

# The Protection of Geographical Indications Act, 2004 (Act 5 of 2004)

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*An Act to Make provision for the Protection of Geographical Indications and to provide for matters incidental thereto and connected therewith.*

*Be It Enacted* by The Queen’s Most Excellent Majesty, by and with the advice and consent of the Senate and House of Representatives of Jamaica, and with the authority of the same, as follows:—

**Part**

**I**

**Preliminary**

*Short Title and Commencement*

1. This Act may be cited as the Protection of Geographical Indications Act, 2004, and shall come into operation on a date to be notified by the Minister by notice published in the *Gazette*.

*Interpretation*

2. In this Act —

“Court” means the Supreme Court;

“geographical indication” means an indication which identifies a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

“good” means any natural or agricultural product or any product of industry or handicraft;

“interested party” includes any person who is—

(a) a producer, manufacturer or merchant, engaged in the production or manufacture of or trade in goods; and

(b) established in—

(i) the locality falsely indicated as the source of such goods or in the region where such locality is situated; or

(ii) the country so falsely indicated or in the country where such false indication is used;

“producer” means—

(a) a producer of agricultural products;

(b) a person who exploits natural products;

(c) a manufacturer of products of industry or handicraft; or

(d) a person who deals or trades in products referred to in paragraphs (a), (b) and (c);

“Registrar” means the Registrar of Industrial Property appointed under the Jamaica Intellectual Property Office Act.

## **Part Protection of Geographical Indications**

**II**

### *Application to Court to Prevent Misleading Use of Geographical Indication*

**3.—**(1) Any interested party may apply to the Court to prevent, in respect of a geographical indication—

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good originates in a geographical area other than the true place of origin, in a manner which misleads the public as to the geographical origin of the good; or

(b) any use which constitutes an act of unfair competition within the meaning of the Fair Competition Act; or

(c) any use which identifies wines or spirits, as the case may be, that do not originate in the place indicated by the geographical indication, as wines or spirits of that origin, even where—

(i) the true origin of those wines or spirits is indicated; or

(ii) the geographical indication is used in translation or accompanied by such expressions as “kind”, “type”, “style”, “imitation”, “comparable to” or other similar expressions.

(2) The Court may, in proceedings under this section, grant an injunction, award damages or grant such other remedy as it considers appropriate.

### *Protection of Geographical Indication*

**4.—**(1) Protection of a geographical indication shall be available under this Act—

(a) subject to subsection (2), whether or not the geographical indication is registered;

(b) against a geographical indication which, although literally true as to the territory, region or locality in which the good originates, falsely represents to the public that the good originates in another territory.

(2) A geographical indication that is registered under section 10(8)(a) shall, in any proceedings under section 3, be presumed, by virtue of its registration, to be a geographical indication as defined in section 2, unless the contrary is proved.

#### *Homonymous Geographical Indications*

5.—(1) Subject to section 4(1)(b), protection shall be accorded to homonymous geographical indications which relate to wines.

(2) Where concurrent use of homonymous geographical indications is permitted, the Registrar shall determine the practical conditions under which those geographical indications shall be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

#### *Geographical Indications Excluded from Protection*

6. No protection shall be available under this Act in respect of—

(a) indications which—

(i) do not fall within the definition of “geographical indication” in section 2; or

(ii) are contrary to public order or public morality; or

(b) geographical indications which, in their country of origin, are not or have ceased to be protected or have fallen into disuse.

#### *Offences*

7.—(1) Any person who knowingly or willfully uses a geographical indication in a manner specified in section 3(1)(a) or (c), commits an offence and, subject to subsection (2), is liable—

(a) on summary conviction in a Resident Magistrate’s Court to a fine not exceeding one million dollars or to imprisonment for a term not exceeding twelve months or to both such fine and imprisonment;

(b) on conviction before a Circuit Court to a fine or to imprisonment for a term not exceeding five years or to both such fine and imprisonment.

(2) Where the Court is satisfied that any benefits were derived by or accruing to the person convicted from the commission of the offence, the Court may order the person convicted to pay to the Crown such pecuniary penalty as the Court determines to be equivalent to the total value of such benefits.

**Part**  
**Registration of Geographical Indications**

**III**

*Registrar*

**8.—(1)** The Registrar shall keep a register to be known as the Register of Geographical Indications—

(a) in which shall be entered such matters as may be prescribed; and

(b) which shall be open for inspection to the public during business hours and from which extracts may be obtained on payment of the prescribed fee.

(2) The Registrar may correct any error of translation or transcription or any error contained in any application for the registration of a geographical indication, any document filed with him or in the Register.

(3) The Registrar—

(a) may, on receiving an application in writing and, if the circumstances of the case so merit, extend the time upon such terms as he may specify for doing any act or bringing any proceedings under this Act; and

(b) shall give notice of such extension to all the persons concerned with the doing of the act or the bringing of proceedings, even though the time for doing the act or bringing the proceedings has expired.

(4) The Registrar shall publish in the prescribed manner a list of the geographical indications registered under this Act.

*Application for Registration*

**9.—(1)** The persons specified in subsection (2) may apply to the Registrar, in the prescribed manner, for registration of a geographical indication.

(2) The persons referred to in subsection (1) are—

(a) any producer or group of producers carrying on an activity in the geographical area specified in the application with respect to the goods so specified;

(b) any competent authority.

(3) An application shall contain the following information—

(a) the name, address and nationality of the applicant;

(b) the capacity in which the applicant is applying for registration;

(c) the geographical indication for which registration is sought;

- (d) the geographical area to which the geographical indication applies;
- (e) the good to which the geographical indication applies;
- (f) the quality, reputation or other characteristic of the good in relation to which the geographical indication is used.

(4) Every application shall be accompanied by the prescribed application fee.

(5) In subsection (2)(b) “competent authority” means any association of persons recognized in the prescribed manner.

### *Registration*

**10.**—(1) Upon receipt of an application under section 9(1), the Registrar shall examine the application to determine whether the conditions specified in subsection (2) are satisfied.

(2) The conditions referred to in subsection (1) are that—

(a) the applicant is a person referred to in section 9(2);

(b) the geographical indication is not excluded from protection by virtue of section 6; and

(c) the application—

(i) contains the information required by section 9(3); and

(ii) complies with any regulation made hereunder in relation thereto.

(3) Where the Registrar ascertains that the conditions specified in subsection (2) are satisfied he shall cause the application to be published in the prescribed manner.

(4) Where an application is published pursuant to subsection (3), a person having an interest in the geographical indication (hereinafter referred to as the objector) may, within the prescribed time and in the prescribed manner, give notice to the Registrar of his opposition to the registration of the geographical indication on any of the grounds specified in subsection (5).

(5) The grounds referred to in subsection (4) are that—

(a) the geographical indication is excluded from protection by virtue of the provisions of section 6;

(b) the applicant is not entitled to apply for registration of the geographical indication; or

(c) the information required under section 9(3) has not been furnished or is incorrect,

and the objector shall state, in relation to—

(i) paragraph (a), the ground of exclusion;

(ii) paragraph (b), the reason the applicant is not entitled to apply for registration;

(iii) paragraph (c), details of the information that has not been furnished or is incorrect.

(6) The Registrar shall, on receipt of a notice under subsection (4), send a copy thereof to the applicant who shall send to the Registrar within the prescribed time and in the prescribed manner, a counter-statement of the grounds on which he relies for his application.

(7) Where the applicant sends a counter-statement, the Registrar shall—

(a) furnish a copy thereof to the objector;

(b) if requested, give the applicant and the objector the opportunity to be heard in the prescribed time; and

(c) decide whether or not to register the geographical indication.

(8) The Registrar shall—

(a) register a geographical indication if he is satisfied that the applicant has complied with subsection (2) and—

(i) the registration has not been opposed within the prescribed time; or

(ii) where it has been so opposed, the opposition has been resolved in the applicant's favour;

(b) refuse to register the geographical indication if he is not so satisfied.

(9) The Registrar shall publish in the *Gazette* and a daily newspaper circulating in the island, a notice of the registration of the geographical indication and shall issue to the applicant a certificate of registration in the prescribed form.

(10) If an applicant does not send in a counter-statement within the prescribed time in accordance with subsection (6), the applicant shall be deemed to have abandoned the application.

#### *Right to Use Geographical Indication*

**11.** Any producer carrying on an activity in a geographical area specified in the Register has the right, in the course of trade, to use a registered geographical indication in relation to the goods so specified if those goods possess the quality, reputation or other characteristics specified in the Register.

#### *Rectification of Register*

**12.—(1)** Any person who has an interest in a geographical indication may apply to the Registrar for rectification of the Register on any of the grounds specified in subsection (2).

(2) The grounds referred to in subsection (1) are that—

(a) the geographical area specified in the Register does not correspond to the geographical indication;

(b) the indication of the good for which the geographical indication is used is missing or unsatisfactory;

(c) the indication of the quality, reputation or other characteristic of the good is missing or unsatisfactory.

(3) The Registrar shall rectify the Register in relation to an application under subsection (1) if he is satisfied that such rectification is necessary.

#### *Cancellation of Registration*

**13.**—(1) A person who has an interest in a geographical indication may request the Registrar to cancel the registration thereof on the ground that it does not, qualify or no longer qualifies for protection by virtue of the provisions of section 6.

(2) Where the Registrar cancels the registration of a geographical indication under this section, he shall remove from the Register the entry relating thereto.

#### *Procedure under Section 12 or 13*

**14.**—(1) Where an application is made under section 12 or 13—

(a) a copy thereof shall be served on the person who applied for registration of the geographical indication to which the application relates;

(b) notice thereof shall be given in the prescribed manner and within the prescribed time to all persons, who, pursuant to section 11, have the right to use that geographical indication.

(2) A person referred to in subsection (1)(b) and any other interested party may apply to the Registrar to be joined in the matter and such application shall be made within such period as the Registrar shall specify.

#### *Appeal from Decision of Registrar*

**15.**—(1) Any person who is aggrieved by a decision of the Registrar Appeal from may, within two months of that decision, appeal to a Judge in Chambers.

(2) The Judge in Chambers may in relation to such appeal—

(a) confirm the Registrar's decision; or

(b) revoke that decision, and in such a case may—

(i) award damages to the appellant; and

(ii) make an order directing the Registrar to take such action as the Judge deems necessary.

*Regulations*

16. The Minister may make regulations, subject to affirmative resolution, generally for the better carrying out of the objects and purposes of this Act and for any matter which is required by this Act to be prescribed.

**Part  
Special Provisions Relating to Trade Marks**

**IV**

*Misleading Trademark*

17.—(1) This section applies to a trademark that contains or consists of a geographical indication relating to a good which does not originate in the territory indicated by the geographical indication, if the use of the indication in the trademark for such product in Jamaica is of such a nature as to mislead the public as to the true place of origin.

(2) The Registrar shall—

(a) on his own initiative; or

(b) at the request of any interested party,

refuse to register that trademark, or, as the case may require, revoke the registration thereof.

(3) Where the Registrar—

(a) refuses to register a trademark, he shall notify the proprietor of the trademark of such refusal within the prescribed time; or

(b) revokes a trademark, he shall cause to be published in the *Gazette* and a daily newspaper circulating in the island, a notice of such revocation.

(4) The protection under this section shall be applicable against a trademark which, although the relevant geographical indication is literally true as to the territory, region or locality in which the good originates, falsely represents to the public that the good originates in another territory.

*Trademarks Conflicting with Geographical Indications for Wines and Spirits*

18.—(1) This section applies to a trademark that contains or consists of a geographical indication which identifies wines or spirits, as the case maybe, as originating from a territory, region or locality indicated by the geographical indications which is not the true place of origin of such wines or sprits.

(2) The Registrar shall—

(a) on his own initiative; or

(b) at the request of an interested party,

refuse to register that trademark or, as the case may require, revoke its registration.

**Part  
Exceptions**

V

*Exceptions*

**19.**—(1) Nothing in this Act shall prevent the continued and similar use in Jamaica of a particular geographical indication of a World Trade Organization Member identifying wines or spirits in connection with goods or services produced by any citizen or resident of Jamaica who has used that geographical indication in a continuous manner with regard to the same or related goods or services in Jamaica—

(a) for at least ten years preceding April 15, 1994; or

(b) in good faith at any time preceding that date.

(2) Subsection (3) shall apply in any case where an application has been made for registration of a trademark or a trademark has been registered in good faith or rights to a trademark have been acquired through use in good faith—

(a) before the coming into operation of this Act; or

(b) before the geographical indication in respect to the trademark is protected in its country of origin.

(3) For the purposes of subsection (2), the provisions of this Act shall not prejudice the registrability of or the validity of the registration of the trademark, or the right to use a trademark on the basis that it is identical with or similar to a geographical indication.

(4) The provisions of this Act shall not apply in respect of a geographical indication of a World Trade Organization Member other than Jamaica, as respects—

(a) goods or services for which the relevant indication is identical with the term customarily used as the common name for such goods and services in Jamaica; or

(b) goods of the vine for which the relevant indication is identical with the customary name of a grape variety existing in Jamaica as of January 1, 1995.

(5) Proceedings under section 3 with respect to the use or registration of a trademark containing or consisting of a geographical indication shall, if the conditions specified in subsection (6) are satisfied, be instituted within five years after the adverse use of the protected geographical indication has become generally known in Jamaica or after the date of registration of the trademark in Jamaica.

(6) The conditions referred to in subsection (5) are that—

(a) the trademark is published by the date of registration referred to in that subsection, if such date is earlier than the date on which the adverse use became generally known in Jamaica; and

*(b)* the geographical indication is not used or registered in bad faith.

(7) The provisions of this Act shall not prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where that name is used in such a manner as to mislead the public.