



Role of Intellectual Property Protection in Jamaica's transformation:

FROM CROWN COLONY TO MIDDLE-AGE INDEPENDENT

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Role of IP Protection in Jamaican's Transformation – **From Crown Colony to Middle-aged Independent**

Introduction



After nearly fifty-six (56) years of independence from Great Britain Jamaica's Intellectual Property (IP) Laws have undergone considerable changes including some stark departures from English Law particularly in the realms of copyright and passing off.

The factors of change have been largely external consequent to Jamaica's entry into the international IP legal framework governed by the World Intellectual Property Organization (WIPO) (now a member for 40 years) and the country's participation in a network of treaties and agreements in the global trade arena since the mid 1990s (the WTO TRIPS Agreement and the Economic Partnership Agreement between the EC and CARIFORUM (EPA)).

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Introduction



There has also been a ground-swell of local lobby groups advocating for indigenous policies and legislative amendments that are better suited to the national context and some judicial decisions that have tread uncharted territory in attempts to break new ground.

Even with the evolution in the laws, some of which now feature uniquely Jamaican markers, imprints of the Imperial Statutes on Jamaica's IP regime are still discernible throughout.

While this is particularly stark in relation to Patents and Designs protection which remain governed by pre-independence statutes traces are found in Copyright and Trademarks as well.

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- ▶ Additionally, the influence of British jurisprudence remains seemingly immovable as the Judicial Committee of the Privy Council continues to weigh in on local decisions as the final appellate court.
- ▶ Despite attempts by learned Counsel and the Jamaican Judiciary to break new ground in their interpretation of IP law, the final court serves as a reminder that we are still not truly independent.
- ▶ This presentation gives an abbreviated history of Jamaica's IP laws as received when the country was a British Colony through to their evolution in independent Jamaica over the past five decades and reviews a few landmark decisions, showing Jamaica in her process of transformation from Crown Colony to Middle-aged Independent.

Role of IP Protection in Jamaican's Transformation – **From Crown Colony to Middle-aged Independent**

Outline

► History & Evolution of Laws

Patents

Copyright

Trademarks

Designs

► National Relevance/Application of IP Laws

► Keeping us in Line

Pfizer Case - Patents

Paymaster Case – Copyright Ownership

► Notable Departures

Image Rights

Duration of Copyright

First Ownership of Copyright

► Final Thoughts

SUMMARY
LEGAL HISTORY
JAMAICA IP

HISTORY & EVOLUTION OF INTELLECTUAL PROPERTY LAWS



Role of IP Protection in Jamaican's Transformation – **From Crown Colony to Middle-aged Independent**

- ▶ Jamaica shares a common legal history with other former British Colonies, particularly her Caribbean Counterparts in relation to IP Rights protection.
- ▶ Imperial statutes applied automatically, and in some instances domestic laws were enacted which adopted British statutes.
- ▶ The English Common Law, which Jamaica applies by reception, has continued to shape the IP regime, particularly in the field of passing off and the protection of trade secrets and confidential information under the law of confidence.

For a comprehensive discussion on Jamaica's Intellectual Property Regime see Dianne Daley, *Intellectual Property Jamaica*, International Encyclopaedia of Laws, Kluwer Law International, Intellectual Property - Suppl. 47 (September 2008) (currently being updated).

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- ▶ British statutes on copyright, designs, patents, and trademarks from the nineteenth and early twentieth century had the force of law in Jamaica even after the country gained independence in 1962.
- ▶ These British Laws were transplanted into the Colonies, with no vision of independence at the time, hence raising questions as regards their continued suitability for the current local context.

For a comprehensive discussion on Jamaica's Intellectual Property Regime see Dianne Daley, *Intellectual Property Jamaica*, International Encyclopaedia of Laws, Kluwer Law 2008 (currently being updated).

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- Upon Independence on August 6, 1962 the Jamaica (Constitution) Order in Council preserved the laws that were in force immediately before the date of independence, subject to amendment or repeal.

“All laws which are in force in Jamaica immediately before the appointed day shall (subject to the amendment or repeal by the authority having power to amend or repeal any such law) continue in force on and after that day...”⁽¹⁾

- Jamaica's independence triggered early discourse on the laws but resulted in only minor changes until the 1990s.

(1) The Jamaica (Constitution) Order in Council 1962, section 4(1)

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- ▶ The Patent Act Law 30 of 1857, Cap. 283, which is the oldest IP statute in operation in Jamaica, has only had administrative amendments in 1974 and 1975.⁽¹⁾
- ▶ The 1974 Act introduced payments of fees to the Attorney General for filing and examination of the petition, declaration and specification.
- ▶ The 1975 Act provided for the lodgement of Letters Patent in the office of the Registrar of Companies and matters of recordation by that office and additions to specifications and other matters to be attended to by that office.

(1) The Patent (Amendment) Act No. 42 of Oct. 1974 and the Patent (Amendment) Act No. 8 of Mar. 1975

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- ▶ Letters Patent are granted by the Queen of England, Queen Elizabeth the Second, through Her representative, the Governor-General of Jamaica.
- ▶ The Act grants Letters Patents for ***'any manner of new manufacture or new mode of manufacture the subject of Letters Patent and grant of privilege within the meaning of the United Kingdom Act of the twenty-first year of the reign of King James the First, Chapter three'***, referring to the English Statute of Monopolies of 1623.

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- ▶ Elements of British statutes such as the Patent Designs and Trade Marks Act of 1883 which replaced the Commissioners with a modern Patent Office and the Patents and Designs Act of 1907 are absent from Jamaica's Patent Act.
- ▶ The Patent Act also falls well below the standards mandated by the WTO Trade Related Intellectual Property Rights Agreement (TRIPS) and the Paris Convention on Industrial Property, notwithstanding Jamaica's WTO membership since 1995 and its accession to the Paris Convention in 2000.

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- ▶ In March 2012, the Senate unanimously agreed that legislative action was immediately needed to repeal the existing patent laws as there was consensus that the laws in existence were not allowing innovators to fully benefit from their inventions and innovations.⁽¹⁾
- ▶ Up to 2015, Jamaica remained on the Office of the United States Trade Representative (USTR) Special Watch List on account of among other things, the outdated Patents Act. Jamaica has been encouraged ***“to adopt the long-awaited Patent and Designs Act which has been under review for nearly a decade.”***⁽²⁾

(1) See-‘Senate wants repeal of century-old patent laws’ <http://jamaica-gleaner.com/gleaner/20120319/news/news1.html>

(2) ‘2015 Special 301 Report’ - <https://ustr.gov/sites/default/files/2015-Special-301-Report-FINAL.pdf>

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- ▶ There was a 2001 Discussion Draft Patent and Designs Bill but after over a decade of deliberations, it was overhauled in a new draft Bill entitled an Act to Repeal the Patent Act and the Designs Act and to make new provisions relating to patents and industrial designs and for related matters dated January 16, 2017 now under discussion.
- ▶ The 2017 Draft Bill seeks to implement the relevant provisions of the TRIPS Agreement, the Paris Convention on Industrial Property and the Patent Cooperation Treaty (PCT)⁽¹⁾ and to provide protection for utility models. Jamaica is not yet a member of the PCT.

(1) The Patent Cooperation Treaty (PCT), Washington on 19 Jun. 1970, amended on 28 Sep. 1979, modified on 3 Feb. 1984, and 3 Oct. 2001 (in force from 1 Apr. 2002).

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- ▶ Copyright has had a most interesting journey in Jamaica's development as a former Colony.
- ▶ The Imperial Copyright Act 1911,^[1] which came into force in the UK on 1 July 1912, automatically extended to Jamaica along with the other English-speaking Caribbean who were at that time part the dominions of His Majesty King George V.^[2]
- ▶ Proclamation by His Majesty's Governors gave the 1911 Act the force of law in Jamaica simultaneously with its coming into force in the UK.^[3]

^[1] Copyright Act, 1911, 1 & 2 Geo. 5 c. 46

^[2] This was not the case for self-governing dominions like Australia, New Zealand and Canada where the Act had to be specifically enforced.

^[3] The Imperial Act was proclaimed in Jamaica on 30 May 1912, gazetted on 6 June 1912 and came into force on 1 July 1912. See 1911 Act s. 37(2) (d).

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- ▶ Jamaica's first domestic copyright statute, the Copyright Act 1913 incorporated provisions on copyright offences and sanctions under the 1911 Act which otherwise would only have applied in the UK.
- ▶ However, when the 1911 Act in the UK was repealed and British Copyright Law was substantially updated by the Copyright Act 1956, Jamaica's copyright law remained static.
- ▶ The 1956 Act did not automatically extend to His Majesty's dominions and Jamaica did not adopt that Act. An amendment in 1965 merely re-titled the Imperial Copyright Act 1911, “the UK Copyright Act 1911”.

The Copyright Act No. 12, July 1913.

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- ▶ It was not until 1977 that the Jamaican Parliament passed an intensely debated new Copyright Act which was intended to repeal the UK Copyright Act 1911. The 1977 Act earned the title 'the still-born Act' as it was never brought into force when certain deficiencies were noted.⁽¹⁾
- ▶ Real change was not to come to Jamaica's copyright regime until 1993, by which time the UK 1956 Act had been repealed and the Copyright, Designs and Patents Act (CDPA) 1988 passed.
- ▶ Jamaica 'came into its own' with the passage of the Copyright Act of 1993 in force as at September 1993 which repealed the Copyright Act of 1911 and substantially mirrored the copyright provisions of the CDPA.⁽²⁾

⁽¹⁾ The Most Honourable Edward Seaga, The Jamaican Hansard – The Honourable Senate Meetings (Debate on the Copyright Bill, 1993) (Session 27 January 1993) p. supra note 1 at p. 2.

⁽²⁾ The Copyright Act No. 4 of 1993 s. 151.

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The significance of this milestone was not lost on Parliament. As stated by the late Honourable Senator Rattray, during the debate on the Copyright Bill, 1993:

“Those of us who view the law essentially as an instrument for the development of our own people, and related to the circumstances of our locality and our times, and a fundamental part of our problem-solving mechanisms, may well wonder how it is that in 1993, thirty-one years after our achievement of national status in Jamaica, our Copyright Legislation is still the United Kingdom Act of 1911. Therein lies the story of the historical journey.”⁽¹⁾

⁽¹⁾ The Jamaican Hansard - The Honourable Senate Meetings (Debate on the Copyright Bill, 1993) (Session 27 January 1993) p. 3. For a discussion on the developments on copyright in Jamaica see Dianne Daley, *Shades of grey: uncovering the century old imperial imprint on Jamaica's modern Copyright Act* – published in *A Shifting Empire: 100 Years of the Copyright Act 1911* edited by Ysolde Gendreau and Uma Suthersanen, Edward Elgar (2013)) pp 168 - 203.

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- ▶ The Copyright Act of 1993 was amended in 1999 to comply with TRIPS and US/Jamaica Bilateral obligations but retained remnants of the Act of 1911 in relation to ownership and duration of copyright in works created before the coming into force of the 1993 Act. Therefore, British case law interpreting the Act of 1911 and the CDPA remain persuasive precedent in Jamaica.
- ▶ Notwithstanding the substantial similarities between the CDPA and the Copyright Act, there are, however, notable differences, some of which have been reinforced by the latest slate of amendments to through the Copyright (Amendment) Act of 2015.
- ▶ The 2015 amendments, though catalyzed by international developments surrounding the Internet (the WIPO Internet Treaties), effected several changes on account of local lobby groups and reflect a uniquely Jamaican approach in some respects.

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- ▶ Trademark protection seems to have had a fairly smooth journey to modernization in Jamaica. The earliest trademark to be registered in Jamaica dates back to the 1880s when British America Tobacco Brands, Ltd. obtained a registration under the UK Patents Designs and Trade Marks Act of 1883-1889 on 21 June 1889.
- ▶ The Trade Marks Law 37 of 1911, came into force in Jamaica on 1 March 1912. This Act (embodied as the Trade Marks Law Cap. 387, 1953), was repealed by the Trade Marks Act No. 32 of 1957, which came into force 1 December 1958.
- ▶ The Act of 1958 was patterned off the UK Trade Marks Act of 1938.

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- ▶ Further to Jamaica's WTO membership and accession to the Paris Convention, the Trade Marks Act 1957 was repealed by a new Trade Marks Act in 1999 which was amended in 2001 to recognize the newly established Jamaica Intellectual Property Office (JIPO).
- ▶ The UK Trade Marks Act of 1994 was the model legislation for the prevailing Act of 1999 (as amended) and the Registrar of Industrial Property of JIPO has adopted, as needed, Practice Directions made under the 1994 UK Act.
- ▶ The Act was updated again in 2013 to incorporate some updates to UK Trade Mark law. The Act is supported by the Trade Marks Rules of 2001 as amended in 2011 and 2013.

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- ▶ The Merchandise Marks Act of 1888⁽¹⁾, another transplant from the British Empire, provides for fines and forfeiture of counterfeit goods.
- ▶ Initially designed to protect British trademark proprietors from misuse of their trademarks through importation of goods bearing the marks into the Colonies, this Act has been used in conjunction with the Jamaica Customs Act of 1941 to impose sanctions against forgery of trademarks and false description of goods and is still in force today.
- ▶ Interestingly, the Merchandise Marks Act was never amended, repealed or referred to in the prevailing Trademarks Act of 1999 but refers to the repealed 1957 Trade Marks Act.

(1) Cap. 244 Laws of Jamaica, as amended by Act No. 35 of 1958 and Act No. 12 of 1985.

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- ▶ Protection for industrial designs in Jamaica is granted through registered designs under the Designs Act No. 32 of 1937 and partly by way of copyright.
- ▶ The design law has its roots in UK Patents Designs and Trade Marks Act of 1883-1889 and the first design registered in Jamaica was registered under the UK Patent and Designs Act of 1907.
- ▶ The Designs Act of 1937 substantially repeats provisions of both statutes but it was only amended in 1975 to transfer the administration of the registration system from the Registrar General to the Registrar of Companies.

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- ▶ With no further updates since, designs protection lacks many of the features of UK Design law and does not meet the standards required by the TRIPS Agreement and the Paris Convention on Industrial Property.
- ▶ The Designs Act is slated to be replaced by a modern industrial designs law, currently encapsulated in the Bill entitled an Act to Repeal the Patent Act and the Designs Act and to make new provisions relating to patents and industrial designs and for related matters dated January 16, 2017.

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Jamaica also has some 'millennium laws' one of which exists on the books mainly on account of obligations under the WTO TRIPS Agreement, namely:

- ▶ The Layout-Designs (Topographies) Act No. 30 of 1999, which came into force on 3 September 1999, was passed in fulfilment of Jamaica's obligations under section 6 of the TRIPS Agreement.

The Protection of Geographical Indications (GI) Act No. 5 of 2004 was an eagerly anticipated piece of legislation in Jamaica, based on the perceived impact it should have on Jamaican agricultural industries and the protection of 'Brand Jamaica'.

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- ▶ The GI Act of 2004 strictly implemented Articles 22 and 23 of the TRIPS Agreement, giving geographical indications for wines and spirits greater protection than that which applies to geographical indications for other goods.
- ▶ The GI Act which was amended in March 2018 going beyond the TRIPS standards, now unifies the standard of protection, wherein all goods are accorded the same level of protection as wines and spirits.
- ▶ It also implements the requirements of the EU-CARIFORUM Economic Partnership Agreement (EPA), that parties must establish a system of protection of GIs in their respective territories by 1 January 2014.

NATIONAL RELEVANCE AND APPLICATION

INTELLECTUAL PROPERTY LAWS



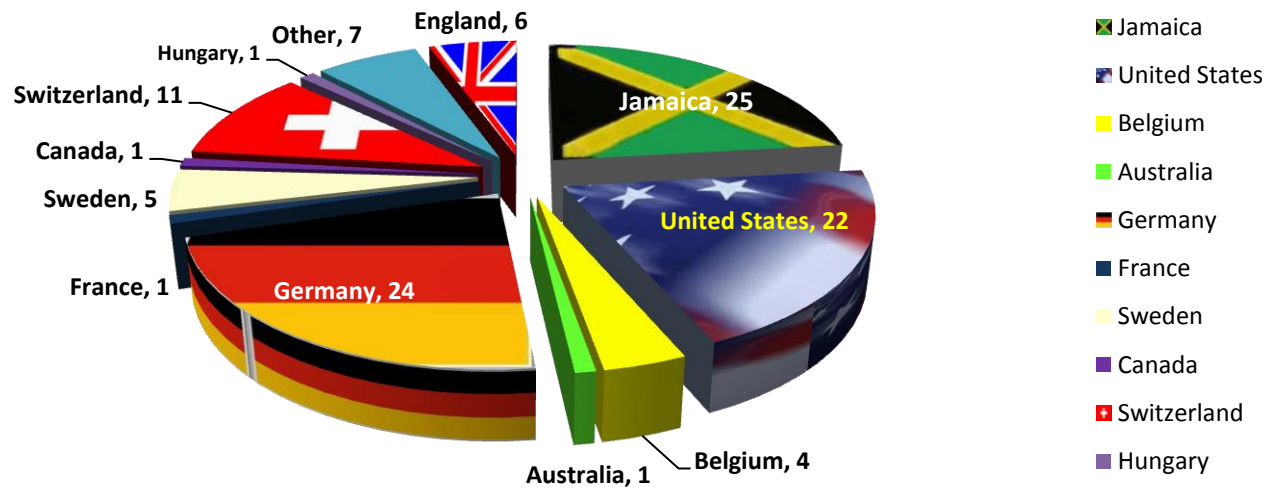
NATIONAL RELEVANCE - IP

- ▶ There is a sense in which Jamaica is still maturing in terms of intellectual property. It is still a relatively young country and the national awareness on the relevance of intellectual property has not yet peaked.
- ▶ It has grown considerably since the start of the millennium, but in the early post-independence years up to the 1990s it is really copyright that dominated the national consciousness, largely because of the strong music/entertainment industry.
- ▶ The debates in Parliament around the 1977 'still-born' Copyright Act and the 1993 Copyright Bill reflect this. Subsequent debates on unconnected IP laws such as layout designs & even patents has had Parliamentarians talking only about copyright.

NATIONAL APPLICATION - IP

- ▶ The registration of patents, designs and, up until the past decade, trademarks, has been dominated by foreigners.
- ▶ It has only been since the establishment of JIPO (2001) and several public education initiatives on IP that there has been an uptick in the use of the registration systems, trademarks in particular, by local industry & businesses.
- ▶ The following slide is just an illustration of use of the Jamaican system in the area of patents.

Patent Application by Country of Origin



JIPO–Patent Directorate Report, Dec. 2012

NATIONAL APPLICATION - IP

- ▶ The Courts have been most active in the area of trademarks and passing off, with landmark Court of Appeal rulings.
- ▶ JIPO routinely adjudicates on trademark oppositions and renders decisions, some of which have been appealed to the Supreme Court.
- ▶ Decisions of the European Court of Justice (ECJ), Court of First Instance (CFI), and the Office for Harmonization in the Internal Market (OHIM), have also guided the interpretation of the Trade Marks Act.

NATIONAL APPLICATION - IP

- ▶ The Courts have also considered jurisprudence from other Commonwealth Countries and the United States of America, most notably in the common law tort of passing off, in the Bob Marley case (discussed below)⁽¹⁾.

(1) *The Robert Marley Foundation v. Dino Michelle Ltd* (1994) 31 J.L.R. 197.

- ▶ Other notable trademark decisions include **McDonald's Corporation v. McDonald's Corporation Ltd.**, litigated in the 1990s and most recently **3M Company v Manufacturera 3M SA de CV** with a 2017 Court of Appeal ruling in favour of 3M Company.

NATIONAL APPLICATION - IP

- ▶ Patent and Trademark Litigation has mainly been initiated by foreign companies giving the impression that perhaps Jamaicans have not yet fully 'owned' their IP Laws. In contrast, copyright combatants have mainly been locals.
- ▶ For example, a recent fight between broadcasters, Television Jamaica Limited (TVJ) and CVM over the showing of excerpts of the 2015 IAAF World Athletic Championships in breach of TVJ's exclusive licence brought the issue of fair dealing to the fore.
- ▶ In this case TVJ acquired the exclusive rights to broadcast the Event and CVM carried portions of the event in its regular news programme News Watch and also through a newly developed programme called "Return to the Nest".

Television Jamaica Limited vs. CVM Television Limited CD 00112 of 2015

NATIONAL APPLICATION - IP

- ▶ TVJ sued CVM for breach of copyright/exclusivity. CVM claimed its use was for the purpose of reporting current events & invoked the fair dealing defence.
- ▶ The Claimant relied on the case of **England and Wales Cricket Board Limited and another v Tixdaq Limited** [2016] EWHC 575 (Ch), in interpreting section 30 (2) of the **CDPA** which is equivalent to section 53 of the Jamaican Act, which outlines the limited purposes for using a protected work that can qualify for a fair dealing defence.

NATIONAL APPLICATION - IP

- ▶ **The trial judge Sykes J, found that some of the uses by CVM were not fair dealing, in particular uses on the Return to the Nest Programme hence it breached TVJ's exclusive rights, while some, particularly uses on News Watch, were protected by the defence of fair dealing.**
- ▶ The judgement has been appealed by CVM and counter-appealed by TVJ and is yet to be heard by the Court of Appeal.
- ▶ It will be interesting to see how the Court of Appeal interprets the boundaries of fair dealing, its assessment of the Lower Court's determination on the purposes for which CVM used the protected material and the weight given to the relevant factors.

NATIONAL APPLICATION - IP

- ▶ The liberalization of Jamaica's telecommunications industry in the early 2000's sparked yet another dispute between Telcos Cable & Wireless Jamaica Ltd, Mossel Jamaica Ltd (t/a Digicel) and Oceanic Digital Jamaica Ltd on the question of copyright protection in C&WJ's telephone directory databases.
- ▶ In 2005 CW&J the former monopoly provider sought a declaration that copyright subsisted in its directory listings.
- ▶ Considering a number of UK cases and even the famous US Case Feist v. Rural in a belated ruling (2011) the learned Justice Rattray held that where copyright subsists in a compilation of data, works or other material, it does not extend to the facts or data comprised therein, with the effect that C&WJ could not use copyright to block its competitors from using the information in its directories.

KEEPING US IN LINE– Privy Council Decisions – Copyright

- ▶ Another defining case on copyright between Jamaican enterprises Paymaster Jamaica Ltd and Grace Kennedy Remittance Services limited involving a local software developer Paul Lowe made its way to the Judicial Committee of the Privy Council whose December 2017 ruling is expected to impact how companies engage with creators of software, content and other copyright works.

[Paymaster Jamaica Ltd. v Grace Kennedy Remittances Services Limited and Paul Lowe [2015] JMCA Civ 20 and Paymaster Jamaica Ltd. and another v Grace Kennedy Remittances Services Limited and Paul Lowe [2017] UKPC 40.]

KEEPING US IN LINE– Privy Council Decisions – Copyright

- ▶ In 1994, Paymaster employed a consultant to assist in designing the architecture for its multi-payment agency system and Paul Lowe, a computer programmer was commissioned to write the software for the system. Lowe, had already developed a cashiering program for direct payments called CSSREMIT but that program only enabled payments to a single company.
- ▶ Lowe modified CSSREMIT based on Paymaster's system specifications and upon completion in around October 1998, licensed the modified program (a multi-payment agency software) to Paymaster. Lowe then offered GKRS a non-exclusive licence to use the same modified CSSREMIT.
- ▶ GKRS had become aware of Mrs. Mark's business plan for a multi-payment system when she had approached them in 1996 seeking investment. GKRS launched its multi-payment agency services in April 2000 in direct competition with Paymaster.

KEEPING US IN LINE– Privy Council Decisions – Copyright

- ▶ Paymaster sued both GKRS and Lowe for breach of copyright and GKRS for breach of confidence and inducement to breach contract, and obtained an interlocutory injunction restraining both parties from using the programme.
- ▶ At trial the learned Justice Jones in a 2010 ruling, denied Paymaster all of its claims and determined that the copyright was vested in Lowe as the author of the computer program, that Lowe ***“never intended to assign away, forever, his ownership of the copyright in either the base CSSREMIT software or the Paymaster multi-payment software to Paymaster”*** and that, as the owner of the copyright in the software, Lowe was entitled to licence it to any person.

[Paymaster Jamaica Ltd. v Grace Kennedy Remittances Services Limited and Paul Lowe Claim no._2000/C.L.P 82.]

KEEPING US IN LINE– Privy Council Decisions – Copyright

- ▶ Paymaster appealed to the Court of Appeal in 2010 and in a ruling handed down in 2015 by the learned Justice Harris, the Court found that GKRS was in breach of confidence but rejected Paymaster's appeal on breach of copyright against Lowe affirming that Paymaster was a non-exclusive licensee and not the owner of the copyright.
- ▶ Paymaster then appealed to the Judicial Committee of the Privy Council, which upheld Justice Jones' decision on all points and disagreed with the CA on some aspects of its ruling.

[Paymaster Jamaica Ltd. v Grace Kennedy Remittances Services Limited and Paul Lowe [2015] JMCA Civ 20.]



NOTABLE DEPARTURES FROM THE EMPIRE



IMAGE RIGHTS

Like the UK, there is no statutory right of publicity/personality in Jamaican law, however, the existence of a property interest as distinct from a privacy interest attached to a personality was recognized in the case of **The Robert Marley Foundation v. Dino Michelle Ltd. (1994) 31 J.L.R. 197.**

NOTABLE DEPARTURES FROM THE EMPIRE
IMAGE RIGHTS

NOTABLE DEPARTURES FROM THE EMPIRE – IMAGE RIGHTS

- ▶ In the Bob Marley Case, the Jamaican court (departing from its British roots) recognised a property right in personality (a broad application of the common law principle of passing off – in the form of the Tort of Appropriation of Personality).
- ▶ This is of growing relevance in Jamaica particularly given the dominance by Jamaican athletes in worldwide track & field events.
- ▶ Applying the Bob Marley case deceased persons can assert this right through their estates or personal representatives.



There was an unauthorized commercial use by the defendant of Bob Marley's name and likeness on T-shirts which the Court felt constituted an invasion or impairment of the plaintiff's exclusive right, resulting in damage.

The court held that Bob Marley, **a celebrity at home and abroad**, had a right to the exclusive use of his image and likeness. The right entitled him to exploit it commercially and that right survived his death. (Clarke J p. 208).

NOTABLE DEPARTURES FROM THE EMPIRE

IMAGE RIGHTS



Clarke J opined that '[a]lthough no West Indian or English decisions recognize property in personality per se, dicta in cases such as *Clark v. Freeman* and *Dockrell v. Dougall* (supra) support the concept of property interest as distinct from a privacy interest attached to personality. Just as the law recognizes property in goodwill of a business so must the law recognize that property rights attach to the goodwill generated by a celebrity's personality. On that basis those rights are violated where the indicia of a celebrity's personality are appropriated for commercial purposes. And the principles of unjust enrichment demand that a person must not 'unjustly' benefit at the expense of another'.

NOTABLE DEPARTURES FROM THE EMPIRE

IMAGE RIGHTS

NOTABLE DEPARTURES FROM THE EMPIRE - IMAGE RIGHTS

- ▶ While the Bob Marley case has not been affirmed by any appellate court it opened the way for application of this extended tort in a later case.
- ▶ Although the Bob Marley case restricted the application of the tort to celebrities, a subsequent Supreme Court first instance decision **Messam v Morris and Williams HCV 1219/2004** extended its application to all persons.
- ▶ Georgia Messam went to a party and met the first defendant Clive Morris, a photographer of Hardcopy, a publication that documented the dancehall scene.

NOTABLE DEPARTURES FROM THE EMPIRE – Image Rights

- ▶ Miss Messam engaged Mr. Morris's services to photograph her at the party so she could send the pictures to her fiancée. The pictures were for her private use. Mr. Morris agreed to take the pictures and that he would treat them with the utmost privacy and confidentiality.
- ▶ Mr. Morris did not deliver the pictures to Miss Messam but instead handed the pictures to Milton Williams, editor of Hardcopy. The pictures were published without Miss Messam's consent.
- ▶ Miss Messam brought a claim against Messrs. Morris & Williams for Breach of Contract, Negligence & Wrongful Appropriation of Personality and succeeded on breach of contract and wrongful appropriation of personality with nominal damages of \$1.00 for each claim with costs.

NOTABLE DEPARTURES FROM THE EMPIRE – Image Rights


- ▶ Sykes J ruled that the claimant need not be a celebrity in order for the tort to be established. (see *Joseph v Daniels* 4 B.C.L.R. (2d) 239 & *Athans v Canadian Adventure Camps* 17 O.R. (2d) 425)
- ▶ Disagreeing with Clarke J in the Bob Marley case, he posited that the tort is not designed to protect celebrities but to protect a person from the loss of marketing his image and therefore targets wrongful commercial use of personality.
- ▶ He also departed from Clarke J on the point that it is necessary to prove that there was a detriment to the celebrity or those claiming through or under him.



IMAGE RIGHTS

The UK courts still do not recognise a personality right as such and appear to restrict the application of the tort of passing off to celebrities and to circumstances where the use implies an endorsement. See [Fenty v Arcadia Group Brands Limited Topshop/Topman Limited \[2015\] EWCA Civ 3 \(The Rihanna Case\) \(see also Gould Estate v. Stoddart Publishing 30 O.R. \(3D\) 520\)](#)

NOTABLE DEPARTURES FROM THE EMPIRE
IMAGE RIGHTS



The Court of Appeal noted that there is in English law no “image right” or “character right” which allows a celebrity to control the use of his or her name or image [29]. It is generally accepted that when images of famous people appear on goods there is no expectation from the public that the goods bearing the famous person’s image actually originate from them.

However, it is possible to use the law of Passing Off to stop the use of an image depending on the circumstances of the case.

NOTABLE DEPARTURES FROM THE EMPIRE

IMAGE RIGHTS

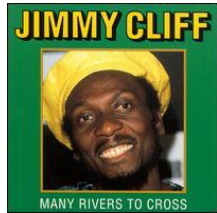
TERM OF COPYRIGHT

Globally, the term of copyright has been trending upwards from Author's **life plus 50 years** (Berne Convention) to **life plus 70 years** and 70 years for 'entrepreneurial' works. This has been the trend in Europe and the US which passed legislation in 1998 to save some important works from the public domain.

However, Jamaica is now one of a handful of countries in the world offering the longest copyright terms. The Copyright Amendment Act 2015 extends the term from life plus 50 years to **life plus 95 years** for works of authorship and from 50 to 95 years for practically all other types of works.

NOTABLE DEPARTURES FROM THE EMPIRE DURATION OF COPYRIGHT





TERM OF COPYRIGHT

An increase to 70 years was supported by some categories of Jamaican rights owners. However, the Jamaican sound recording and music industry lobbied for an even longer term extension in order to preserve Jamaican recordings of iconic songs, such as *Many Rivers to Cross* by Jimmy Cliff and *One Love* by Bob Marley created in the 1960s, which had already fallen or were about to fall into the public domain. The extension however applies across the board and its retrospective effect captures some works and recordings that were governed by the 1911 Act.

NOTABLE DEPARTURES FROM THE EMPIRE

DURATION OF COPYRIGHT



TERM OF COPYRIGHT

Under the 1993 Act (pursuant to section 153(2), the duration of copyright in sound recordings created prior to its coming into force on Sept 1 1993, is governed by the 1911 Act, under which they enjoyed a 50 year term.

The 2015 Amendment Act appears to have overridden the effects of Section 153(2) by extending the term for protection of such sound recordings by 45 years as the increase applies to sound recordings in which copyright subsisted in Jamaica immediately before September 1, 1993.

NOTABLE DEPARTURES FROM THE EMPIRE DURATION OF COPYRIGHT



TERM OF COPYRIGHT

The term extensions apply retroactively and begin from the year that subject work originally fell into the public domain. All works for which copyright expired on January 1, 2012 up to July 29, 2015, gain another 45 years, and those thereafter are protected for life plus 95 years or 95 years as the case may be, and 50 years in the case of typographical arrangements.

NOTABLE DEPARTURES FROM THE EMPIRE
DURATION OF COPYRIGHT



OWNERSHIP OF COPYRIGHT

Express provisions on ownership of copyright in the 1995 Copyright Amendment Act, which appear consequential to the provisions on term extension, reinforce Jamaica's departure from the norm in relation to ownership of copyright in respect of works created by employees in the course of their employment.

The 1993 Act departed from the UK and other common law jurisdictions by not exempting works created in the course of employment from the rule that the author is the first owner of the copyright. The 2015 Act reinforces the departure in relation to all works except those created for the Crown by Crown employees and consultants.

NOTABLE DEPARTURES FROM THE EMPIRE OWNERSHIP OF COPYRIGHT



Judicial
Committee of
the Privy Council
Decisions

**KEEPING US IN
LINE - PATENTS**



KEEPING US IN LINE– Privy Council Decisions - Patent

- ▶ Jamaica's archaic Patent system is quite intensively used by foreign applicants and seems to serve them well.
- ▶ An invention that has been patented abroad can still be patented in Jamaica so long as the foreign patent remains valid and the invention is new to Jamaica. This was designed to protect British patentees who traded their inventions abroad. Several pharmaceutical companies have taken advantage of this.
- ▶ This issue was the subject of litigation between Pfizer and some local pharmaceutical companies which went to the Privy Council - **Pfizer Limited (Appellant) v Medimpex Jamaica Limited and another (Respondents) [2014] UKPC 20 (discussed below)**.

See Dianne Daley & Nicole Foga, *Jamaica: Local pharmaceutical companies win temporary relief from Pfizer* – IP Value 2010: Building and Enforcing Intellectual Property Value (Global White Page) p. 98 and *Jamaica: Pharmaceutical companies score another victory as Pfizer loses appeal* - IP Value 2013: Building and Enforcing Intellectual Property Value (Global White Page) p. 65 .

KEEPING US IN LINE– Privy Council Decisions - Patent

- ▶ Pfizer owned the patent in amlodipine besylate – a hypertension drug branded Norvasc - through several equivalent letters patents and applied in 1992 and was granted a Jamaican Letters Patent in 2002. However, the earliest patent for amlodipine besylate granted in Egypt had expired from 1997.
- ▶ Local pharmaceutical distributors Medimpex Jamaica Limited and Lasco Distributors Limited began to market generics containing the drug and were sued by Pfizer in 2002 for patent infringement.
- ▶ The companies argued that by virtue of Section 29 of Jamaica's Patent Act 1857, Pfizer's Jamaican patent was invalid and hence there was no need for a licence from Pfizer. Section 29 ties the subsistence of a Jamaican patent to the validity of the earliest foreign patent for the same invention.

KEEPING US IN LINE– Privy Council Decisions - Patent

- ▶ When the matter went to trial however, the Court ruled in favour of the local pharmaceutical determining that Pfizer's patent was not valid.
- ▶ Pfizer appealed the Court of Appeal and in May 2012 the Court of Appeal upheld the Supreme Court's ruling on the point that Pfizer's Jamaican letters patent for amlodipine besylate was invalid, given that a foreign letters patent for the same substance had expired before the Jamaican letters patent was granted.
- ▶ Pfizer appealed the decision before the Judicial Committee of the Privy Council and while there were aspects of the lower courts' ruling that the Board disagreed with, the Board upheld the ruling on the invalidity of Pfizer's patent.

KEEPING US IN LINE– Privy Council Decisions - Patent

- ▶ Section 41 of Jamaica's Patent Act provides that in the case of doubts arising as regards the construction of this Act, it “**may be construed by analogy to the laws now or hereafter to be in force in England relating to the granting of Letters Patent for inventions, so far as the provisions of such laws shall be applicable.**”
- ▶ Hence reference to British Patent Law was inescapable in seeking to arrive at the meaning of the relevant provisions in Jamaica's Patent Act.
- ▶ The Lower Court turned to section 25 of the 1852 Act (Britain) in seeking to interpret section 29 of Jamaica's Patent Act which is *pari materia* to section 25.

KEEPING US IN LINE– Privy Council Decisions - Patent

The Board agreed with the trial judge, Jones J in his reference to section 25 of the 1852 Act, where he cited Lord Chelmsford summary of the Board opinion in *In re Betts' Patent* (1862) 15 ER 621, 625: that

- ▶ **“Where a patent is taken out in a Foreign country before a patent for the same invention in the United Kingdom, the latter patent is to terminate at the same time as the Foreign patent. Where the term in a Foreign patent has expired, any grant of Letters Patent in the United Kingdom made after that period is to be of no validity.”**

KEEPING US IN LINE– Privy Council Decisions - Patent

The Board further agreed with Jones J and the Court of Appeal “that on the proper construction of section 29 as a whole, if an invention has been patented abroad, then, irrespective of the identity of the foreign patentee, a Jamaican patent for the same invention:

- ▶ “will not continue in force after the expiration of the foreign patent; and, if there is more than one such foreign patent, it will not continue in force after the expiration of any one of those foreign patents;
- ▶ will be invalid if granted after the expiration of the foreign patent.

It followed that the Patent was invalid because it was granted after the date upon which Egyptian patent No 18266 had expired.”

JAMAICA'S TRANSFORMATION – FINAL THOUGHTS

- ▶ Jamaica continues to chart her own course and has come a considerable way in the development of its national intellectual property regime with some distinctly national features such as the 95 year copyright term and the Court's attempts at recognizing a tort of appropriation of personality.
- ▶ The guidance of the Privy Council in the interpretation of Jamaica's IP Statutes has proven invaluable as even with the modern trademark and copyright laws, their British roots are still traceable in the 'fruits'.

JAMAICA'S TRANSFORMATION – FINAL THOUGHTS

- ▶ Perhaps the protracted delays in deciding on a new Patent and Designs system reflects the policy makers' serious deliberations on how to construct a system best suited to the national context.
- ▶ The inclusion of Utility Model (Petty Patents) protection in the 2017 Draft Bill, for example, is a recognition that the incremental levels of innovation in the society still merit some protection but may fall short of the inventive leap required to obtain 'full' patent protection in the context of universal novelty.
- ▶ The stage is set for a distinctly Caribbean IP regime as CARICOM countries work towards a harmonized approach to IP and are taking deliberate but slow steps to implement EPA and other 'TRIPS plus' treaty obligations.



JAMAICA'S TRANSFORMATION

FINAL THOUGHTS

As learned counsel and Judges continue to test the bounds of Colonized IP with independent thought and decisions that can stand up to the scrutiny of the Privy Council perhaps a path is being paved to full judicial independence with the Caribbean Court of Justice (CCJ) taking the reins as the Caribbean's final appellate court.