



International Opposition Guide

Comparative Practice and Procedures

JAMAICA

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International Opposition Guide: Comparative Practice and Procedures is an exclusive service provided to INTA members that offers a searchable database of country profiles on the structure of trademark opposition practice and procedure including:

- general provisions
- alternatives to opposition
- opponent issues
- filing requirements
- post-filing stages and procedures

Each jurisdiction profile follows a standardized format, with topics organized by subject heading. This format makes it easy to search within a jurisdiction profile or to compare how different jurisdictions treat a particular subject.

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This material is only intended to provide an introduction to and simplified profile of an area of this jurisdiction's trademark law and practice and has primarily been prepared for practitioners considering the merits of filing an opposition in this jurisdiction. This material does not take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of this jurisdiction such as might be provided by a local trademark attorney.

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I. AVAILABILITY

A. Pre- or Post-Grant

- Opposition is available.
- Opposition is conducted pre-grant.
- Opposition is available for either all or part of the goods/services covered by a trademark application or registration.

B. International Registrations

- This jurisdiction is expected to become a member of the Madrid Agreement and/or the Madrid Protocol: Jamaica's government has conditioned accession to the passage of amendments to the Trade Marks Act and Rules. It is not possible to predict when this will be accomplished. Discussions on required amendments are in progress.

C. Collective and Certification Marks

- Collective marks are registrable. Collective marks are treated like ordinary trademarks but are subject to some special provisions including the requirement to file regulations relating to the use of the mark prior to the mark's being considered for registration. See Trade Marks Act section 3 and the First Schedule.
- Opposition to an application for a collective mark is available (i.e., pre-grant).
- Certification marks are registrable. Certification marks are treated like ordinary trademarks but are subject to some special provisions including the requirement to file regulations relating to the use of the mark prior to the mark's being considered for registration. See Trade Marks Act section 3 and the Second Schedule.

- Opposition to an application for a certification mark is available (i.e., pre-grant).

II. EFFECT ON REGISTRATION RIGHTS

- An opposition (even if unsuccessful or later withdrawn) will delay the grant of full registration rights to the applicant.

III. GROUNDS

A. Absolute, Relative and Other Grounds

- The following grounds are admissible for opposition:
 - relative grounds (based on proprietary rights, e.g., conflicting prior application/registration or rights in unregistered marks);
 - absolute grounds (based on grounds other than proprietary rights, e.g., not a proper trademark, descriptiveness or deceptiveness);
 - bad faith issues (e.g., wrongful claim to ownership);
 - conflicting copyright or design rights;
 - rights under Art. 6 bis of the Paris Convention or the equivalent thereto (notorious or well-known mark);
 - rights under Art. 6 septies of the Paris Convention or the equivalent thereto (registration in the name of the agent or other representative of the proprietor of the mark);
 - rights in a locally registered company name (where the company name is used as a trademark);
 - rights in a foreign registered company name (where the company name is used as a trademark);
 - rights under Art. 8 of the Paris Convention or the equivalent thereto (trade names) (where the trade name is used as a trademark or service mark);
 - rights under Art. 6 ter of the Paris Convention or the equivalent thereto (Prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations);
 - offenses against public policy or principles of morality.

B. First to Use or First to File

- In an opposition involving conflicting trademark registrations or applications, a later filing date prevails over an earlier use date (i.e., this is a first-to-file jurisdiction).

IV. FORUM

- The opposition authority is part of the Trade Marks Registry/Office.

V. COSTS AND FEES

A. To Initiate

- The government/official fees for filing an opposition based on a single prior registration are: the same as for an opposition based on multiple prior registrations, i.e., JMD

4,500 (approximately USD 45). An additional USD 45 is required for the filing of evidence in support of the opposition.

- The approximate range of attorney fees for filing an opposition based on a single prior registration is: USD 600 to USD 1,000.
- A listing of Government/official fees for oppositions can be found online at: <http://www.jipo.gov.jm>.
- The website listing of Government/official fees for oppositions is presented in the following languages: English.

B. Monetary Bonds or Surety from Foreign Opponent

- Provisions requiring monetary bonds or other surety from a foreign opponent are as follows: This is in the Registrar's discretion as outlined in Trade Marks Rule 12(14). There is currently no practice note or form that outlines what the Registrar would deem sufficient for the purposes of security. However, the Registrar may be guided by the Civil Procedure Rules.

VI. BURDEN OF PROOF

- The burden of proof is neutral; i.e., both parties must prove any grounds, facts, allegations and defenses on which they rely in the opposition.

VII. SUBSTANTIVE EXAMINATION

- The trademark registration process includes an official, substantive examination.
- This system includes an official substantive examination of an application on:
 - both absolute and relative grounds.
- The official, substantive examination of an application is conducted before publication for opposition.
- Examination on relative grounds includes an official search for conflicting prior applications and the examiner has the right of objection and refusal based on cited marks.
- Any official substantive examination report is not open to public inspection before the end of the official opposition term.
- Opposition is not considered as part of the official substantive examination and is decided in a separate proceeding.
- An official substantive examination will not be conducted after an opposition proceeding has been concluded or after an opposition proceeding has been withdrawn.

VIII. STANDING AND OTHER OPPONENT ISSUES

A. Valid Opponent/"Person" and/or "Interested Person" Defined

- Standing to oppose extends to:
 - any person. Legal interest is not required. It is, however, usually a person with a legal interest, i.e., someone with an earlier or similar mark or someone using the mark as a generic term that seeks to oppose.
- For purposes of standing, "person" is defined as:

- both natural and juridical persons.

B. On Basis of Grounds

- Where opposition is based on relative grounds (i.e. a prior registered or unregistered right) then:
 - a licensee may utilize the prior right as a ground of opposition.
- Relevant prior rights need not be locally established rights (e.g., local national registration rights, applicable regional rights or relevant International Registration extensions or local rights in unregistered marks).
- If prior rights are not established locally, prior rights established in other jurisdictions may be sufficient for purposes of establishing standing under the following circumstances: Prior rights may also include: (1) copyright, which is recognized in Jamaica in respect of all members of the Berne Convention; (2) unregistered signs or names used in the course of trade; and (3) marks entitled to protection as well-known trademarks under the Paris Convention. For unregistered signs or names, passing off actions usually are applicable where the business in question has goodwill associated with reputation in the relevant jurisdiction.

C. Assignees and Licensees

- An unregistered assignee of a relevant prior right may be a valid opponent. However, if the assignment is not registered, the assignee will not be entitled to any damages. In infringement proceedings, for example, with respect to acts occurring before the assignment is registered, the assignee may not be entitled to damages or an accounting of profits where the assignment was not registered within six months of the date of the assignment.
- A registered licensee of a relevant prior right may be a valid opponent.
- An unregistered licensee of a relevant prior right may be a valid opponent. However, without registration of the license, he/she would not be entitled to damages and other benefits in proceedings for infringement.

D. Concealing Identity of Opponent

- An opposition filed in the name of the legal representative for purposes of concealing the identity of the principal is considered validly filed if all other criteria are met by the opponent.

E. Joint Opponents

- Two or more opponents may jointly file a single opposition. (If the parties co-own prior rights or if one party is the proprietor and the other the licensee or partial assignee of rights in the mark, this should be allowable. There is nothing that expressly provides for joint oppositions in the Trade Marks Act, and presumably nothing precludes the same. The Trade Mark Rules do not expressly address this scenario. However, where two or more parties oppose the same application, in practice the Registrar has conducted the opposition hearing jointly.)
- A parent company and its trading subsidiary may be indicated together as opponents in a single joint opposition.
- Two otherwise unrelated companies may not file a single joint opposition. Although not specifically prohibited by the Trade Marks Act, this is not done in practice and the Trade Marks rules and forms appear to accommodate only one opponent. However, the

Registrar has conducted a joint hearing where two or more parties have opposed the same application.

F. Foreign Opponent

- Oppositions cannot be filed from abroad; they must be filed by a local attorney or an agent with a local address for service.

G. Opponent's Prior Rights and Use

- If an opponent relies on a prior registration, the applicant or opposition authority:
 - cannot require the opponent to provide proof of use of the earlier registered mark.

IX. TERM AND EXTENSION

A. Opposition Term: National Applications/Registrations

- The system provides a fixed initial term within which an opposition may be filed.
- With respect to national applications/registrations, the initial opposition term begins:
 - on the date that the details of the application are published for opposition in the local official IP bulletin, journal or gazette. This publication is called: The Trade Marks Journal. This publication is not available online.
- With respect to national registrations in this jurisdiction, the initial opposition term expires the following number of days or months following the date mentioned above: two months. For example, if publication is on November 22, 2012, the opposition period would expire on January 22, 2013. Where the expiration date falls on a weekend or public holiday, the applicable date would be the following weekday.

B. Opposition Term: International Registrations

- Not Applicable

C. Deadline Not on Normal Business Day

- An opposition deadline that does not fall on a normal business day or that falls on a local public holiday or other officially excluded days may be met by action on the next business day.
- Normal business days of the week are:
 - Monday through Friday.

D. Extensions

- The opposition term is not extendable. The grounds of opposition must be filed within two months of the publication date. Please note that although, the Trade Marks (Amendment) Act, 2013, appears to allow an opponent to request an extension of time within which to file the opposition, this provision has been noted as an obvious error which the Government intends to correct shortly.

X. FILING REQUIREMENTS

A. Minimum Filing Requirements

- The minimum filing requirements to initiate an opposition (i.e., to obtain a filing date) are: Notice of Opposition (Form TM4); statement of grounds of opposition; filing fees.
- The following additional actions or documentation are required to complete the required filing formalities (i.e., to shift the burden of action to the registration applicant) and will be accepted after the opposition term has expired: none.

B. Payment of Official Fees

- Opposition fees can be paid using the following payment modes:
 - cheque or cash.

C. Public Inspection of Documents

- Documentation submitted in an opposition is not open to public inspection.

D. Additional Grounds

- Additional grounds of opposition may not be introduced to the proceeding after an opposition has been filed.

E. Representation

- The opponent is required to act through a locally authorized representative during the entire proceeding, if the opponent is foreign-based.

F. Language and Translations

- Opposition documents must be submitted in the following local official language(s): English.
- Opposition documents may not be submitted in a language (or languages) other than the one(s) listed above.

XI. POST-FILING STAGES AND PROCEDURES

A. Sequence and General Considerations

- Depending on the jurisdiction, opposition proceedings generally involve a number of stages between the filing of the opposition and the official decision or judgment. Typically, the post-filing stages will require either that alternating actions be taken by one party after the other in consecutive steps or that actions be taken concurrently by both parties.
 - In this jurisdiction, opposition proceedings require alternating action by one party after the other. There is a general period of two months between each action. The initial two-month period for the filing of the opposition which used to be non-extendable is now extendable upon an application by the Opponent. The subsequent two-month periods are extendable on application by the affected party. In relation to the Counterstatement which is due two months after the opposition has been filed and served either party may apply for a "cooling-off period" of a further two months to facilitate settlement. The Cooling-off period will be granted by the Registrar upon an application supported by a declaration that the other party has agreed to it. The Cooling-off period may be extended by the

Registrar for up to six months after the expiration of the 2 month period upon application by the applicant supported by a declaration that the opponent has agreed to it. If the applicant does not file the Counterstatement within one month of the expiry of the cooling-off period the trademark application shall be deemed to be withdrawn.

B. Length of Opposition Procedure

- The approximate length of time from the filing of an opposition to an official decision concluding the opposition procedure is: 14 months.

C. Monetary Awards

- The opposition authority has the power to make a formal monetary award to the successful party. The award includes the following specific costs, official or attorney fees or other compensation: The opposition authority may seek security for costs if the opponent resides abroad and may award the successful party costs in the proceedings, including legal costs but not compensation. The opposition authority may also make formal monetary awards to both parties when each has partially succeeded.
- To receive a formal monetary award, the successful party in an opposition does not need to file a separate application. There is no requirement under the Trade Marks Rules for the filing of a separate application to claim a monetary award of costs, which leaves it open for applications to be made even orally to the Registrar in any proceedings before him under the Trade Marks Act.
- The amount or basis for calculating a typical monetary award is: The amount or basis for calculating a typical monetary award is not prescribed by the Trade Marks Rules and there is no established practice of claiming monetary awards and by extension calculating such awards. Rule 48 provides that "the Registrar may, in any proceedings before him under the Act or these rules, by order award to any party such costs as he may consider reasonable, and direct how and by what parties they are to be paid." This gives the Registrar a very wide discretion to make such awards, although, as a matter of practice, the Registrar may look to the courts for guidance in the calculation of costs.

D. Withdrawal of Oppositions or Applications

- Withdrawal of an opposition with or without the agreement of the applicant to the terms of the withdrawal automatically terminates the proceedings.
- Withdrawal of an opposition without the agreement of the applicant to the terms of the withdrawal can have the following consequences with regard to the award of costs: The Registrar has powers under the Rules in any proceeding before him to award costs to either party. It would be within the discretion of the Registrar whether the applicant is entitled to costs consequent on a withdrawal of the opposition, and this may depend on at what stage during the proceedings the withdrawal is done. If it is done, for example, after the applicant files a counter-statement and evidence or after the hearing has begun, the withdrawal may attract an award of costs if the applicant requests it.
- Withdrawal of an opposed application with or without the agreement of the opponent to the terms of the withdrawal automatically terminates the proceedings.
- Withdrawal of an opposed application without the agreement of the opponent to the terms of the withdrawal can have the following consequences with regard to the award of costs: The Registrar has powers under the Rules in any proceeding before him to

award costs to either party. It would be within the discretion of the Registrar whether the opponent is entitled to costs consequent on a withdrawal of the opposed application, and this may depend on at what stage during the proceedings the withdrawal is done. If it is done, for example, after the opponent files evidence or after the hearing has begun, the withdrawal may attract an award of costs if the opponent requests it.

- Withdrawal of an opposition or of an opposed application outside of this jurisdiction (with or without the agreement of the other party to the terms of the agreement) has no effect on opposition or other proceedings in this jurisdiction.
- If the opponent has withdrawn the opposition, the opposition authority cannot reject the opposed application on any of the opposition grounds.
- A formal basis is not required for withdrawal of an opposition.
- The limitation or restriction of the applicant's goods/services, with or without a written settlement agreement, is commonly a basis for withdrawal of the opposition.
- The terms of a settlement agreement need not be disclosed to the opposition authority.
- The opposition authority need not approve any settlement reached and/or formal withdrawal of the opposition.

XII. APPEALS

A. Availability/Deadline

- An opposition decision may be appealed.
- The following party or parties may file an appeal: any party to the opposition proceeding.
- The deadline for filing an appeal is: 28 days from the date that the Registrar's decision (including a statement of reasons) was sent to the affected party.

B. Forum

- There is a single appeal authority, the name of which is: the Supreme Court of Judicature of Jamaica.
- The following appeal authority/authorities is/are independent of the Trademarks Registry/Office: The Supreme Court of Judicature of Jamaica.

C. Cost/Monetary Bonds or Surety

- The government/official fees for filing an appeal are: JMD 2,000 (approx. USD 20) to stamp the document.
- The approximate range of attorney fees for filing an appeal is: Attorney fees can vary significantly depending on the firm/attorney. Fees for filing the appeal can range between USD 500 and USD 2,000 or more.
- The government/official fees for prosecuting an appeal to conclusion are: JMD 2,000 (approx. USD 20) to stamp the document.
- The approximate range of attorney fees for prosecuting an appeal to conclusion is: Attorney fees can vary significantly depending on the firm/attorney and the time spent on the matter. Fees can range between USD 2,000 and USD 10,000 or more.
- Monetary bonds or other surety may be required of foreign appellants. Security for costs is an application where a defendant gives the court an estimate of its legal costs to defend the claim and asks the court to order the claimant to pay, usually two-thirds

of that amount, into court or into an interest-bearing bank account in the joint names of the claimant and the defendant's attorneys-at-law.

D. Other Circumstances

- Important circumstances of appeal that are not mentioned above include: none.

E. Higher Appeals: Availability/Monetary Bonds or Surety

- An appeal decision is not final. Higher appeals are possible and can be made to: the Court of Appeal and thereafter to the Judicial Committee of the Privy Council, which sits in the UK.
- On higher appeal, monetary bonds or other surety may be required of foreign appellants.

XIII. OTHER ISSUES

A. Subsequent Infringement Proceedings

- In subsequent equivalent infringement proceedings, it is not known whether an opposition decision is binding on the court.

B. Local Requirements/Perspectives

- Particular local requirements that are not covered above and that are not common in other jurisdictions or familiar to foreign practitioners include: not known.

C. Anticipated Revisions of the Law

- The following important changes in relevant law are anticipated in the near future: The Trade Marks Act and Rules were amended effective August 31, 2013 to, among other things, provide for a "cooling-off period" in opposition proceedings. Further, the period of non-use in respect of which a mark can be revoked based on non-use has been changed from three years from the date of completion of the registration procedure to five years prior to the date of the application for revocation.

XIV. ALTERNATIVES

A. Cancellation

- There are procedures available whereby third parties can apply to cancel or partially cancel a registration (whether or not an opposition has been filed).
- These procedures are known (or translate into English) as:
 - revocation;
 - invalidation.

Revocation usually applies where actions post-registration such as non-use or use in a deceptive manner justify revocation. Invalidity is based on the ground that the registration should not have been granted in the first place, such as that the mark was applied for in bad faith or it did not qualify for registration.

- The grounds to initiate a revocation are:
 - the mark is generic (As a consequence of acts or inactivity of the proprietor, the trademark has become the common name in the trade for a product or service in respect of which it is registered.);
 - the mark is used in a misleading and/or deceptive manner (by the proprietor or with his consent);
 - the mark is a trade or business name;
 - the mark is not used for bona fide purposes in Jamaica in relation to the goods/services for which it is registered, within five (5) years prior to the date of an application for revocation and there are no proper reasons put forward by the proprietor for its non-use; or the bona fide use of the mark has been suspended for a continuous period of five (5) years prior to the date of an application for revocation and there are no proper reasons put forward by the proprietor for its disuse.
- The grounds to initiate a invalidation are:
 - the mark is descriptive;
 - the mark is misleading and/or deceptive;
 - the mark lacks distinctiveness;
 - the mark is generic;
 - the mark consists of a geographical indication;
 - the mark is functional;
 - the mark is against public policy or principles of morality;
 - the mark has not been authorized by competent authorities pursuant to Article 6ter of the Paris Convention;
 - the mark includes a badge or emblem of particular public interest;
 - the mark is used in a misleading and/or deceptive manner;
 - the mark is prohibited in this jurisdiction;
 - the application for or registration of the mark was made in bad faith;
 - there is an earlier application or registered mark;
 - there are earlier use-based rights in an unregistered mark;
 - the mark is covered by a copyright (or rights in designs.);
 - the mark is a company name (If the company name acquired a reputation by virtue of use in the course of trade.);
 - the mark is notorious or well known (Article 6bis of the Paris Convention);
 - the mark is a trade or business name (which acquired reputation by virtue of use in the course of trade.).
- To compare the grounds for the above procedures to the grounds for opposition, please see [Section III. Grounds: A. Absolute, Relative and Other Grounds](#)
- The burden of proof is on both parties to prove the allegations and defenses upon which they rely in the cancellation. Where registration is being revoked on the basis of non-use, the burden is on the registrant to prove use. If no proof of use is filed, the registrant may be deemed to have withdrawn the registration.
- The burden of proof in an opposition is the same as it is for a cancellation. The general rule is that he who asserts must prove. Where the applicant for a revocation or invalidation alleges that the application was filed in bad faith, the burden of proving bad faith lies with the person requesting the revocation/invalidation.

- It cannot be said that cancellation or equivalent proceedings are or are not preferable to opposition proceedings in some circumstances, as they seek different results and are not alternatives to one another.

B. Observations and Letters of Protest

- There are procedures for official consideration of informal protests raising objections to grant (e.g., observations, letters of protest, etc.), and these will be reviewed and result in official objection if well based.
- The deadline for informal protests raising objection is: at any time after publication of the application and before the grant of registration.
- Informal protests raising objection must be made to the Trademarks Registry/Office.
- The legal representative need not identify his client in such informal protests. Any person may make observations in respect of the registration of a mark.
- The following grounds may be raised in informal protests raising objection:
 - the same as those for opposition.

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