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**INTELLECTUAL PROPERTY
RIGHTS IN JAMAICA:
An Action Plan**

FINAL REPORT

U.S. Agency for International Development

Prepared for: USAID/Jamaica

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EXECUTIVE SUMMARY

The Government of Jamaica is making progress in drafting the basic laws necessary to protect intellectual property. More work is required, however, and enforcement of those laws remains an open question.

The 1994 bilateral IPR Agreement requires Jamaica to establish laws meeting specific criteria in the fields of copyright, sound recordings, encrypted satellite signals, trademarks, geographical indications, patents, layout-designs of semiconductor integrated circuits, and trade secrets. In addition, Jamaica is obliged to adhere to and implement the Paris, Berne, Geneva, and Brussels Conventions. Moreover, Jamaica is required to satisfy specific obligations regarding the enforcement of intellectual property rights. The Government of Jamaica is obliged to make a good faith effort to enact necessary legislation by September 17, 1995.

To date, Jamaica has enacted a new copyright law and is in the process of promulgating regulations to govern the cable television industry. Moreover, Jamaica is currently a member of the Berne and Geneva Conventions. A special task force comprising the Office of the Attorney General, the Office of the Prime Minister, the Ministry of Industry, the Scientific Research Council, the Private Bar, and the Register of Companies collaborated to produce drafting instructions for other areas of intellectual property covered by the bilateral IPR Agreement. Consideration is being given to adhering to the Paris and Brussels Conventions.

The industrial property registry, within the Office of the Registrar of Companies, operates now, albeit slowly. The entire Office of the Register is being automated, however, which should speed up the registration of trademarks, patents, and designs.

Enforcement of intellectual property rights in the courts, by the police and customs remains problematic. Some training in the field of intellectual property may be warranted to address the complaint that enforcement is problematic due to an untrained enforcement workforce.

INTRODUCTION

Jamaica became the 27th country to sign a Bilateral Investment Treaty (BIT) with the United States February 4, 1994 and the sixth country in the western hemisphere to do so, thus signalling its continued commitment to a liberalized economy and open investment regime. The BIT guarantees investors the unrestricted transfer of capital and profits, access to international arbitration, and a commitment by both countries to adhere to internationally recognized standards for expropriation and compensation. The two countries also signed an Intellectual Property Rights (IPR) Agreement on March 17, 1994 which was negotiated over a three year period in conjunction with the BIT, by GOJ and USTR. The IPR agreement is designed to afford a standard mark of protection for intellectual property (copyrights, sound recordings, satellite signals, trademarks, patents and semiconductors) and reflects substantially the provisions in the GATT/WTO and NAFTA which related to intellectual property rights. The BIT and IPR agreements together are intended to establish transparent and predictable guidelines for U. S. businesses to operate in Jamaica. Policy dialogue and subsequent reforms that create an increasingly private sector led economy are critical to success of Mission projects that support its number one strategic objective of increased participation in economic growth. Effective implementation and management of adjustment measures are critical to strengthening markets and developing a more efficient, broadbased economy. USAID/Jamaica's Improved Markets, Export Growth and Opportunities (IMEGO) project supports policy reform by building capacity for policy implementation and broadening the benefits of a liberalized economy across social strata.

In July 1995, a team composed of Jason P. Matechak, USAID Washington Global Bureau, Richard C. Wilder, U.S. Patent and Trademark Office - Legislation and International Affairs Office and Clark W. Luckert, a senior partner in an IPR law firm in New York, traveled to Jamaica to analyze the situation and prepare an action plan.

This report will analyze where Jamaica is today, what actions are currently underway to strengthen the Jamaican IPR system, and a USAID action plan to assist Jamaica in achieving its goals.

I. CURRENT AND PROPOSED LOCAL SYSTEM IN JAMAICA FOR INTELLECTUAL PROPERTY RIGHTS

A. Legal Infrastructure

1. Patents

The current patent statute dates from 1857 when Jamaica was a part of the British Empire. This patent law which is based on English patent law has been copied in many Commonwealth countries and is essentially a sound patent law statute. However, changes are needed to this patent statute to conform with various obligations which Jamaica has undertaken, specifically the Bilateral Intellectual Property Rights Agreement with the United States, and the WTO TRIPs Agreement. In discussions with the Attorney General's office, it was indicated that this patent statute will be repealed and that a new patent statute will take its place.

The current patent regime is administered by the Registrar of Companies in the Ministry of Industry, Investment and Commerce. The Registrar of Companies has advised that approximately 70 patent applications are filed per year with resulting registrations in about 18 cases. The greatest administrative issue concerning the Patent Office is examining applications and computerization. A litigation firm in Kingston advised that there is no patent litigation and that there are no reported Jamaican cases in the area.

Another pressing issue in the patent area is the concern expressed by several members of the scientific and academic communities that increased patent protection will impair the free flow of ideas in Jamaica and actually stifle innovation instead of encouraging it. Although these statements show the need for education, the overall attitude explains the apparent lack of use of the current Jamaican patent system, which in theory should be able to function within normal parameters.

2. Industrial Designs

The current statute concerning industrial designs dates from 1975, is based on English design law and is essentially sound. However, in our discussions with the Attorney General's office, it was indicated that a new industrial design statute would be implemented.

3. Trademarks

The current trademark statute dates to 1958 and is based on standard English trademark law. Accordingly, the trademark statute is essentially sound, and trademark litigation is more common in Jamaica since trademarks are used more in Jamaican business. There are several reported cases which have taken place in Jamaica within the past decade within the trademark area which supplement English common law which is applied in Jamaican courts.

The Attorney General's office has indicated that the trademark law will also be repealed and replaced by a completely new trademark law to comply with the Bilateral Intellectual Property Agreement as well as the WTO TRIPs Agreement. The most important aspect of change will be the introduction of registration of service marks, but there may be additional changes as well, depending upon the dictates of the drafting instructions.

The Patent Office and courts apparently give some protection for internationally famous trademarks even without local trademark registration, but detailed proof of the international fame of the mark must be submitted. A review of businesses in Kingston does indicate some use of internationally famous trademarks in a pirated fashion, such as the KING BURGER hamburger restaurant, but apparently the private sector has been taking action in the courts to stop such piracy.

Concerning Jamaican businesses abroad, there were several objections raised by the Jamaican Manufacturing Association (JMA) and the Jamaica Exporters Association (JEA) that expressions such as "Jamaica Jerk" and "Jamaica Style" were being used by third parties in foreign countries without apparent redress. Accordingly, there was some interest in focusing on geographical indications law and treaties, although our team pointed out that most countries provide protection against false indications of origin without treaty obligations based on the concept of deceptiveness. There is also the unresolved issue as to whether these expressions are "generic" for a type of food, and are not trademarks or certification marks at all. Minister Paulwell indicated interest in the new "100% Jamaican" promotional campaign, and presumably "100% Jamaican" could be a certification mark protected in Jamaica and abroad.

The Registrar of Companies indicated that approximately 1000 trademark applications are filed each year, significantly more than the number of patent applications. The backlog of examination is approximately 18 months to several years for the time of filing an application to registration.

4. Copyright

The current statute concerning copyright dates to 1993. In the same year, Jamaica joined the Berne Convention, thus entering Jamaica into the international copyright system. The local law and the Berne Convention give Jamaica a good legal framework for copyright protection.

Several of the interviewees we consulted, particularly the JMA and JEA, expressed concern about protection of the works (in Jamaica and abroad) of indigenous Jamaican musicians and composers, as well as visual artists. At the moment, there does not appear to be widespread knowledge about the new law and how it works, and thus there was concern that a number of important original works are not being adequately protected. A Copyright Tribunal chaired by Beverly Pereira has been established which should regulate ownership of copyright, collective rights and perhaps royalties.

5. Trade Secrets and Confidential Information

Although there does not exist a statute on trade secrets, and protection for trade secrets is mandatory by the Bilateral Intellectual Property Agreement as well as the WTO TRIPs Agreement, trade secrets (also known as confidential information) may be adequately protected under the British common law as applied to Jamaica. Accordingly, although there has not been any litigation on the subject, it may be feasible to bring a trade secret court action in Jamaica under the British common law. Of course, the courts may not be familiar with such subject matter and the subsequent outcome of such litigation would be uncertain.

6. Unfair Competition

Jamaica recently enacted The Fair Competition Act of 1993, which is essentially an antitrust statute. This statute set up the Fair Trading Commission, a statutory body, which appears to be working quite well monitoring and administering the law. Additionally, the Commission does appear to have tangential intellectual property jurisdiction since it deals with false advertising and false designations of origin (which could include misleading use of trademarks).

Moreover, Jamaica follows the British common law, in which the action for "passing off" is available. Although passing off is more limited than notions of unfair competition, some protection is available for unregistered trademarks and trade dress (packaging).

7. Integrated Circuits

There is currently no protection against duplication of integrated circuits per se although some protection may be available under the copyright law. A new law may be required to implement the Bilateral Agreement and the WTO TRIPs Agreement.

B. Legal Institutions

1. Court System

The current court system is composed of the Supreme Court (the lowest court), on which sit 21 judges, the Court of Appeal, on which sit 7 judges, and the Privy Council in London as the highest court (although a Caribbean Supreme Court is being actively considered). Within the approximately 300 lawyers in Kingston, it is estimated that approximately 15 are knowledgeable in intellectual property rights law. We were advised that ex parte actions are available under Anton Piller orders (seizures). So-called "Anton Piller" orders are based on the British Anton Piller case and permit a plaintiff to obtain an ex parte order (without notice to the defendant) to seize infringing merchandise if a prima facie case is proven. Such ex parte orders to seize counterfeit or pirated goods would be executed by the court bailiff with the help of the local police. There has been discussion of a separate Commercial Court to handle commercial and IPR cases.

The courts appear to be overworked, and the average case takes approximately 3 - 4 years to reach conclusion (although ex parte Anton Piller seizure orders can be obtained in 24 hours).

2. Ministry of Industry, Investment & Commerce

The principal government ministry which regulates intellectual property rights is the Ministry of Industry, Investment & Commerce, which oversees the Registrar of Companies (the body which registers both patents and trademarks). In our interview with Minister Paulwell, interest was shown in establishing a new IPR Office which would encompass all intellectual property rights functions, including patents, trademarks and copyrights. It was unclear if such a new IPR office would have policing capabilities similar to the FTC.

At the moment, the Registrar of Companies is in the process of computerization in two sectors, the first sector being the Companies Registry and the second sector being the Patent and Trademark Office. Phase One (companies) should be completed within 18 months, although all the current computer programs have not been written. The computerization process is being assisted by Coopers & Lybrand (Canada), which is writing the software for the transition. The team was quite impressed with the sophistication of the equipment which included optical scanners, a laser disk jukebox, UNIX server and laser printers. Currently, the Patent and Trademark Office had trademark applications in the last fiscal year of 1229, approximately 70 patent applications, 12 trademark oppositions, and uncertain statistics on trademark cancellations. To date, a total of 26,000 trademarks and 3,125 patents have been registered although a number of these patent and trademark registrations have now been cancelled. The current staff of the Patent and Trademark Office is seven. Presumably, additional personnel will be needed if and when the new IPR legislation is in place.

3. Prime Minister's Office

At the moment, the Prime Minister's Office has principal authority for the copyright law since the Prime Minister's portfolio incorporates jurisdiction over culture. Accordingly, there is a copyright desk in the Prime Minister's Office although there is no copyright office per se.

4. Copyright Tribunal

After the 1993 copyright law came into effect, a Copyright Tribunal was established which has nine (9) members with Beverly Pereira as chair. At the moment, the Copyright Tribunal is studying its most pressing concern, namely, the implementation of the copyright law in Jamaica. Of particular concern is the establishment of collective societies for the collection of royalties for composers and musicians who apparently feel they are not adequately compensated for the use of their work (similar to BMI or ASCAP). It is possible that this Copyright Tribunal is the precursor of a complete Copyright Office, but this is not certain at the moment.

5. Customs

Apparently the Jamaican Customs officials are quite professional and essentially assign duties on merchandise. However, it appears as if Customs is not aware of its new responsibilities within the WTO framework whereby Customs must intercept counterfeit and pirated goods at the borders. Accordingly, Customs needs to be educated in its new responsibilities as well as the latest techniques in counterfeit surveillance and detection.

6. Fair Trading Commission

The Unfair Competition Act has established a statutory body, the Fair Trading Commission, which commenced operations in November 1993. The Commission has three part-time commissioners and 17 full time staff including four lawyers, and apparently takes an active role in enforcing the law. They have received a number of referrals concerning misleading advertising and appears to be an alternative enforcement medium of intellectual property rights and trademarks.

The Fair Trading Commission has had extensive contact with its United States counterpart, the FTC, and appears to be well trained and adapted to enforce its responsibilities. There was some interest expressed in an IPR office which would have similar policing capabilities.

7. Jamaican Broadcasting Commission

The Jamaican Broadcasting Commission is establishing procedures for cable and satellite television regulation. At the moment, it is estimated that there are approximately 60,000 illegal signals originating from the illegal distribution of signals of U. S. domestic satellites since Jamaica is in the footprint of such satellites. The most common method of signal piracy is obtaining a valid premium program subscription by means of a U.S. address, obtaining the code, receiving the signal in Jamaica (since it is in the footprint), and thereafter retransmitting the signal to other subscribers who pay the pirate a cable fee. The cable satellite legislation is considered a "hot item" and apparently government action will be coming in the near future, perhaps as early as this Fall guided by the knowledgeable Commissioner McCook. The JBC appears to be actively preparing for the implementation of the new regulations including considering a public education campaign and a monitoring truck and monitoring agents. Training is indicated for such persons at the commission who will do the monitoring.

Under the proposed regulations, Notices of Intent will be filed instead of applications since there is no current accompanying legislation for cable licensees. The applicants must provide Letters of Intent from U. S. or European program suppliers to indicate that they have made a good faith effort to obtain legitimate rights in the programs to be carried. Once licensed, the JBC will monitor the signal to determine if unauthorized channels are being carried. After the JBC determines unauthorized channels are being carried by a licensee, the licensee will be appropriately notified and, presumably, piracy will be significantly diminished. At the moment, cable television is not included in the current Jamaican broadcast law although there is some

statutory authority to regulate such activity either through the broadcast law or the public utilities law. The JBC is not anticipating exclusive licenses, but rather the use non-exclusive licenses using the current physical set-up . Of course, there will be a moratorium on preexisting piracy prosecution since, at the moment, all cable is pirated.

The JBC also envisions an active public educational program within the next several weeks, which includes providing notices in local newspapers concerning the new regulations, as well as sending "Op Ed" pieces for newspapers on intellectual property rights, related issues and technical standards. Although "local content" regulations were discussed, the JBC has decided to use an encouragement model as opposed to a regulation model. Accordingly, the interview with the JBC indicates that the cable legislation and implementing regulations are fairly advanced in drafting stage and should be implemented shortly.

II. CURRENT INTERNATIONAL TREATIES IN EFFECT IN JAMAICA FOR INTELLECTUAL PROPERTY RIGHTS

A. U. S. - Jamaica Bilateral Intellectual Property Rights Treaty

On March 17, 1994, the United States and Jamaica signed the Bilateral Intellectual Property Rights Treaty which accompanied the previous Bilateral Investment Treaty. This treaty, in standard form, essentially incorporates NAFTA provisions on intellectual property protection (i.e., stronger protection than WTO TRIPs), and requires Jamaica to join the Paris Convention on industrial and intellectual property and the Brussels Satellite Convention in addition to the current required treaties which they have already joined, namely, the Berne Copyright Convention and the Geneva Phonogram Convention. This treaty has an 18 month implementation window which will close on September 17, 1995. By such date, Jamaica must show the United States that it has used its "best efforts" to comply.

At the moment, the cable satellite legislation and regulations appear to be fairly far along in the drafting phase. However, the draft legislation concerning implementation of the changes required in the patent, trademark, and copyright fields under the Bilateral Agreement, as well as the WTO TRIPs Agreement, have reached only the stage of the drafting instructions from the special interministerial committee set up for this purpose. Once the drafting instructions are issued, one person, Beverly Pereira, will draft appropriate legislation. Ms. Pereira will need to draft several major pieces of legislation, i.e., a new patent act, a new trademark act, a new design act, a new integrated circuit act, and amendments to the copyright act. After these drafts are reviewed, they are then sent to Parliament. In a realistic timeframe, therefore, we can assume that the cable satellite regulations will become effective by the end of 1995, that the drafting instructions will be sent to Ms. Pereira within the several months, and that the implementing legislation for IPR reform will be enacted by Parliament by the end of 1996. Of course, this timetable can be accelerated if technical assistance is given to Ms. Pereira to draft

the appropriate IPR legislation and, once the language is finalized, if such legislation is given governmental priority in the Parliament. In all fairness, however, the team did find that work was underway and that a good faith effort was being made to comply with Jamaica's obligations.

B. World Intellectual Property Organization (WIPO)

Although the treaty on the establishment of WIPO in Geneva is not a major intellectual property rights treaty, it does provide Jamaica with an avenue for receiving valuable technical assistance concerning the drafting legislation as well as training staff.

C. Berne Copyright Convention

The Berne Convention is the premier international copyright convention. It includes the concept of national treatment as well as minimum standards for copyright protection (Berne minima) for each member state. Additionally, WTO as well as the Bilateral Intellectual Property Agreement require compliance with the Berne Convention. Accordingly, the adherence of Jamaica to the Berne Convention in 1993 is a significant development in its intellectual property rights structure. Since the Copyright Act and the Berne Convention became effective fairly recently, in 1993, the copyright law's potential has yet to be realized. However, since an educational program is eminent, the Copyright Act as well as the Berne Convention should be better understood and used in the future.

D. Geneva Phonogram Convention

The Geneva Phonogram Convention is required under the Bilateral agreement, and thus is an important part of the intellectual property system in Jamaica. One of the reasons the Geneva Phonogram Convention was created is that phonograms were not fully protected under the Berne Convention as a copyrightable work (i.e., certain countries did not recognize records, tapes, CDs, etc. as protectable "works" since they were considered performances of works and not the works themselves). In the case of Jamaica, the Copyright Act protects phonograms as protected works in Section 6(1)(b), as well as protecting such products internationally under the Geneva Convention. Accordingly, the legal framework for protection of phonograms is in place but, as mentioned previously, the statutes and the courts have been underutilized in the intellectual property rights area.

E. Rome Neighboring Rights Convention

Jamaica has also adhered to the Rome Convention on so-called "neighboring rights" (droits voisins) (i.e., performance and broadcasting rights). Although mentioned in the WTO TRIPs Agreement, but not required, the Rome Convention provides additional protection for performance and broadcast rights in Jamaica.

III. PROPOSED INTERNATIONAL TREATIES FOR INTELLECTUAL PROPERTY RIGHTS

A. Paris Convention

The premier international industrial and intellectual property rights treaty is the Paris Convention. Such treaty has not been ratified by Jamaica. In our discussions at the Attorney General's office and in other interviews, it was made clear that adherence to the Paris Convention will be a priority for Jamaica, perhaps in the next several months. This adherence is required by both the WTO TRIPs Agreement and the Bilateral Agreement.

B. Brussels Satellite Convention

The Brussels Satellite Convention is required by the Bilateral Agreement with the United States and we have been advised that consideration is being given to adherence to the Convention. The JBC is proceeding to implement regulations to curb satellite piracy in Jamaica. In the long run, the efforts of the JBC may be more effective in combatting satellite piracy than mere adherence to the Brussels Satellite Convention, but both are preferable and adherence to the Convention is required by the Bilateral Agreement.

C. Patent Cooperation Treaty

Although the Patent Cooperation Treaty (PCT) is not required by the Bilateral Agreement or the WTO TRIPs Agreement, it is an important international treaty in the area of patent protection. The so-called PCT is an international treaty coordinating patent applications and searching in WIPO. PCT membership has increased by 10 countries in the first months of 1994, and the number of international applications has increased by over 15% over the respective period of 1993. In the first six months of 1994, over 16,000 PCT applications were filed.

Since the current Jamaican patent system is underutilized, adherence to the PCT may make the system more sophisticated, as well as making it easier for foreign applicants to use the Jamaican patent system. Additionally, PCT patent examination reports may be made available to Jamaica, thus making the local patent examination procedure easier.

IV. DESCRIPTION OF WTO TRIPs OBLIGATIONS

During the past decade, the United States has focused intensely on improving the protection accorded to intellectual property worldwide. For additional leverage, improved intellectual property protection was made part of the trade negotiations of the United States. As part of the Uruguay Round of multilateral trade negotiations under the General Agreement on Tariffs and Trade (GATT), the United States has sought to negotiate an agreement on intellectual property aimed at establishing adequate minimum standards for the protection of intellectual property rights; ensuring availability of effective procedures, internally and at the border, for enforcing

those rights; and taking advantage of the procedures in the GATT for the settlement of disputes regarding the Members' obligations to establish the minimum standards and the enforcement procedures.

One of the agreements from the latest round of trade talks under the General Agreement on Tariffs and Trade (GATT) is directed to intellectual property protection and its enforcement - the TRIPs Agreement. This effort has also resulted in such protection and enforcement being a key part of the North American Free Trade Agreement (NAFTA) which entered into force at the beginning of this year. The salient portions of the TRIPs agreement can be summarized as follows.

A. Copyright

Where copyright and related rights are concerned, countries will be obligated to comply with Articles 1-21 of the Berne Convention for the Protection of Literary and Artistic Works. Article 6bis of the Convention is excepted because it concerns an author's "moral rights," not economic rights that are appropriate for an agreement on trade across national borders. TRIPs requires countries to protect Computer programs as "literary works" under the Berne Convention and to protect compilations of data and other material that constitute intellectual creations because of the arrangement of their contents.

Under TRIPs, commercial rental of computer programs and cinematographic works, absent permission of the copyright owner, is to be prohibited; however, a country may be excepted from this obligation in the case of cinematographic works provided that such rental has not led to material impairment of the reproduction rights of the copyright owners. The exception to the ban on commercial rental for cinematographic works was negotiated by the United States because rentals of motion picture videos here have not resulted in any widespread copying and it was believed, therefore, that a rental right for Cinematographic works was not necessary for their protection in the United States.

Under TRIPs, performers must be given the right to prevent the unauthorized recording of their performances and, should such recording occur, to prevent reproduction of that recording. They also must have the right to prevent the unauthorized broadcast of their live performance and any other communication of that performance to the public. Sound recording producers must be given the right to prevent unauthorized reproduction of their sound recordings, directly or indirectly, and to prevent rentals of the sound recordings. These rights of performers and sound recording producers are to extend for fifty years from the date on which a performance or fixation occurred.

Broadcasters' rights under TRIPs are provided in alternative form. Broadcasters must have the ability to prevent fixation of broadcasts, reproduction of such fixations, rebroadcast by wireless means and any other communication of their broadcasts to the public, or, if a country does not provide rights to broadcast organizations themselves, it must ensure to the owners of the copyright in the subject matter of the broadcasts the possibility of preventing the activities

mentioned. Broadcasters' rights will extend for at least twenty years from the date on which the broadcast occurred.

The TRIPs Agreement fails to provide full national treatment for motion picture and sound recording producers. Certain countries, especially some Member States of the European Union, now collect revenue from the broadcast of sound recordings and films and impose levies on the sale of blank recording media and equipment because these can be used to make private, unauthorized copies of copyrighted works or works protected by related rights.

B. Trademarks and Service Marks

TRIPs adds significantly to the protection provided trademarks under the Paris Convention for the Protection of Industrial Property in several ways. First, TRIPs defines trademarks and identifies elements that must be eligible, individually or in combination, for recognition as trademarks and expressly requires that service marks be registrable. Second, a system of publication and cancellation must be available in connection with the registration of trade and service marks. Third, protection of well-known marks also is extended to include service marks.

In addition, protection of trademarks is required, even where the goods or services are not similar to those used in connection with a registered mark, if the use of a similar mark on those goods or services would indicate a connection with a registered mark and would cause damage to the owner of the registered mark.

The term of registration for a trademark must be at least seven years and the registration must be renewable indefinitely. Registrations can be canceled for non-use only after an uninterrupted period of three years of non-use, and, even then, a registration cannot be canceled if the non-use resulted from conditions that were beyond the trademark owner's control. Conditions like import restrictions and other government requirements for goods and services are expressly identified as conditions justifying non-use. Use in a country by a licensee of the mark's owner precludes a claim of non-use.

Another important provision bars compulsory licensing for trademarks and allows assignment of trademarks with or without the business to which the trademark belongs. Governments are also prohibited from imposing special requirements on the use of trademarks, such as use with local marks or use in a way that detracts from the effectiveness of the mark in distinguishing the goods or services of the owner from those of others.

C. Geographical Indications

U.S. TRIPs negotiators had reservations concerning the need to enhance protection for geographical indications during the Uruguay Round and directed their efforts at ensuring that, under any standards established, existing trade and service marks in the United States, such as London Fog, Swiss Miss, or Dutch Boy Paints, for example, would not be subject to

cancellation, and use of generic terms like chablis and champagne would not be prohibited. Now that negotiations are complete and this protection is cast in stone, however, we might begin to look at the section on geographical indications as an opportunity rather than a nuisance.

A geographical indication is defined as an indication that identifies a good originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is attributable to its geographical origin. TRIPs requires that Member countries have the legal means for "interested parties" to prevent use of any means in the designation or presentation of a good that indicates or suggests, in a manner that misleads the public, that the good in question comes from a geographical area other than its true place of origin. To prevent confusion when two place names are the same, the provision is applicable even where an indication is literally true, but it implies that the goods come from a different territory. Member countries must also refuse or invalidate the registration of a trademark containing a geographical indication with respect to goods not originating in the territory indicated, where the use of the trademark would mislead the public as to the true place or origin of the goods.

There are special provisions in TRIPs dealing with wines and spirits that prohibit even the use of indications in combination with "kind," "type," "style," "imitation," or similar words. There are exceptions, however, for terms that have become generic and for marks that have been used on the same goods or services in good faith for ten years prior to the conclusion of the Uruguay Round. The U.S. Bureau of Alcohol, Tobacco and Firearms (ATF) does prohibit use of labels that would mislead consumers as to the origin of alcoholic beverages, so the United States is already in compliance in that regard.

TRIPs calls for further negotiations on geographical indications in connection with wines and spirits. The reputation of California regional wines, Kentucky bourbon, etc. is increasing around the world. The United States and other countries that produce wines and spirits might profit from now taking a second look at this subject to determine what benefits might flow from regarding future negotiations offensively.

D. Industrial Designs

In connection with industrial designs, TRIPs requires countries to provide protection for new and original industrial designs, with certain exceptions. Textiles receive particular mention to ensure that the requirements for protection are not so excessive that they effectively deny protection for textile designs, which tend to change frequently. Owners of protected industrial designs are to be able to prevent others from making, selling or importing articles bearing or embodying their designs for a period of at least ten years.

These provisions can be very important to many U.S. businesses that find their products being copied by companies in other countries. The existence of protection for designs also might encourage many of these companies to begin developing their own designs since, hopefully, they will be able to prevent other local companies from copying their designs and competing with

them in the local market. Nothing develops respect for intellectual property faster than having some of your own to protect.

E. Patents

TRIPs contains some significant benefits for inventors. First, TRIPs requires that product and process patents be available in all fields of technology. The only permissible exceptions to that broad obligation are for diagnostic, therapeutic and surgical methods for treating humans or animals, and for plants and animals, other than microorganisms, and essentially biological processes for producing plants or animals. Countries not providing patent protection for plant varieties must provide that protection through an effective sui generis system.

TRIPs specifies that patent owners must be given the right to prevent others from making, using, offering for sale, selling, or importing products covered by a product patent and from using a process claimed in a patent or using, offering for sale, selling, or importing at least the product obtained directly from use of the process. The right to assign or license rights under the patent is also assured. TRIPs Members are permitted to maintain limited exceptions to patent rights so long as those exceptions do not unreasonably conflict with the normal exploitation of the patent by the patent owner, nor prejudice his legitimate interests. This is intended to allow such things as exhaustion within a country after the sale of a patented product.

Of particular importance to patent owners are the restrictions that the TRIPs Agreement places on compulsory licensing. First, countries will no longer be allowed to grant compulsory licenses if a patentee does not manufacture the patented invention in the country. Importation will have to be treated as "working," so, only in circumstances in which a patentee makes no provision for marketing his product in a country, would a compulsory license for "non-working" even qualify under TRIPs. TRIPs also imposes conditions on all compulsory licensing to ensure that voluntary licensing is encouraged, that payment for any compulsory license is fair, that rights under a license are non-exclusive and can be transferred only under limited conditions, and that decisions regarding compulsory licenses are appealable. There are special provisions dealing with government use of patent rights and for use in national emergencies. Particularly important for industries in California, semiconductor technology may not be the subject of a compulsory license except as a remedy for an antitrust violation or non-commercial government use. Finally, dependent patent compulsory licenses may still be granted, but only if 1) the second invention represents an important technical advance over the first patent, and 2) the owner of the first patent receives a cross-license under the second patent. In addition, a dependent patent compulsory license is assignable only with the assignment of the second patent.

F. Semiconductor Chip Layout Designs

The TRIPs text incorporates and corrects the deficiencies of the Washington Treaty on Intellectual Property in Respect of Integrated Circuits. Unlike the Washington Treaty, TRIPs 1) expressly covers articles incorporating protected chips; 2) assures a reasonable royalty to the right-holder after notice in connection with the disposition of stock on hand; 3) extends the term

of protection to 10 years (Washington required 8); and 4) prohibits compulsory licensing in connection with semiconductor chip layout designs except as an antitrust remedy or for non-commercial government use.

G. Trade Secrets

While the TRIPs Agreement speaks of "undisclosed information," it is referring to what are commonly called trade secrets. The obligations look very much like the Uniform Trade Secrets Act in the United States. Those who control information that is not generally known or readily ascertainable, that has value because it is not known, and that is the subject of efforts to keep it secret, must be given the ability to prevent others from disclosing, acquiring, or using the information in a manner that is contrary to honest commercial practices.

In addition to providing for the protection of trade secrets, TRIPS also calls for steps to be taken to protect against unfair commercial use of data submitted to government agencies to obtain marketing approval for pharmaceutical and agricultural chemical products containing new chemical entities. In this context, "unfair commercial use" means other parties relying on the data to obtain marketing approval for their own products, where they have made no financial contribution to the original submitter of the data.

H. Enforcement

The enforcement section spells out the details of an adequate judicial enforcement system, with transparent processes, written opinions, and the ability to appeal decisions. TRIPs addresses the particulars of judicial and administrative procedure, remedies, both temporary and final, and border enforcement, which is mandatory for counterfeit and pirated products, discretionary for other forms of intellectual property.

Developing countries will have a period of five years in which to bring their legislation into conformity with the obligations of the TRIPs Agreement, other than the national and MFN obligations. Any countries that do not now provide patent protection for pharmaceutical and agricultural products will have an additional five years (for a total of 10 years) to comply with that requirement.

Many of the countries of the world, however, have already achieved the substantive standards that TRIPs requires with regard to the rights in connection with the various forms of intellectual property. It is in connection with enforcement where compliance might be slow. As the economies of these countries develop further, however, the countries will find that improving enforcement is necessary to protect the rights of their own nationals. Any changes they make for domestic enforcement will have to be granted to nationals of WTO countries under the national treatment obligations that come into effect for all countries after one year.

V. OVERVIEW OF NAFTA/FTAA IPR REQUIREMENTS

Chapter 17 of the NAFTA, although brought into force before the GATT/TRIPS, is largely based on the GATT/TRIPS. This is because the GATT/TRIPS negotiations had been underway for five years before the NAFTA negotiations began. Because the NAFTA negotiation was among but three parties as contrasted with the more than 100 countries involved in GATT, the NAFTA generally embraces a higher standard of protection for intellectual property. Among the areas where NAFTA differs from the GATT/TRIPS are the following:

- ~ NAFTA provides more effective copyright protection for sound recording particularly in regard to rental rights;
- ~ NAFTA provides explicit protection for encrypted program-carrying satellite signals;
- ~ NAFTA requires protection for pharmaceutical and agrochemical products already patented elsewhere but only newly patentable in a country adhering to NAFTA ("pipeline protection");
- ~ NAFTA prohibits dependent patent compulsory licensing, i.e., the compulsory licensing of one patent in order to practice the invention in another patent;
- ~ NAFTA requires a minimum trademark term of 10 years;
- ~ NAFTA provides for 5 years of exclusive use of data submitted to a government for marketing approval of a new chemical entity; and
- ~ NAFTA does not permit adhering countries to delay implementation for up to eleven years, instead requiring compliance with all provisions, with one minor exception, within several years of the entry into force of the NAFTA.

Both Jamaica and Trinidad and Tobago have indicated interest in NAFTA and NAFTA parity in the past. Additionally, any new Western Hemispheric version of NAFTA (FTAA) will probably include NAFTA IPR standards.

Although this report will not review each of the NAFTA Articles in detail, how they may be implemented in the new Free Trade Area of the Americas (FTAA) and how each NAFTA Article differs from the WTO TRIPS provisions, below are listed the titles of each of the Articles relating to intellectual property in the NAFTA Agreement, namely, Articles 1701 through 1721.

Article 1701: Nature and Scope of Obligations

Article 1702: More Extensive Protection

Article 1703: National Treatment

Article 1704: Control of Abusive or Anticompetitive Practices or Conditions

- Article 1705: Copyright
- Article 1706: Sound Recordings
- Article 1707: Protection of Encrypted Program-Carrying Satellite Signals
- Article 1708: Trademarks
- Article 1709: Patents
- Article 1710: Layout Designs of Semiconductor Integrated Circuits
- Article 1711: Trade Secrets
- Article 1712: Geographical Indications
- Article 1713: Industrial Designs
- Article 1714: Enforcement of Intellectual Property Rights: General Provisions
- Article 1715: Specific Procedural and Remedial Aspects of Civil and Administrative Procedures
- Article 1716: Provisional Measures
- Article 1717: Criminal Procedures and Penalties
- Article 1718: Enforcement of Intellectual Property Rights at the Border
- Article 1719: Cooperation and Technical Assistance
- Article 1720: Protection of Existing Subject Matter
- Article 1721: Definitions

VI. ACTION PLAN FOR USAID/JAMAICA

A. Technical Assistance

1. USAID/Jamaica should provide technical assistance to the intellectual property rights legislation amendments drafting team headed by Ms. Beverly Pereira in their current efforts to draft legislation for the patent, trademark, and copyright areas. A legal expert should be available to assist in the drafting of such implementing legislation. (10 work days)

2. It is possible that implementing regulations will be needed to supplement the existing proposed implementing legislation. A legal expert should be available to assist in the drafting of such implementing regulations. (10 work days)

B. Training

3. Two members of the current Patent and Trademark Office of the Registrar of Companies should be trained for two weeks each under the United States Patent and Trademark Office (USPTO) Visiting Scholars program. Although the USPTO provides free training, the travel, lodging and meal expenses should be provided by USAID.

4. Two members of the current Customs Office should be trained for two weeks at the United States Customs Office training facility. Although U. S. Customs may provide free training, travel, the lodging and meal expenses should be provided by USAID.

5. Temporary trademark and patent examiners should be made available to the Jamaican Registrar of Companies to assist in the training process and actual case management on a temporary basis and with the specific objective of reducing the backlog of pending cases. This particular procedure was followed recently in Bermuda with British and Canadian examiners and was quite effective. (20 work days)

C. Education

6. USAID should work with its Jamaican counterpart, JAMPRO, to conduct a comprehensive education program for the general public, legal professionals, as well as interested industry sectors, on the changes in the intellectual property rights law in Jamaica as well as the importance of intellectual property rights generally. JAMPRO may work with other interested organizations such as JEA, JMA, and the CAST Entrepreneurial Center. These seminars and workshops, coordinated through JAMPRO, should be developed and discussed in detail with the interested parties. (30 work days)

7. A standard review of intellectual property rights law, such as Intellectual Property Rights Basics, should be placed in various newsletters such as the PSOJ Newsletter. (5 work days)

D. Referrals

8. USAID should work with WIPO to obtain WIPO funding for training and technical assistance for the Jamaican Bar, Judiciary, and government employees. (2 work days)

9. USAID should work with the interested Jamaican Government Ministry to apply for a MIF grant from the InterAmerican Development Bank to obtain additional equipment for the Registrar of Companies and the JBC. (1 work day)

10. The Jamaican Judiciary should be trained in the importance of intellectual property rights. It is recommended that the Court of Appeals for the Federal Circuit (the U. S. patent appellate court) in Washington be consulted as to possible judicial candidates for a journey to Jamaica to hold an intellectual property rights symposium developed by USAID in Jamaica for judges only. (20 work days)

11. USAID should refer ATRIP, an American group of intellectual property law professors, to coordinate with CAST and perhaps the University of the West Indies for conducting appropriate seminars, college courses, and law school courses developed by USAID and ATRIP on intellectual property rights. (10 work days)

12. USAID should coordinate with governmental agencies and private sector agencies in the United States, such as U. S. Customs, World Customs Organization, MPAA or IIPA, to obtain appropriate funding and training for IPR-related equipment and personnel (monitoring trucks, used radio equipment, counterfeit identification workshops, etc.). (5 work days)

VII. CONCLUSION

The foregoing report and action plan indicate that work is needed in education and training to create understanding as to all aspects of IPR change in Jamaica. The deadlines created by the Bilateral Agreement as well as the WTO TRiPs Agreement, assisted by the USAID educational and training program, should create an IPR climate which promotes Jamaica's economic development into the next century.

INTERVIEW LIST

I. GOVERNMENT

- A. Ministry of Commerce, Investment and Industry**
 - His Excellency Philip Paulwell, Minister of State
 - Mrs. Edwards, Registrar of Companies

- B. JBC (Jamaican Broadcasting Corporation)**
 - Mr. Wayne McCook

- C. Prime Minister's Office**
 - Dr. Arnold Ventura (Scientific consultant)

- D. FTC (Fair Trading Commission)**
 - Ms. Marlene DeMercado

- E. Attorney General**
 - Mr. Patrick Robinson
 - Ms. Beverly Pereira (independent consultant)
 - Mr. Brian Wallace
 - Ms. Michelle Walker
 - Mr. Sheldon McDonald

II. PARASTATAL ORGANIZATIONS

- A. JAMPRO (Jamaica Promotions Corporation)**
 - Mr. Lucien Ratterey
 - Ms. Jacqueline Neath
 - Ms. Beverly Rose-Forbes (Ministry of Industry, Investment & Commerce)

III. PRIVATE SECTOR ORGANIZATIONS

- A. JEA (Jamaican Export Association)**
 - Ms. Beverly Morgan
 - Ms. Pauline Gray

- B. JMA (Jamaican Manufacturing Association)**
 - Mr. Anthony Hyde

- C. PSOJ (Private Sector Organization of Jamaica)**
 - Mr. Charles Ross

IV. LAW FIRMS

- A. Myers, Fletcher & Gordon
 - Mr. Maurice Robinson
 - Mr. Peter Goldson
 - Mr. Michael Hylton
- B. Mr. B. Harold Brady (Law Offices of)

V. UNIVERSITIES

- A. CAST
 - Dr. Alfred Sangster

VI. BANKING INSTITUTIONS

- A. InterAmerican Development Bank
 - Mr. John C. Yates
- B. World Bank
 - Mr. Van Pulley

VII. U. S. EMBASSY

- A. ECON SECTION
 - Mr. Frank Kerber
 - Mr. John Riley
- B. USAID
 - Dr. Carole Henderson-Tyron
 - Mr. William C. Craddock
 - Ms. Claudia Hunter