An application under subsection (1) may be made either to the Registrar or the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court the application shall be made to the Court; and

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(b) if in any other case, the application is made to the Registrar, the Registrar may—

- (i) at any stage of the proceedings refer the application to the Court; or
- (ii) after hearing the parties, determine the question between them, subject to appeal to the Court.

(3) Except where the Registrar or the Court directs otherwise, the effect of the correction of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Registrar may, on request made in the prescribed manner by a proprietor of a registered trade mark or licensee, enter any change in his name, address or description as appears on the register.

63.—(1) Rules may be made empowering the Registrar to do such things as the Registrar considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

Adaptation
of entries
to new
register.

(2) The rules may provide, in particular, for the amendment of existing entries on the register so as to accord with the new classification.

(3) The Registrar shall not exercise the power of amendment so as to extend the rights conferred by the registration, except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(4) The rules may empower the Registrar—

- (a) to require the proprietor of a registered trade mark within such time as may be prescribed, to file a proposal for amendment of the register; and

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(b) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.

(5) A proposal filed under subsection (4) shall be advertised and may be opposed in such manner as may be prescribed.

Registration
prima facie
evidence.

64. In all legal proceedings relating to a registered trade mark, including proceedings for the correction of the register, the registration of a person as a proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Certificate
of validity
by Court.

65.—(1) If in proceedings before the Court the validity of the registration of a trade mark is contested and the Court finds that the trade mark is validly registered, the Court may give a certificate to that effect.

(2) If the Court gives such a certificate and in subsequent proceedings—

- (a) the validity of the registration is again questioned; and
- (b) the proprietor obtains a final order or judgement in his favour,

he is entitled to his costs as between attorney-at-law and client, unless the Court directs otherwise.

(3) Subsection (2) does not extend to the costs of an appeal in any proceedings mentioned in that subsection.

PART IX. *General Provisions*

Powers of Commissioner of Customs Relating to Infringing Goods

Prohibited
goods.

66.—(1) The proprietor of a registered trade mark or a licensee, may give notice in writing to the Commissioner of Customs—

- (a) that he is the proprietor or, as the case may be, a licensee of the registered trade mark;

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- (b) that, at the time and place specified in the notice, goods which are infringing goods in relation to that registered trade mark are expected to arrive in Jamaica; and
- (c) that he requests the Commissioner to treat them as prohibited goods under the Customs Act.

(2) When a notice is in force under this section, the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited; but a person is not, by reason of the prohibition, liable to any penalty under the Customs Act other than forfeiture of the goods.

67. The Commissioner may make regulations subject to affirmative resolution in respect of the following matters—

Power of Commissioner to make regulations.

- (a) prescribing the form in which notice is to be given under section 66; and
- (b) requiring the person giving notice to give such evidence as may be prescribed in the regulations at the time or times so prescribed; and
- (c) requiring that person to comply with any prescribed conditions, in particular—
 - (i) to pay the prescribed fees in respect of the giving of the notice;
 - (ii) to give security in respect of any liability or expense which the Commissioner may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained;
 - (iii) to indemnify the Commissioner against any such liability or expense whether security has been given or not,

and regulations may make different provisions as respects different classes of case to which they apply and may include such incidental

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and supplementary provisions as the Commissioner considers necessary or desirable.

Disclosure
of informa-
tion.

68. When information relating to infringing goods, material or articles (as defined in section 32) has been obtained by the Commissioner for the purposes of or in connection with the exercise of his function in relation to imported goods, the Commissioner may authorize the disclosure of that information for the purpose of facilitating the exercise by any person of any function in connection with the investigation or prosecution of an offence under section 69 or any other law relating to such investigation or prosecution.

Offences

Unauthorized
use of
trade mark.

69.—(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 trade mark he—

- (a) applies to goods a sign identical with, or likely to be mistaken for, a registered trade mark; 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 a business any goods referred to in paragraph (6) 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 a business paper in relation to goods or for advertising goods; or

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- (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.

(4) No offence is committed under this section unless—

- (a) the goods are goods in respect of which the trade mark is registered; or
- (b) the trade mark has a reputation in Jamaica and the use of the sign takes, or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the reputation of the trade mark.

(5) It is a defence for a person charged with an offence under this section to show that he believed on reasonable grounds that the use of the sign in the manner in which was used or was to be used was not an infringement of the registered trade mark.

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(6) 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.

Falsifica-
tion of
entry.

70.—(1) A person commits an offence if he makes or causes to be made a false entry in the register or makes or causes any writing or document 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 or having reason to believe that the entry or writing is false.

(2) A person guilty of an offence under subsection (1) is liable—

- (a) on summary conviction before a Resident Magistrate to a fine not exceeding two hundred and fifty thousand dollars or to imprisonment for a term not exceeding six months;
- (b) on conviction before a Circuit Court to a fine or to imprisonment not exceeding six years or to both such fine and imprisonment.

Falsely
representing
trade mark
as registered
mark.

71.—(1) A person commits an offence if he—

- (a) represents that a mark is a registered trade mark; or
- (b) makes a representation as to the goods or services for which a trade mark is registered,

knowing or having reason reason to believe that the representation is false.

(2) The use in Jamaica in relation to a trade mark of the word "registered" or of any other word or symbol importing a

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reference (expressed or implied) to registration, shall be deemed to be a representation as to registration under this Act, unless it is shown that the reference is to registration in another country and that the trade mark is, in fact, so registered for the goods or services in question.

(3) A person guilty of an offence under this section is liable on summary conviction before a Resident Magistrate to a fine not exceeding two hundred and fifty thousand dollars or to imprisonment for a term not exceeding six months.

72.—(1) Where in connection with the investigation or prosecution of a relevant offence infringing items have come into the possession of any person, that person may apply under this section for an order for the forfeiture of the infringing items. Forfeiture.

(2) An application may be made—

- (a) to the Court before which any proceedings have been brought for a relevant offence relating to the infringing items; or
- (b) to the Resident Magistrate's Court by way of a complaint, if no application has been made under paragraph (a).

(3) A court shall not make an order under this section unless it is satisfied that the items are infringing items; and the Court may so regard them if it is satisfied that a relevant offence was committed in relation to items which are representative of the infringing items, whether by reason of being of the same design or part of the same consignment or batch, or otherwise.

(4) Any person aggrieved by an order of the Resident Magistrate's Court made under this section or a decision not to make an order may appeal to the Court of Appeal and an order so made may provide for delaying the coming into force of the order pending the making and determination of any appeal.

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(5) The Court may order that any infringing items forfeited under this section—

- (a) shall be destroyed in accordance with the directions of the Court; or
- (b) shall be released to such person as the Court may specify, on condition that such person causes the offending sign to be erased, removed or obliterated and complies with any order to pay costs made against him in the proceedings for the order for forfeiture.

(6) In this section—

"infringing items" means—

- (i) goods which, or the packaging of which bear a sign identical to or likely to be mistaken for a registered trade mark;
- (ii) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods or for advertising of goods; or
- (iii) articles specifically designed or adapted for making copies of such a sign; and

"relevant offence" means any offence under section 70 or under any other law relating to trade marks or any offence involving dishonesty or deception.

Offence by
partnership;
body corpo-
rate.

73.—(1) Where an offence under this Act is alleged to have been committed by a partnership, proceedings shall be brought against the partnership in the name of the firm and not in that of the partners, but without prejudice to any liability of the partners under subsection (4).

(2) Any rules of courts relating to the service of documents on a body corporate shall apply for the purposes of any proceedings under subsection (1).

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(3) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(4) Where a partnership is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly.

(5) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly.

(6) In this section "director" in relation to a body corporate whose affairs are managed by its members, means any member of the body.

Supplementary Provisions

74. In proceedings before the Court under this Act, the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties. Costs.

75.—(1) There shall not be entered in the register any notice of any trusts express, implied or constructive, nor shall any such notice be receivable by the Registrar. Trusts and equities.

(2) Subject to the provisions of this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

76. Where any act is required to be done under this Act, by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may be done in accordance with the rules, (or in particular cases by special leave of the Court) by an agent of that person duly authorized in the prescribed manner. Trade mark agents.

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Jamaican
waters
included.

77. For the purposes of this Act, the archipelagic waters and the territorial waters of Jamaica shall be treated as part of Jamaica.

Rules.

78. The Minister may from time to time make such rules subject to affirmative resolution—

- (a) for regulating the practice under this Act including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing in such manner as he may think fit, of copies of trade marks and other documents;
- (e) for the regulation of trade mark agents;
- (f) prescribing fees payable under this Act;
- (g) generally, for regulating the business of the Office of the Registrar of Companies in relation to trade marks and all things by this Act placed under the direction or control of the Registrar.

Fees.

79. There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.

Exemption
from stamp
duty.

80. All certificates and certified copies given by the Registrar under this Act shall be exempt from stamp duty.

Modification
of laws.

81.—(1) The Minister may, by order, with effect from any date specified in the order, not being earlier than the appointed day, alter any enactment if he considers such alteration to be necessary or expedient on account of anything contained in this Act.

(2) An order made pursuant to subsection (1) shall be subject to affirmative resolution.

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(3) In this section—

- (a) "alter" includes adapt or repeal;
- (b) "enactment" includes any instrument having the force of law but does not include this Act.

FIRST SCHEDULE

(Section 3)

Collective Marks

1. In relation to a collective mark, the reference in the definition of "trade mark" (appearing in section 2 (1)) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Signs comprised in collective marks.

2. Notwithstanding section 11 (1) (c), a collective mark may be registered which consists of signs or indications which may serve in trade to designate the geographical origin of the goods or services, but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Indication of geographic origin.

3.—(1) A collective mark shall not be registered if the public is likely to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a collective mark.

Restriction on registration.

(2) The Registrar may require that a mark in respect of which application is made for registration include some indication that it is a collective mark, and notwithstanding section 23 (2), an application may be amended so as to comply with any such requirement.

4.—(1) An applicant for registration of a collective mark shall file with the Registrar regulations governing the use of the mark; and such regulations shall specify—

Regulations re use of mark.

- (a) the persons authorized to use the mark;
- (b) the conditions of membership of the association; and
- (c) where they exist, the conditions of use of the mark, including any sanctions against misuse.

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(2) Provision may be made by rules for further requirements with which the regulations have to comply.

Approval of regulations.

5.— 1) A collective mark shall not be registered unless the regulations governing the use of the mark—

- (a) comply with paragraph 4 (1) and any further requirements imposed by rules; and
- (b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant shall file the regulations with the Registrar and pay the prescribed fee, failing which, the application shall be deemed to be withdrawn.

Power of Registrar relating to regulations.

6.—(1) If it appears to the Registrar that the requirements specified in paragraph 5 (1) are not met, the Registrar shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(2) If the applicant fails to satisfy the Registrar that those requirements are met or fails to file amended regulations so as to meet them, or to respond before the end of the specified period, the Registrar shall refuse the application.

(3) The Registrar shall accept the application if it appears that those and all other requirements are met and shall proceed in accordance with section 22.

Publication of regulations, opposition, etc.

7. The regulations governing the use of the mark shall be published and notice of opposition may be given and observations may be made, relating to the matters mentioned in paragraph 5 (1), in addition to any other grounds on which the application may be opposed or observations made.

Regulations open to inspection. Amended regulations to be filed.

8. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

9.—(1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with and accepted by the Registrar.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to the Register expedient to do so, cause them to be published, in which event, notice of opposition may be given, and observations may be made relating to the matters mentioned in paragraph 5 (1).

Authorized user: rights *re* infringement.

10.—(1) Sections 8 (6), 38 (2) and 66 apply in relation to an authorized user of a registered collective mark as they apply in relation to a licensee of a trade mark.

(2) The following provisions of this paragraph have effect as regards the rights of an authorized user in relation to infringement of a registered collective mark.

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(3) An authorized user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.

(4) If the proprietor—

(a) refuses to do so; or

(b) fails to do so within two months after being called upon,

the authorized user may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought by virtue of this paragraph, the authorized user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as plaintiff or added as a defendant; but this does not affect the granting of interlocutory relief on an application by an authorized user alone.

(6) A proprietor who is added as a defendant as mentioned in subparagraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the proprietor of a registered collective mark—

(a) any loss suffered or likely to be suffered by authorized users shall be taken into account; and

(b) the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

11. Apart from the grounds of revocation provided in section 43, the registration of a collective mark may be revoked on the ground— Grounds of revocation.

(a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 3 (1); or

(b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or

(c) that an amendment of the regulations has been made so that the regulations no longer comply with paragraph 4 (1) and any further conditions imposed by rules or are contrary to public policy or to accepted principles of morality.

12. Apart from the grounds of invalidity provided in section 45, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 3 (1) or 5 (1). Grounds of invalidity.

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SECOND SCHEDULE

(Section 3)

Certification Marks

Signs comprised in certification marks.

1. In relation to a collective mark, the reference in the definition of "trade mark" (appearing in section 2 (1)) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographic origin.

2. Notwithstanding section 11 (1) (c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Restriction on registration.

3.—(1) A certification mark shall not be registered—

- (a) if the proprietor carries on a business involving the supply of goods or services of the kind certified; or
- (b) if the public is likely to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may require that a mark in respect of which application is made for registration include some indication that it is a certification mark, and notwithstanding section 23 (2), an application may be amended so as to comply with any such requirement.

Regulations re use of mark.

4.—(1) An applicant for registration of a certification mark shall file with the Registrar regulations governing the use of the mark; and such regulations shall specify—

- (a) the persons authorized to use the mark;
- (b) the characteristics to be certified by the mark;
- (c) how the certifying body is to test those characteristics and to supervise the use of the mark;
- (d) the fees (if any) to be paid in connection with the operation of the mark; and
- (e) the procedures for resolving disputes.

(2) Provision may be made by rules for further requirements with which the regulations have to comply.

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5.—(1) A certification mark shall not be registered unless the regulations governing the use of the mark— Approval of regulations.

- (a) comply with paragraph 4 (1) and any further requirements imposed by rules and are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant shall file the regulations with the Registrar and pay the prescribed fee, failing which, the application shall be deemed to be withdrawn.

6.—(1) If it appears to the Registrar that those requirements specified in paragraph 5 (1) are not met, the Registrar shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations. Power of Registrar relating to regulations.

(2) If the applicant fails to satisfy the Registrar that those requirements are met or fails to file regulations amended so as to meet them or to respond before the end of the specified period, the Registrar shall refuse the application.

(3) The Registrar shall accept the application if it appears that those and all other requirements are met and shall proceed in accordance with section 22.

7. The regulations governing the use of the mark shall be published and notice of opposition may be given and observations may be made, relating to the matters mentioned in paragraph 5 (1), in addition to any other grounds on which the application may be opposed or observations made. Publication of regulations, opposition, etc.

8. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register. Regulations open to inspection.

9.—(1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with and accepted by the Registrar. Amended regulations to be filed.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to the Registrar expedient to do so, cause them to be published, in which event, notice of opposition may be given, and observations may be made relating to the matters mentioned in paragraph 5 (1).

10. The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar. Consent of Registrar required.

11.—(1) Sections 8 (6), 38 (2) and 66 apply in relation to an authorized user of a registered certification mark as they apply in relation to a licensee of a trade mark. Authorized user: right *re* infringement.

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(2) In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorized users shall be taken into account; and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds of
revocation.

12. Apart from the grounds of revocation provided in section 43, the registration of a certification mark may be revoked on the ground—

- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 3 (1); or
- (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
- (c) that an amendment of the regulations has been made so that the regulations no longer comply with paragraph 4 (1) and any further conditions imposed by rules, or are contrary to public policy or to accepted principles of morality.

Grounds of
invalidity.

13. Apart from the grounds of invalidity provided in section 45, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraphs 3 (1) or 5 (1).