
**Council for Trade-Related Aspects of
Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY
LAWS AND REGULATIONS NOTIFIED UNDER
ARTICLE 63.2 OF THE AGREEMENT**

JAMAICA

The present document reproduces the text¹ of the Patents and Designs Bill, as notified by Jamaica under Article 63.2 of the Agreement (see document IP/N/1/JAM/2).

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET RÉGLEMENTATIONS CONSACRÉES À LA
PROPRIÉTÉ INTELLECTUELLE NOTIFIÉES AU TITRE
DE L'ARTICLE 63:2 DE L'ACCORD**

JAMAÏQUE

Le présent document contient le texte¹ du projet de Loi sur les brevets et les décisions et modèles, notifié par la Jamaïque au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/JAM/2).

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA
PROPIEDAD INTELECTUAL NOTIFICADOS EN VIRTUD
DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

JAMAICA

En el presente documento se reproduce el texto¹ del proyecto de Ley de Patentes y Dibujos y Modelos Industriales, que Jamaica ha notificado en virtud del párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/JAM/2).

¹ In English only./En anglais seulement./En inglés solamente.

THE PATENTS AND DESIGNS ACT, 2001
(Act of 2001)

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A 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.

BE IT ENACTED by The Queen's Most Excellent Majesty,
by and with the advice and consent of the Senate and House
of Representatives of Jamaica, and by the authority of the
same, as follows:-

PART I. *Preliminary*

- Short title and commence-
ment. 1. This Act may be cited as the Patents and Designs Act,
2001, and shall come into operation on a day to be appointed
by the Minister by notice in the *Gazette*.
- Interpre-
tation. 2. In this Act -
"appointed day" means the day appointed by the Minister
pursuant to section 1;
"convention country" means a country, other than Jamaica,
declared by order under section 16 to be a
convention country for the purposes of this Act;
"exclusive licensee" means a licensee under a licence
granted by the patentee and conferring on the
licensee the right to exploit the patented invention
in Jamaica to the exclusion of the patentee and all
other persons;
"to exploit" in relation to an invention includes -
 (a) where the invention is a product -
 (i) to make, sell, offer for sale, or
 otherwise dispose of the product;

(ii) to use or import it,
or to stock it for the purpose of doing any of
those things; or

(b) where the invention is a method or process, to
use the method or process or do any act

mentioned in paragraph (a) in respect of a
product directly obtained by means of the
[method or] process;

"filing date" means the date referred to in section 10;

"to file" means to file with the Office;

"foreign vessel" means a vessel registered in a
prescribed foreign country;

"industrial design" shall be construed in accordance
with section 60;

"infringement proceedings" means proceedings for the
infringement of a patent;

"international application" has the same meaning as in
the Patent Co-operation Treaty;

"International Bureau" means the International Bureau of
the World Intellectual Property Organization
[established by the convention signed at Stockholm
on the 14th day of July, 1967];

"invention" means an idea which permits in practice the
solution to a specific problem in the field of
technology;

"inventor" means the deviser of an invention;

"licence" means a licence to exploit, or to authorize the
exploitation of a patented invention;

"non-voluntary licence" means a licence granted under an
order made under section 46;

"Office" means the Jamaica Intellectual Property Office established under the Jamaica Intellectual Property Office Act;

"patent" means the title granted under this Act to protect an invention, and unless the context otherwise requires, includes, subject to Part [] a [utility model certificate].

"Patent Co-operation Treaty" "or Treaty" means the Patent Co-operation Treaty done at Washington on the 19th, June, 1970, as amended from time to time and in force in Jamaica;

["publish" unless the context otherwise requires means to make available to the public whether by means of a national daily newspaper or otherwise];

"Register" means the register to be kept under section 81;

["registered" means -

- (a) in relation to a patent, entered in the Register of Patents; and
- (b) in relation to a patent attorney, entered in the Register of Patent Attorneys;]

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

["rules" means the rules made under section 101;]

"sealed" means sealed with seal of the Office;

"utility model certificate" means a certificate granted under section [] to protect the [title] to a registered utility model;

"to work" in relation to a patented invention means -

- (a) where the invention is a product, to make or import the product; or

- (b) where the invention is a method or process, to use the method or process or do any act mentioned in paragraph (a) in respect of a product resulting from such use.

PART II. PATENTABLE INVENTIONS

Patentability

- Conditions for patent-ability.
3. - (1) An invention is patentable only if -
- (a) it is new, involves an inventive step and is capable of industrial application; and
 - (b) the grant of a patent for it is not excluded under section 4.
- (2) An invention may be, or may relate to, a product or process.
- Restrictions on grant of patent.
4. - (1) A patent shall not be granted for -
- (a) plants, varieties of plants or animals other than than micro-organisms;
 - (b) essentially biological processes for the production of plants or animals, other than non-biological and micro-biological processes.
- (2) The following are not patentable -
- (a) inventions the implementation of which would be contrary to public order or morality or would cause serious prejudice to the environment;
 - (b) methods of surgical or therapeutic treatment and of diagnosis applied to the human body or to the bodies of animals (but not the products for use in any of those methods);
 - (c) discoveries, mathematical methods or the formulation of abstract theories;
 - (d) schemes, performing purely mental acts or playing games.

Novelty of
invention.

5. - (1) An invention that does not form a part of the state of the art is to be taken to be new.

(2) The state of the art in relation to an invention consists of all matter (whether a product, a process, information about either or anything else) that has been made available to the public anywhere in the world prior to the filing date or the priority date (as may be appropriate) of the application claiming the invention, by means of a written or oral description, use or by any other means.

(3) In relation to an invention for which application for a patent is made, the state of the art shall also be taken to comprise matter contained in an application for another patent which was published on or after the priority date of that invention, if that matter -

(a) has a priority date earlier than that of the invention; and

(b) was contained in the application for that other patent both as filed and as published.

(4) Where matter constituting the invention is disclosed in a period before the filing date, or the priority date, as the case may be, then, so long as the disclosure did not occur earlier than the six-month period immediately prior to such date, the disclosure shall not be taken to be part of the state of the art if it was due to or made in consequence of any act specified in subsection (5).

(5) The acts referred to in subsection (4) are as follows -

(a) the matter having been obtained unlawfully or in breach of confidence by any person from the inventor or from any other person to whom the matter was available in confidence by the inventor;

(b) a breach of confidence was committed by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or

(c) the inventor displayed the invention at an international exhibition, and the applicant -

(i) states, on filing the application, that the invention has been so displayed; and

(ii) files, within the prescribed period, written evidence in support of the statement complying with any prescribed conditions.

(6) Where an invention consists of a substance or compound for use in a method of surgical or therapeutic treatment or method of diagnosis, the fact that the substance or compound is part of the state of the art shall not prevent the invention from being taken to be new, so long as the use of the substance or composition in such method does not form part of the state of the art.

(7) In this section references to the inventor include references to any owner of the invention for the time being.

Inventive
step.

6. An invention shall be taken to involve an inventive step if, having regard to the state of the art, relevant to the application claiming the invention and within the meaning of section 5(2), it is not obvious to a person having ordinary skill in the art.

Industrial
application.

7. An invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry [, including agriculture, fishery and handicraft].

PART III. PROCEDURE FOR OBTAINING PATENT

Who may
apply.

8. - (1) An application for a patent may be made by -

- (a) any person claiming to be the true and first inventor of the invention; or
- (b) any person who is an assignee of the person so claiming, and in either case, may be made by that person alone or jointly with [any other person].

(2) Without prejudice to the provisions of subsection (1), an application for a patent for an invention in respect of which an application for protection has been made in a convention country, may be made by the [applicant] for protection or by the applicant's assignee.

(3) An application may be made under subsection (1) or (2) by -

- (a) the personal representative of any deceased person who, immediately before his death, was entitled to make an application; or
- (b) the assignee of the personal representative.

Application
for patent.

9. - (1) An application for a patent shall be filed with the Registrar in the prescribed form and manner and shall be accompanied by the prescribed fee.

(2) Every application shall contain -

- (a) a request for the grant of a patent;
- (b) a specification containing -
 - (i) a description of the invention;
 - (ii) one or more claims;
 - (iii) any drawing referred to in the description or in any claim; and

(c) an abstract.

(3) Where the applicant or one of the applicants is not the inventor -

- (a) the application shall contain a declaration by the applicant that he believes that the person named as the inventor is correctly named as such; and
- (b) the request shall be accompanied by a statement justifying the right of that applicant to the patent.

(4) The request shall contain the name of the applicant, the name of the inventor and the agent (if any) and a title indicating the subject of the invention.

(5) The description shall -

- (a) particularly describe the invention in a manner which is sufficiently clear and complete for the invention to be performed by a person having ordinary skill in the art; and
- (b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection.

(6) The claim or claims shall -

- (a) define the matter for which protection is sought;
- (b) be clear and concise and supported by the description; and
- (c) relate to one invention or to a group of inventions which are so linked as to form a single inventive concept.

(7) The abstract shall merely provide technical information and -

- (a) shall not on publication, form a part of the state of the art; and
- (b) shall not be taken into account for the purpose of interpreting the scope of the protection.

Filing
date.

10. - (1) Subject to the following provisions of this section [and section 11 and to the rules], the date of filing a patent application shall be the earliest date on which all the following conditions are satisfied in relation to the application -

- (a) the documents filed contain an indication that a patent is sought in pursuance of the application;
- (b) those documents -
 - (i) identify the applicant or the applicants for the patent; and
 - (ii) contain a description of the invention for which a patent is sought whether or not the description complies with the other provisions of this Act and the rules; and
- (c) the applicant has paid the prescribed filing fee.

(2) If the Registrar finds that the conditions specified in subsection (1) are not satisfied, the Registrar shall invite the applicant to make the necessary corrections within the prescribed period, and if the corrections are not so made, the application shall be treated as if it had not been filed.

(3) Where after a patent application has been filed and before the grant of the patent -

- (a) a new application is filed by the original applicant or his successor in title in accordance with the rules in respect of any part of the matter contained in the earlier application; and
- (b) the conditions specified in subsection (1)(a) and (b) are satisfied in relation to the new application,

the filing date of the earlier application shall be treated as the filing date of the new application.

(4) Where an application is divided pursuant to section 12, each divisional application is entitled to the filing date of the initial application.

Priority
date.

11. - (1) An applicant for a patent may claim on for his application, a right to priority with reference to an earlier application by him or his predecessor in title filed in relation to the same invention in a convention country.

(2) An applicant who wishes to make a claim for a right of priority shall -

- (a) make a declaration to that effect in the application; and
- (b) indicate the filing date of the application in the convention country.

(3) Where an application contains the matters referred to in subsection (2), the Registrar may request the applicant to furnish, within the prescribed period -

- (a) a copy of the earlier application certified as correct by the appropriate authorities in the country in which that application was filed; and
- (b) if the earlier application is not in English, a translation of it in English accompanied by a declaration by the translator that the translation is to the best of his knowledge, complete and faithful.

(4) An applicant for a patent under this Act is entitled to a right of priority in respect of the application if -

- (a) his application under this Act is made before the expiration of twelve months from the date immediately after the filing date of the earlier application or, if there is more than one, of the first of them; and

(b) he has acted as required under subsections (2) and (3) and in accordance with such rules as may be prescribed.

(5) Where the Registrar finds that the requirements of subsection (3) or the rules have not been met, the declaration by the applicant under subsection (2)(a) shall be regarded as having not been made.

(6) Where two or more applications have been filed earlier in the same country or in different countries, being applications which constitute regular filings in such country or countries, then, the priority date under this Act shall be taken to be the earliest filing date of the previous regular filings.

(7) Where the date taken to be the priority date under subsection (6) or the filing date in Jamaica under section 10 or both, were effected by a person who was not entitled to the grant of the patent, the true owner of the right may claim the priority conferred by subsection (4).

(8) The acceptance by the Registrar of a claim to a right of priority in respect of a patent application does not relieve a patentee of the obligation to prove the existence of the right.

(9) In relation to a patent application, no opposition may be raised with reference to any act occurring between the priority date and the date on which the application is first filed under this Act.

(10) In this section ``regular filing'' means any filing of an application that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent outcome of the application.

Divisional application. 12. - (1) At any time before the termination of the examination of an application relating to two or more inventions, the application may be divided into two or more applications (hereinafter called "divisional applications") at the direction of the Registrar or at the request of the applicant, provided that each divisional application makes specific reference to the original application and does not extend beyond the description in the original application.

(2) A divisional application which does not comply with subsection (1) shall be deemed to be withdrawn.

(3) Each divisional application shall have the filing date of the original application and shall have the benefit of any priority enjoyed by the original application.

(4) The prescribed fee shall be payable in respect of each divisional application.

Information on foreign applications. 13. - (1) An application shall, at the request of the Registrar, furnish the Registrar with the date and number of any application for a patent or other title of protection made in an industrial or intellectual property office of any other country, or within a regional industrial intellectual property office (hereinafter referred to in this section as a "foreign application"), relating to the same or essentially the same invention as that claimed in the application filed with the Registrar.

(2) The applicant shall, upon request, furnish the Registrar with the following documents relating to one of the foreign applications referred to in subsection (1) -

- (a) a copy of any communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application;

- (b) a copy of the patent or other title of protection granted on the basis of the foreign application;
- (c) a copy of any final decision rejecting the foreign application or refusing the patent requested in the foreign application;
- (d) a copy of any final decision invalidating the patent or other title of protection granted, on the basis of the foreign application referred to in subsection (1).

(3) Documents furnished pursuant to subsections (1) and (2) shall, if not in English be translated into English and be accompanied by a declaration by the translator that the translation is, to the best of his knowledge complete and faithful; and such documents may be used only to facilitate the evaluation of the novelty and inventive step of the application filed with the Registrar.

(4) The applicant may submit comments on any documents furnished by him under subsections (1) and (2).

Mention
of inventor.

14. - (1) The inventor or joint inventors of an invention have the right to be mentioned as such in any patent granted for the invention unless there has been submitted to the Registrar by him or them, as the case may be, a written declaration indicating a desire not to be so named.

(2) A promise or undertaking by the inventor made to any person to the effect that he would make such a declaration shall be void.

(3) The mention of a person as an inventor pursuant to this section shall not confer or derogate from any rights under the patent.

[(4) Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the Registrar for a certificate to that effect, and the Registrar may issue such a certificate and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1).]

National
treatment.

15. As regards the protection of patents, utility models, industrial designs or applications therefore, this act shall apply also to nationals of any convention country and, nationals of a non-convention country who are domiciled in or have [real and effective] industrial or commercial establishments in Jamaica;

Convention Application

Convention
application.

16. - (1) With a view to fulfilling obligations under any Treaty, international convention or arrangement, the Minister may by order published in the Gazette declare a country specified in the order as a convention country for the purposes of Act.

(2) A patent application from any country so specified under subsection (1) shall be referred to hereinafter as a convention application and shall -

- (a) specify the date on which and the country in which the patent application or the first such application was filed; and
- (b) state that no patent application in respect of the invention had been made in the convention country before that date by the applicant or any person from whom he derives title.

International Application

International 17. - (1) An international application for (designating application. Jamaica) for which a filing date has been accorded under the Patent Co-operation Treaty shall, subject to sections 18 and 19, be treated for the purposes of [this Part] [this Act] as an application for a patent under this Act.

(2) If the international application or the designation of Jamaica in it is withdrawn or (except as mentioned in subsection (3)) deemed to be withdrawn under the Treaty, it shall be treated as withdrawn under this Act.

(3) An international application shall not be treated as withdrawn under this Act if it or the designation of Jamaica in it is deemed to be withdrawn under the Treaty -

- (a) because of an error or omission in an institution having functions under the Treaty;
- (b) because, owing to circumstances outside the applicant's control, a copy of the application was not received by the International Bureau before the end of the time limited for that purpose under the Treaty; or
- (c) or in such other circumstances as may be prescribed.

(4) Where an international application which designates Jamaica is refused a filing date under the Treaty and the Registrar determines that the refusal was caused by an error or omission in an institution having functions under the Treaty, the Registrar may direct that the application shall be treated as an application under this Act, having such filing date as the Registrar may direct.

Treatment
of appli-
cation.

18. - (1) During the international phase of an international application [(Jamaica)] the provisions of the Patent Co-operation Treaty and the Regulations thereunder relating to [publication, search, examination and amendment], shall apply instead of the relevant provisions of this Act.

(2) The international phase of the application means the period from the date of filing of the application in accordance with the Treaty until the national phase begins.

(3) The national phase of the application begins -

- (a) when the prescribed time limit expires, but only if prior thereto the translation (where applicable) of the application into English has been submitted to the Office and the applicant has paid the prescribed fee; or
- (b) on the applicant expressly requesting the Registrar to proceed, in advance of such expiry, with the national phase of the application, so long as a copy of the application is filed at the Office, if not previously done pursuant to the Treaty, a translation of the application into English is provided where necessary and the prescribed fee is paid,

and for the purposes of sub-paragraph (b) "a copy of the application" includes a copy published in accordance with the Treaty in a language other than in which it was originally filed.

(4) If before the expiration of the prescribed period, conditions mentioned in subsection (3) (a) are not satisfied, the application shall be taken to be withdrawn.

(5) Where an amendment is made to an international application during the international phase, the amendment will be treated as made under this Act if -

- (a) before the end of the prescribed period, any necessary translation of the amendment has been filed at the Office and the applicant has paid the prescribed fee; or
- (b) where the applicant expressly requests the Registrar to proceed earlier with the national phase of the application, there is then filed with the Office a copy of the amendment (if it had not been previously sent in accordance with the Patent Co-operation Treaty) and any necessary translation thereof.

(6) Where the requirements of subsection (5) (a) or (b) are not satisfied, the any amendment to an international application during the international phase shall be disregarded.

(7) The Registrar shall, on payment of the prescribed fee, publish any translation filed at the Office under subsection (3) or (5).

Adapting
Act to in-
ternational
application.

19. The following provisions shall apply where an international application (Jamaica) is accorded a filing date under the Patent Co-operation Treaty -

- (a) the filing date so accorded shall be treated as the date of filing the application under this Act, or if the application is re-dated under the Patent Co-operation Treaty to a later date, that later date shall be treated as the date of filing;
- (b) any declaration of priority contained in the application shall be treated as made under section 11(2), and where in accordance with the Treaty extra days are allowed, the period of twelve months specified in section 11(4) shall be treated as altered accordingly;

- (c) any statement of the inventor's name under the Treaty shall be treated as a statement filed in an application under section 8(1).

(2) Where an international application which has not otherwise been published under this Act is published in accordance with [the Treaty] then, except as provided in subsection (3), it shall be treated as published for the purposes of section 22 when the conditions specified in section 18(3)(a) are satisfied.

(3) For the purposes of sections 52 and [87], the application, not having been published under this Act, shall be treated as published under section 22 -

- (a) if it is published in English, on its being so published; and

- (b) if it is published in a language other than English -

- (i) on the publication of a translation of the application in accordance with section 18; or

- (ii) on the service by the applicant of a translation into English of the specification of the application on the Government department concerned or, as the case may be, on the person committing the infringing act,

and reference in paragraph (b)(ii) to the service of a translation on a government department or other person is to its being sent by post or delivered to that department or person.

(4) The provisions of section 12 shall apply -

- (a) during the international phase of the application applies notwithstanding the application;

(b) cease to apply after the end of the international phase.

(5) When the national phase begins, the Registrar shall refer the application for so much of the examination and search under sections 23, and 24 as the Registrar considers appropriate in view of the examination or search carried out under the Treaty.

Provisions as to Applications

Withdrawal of application. 20. - (1) An application which has a filing date by virtue of section 10(1) shall be taken to be withdrawn at the end of the period prescribed unless before that time the applicant -

(a) files at the Office -

(i) one or more claims for the purposes of the application; and

(ii) the abstract;

(b) makes a request for a preliminary examination and search under the Act; and

(c) pays the prescribed search fee.

(2) An applicant may file a request for the withdrawal of a patent application within [sixteen months] from the date of filing or the date of earliest priority, as the case may require.

[(3) Notice of withdrawal or abandonment of a patent application shall be published in the *Gazette*.]

A patent application which is withdrawn or abandoned shall be published in the *Gazette*.]

[(4) Withdrawal of an earlier application that has not produced any effect shall cause priority to go to the earliest subsequent application.]

Amendment of application. 21. - (1) At any time before a patent is granted pursuant to an application under this Act, the applicant may amend the application in accordance with the prescribed conditions.

(2) The Registrar may, on his own initiative, amend the specification and abstract contained in a patent application so as to acknowledge a registered trade mark.

Publication of application. 22. - (1) Where an application has a filing date then, as soon as possible after the end of the prescribed period, the Registrar -

(a) shall, unless the application is withdrawn or refused before the preparations for its publication have been completed by the Office, publish it as filed (including the original claims and any amendments thereto, and new claims substituting immediately before the completion of those preparations) and;

(b) may, at the request of the applicant publish the application during the prescribed period, and in either event shall advertise the fact and the date of its publication in the *Gazette*.

[(2) The Registrar may omit from the specification of a published patent application any matter -

(a) which, in the Registrar's opinion, disparages any person in a way likely to damage such person;

(b) the publication or exploitation of which would, in the Registrar's opinion, encourage offensive, immoral or anti-social behaviour.]

Examination and Search

Preliminary examination and search. 23. - (1) Where an application has a filing date and is not withdrawn under any of the foregoing provisions of this Act the applicant may, within the prescribed time, in the prescribed manner, make a request to the Registrar for a formalities examination.

(2) For the purpose of the formalities examination, the Registrar shall determine whether the application is in [formal] compliance with the requirements of sections 9(2), (3) and (4) and 13 and of any regulations relating thereto.

Substantive Examination

Substantive examination. 24. - (1) Where the Registrar is satisfied that the requirements specified in section 23(2) have been complied with, he shall determine whether the application complies with the requirements of sections 3 to 7, and 9 and 12 of any regulations relating thereto.

(2) For the purposes of making a determination under subsection (1) the Registrar -

(a) if he thinks fit may, after prior notification to the applicant and payment by the applicant of the prescribed fee transmit the application to an authority duly authorized by the Minister to carry out a search and examination required under section 23 and this section [and references to 'examiner' under this Act mean an examiner under any such authority];

(b) shall take into account -

(i) the report of any such search and examination;

(ii) the results of any international search report and any international preliminary examination report under the Patent Co-operation Treaty carried out in relation to the application;

(iii) the results of any search or examination referred to in section 13(2)(a) and any decision referred to in section 13(2)(d).

(3) If the fee is not paid within the prescribed period, the application shall be taken to be withdrawn at the end of that period.

(4) The examiner shall determine whether or not the search would serve any useful purpose in relation to the application as constituted, for the time being, and where he determines that -

(a) the search would serve a useful purpose, whether as regards the whole or any part of the application, he shall proceed to conduct the search and shall report thereon to the Registrar;

(b) no useful purpose would be served by conducting the search, he shall report thereon to the Registrar accordingly.

(5) In conducting the search the examiner shall make such investigations as he considers practicable and necessary to identify the documents which he thinks will be needed to decide, on a substantive examination of the application hereunder, whether the invention for which the patent is sought is new and involves an inventive step.

(6) Where the examiner forms the opinion, whether before or during the preliminary search, that an application relates to two or more inventions which are not so linked as to form a single inventive concept, he shall initially conduct a search in relation only to the first invention specified in the claim to the application, so, however, that he may proceed to conduct a search in relation to another invention specified in the application if the applicant pays the search fee in respect of that other invention.

(7) Where the Registrar refuses an application under this section, he shall, by notice in writing inform the applicant of the decision and the reasons therefor.

Grant of
patent.

25. - (1) Where the Registrar is satisfied that the application complies with requirements of sections 23(2) and 25(1) he shall grant a patent for the invention in respect of which the application was made.

(2) Where the Registrar is not so satisfied, he shall refuse the application and within [] days of that decision, notify the applicant accordingly.

(3) A patent granted under subsection (1) shall be in the prescribed form and shall be sealed with the seal of the Office.

(4) Where two or more applications for a patent for the same invention having the same priority date are filed by the same applicant or his successor in title, the Registrar may on that ground, refuse to grant a patent in pursuance of more than one of the applications.

(5) Upon the grant of a patent the Registrar shall -

- (a) make an entry of the patent in the Register, including the date on which the patent is sealed pursuant to subsection (2);
- (b) issue the patent to the applicant;
- (c) published in the *Gazette* a reference to the grant of the patent;
- (d) make copies of the patent available to the public, on payment of the prescribed fee.

(6) The patent shall contain -

- (a) a certificate to the effect that the requirements of this Act and rules for the grant of a patent have been complied with; and
- (b) such other information as may be prescribed.

Duration. 26. - (1) The term of a patent shall be twenty years from the filing date .

(2) A patent shall cease to have effect at the end of the period prescribed for the payment of any renewal fee if it is not paid within the prescribed time.

Postponement of grant. 27. - (1) At the request of the applicant, the grant of a patent may be postponed for a maximum of six months from the date of the communication indicating that the examination procedure has been completed.

(2) Where the Minister certifies that the public interest requires that the invention be kept secret, the Registrar may allow an extension of the time for grant beyond six months, subject to such conditions and procedures as may be specified,.

Provisions as to Patents After Grant

Amendment of specification after grant. 28. - (1) Subject to the following provisions of this section the Registrar may, on an application made by the patentee, allow the specification of the patent to be amended subject to such conditions, if any, as the Registrar thinks fit.

(2) The Registrar shall not allow amendments under subsection (1) where proceedings are pending before the Registrar or the Court in which the validity of the patent may be put in issue.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Without an application being made to the Registrar, the Registrar may, amend the specification of a patent so as to acknowledge a registered trade mark.

(5) A person may give notice to the Registrar of his opposition to an application under this section by the patentee, and if he does so, the Registrar shall notify the owner and consider the opposition in deciding whether to grant the application.

PART IV. PROPERTY RIGHTS AND OWNERSHIP

Nature of rights. 29. A patent or application for a patent is personal property and the rights in a patent and in any application for a patent may be transferred, created or granted in accordance with the provisions of this Act.

Exclusive rights. 30. Subject to the provisions of [this Act], a patent gives the patentee the exclusive rights, during the term of the patent to exploit the invention and to authorize another person to exploit the invention.

Ownership

Persons to whom may be granted. 31 - (1) A patent for an invention may be granted only to a person who -

- (a) is the inventor;
- (b) would, on the grant of the patent for the invention be entitled to have the patent assigned to him;
- (c) derives title to the invention from the inventor or a person mentioned in paragraph (b);
- (d) is the legal representative or a person referred to in paragraph (a), (b) or (c).

(2) A patent may be granted to a person whether or not he is a Jamaica national.

Co-ownership. 32 - (1) Subject to any agreement to the contrary, whether there are two or more patentees -

- (a) each of them is entitled to an equal undivided share in the patent; and
- (b) each of them is entitled by himself or by his agent to exercise the exclusive rights given by the patent for his own benefit without obtaining the consent of or accounting to the others; and
- (c) none of them may grant licence under the patent or assign an interest in it, without the consent of the other or others.

(2) Where a patented product or a product of a patented method or process is sold by any of two or more patentees, the buyer, and a person claiming through the buyer, may deal with the product as if it had been sold by all the patentees.

(3) This section does not affect the rights or obligations of a trustee or a legal representative of a deceased person or rights or obligations arising out of either of those relationships.

- Directions to 33 - (1) Where there are two or more patentees the Co-owners. Commissioner may, on the application of any of them, give directions in accordance with the applications as the Commissioner thinks fit, being directions concerning -
- (a) a dealing with the patent or an interest in it;
 - (b) the grant of licences under the patent; or
 - (c) the exercise of a right under section 32 in relation to the patent.
- (2) If a patentee fails to do anything necessary to carry out a direction under subsection (1) within twenty-eight days after being asked in writing to do so by one of the other patentees, the Registrar may, on the application of one of those other patentees, direct a person to do it in the name and on behalf of the defaulting patentee.
- (3) Before giving a direction, the Registrar shall give an opportunity to be heard -
- (a) in the case of an application by a patentee or patentees under subsection (1), to the other patentee or patentees; and
 - (b) in the case of an application under subsection (2), to the defaulting patentee.
- (4) The Registrar shall not give a direction that -
- (a) affects the rights or obligations of a trustee or of the legal representative of a deceased person, or rights and obligations arising out of either of those relationships; or
 - (b) is inconsistent with the terms or an agreement between the patentees.
- Inventions by 34 - (1) Notwithstanding anything in any rule of law, an employees. invention made by an employee shall to be taken to belong to the employer if -

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him and in either case, the circumstances were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties, he had a special obligation to further the interests of the employer's undertaking.

(2) Any invention made by an employee in circumstances not specified in subsection (2) shall be taken to belong to the employee.

(3) Where by virtue of subsection (2) an invention belongs to an employee, nothing done -

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent; or
- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right in any model or document relating to the invention to which the employer is entitled.

Compensation 35 - (1) Subject to subsection (3) where it appears to
of employees. the Court or the Registrar on an application made by an
employee within the prescribed period that -

- (a) the employee had made an invention which by virtue of section 34 belongs to the employer for which a patent has been granted;

- (b) having regard among other things to the size and nature of the employer's undertaking, the patent is of outstanding benefit to the employer; and
- (c) by reason of that fact, it is just that the employee should be awarded compensation to be paid by the employer,

the Court or the Registrar, as the case may be, may award the employee such compensation of an amount determined under section 36.

(2) Subject to subsection (4), on an application made by an employee within the prescribed period the Court or the Registrar may award compensation in accordance with section 36 to that employee if satisfied that the matters referred to in subsection (3) apply to that employee.

(3) The matters mentioned in subsection (2) are that -

- (a) a patent has been granted from an invention made by and belonging to the employee;
- (b) the rights of the employee in the invention, or in any patent or application for a patent for the invention have, [since the appointed day] been assigned to the employer or an exclusive licence under the patent or application, has [since the appointed day] been granted to the employer;
- (c) the benefit derived by the employee from the contract of assignment or grant or any ancillary contract (referred to in this section as the "relevant contract") is inadequate in relation to the benefit derived by the employer from the patent; and

(d) by reason of the matters outlined in paragraphs (a), (b) and (c) it is just that the employee should be awarded compensation to be paid by the employer in addition to the benefit derived from the relevant contract.

(4) Subsections (1) and (2) shall not apply to the invention of an employee where a relevant collective agreement provides for the payment of compensation in respect of inventions of the same description as that invention to employees of the same description as that employee.

(5) Subsection (2) shall have effect notwithstanding anything in the relevant contract or any agreement applicable to the invention (other than any such agreement).

(6) The Registrar may decline to deal with an application made under this section if it appears to the Registrar that it involves matters which would more properly be determined by the Court.

(6) References in this section to an invention belonging to an employer or employee are references to it so belonging as between the employer and the employee.

(7) In this section -

"the prescribed period" in relation to proceedings before the Court, means the period prescribed by rules of court; and

"relevant collective agreement" means a collective agreement within the meaning of the Labour and Industrial Relations Act made by or on behalf of a trade union to which the employee belongs and by the employer or an employer's association to which the employer belongs, which is in force at the time of the making of the invention.

Amount of compensation. 36. - (1) The award of compensation to an employee under section 35(1) and (2) shall be such as will secure to the employee a fair share of benefit which the employer has derived or may reasonably be expected to derive from the patent or from the assignment or grant to a person connected with the employer of the property or any right in the invention or in property in an the application for the patent.

(2) For the purposes of subsection (1), the amount of any benefit derived or expected to be derived by an employer from the assignment or grant to a person connected with him, of the property in or any right in either a patent for an invention, an application for such a patent, or the invention itself, shall be taken to be the amount which could reasonably be expected to be so derived by the employer if that person had not been connected with the employer.

(3) Where the Crown or a prescribed research organization in its capacity as employer assigns or grants the property or right in an invention or application for a patent-

- (a) to a body whose functions consist of developing or exploiting inventions resulting from the public research; and
- (b) does so for no consideration or only a nominal consideration,

any benefit derived from the invention, patent or application by that body shall be treated for the purposes of subsections (1) and (2) as so derived by the Crown or, as the case may be, the prescribed research organization.

(4) In determining the fair share of the benefit to be secured for an employee in respect of a patent for an invention which has always belonged to the employer or which originally belonged to the employee, the Court or the Registrar shall take account of such matters as may be prescribed.

(5) An order for compensation under section 36 may provide for the payment of a lump sum or for periodical payments, or both.

(6) The refusal of the Court or the Registrar to make an order on an application made by an employee under section 36 shall not prevent a further application being made under that section by the employee or any of his successor in title of his.

~~(7) Where the Court or the Registrar has made an order under section 35, then, the Court or, as the case may be, the Registrar may, on an application made by the employer or the employee, vary, discharge or suspend any provision of the order and revive any provision so suspended, and section 35(5) shall apply to the application as it applies to an application under that section.~~

Enforce- 37. - (1) This section applies to any contract (whenever
ability of made) relating to inventions made by an employee, being a
contracts re- contract entered into by him -
employee's (a) with the employer, alone or with another; or
inventions. (b) with some other person at the request of the
employer or in, pursuance of the employee's contract
of employment.
(2) Any term in a contract to which this section
applies which diminishes the employee's rights -

- (a) in inventions of any description made by the employee at any time which is after the appointed day and the date of the contract; or
- (b) in patents for those inventions or applications for such inventions,

shall be unenforceable against the employee to the extent that it diminishes the employee's rights in an invention of that description so made, or in a patent for such invention or an application for any such patent.

(3) Subsection (2) shall not be construed as derogating from any duty of confidentiality owed by an employee to an employer by virtue of any rule of law or otherwise.

(4) This section applies to any arrangement made with a public officer by or on behalf of the [Crown] as his employer as it applies to any contract made between an employee and an employer [other than for the purpose of this section].

Supple-
mentary.

38. - (1) Sections 34 [to 37] shall not apply to -
- (a) an invention made before the appointed day; or
 - (b) an invention made by an employee unless at the time it was made -
 - (i) the employee was mainly employed in Jamaica; or
 - (ii) he was not mainly employed anywhere; or
 - (iii) his place of employment could not be determined, but his employer has a place of business in Jamaica to which the employee was attached, whether or not he was also attached elsewhere.

(3) In sections 34 to 37 and this section, except so far as the context otherwise requires, references to the making of an invention by an employee are references to his making it alone or jointly with any other person, but do not include references to the mere contributing of advice or assistance by the employee in the making of an invention by another employee.

(4) Any references in sections 34 to 37 to a patent and to a patent being granted are, respectively, references to a patent and to other protection and to its being granted whether under the law of Jamaica or the law in force in any other country or under any treaty or international convention.

(5) For the purposes of sections 34 and 37, the benefit derived or expected to be derived by an employer from a patent shall, where he dies before any award is made under section 35 in respect of the patent, include any benefit derived or expected to be derived from the patent, by the employee's personal representatives or by any person in whom it was vested by their assent.

(6) Where an employee dies before an award is made under section 33 in respect of a patented invention made by the employee, the personal representatives of the employee or their successors in title may exercise the right of the employee to make or proceed with an application for compensation under subsection (1) or (2) of that section.

(7) In sections 35 and 36 and this section "benefit" means benefit in money or money's worth.

[(8) The definition of "connected person" in the Income Tax Act shall apply for determining for the purposes of section 33 whether one person is connected with another as it applies for determining that question for the purposes of that Act.]

PART V. MODIFICATION OF RIGHTS

Voluntary Licences

Grant of
licence. 39. - (1) The applicant for or the owner of a patent may grant a licence to work the invention to which the application or the patent relates.

(2) If, and to the extent that a licence allows, a sub-licence may be granted under it.

(3) A licence and the sub-licence may be assigned or mortgaged and shall vest by operation of law in the same way as any other personal property, and may be vested by an assent of personal representatives.

(4) A licence has effect with regard to third parties only if it is registered under section [82], but need not be recorded for the purposes of proving use.

[(5) Where an improvement is made to a licensed patent the licensee shall be afforded a preferential right to a licence in respect of the improvement.]

Licences of Right

Offer to
license. 40. - (1) Subject to subsection (2), the Registrar may, on application made by a patentee at any time after the sealing of a patent, endorse the patent with the words "licences of right".

(2) On receipt of an application under subsection (1), the Registrar shall -

- (a) give notice to the application to any person entered on the Register as entitled to an interest in the patent;
- (b) give him an opportunity within a specified time to be heard on the matter; and
- (c) if satisfied that the patentee is not precluded by contract from granting licences under the patent,

[and that any of the grounds specified in section 45(1) apply] cause the patent to be endorsed accordingly.

(3) Where a patent is endorsed under this section -

- (a) any person shall, after the date of the endorsement, be entitled as of right to a licence under the patent upon such terms as may be agreed between the patentee and the person seeking the licence, or in default of agreement, as may be determined by the Registrar on application by either of them;
- (b) where a licence was granted under the patent before the endorsement, the Registrar may, on the application of the holder of the licence, order that the licence be exchanged for a licence to be granted by virtue of the endorsement on terms to be determined by the Registrar.

(4) Every endorsement of patents under this section shall be entered in the Register and shall be published in the **Gazette** and in such other manner as the Registrar thinks desirable for bringing the endorsement to the notice of manufacturers.

[(5) The amount determined as payable under this section in respect of a licence may be reviewed one year after the determination.]

[(6) The patentee may withdraw an offer any time prior to express acceptance of the terms of the offer by an interested party, in which event, the provisions of section 42 shall not apply.]

- Agreement by defendant to take licence. 41. If in proceedings for infringement of the patent endorsed under section 40 (otherwise than by the importation of goods) the defendant agrees to take a licence on terms to be determined by the Registrar, no injunction shall be granted against him, and the amount (if any) recoverable against him by way of damages shall not exceed double the amount which would have been payable by him as licensee if such licence had been granted before the earliest infringement.
- Reduction of renewal fees. 42. The renewal fees payable in respect of a patent after the date of endorsement under section 40 shall be [one-half] of the renewal fees which would be payable if the patent were not so endorsed.
- Request for Cancellation. 43. The patentee may request cancellation of a licence if a licensee -
- (a) does not begin [effective exploitation] within one year of the grant of the licence;
 - (b) interrupts the working of the patent for a period of more than one year; or
 - (c) fails to comply with the conditions of exploitation.

Non-Voluntary Licences

- Application for grant of non-voluntary licence. 44. At any time after the expiration of three years from the date of sealing of a patent or four years from the date of the patent, whichever is the later, any person may apply to the Registrar for the grant of a licence under the patent on one or more of the following grounds, that is to say -
- (a) where the patented invention is capable of being commercially worked in Jamaica, that it is not being so worked or is not being so worked to the fullest extent that is reasonably practicable;

- (b) where the patented invention is a product, that the demand for the product in Jamaica is not being met or not being met on reasonable terms or is being met to a substantial extent by importation;
- (c) where the patented invention is capable of being worked commercially in Jamaica, that it is being prevented or hindered from being so worked -
 - (i) in the case of a product, by the importation of the product;
 - (ii) in the case of a process, by the importation of a product obtained directly by means of the process or to which the process has been applied;
- (d) that by reason of the refusal of the owner of the patent to grant a licence or licences on reasonable terms -
 - (i) a market for the export of a patented product made in Jamaica is not being supplied; or
 - (ii) the working or efficient working in Jamaica of any other patented invention which makes a substantial contribution to the art is being prevented or hindered; or
 - (iii) the establishment or development of commercial or industrial activities in Jamaica is being unfairly prejudiced;
- (e) that by reason of conditions imposed by the owner of the patent on -
 - (i) the grant of licences under the patent;
 - (ii) the disposal or use of the patented product; or

(iii) the use of the patented process, the manufacture, use or disposal of materials or development of commercial or industrial activities in Jamaica is being unfairly prejudiced.

Guiding
principles
etc., in
considering
applications.

45. - (1) In making a determination in relation to an application under section 44, the Registrar shall be guided by the following principles -

- (a) inventions that can be worked on a commercial scale in Jamaica and should, in the public interest be so worked, should be worked without undue delay and to the fullest extent that is reasonably practicable;
- (b) the inventor or other person beneficially entitled to a patent should receive reasonable remuneration, having regard to the nature of the invention;
- (c) that the interests of any person for the time being working or developing an invention in Jamaica under the protection of a patent should not be unfairly prejudiced.

(2) Without prejudice to subsection (1) and subject to subsection (3), in determining whether to make an order [or entry] in pursuance of such an application, the Registrar shall take account of the following matters -

- (a) the nature of the invention, the time which has elapsed since the publication in the Gazette of a notice of the grant of the patent and the measures already taken by the owner of the patent or any licensee to make full use of the invention;
- (b) the ability of any person to whom a licence would be granted under the order concerned to work the invention to the public advantage; and

(c) the risks to be undertaken by that person in providing capital and in working the invention if the application for an order is granted.

(3) The Registrar is not required to take account of matters which arise subsequent to the making of the application.

Order to
grant
licence.

46. - (1) Subject to the following provisions of this section, on being satisfied in relation to an application under section 44 that any ground specified in that section is established, the Registrar [may] [shall] grant the licence to the applicant on such terms as the Registrar thinks fit.

(2) Where the application is made on the ground specified in section 44(a) and it appears to the Registrar that the time which has lapsed since the publication in the **Gazette** of a notice of the grant of the patent has for any reason been insufficient to enable the invention to be so worked, the Registrar may by order adjourn the application for such period as will, in his opinion give sufficient time for the invention to be so worked.

(3) No order shall be made under this section in respect of a patent (the patent concerned) on the ground mentioned in section 44(d)(ii), unless the Registrar is satisfied that the owner of the patent for the other inventions (the other patent) is able and willing to grant a licence under the other patent on reasonable terms to the owner of the patent concerned and his licensees.

(4) An application may be made under section 44 in respect of a patent notwithstanding that the applicant is already the holder of a licence under the patent; and no person shall be estopped or barred from alleging any of the matters specified in that section by reason of any admission made by him, whether in such a licence or otherwise, or by reason of his having accepted such a licence.

Supplementary provisions as to licences. 47. - (1) Where on an application made under section 44 in relation to a patent the Registrar is satisfied that the manufacture, use or disposal of materials not protected by the patent is unfairly prejudiced by reason of conditions imposed by the owner on -

- (a) the grant of licences under the patent;
- (b) the disposal or use of the patented product; or
- (c) the use of the patented process,

the Registrar may, subject to the provisions of that section, order the grant of licences under the patent to the applicant and such of the applicant's customers as the Registrar thinks fit.

(2) Where an application is made under section 44 by a person who holds a licence under a patent, the Registrar may cancel the existing licence and grant a new licence or may amend an existing licence.

Effect of reports on monopoly and competition issues. 48. - (1) Where a report has been laid before Parliament by the Securities Commission containing the conclusions to the effect that on a merger reference, a merger situation requiring an investigation has been created of the situation or particular elements in the situation or consequences of it specified in the report may operate or may be expected to operate against the public interest, the Minister responsible for securities may, subject to subsection (3), apply to the Registrar to take action under this section.

[(2) Where a report has been laid before Parliament by the Fair Trading Commission on a [monopoly reference, a competition reference or a] reference under the Fair Trading Act, that a person is pursuing a course of conduct [is in contravention of that Act] which [operates against the public interest], the Minister responsible for commerce may, subject to subsection (3), apply to the Registrar to take action under this section.]

(3) Before making an application under subsection (1) or (2), the Minister shall -

- (a) publish in such manner as the Minister thinks appropriate, a notice describing the nature of the proposed application; and
- (b) consider any representations which may be made within 30 days of such publication by persons whose interests appear to him to be affected.

(4) If on an application under this section it appears to the Registrar that the matters specified in the report under subsection (1) or (2) as being those which in the opinion of the relevant Commission operate or operated or may be expected to operate against the public interest include -

- (a) conditions in licences granted under a patent by its owner restricting the use of the invention by the licensee or the right of the owner to grant other licences; or
- (b) refusal by the owner of a patent to grant licences on reasonable terms,

the Registrar may by order cancel or modify any such conditions or may, instead or in addition, make an entry in the register to the effects that licences under the patent are to be available as of right.

Opposition, Appeal and Arbitration Respecting Licences

[Opposition. 49. - (1) The owner of the patent concerned or any other person wishing to oppose an application under section 44 may, in accordance with rules made under this Act, give to the Registrar notice of opposition; and the Registrar shall consider the opposition in deciding whether to grant the application.

(2) Where an appeal is brought from a -

- (a) an order made by the Registrar in pursuance of an application under section 44;
- (b) from a decision of the Registrar to make an entry in the Register in pursuance of such an application;
- (c) or from a refusal of the Registrar to make such an order or entry,

the Attorney General shall be entitled to appear and be heard.

(3) Where an application is opposed under subsection (1) and -

- (a) the parties consent; or
- (b) the proceedings require a prolonged examination of documents or any scientific or local investigation which cannot, in the opinion of the Registrar, be conveniently made before the Registrar,

the Registrar may at any time order the whole proceedings, or any question or issue of fact arising in them to be referred to an arbitrator agreed on by the parties or in default of agreement, appointed by the Registrar.

(4) Where the whole proceedings are referred pursuant to subsection (3) -

- (a) section [] of the Arbitration Act statement of cases by arbitrators) shall not apply to the arbitration unless the parties otherwise agree before the award of the arbitrator is made;

(b) an appeal shall lie from the award to the Court.

(5) Where a question or issue of fact is so referred, the arbitrator shall report his findings to the Registrar.]

Supplementary provisions as to licences. 50. - (1) In any proceedings on an application made under section 44 in respect of a patent, any statement with respect to -

(a) any activity to the patented invention; or

(a) the grant or refusal of licences under the patent, contained in a report [of the Securities Commission laid before Parliament under the Securities Act or a report] of the Fair Trading Commission under the Fair Trading Commission Act shall be *prima facie* evidence of the matters stated.

[(2) The Registrar may make an entry in the Register under section 40(4) notwithstanding any contract which would have precluded the entry on the application of the owner of the patent under subsection (2) of that section.]

(3) No order or entry shall be made in pursuant to an application under section 45 which would be at variance with any treaty or international convention to which Jamaica is a party.

[Special provisions re-patented inventions worked in a relevant country. 51. - (1) The Minister may be order provide that the Registrar may not (otherwise than for the public interest) make an order or entry in respect of a patent in pursuant to an application under section 44 if the invention concerned is being commercially worked in any relevant country to which the order relates and the demand in Jamaica for any patented product resulting from that working is being met by importation from that country.]

(2) In subsection (1) "relevant country" means a country whose law in the opinion of the Minister, makes provision or will make provision for treating the working of an invention in and importation from Jamaica in a similar way to which the order would (if made under section (1)) treat the working of an invention in and importation from, the country.

Use of Patented Invention by Crown

Use of
invention in
service of
Crown.

52. - (1) Subject to subsection (5) and to sections 53 and 56, and to the rules, but notwithstanding any other provision of this Act, any Government department or agency or any person authorized in writing by a Government department or agency (hereinafter referred to as an authorized person) may exploit for the services of the Crown, any invention -

(a) for which an application for a patent has been made under this Act; or

(b) which is a patented invention,

and anything done by virtue of this subsection shall not amount to an infringement of the patent concerned or the application for the patent.

(2) For the purposes of this section and section 55 -

(a) any use of an invention for the supply to the Government of any country outside of Jamaica of articles required for the defence of that country, shall be deemed to be a use of the invention for the services of the Crown;

(b) the power of a government department or agency or an authorized person [under this section] to sell a patented invention shall not, in the case of a patent relating to an integrated circuit, extend to sale of invention to the public.

(3) Where the Minister by order, [subject to negative resolution] makes a declaration in accordance with subsection (4) in relation to the use of any invention, such use shall for the purposes of this section and sections 54 and 55 be deemed to be a use for the services of the Crown.

(4) A declaration referred to in subsection (3) shall state the use of any invention by any person or any class of persons engaged in a particular industry is necessary or desirable to enable full benefit to be derived by the members of the public in Jamaica of any enterprise or undertaking in which the Government has a complete or almost complete monopoly.

(5) The right to use an invention conferred by this section -

- (a) is not exclusive;
- (b) shall not be assigned otherwise than in connection with the goodwill of the business in which patented invention is used; and
- (c) is, notwithstanding subsection (2)(a), limited to the supply of the invention predominantly in Jamaica by a government department or agency or an authorized person authorized under this section.

(5) The purchaser of any articles sold in the exercise of powers conferred by this section and any person claiming through the purchaser shall be entitled to deal with them in the same manner as if the patent were held on behalf of the Crown.

Rights holder 53. As soon as practicable after an invention has been
to be exploited under section 52(1), the Minister responsible for
informed the department or agency which exploited the invention shall
of use. inform the applicant or patentee of the exploitation and
give him any information relating thereto as he may from
time to time reasonably require, unless it appears to the
Minister that it would be contrary to the public interest to
do so.

Rights of 54. - (1) Subsection (2) shall apply in respect of any
third patented invention or an invention in respect of which an
parties in application is pending, that is used for the services of the
respect of Crown in the manner specified in subsection (3).

Crown. (2) In relation to an invention referred to in
subsection (1), the provisions of any licence, assignment or
agreement made, whether before or after the commencement of
this Act, between the patentee or applicant for the patent
or any person who derives title from whom he derives title
and any person, other than a government department or
agency, shall be of no effect to the extent that those
provisions -

- (a) restrict or regulate the use of the invention, or
any model, document or information relating thereto;
or
- (b) provide for the making of payments in respect of any
such use, or calculated by reference thereto,
and the reproduction or publication of any model or document
connection with such use shall not be [deemed] to be an
infringement of any copyright substituting in the model or
document.

(3) For the purposes of this section an invention is used for the services of the Crown if it is used by -

- (a) a Government department or agency or an authorized person;
- (b) a patentee or an applicant for a patent by order of a Government department or agency.

Reference of
department
disputes re-
Crown use.

55. - (1) Any dispute as to -
(a) the exercise by a government or agency or a person authorized by either of them of the powers conferred by section 53; or as
(b) the terms for the use of an invention for the services of the Crown under that section,
maybe referred to the Court by either party to the dispute in such manner as may be prescribed by rules of Court.

(2) In any proceedings under this section to which a Government department or agency is a party, the department or agency may -

- (a) if the patentee is a party to the proceedings, apply for revocation of the patent upon any ground which a patent may be revoked under section 61;
- (b) in any case, put in issue the validity of the patent without applying for its revocation.

(3) In determining any dispute referred to it under this section, the Court shall have regard to -

- (a) any benefit or compensation that the patentee may have received or may be entitled to receive, directly or indirectly from any Government department or agency or an authorized person in respect of the invention in question; and
- (b) the need to ensure that the patentee shall receive reasonable remuneration having regard to the nature of the patented invention.

(4) In any proceedings under this section, the Court may at any time order the whole proceedings or any question or issue of fact arising in the proceedings to be referred to a special or official referee or an arbitrator, on such terms as the Court may direct, and references to the Court in the foregoing provisions of this section shall be construed accordingly.

Patentee's right to compensation. 56. - (1) Where an invention is exploited for the services of the Crown under section 49, the Government department or agency concerned shall pay -

(a) to the owner of the patent; or

(b) if there is an exclusive licence in force in respect of the patent, to the exclusive licensee,

such compensation as may agreed or determined by an agreed method or, in the absence of agreement, as may be determined by a reference to the Court under section 52, on the application of either party.

(2) For the purposes of subsection (1) -

(a) the terms or the method may be agreed before, during or after the exploitation;

(b) any amount payable by virtue of that subsection is in addition to any amount payable under section 49 or 52.

(3) When fixing the terms, the Court may take into account any compensation that a person having an interest in the invention or the patent has received directly or indirectly for the invention from the department or agency concerned.

[(4) In this section the "Government department [or agency concerned" means, in relation to any use of the invention for the service of the Crown, the Government department or agency by whom or on whose authority the patent was exploited.

Cessation of use by order of Court. 57. - (1) The Court may, on the application of the patentee or other interested person declare that the exploitation of the invention by the Crown is not or is no longer necessary [for the proper provision of services] if the Court is satisfied that, in all circumstances of the case, it is fair and reasonable to make the declaration.

(2) The Court may, also order that the Government department or agency concerned should cease to exploit the invention -

(a) on and after a date specified in the order; and

(b) subject to any conditions specified in the order.

(3) In making an order under this section, the Court shall ensure that the legitimate interests of the Crown are not adversely affected by the order.

Acquisitions and Assignments

Acquisition of patent etc., by Crown. 58. - (1) The Minister may by order direct that a patent or invention that is the subject of a patent application be acquired by the Crown.

(2) An order made under subsection (1) shall be subject to the negative resolution and shall contain such supplemental and ancillary matters as the Minister considers necessary or desirable to give full effect to its provisions.

(3) When an order is made under subsection (1), all rights in respect of the patent or the invention are, by virtue of this subsection, transferred to and vested in the Crown.

(4) Notice of the acquisition shall be given to the patentee or applicant and shall be published in the *Gazette* [unless, in the case of the acquisition of an invention that is the subject of an application for a patent or a prohibition order, or an order under section [] is in force in respect of the application].

(5) The Crown shall pay to [the patentee, applicant or, as the case may be, any person entitled to compensation in respect of the acquisition], such compensation as is agreed between the Crown and that person or, in the absence of agreement, as is determined by the Court on an application made by either of them.

Assignment by inventor. 59. - (1) An inventor or the successor in title of an inventor may assign the invention and any patent granted or to be granted for the invention.

(2) The assignment and all covenants and agreements in the assignment are valid and effectual, even if valuable consideration has not been given for the assignment, and may be enforced by proceedings in the name of the Minister.

PART VI. INDUSTRIAL DESIGNS

Meaning of "industrial design". 60. For the purposes of this Act, an industrial design is any composition of lines and colours or any three-dimensional form, whether or not associated with lines or colours, which -

- (a) gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product;
- (b) does not serve solely to obtain a technical or functional result and leaves no freedom as regards arbitrary features of appearance.

- Registrable industrial design.
61. - (1) An industrial design is registrable if it is original and not contrary to public order or morality.
- (2) For the purposes of this Act, an industrial design is original if it is not commonplace in the design field in question at the [time of its creation] [filing date (where applicable) or the priority date of the application for registration].
- (3) Account shall not be taken of a disclosure earlier than the applicable date referred to in subsection (2) if such disclosure did not occur earlier than [six] months immediately prior to such date and was due to or made in consequence of -
- (a) the matter having been obtained unlawfully or in breach of confidence by any person from the inventor or from any other person to whom the matter was available in confidence by the inventor;
 - (b) a breach of confidence by any person who obtained the matter in confidence from the inventor or from any other person to whom it was made available, or who obtained it, from the inventor; or
 - (c) the inventor having displayed the invention at an international exhibition, and the applicant states, on filing the application, that the invention has been so displayed and files, within the prescribed period, written evidence in support of the statement complying with any prescribed conditions.
- Who may apply.
62. - (1) An application for the registration of and industrial design may be made by -
- (a) any person claiming to be the creator of the industrial design;

(b) any person who is an assignee of the creator of the design,
and in either case may be made by that person alone or jointly with any other person.

(2) An application may be made under subsection (1) by the personal representative or the assignee of the personal representative of any deceased person who, immediately before his death, was entitled to make an application.

Application for registration of industrial design. 63. - (1) An application for the registration of an industrial design shall be filed with the Registrar in accordance with this section and such procedures as to form and manner as may be prescribed.

(2) Every application shall contain -

- (a) a request for the registration of the design;
- (b) drawings, photographs or other adequate graphic representation of the article or articles embodying the design;
- (c) an indication of the kind of products for which the industrial design is to be used,

and where the design is two dimensional or three-dimensional, the application may be accompanied by a specimen of the article embodying the industrial design.

(3) An application may also contain a request that upon registration, the publication of the industrial design be deferred for a period not exceeding twelve months from the date of filing, or, where priority is claimed, from the date of priority.

(4) Two or more industrial designs which relate to the same class of the international classification or to the same set or composition of articles may be the subject of the same application.

Withdrawal
of applica-
tion for
industrial
design.

64. A pending application may be withdrawn at any time before its is determined.

Right of
priority for
industrial
design.

65. - (1) The provisions of subsections (1), (2), (3) and (4) of section 11 (which relate to dates of priority) shall, subject to the modifications outlined in the other provisions of this section, *mutatis mutandis* apply to applications under this Part.

(2) Section 11(4)(a) shall apply to industrial designs as if the words "six months" were substituted for the words "twelve months".

Filing
date of
industrial
design.

66. - (1) Subject to the provisions of this section the filing date of an application for the registration of an industrial design shall be the [earliest] date on which an application is submitted to the Registrar containing -

(a) [documents] [an indication] identifying the applicant;

(b) adequate graphic representation of the article [or articles] embodying the design.

(2) If the Registrar is not satisfied that the conditions specified in subsection (1) have been fulfilled, the Registrar shall invite the applicant to make the necessary corrections within the prescribed period and if the corrections are not so made, the application shall be treated as if it had not been filed.

Examination
of appli-
cation.

67. - (1) After assigning filing date the Registrar shall examine whether the application satisfies the requirements of sections 60, 61 and 63 and any related regulations.

(2) Where the Registrar is satisfied that the requirements referred to in subsection (1) have been fulfilled, he shall forthwith publish the application in the prescribed manner.

Opposition
to appli-
cation.

68. - (1) Any interested person may, within the prescribed period and in the prescribed manner, give to the Registrar notice of opposition to the registration of the industrial design on grounds that -

- (a) one or more of the requirements of sections [61] and [63] and regulations pertaining thereto are not fulfilled; or
- (b) the applicant does not have a right to the registration of the industrial design.

(2) The Registrar shall forthwith send a copy of the notice to the applicant who shall, within the prescribed period and in the prescribed manner, send to the Registrar a counter-statement of the grounds on which he relies for his application; if he does not do so, he shall be deemed to have abandoned the application.

(3) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties (, if either or both so desired) and considering the merits of the case, shall decide whether the industrial design should be registered.

(4) After an application is published and until the registration of the industrial design, the applicant has the same privileges and rights as he would have if the industrial design had been registered, so, however, that it shall be a valid defence to an action brought hereunder in respect of an act done after the publication of the application, if the defendant establishes that the industrial design could not validly have been registered at the time the act was done.

(5) Where the Registrar finds that the conditions referred to in subsection (2) are fulfilled, and the registration of the industrial design -

(a) has not been opposed within the prescribed time limit; or

(b) has been opposed and the opposition has been decided in the applicant's favor,

the Registrar shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design.

Duration of
Registra-
tion; re-
newal fees.

69. - (1) Subject to the provisions of this Act, the initial registration of an industrial design shall be in force for a period of five years from the filling date.

(2) The registration of an industrial design for a similar period may, upon payment of the prescribed fee within the prescribed time, be renewed on two consecutive occasions.

Meaning of
``designer''.

70. - (1) In this Part the ``designer'', in relation to a design, means the person who creates it.

(2) In the case of a computer-generated design the person by whom the arrangements necessary for the creation of the design are undertaken shall be taken to be the designer.

Ownership of design right. 71. - (1) The designer is the first owner of any design right in a design which is not created in pursuance of a commission or in the course of employment.

(2) Where a design is created in pursuance of a commission, the person commissioning the design is the first owner of any design right in it.

(3) Where, in a case not falling within subsection (2) a design is created by an employee in the course of his employment, his employer is the first owner of any design right in the design.

Rights conferred by registration of industrial design. 72. - (1) Subject to the provisions of [], the registration of an industrial design gives the owner the exclusive right during the term of such registration to exploit and to authorize the exploitation of the registered industrial design.

(2) The registered owner of an industrial design may, subject to the provision of subsection (3), bring proceedings in respect of any act done without his consent which constitutes the exploitation of the design or which makes it likely that such exploitation will occur, and without affecting any other jurisdiction of the Court, may make the same claims *mutatis mutandis* as those applicable under section [78] in relation to an infringement of patent.

(3) The rights conferred by the registration of an industrial design shall not extend to an act in respect of an article which has been put on the market [any where in the world] by the owner of the registered industrial design or with his consent.

(4) In this Act "exploitation" in relation to a registered industrial design means the making, selling, or importation of articles incorporating the design.

Revocation of registration of design. 73. - (1) Subject to the provisions of this Act, the registration for an industrial design may, on the application of any interested person be revoked by the Court on the ground that -

- (a) the requirements of section 61 [and 63] have not been met; or
- (c) the registered owner is neither the creator of the industrial design nor the successor-in-title of the creator.

PART VI - REVOCATION AND SURRENDER OF PATENTS

Revocation

Grounds for revocation by Court. 74. - (1) Subject to the provisions of this Act, a patent may, on the application of any person interested, be revoked by the Court on any of the following grounds -

- (a) the invention, so far as claimed in any claim of the specification, was claimed in a valid claim having an earlier priority date contained in the specification of another patent granted in Jamaica;
- (b) the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) the patent was obtained in contravention of the rights of the person who makes the application to the Court or of any person under or through whom he claims;
- (d) the invention was not patentable by virtue of section 3;
- (e) that the invention, so far as claimed, is not new, having regard to what was known or used before the priority date of the application in Jamaica or the filing date;

- (f) the invention, so far as claimed in the specification, is obvious and does not involve an inventive step having regard to what was known or used before the priority date of the application in Jamaica;
 - (g) the specification does not describe the invention in a manner which is clear and complete enough for it to be performed by a person skilled in the art;
 - (h) the scope of any claim of the specification is not sufficiently and clearly defined or is not [fairly] based on the matter disclosed in the specification;
 - (i) the invention, so far claimed in any claim of the specification, was secretly used in Jamaica, otherwise than as mentioned in subsection (2), before the priority date;
 - (j) the patent was granted on a false suggestion or representation;
 - (k) the patent was granted contrary to law.
- (2) For the purpose of -
- (a) subsection (1)(i), no account shall be taken of any use of the invention -
 - (i) for the purpose of reasonable trial or experiment only; or
 - (ii) by a government department or agency or any person authorized in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to a Government department or agency or authorized person; or

(iii) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence or of any person from whom he derives title; and

(b) subsection (1)(e) or (f), no account shall be taken of any secret use.

(3) Without prejudice to the provisions of subsection (1), a patent may be revoked by the Court -

(a) on the application of a Government department or agency, if the Court is satisfied that the patentee has, without reasonable cause, failed to comply with a request of a department or agency to make, use of work the patented invention for the services of the Crown upon reasonable terms; or

(b) on application, with the written consent of the Attorney-General, of any person not otherwise entitled to apply under this section.

(4) Every ground on which a patent may be revoked shall be available as a ground of defence in any proceeding for the infringement of the patent under PART VI.

[Revocation by Registrar. 75. - (1) At any time within twelve months after the grant of a patent, any interested person who did not oppose the grant of the patent may, subject to subsection (2), apply to the Registrar for an order revoking the patent on anyone or more of the grounds upon which the grant of the patent could have been opposed.

(2) Where an action for infringement or proceedings for the revocation of a patent are pending in any Court, an application under subsection (1) shall not be made except with the leave of the Court.

(3) Where an application is made under this section, the Registrar shall notify the patentee within the prescribed period after the application and shall give the patentee an opportunity to be heard before deciding the case.

(4) If, on an application under this section the Registrar is satisfied that any of the grounds referred to in this subsection (1) are established, the Registrar may, subject to subsection (5), by order direct that the patent be revoked unconditionally, as from a date specified in the order, unless within such period as the Registrar may so specify, the specification amended to the Registrar's satisfaction.

(5) The Registrar shall not make an order for the unconditional revocation of a patent under subsection (4) unless the circumstances are such as would have justified his refusing to grant the patent in proceedings under section [] (opposition proceedings).

[(6) An appeal to the Court shall lie from any decision of the Registrar under this section.]]

Surrender of Patent

Procedure for 76. - (1) A patentee may at any time by notice in writing
surrender. to the Registrar, offer to surrender a patent.

(2) On receipt of the offer under subsection (1), the Registrar shall advertise in the prescribed manner, the fact that the offer has been received, indicating the prescribed period within which notice of opposition to the surrender may be sent to the Registrar.

(3) Any person interested may, within the prescribed time, give notice of opposition to the surrender, to the Registrar who shall, notify the patentee accordingly.

(4) After hearing the patentee and any opponent, (if desirous of being heard) the Registrar may accept the offer and [by order revoke the patent], if he is satisfied that the patent may properly be surrendered.

(5) An appeal to the Court shall lie from any decision of the Registrar under this section.

Record of
revocation
or surrender.

77. The Registrar shall enter particulars of any revocation or surrender under this Part in the Register.

PART VII - INFRINGEMENT OF PATENT

Infringing Acts

Acts consti-
tuting
infringement.

78. - (1) Subject to [subsection (2) and] section 79, a patent for an invention is infringed by a person who, while the patent is in force and without the consent of the [owner of the patent,] does in Jamaica any of the following acts in relation to the invention, that is to say -

(a) where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;

(c) whether the invention is a process -

(i) he uses the process or offers it for use in Jamaica when he knows, or it is obvious to a reasonable person in the circumstances, that such use without the consent of the owner would be an infringement of the patent;

(ii) he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

(2) Subject to subsection (3) and section 79, a patent is also infringed by a person who, while the patent is in force and without the consent of the owner of the patent, supplies or offers to supply in Jamaica a person, other than a licensee or other person entitled to work the invention, with any of the means, relating to an essential element of the invention for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting and are intended to put the invention into effect in Jamaica.

(3) Subsection (2) shall not apply to the supply or offer of a [staple commercial product] unless the supply or the offer is made for the purpose of inducing the person supplied or, as the case may be, the person to whom the offer is made, to do an act which constitutes an infringement of the patent by virtue of subsection (1).

Exception to 79. - (1) An act which would, apart from this section, infringement. constitute an infringement of a patent shall not do so if that act -

- (a) is done privately and for purposes which are not commercial;
- (b) is done for experimental purposes relating to the subject matter of the invention;
- (c) consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical or registered dental practitioner or consists of dealing with a medicine so prepared;

- (d) consists of the use, exclusively for the needs of a relevant ship of a product or process in the body of such a ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship temporarily or accidentally entered the internal or territorial waters of Jamaica;
- (e) consists of the use of a product or process in the body or operation of a relevant aircraft or vessel which has temporarily or accidentally entered or is crossing Jamaica (including the air space above it and its territorial waters) or the use of accessories for such a relevant aircraft or vessel;
- (f) consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing Jamaica as mentioned in paragraph (e), or of the importation into Jamaica or the use or storage thereof any part or accessory for such an aircraft.

(2) For the purposes of section 78(2), the fact that an act done by a person is, by virtue of subsection (1) (a), (b) or (c) prevented constituting an infringement, does not entitle the person to work the invention.

(3) In this section -

"registered dental practitioner" means a dental practitioner registered under the Dental Act;

"registered medical practitioner" means a medical practitioner registered under the Medical Act;

"relevant ship" and "relevant aircraft or vessel" mean, respectively, a ship and an aircraft or vessel registered in or belonging to any country other than Jamaica which is party to the Paris Convention.

Infringement Proceedings

Power to institute proceedings. 80. - (1) Subject to the following provisions of this section and to section 83, the patentee may bring proceedings in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court,) may apply for -

- (a) an injunction restraining the defendant from any acts of infringement;
- (b) damages in respect of the infringement;
- (c) an account of profits derived from the infringement;
- (d) an order for the delivery up or destruction of any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;
- (e) a declaration that the patent is valid and has been infringed by the defendant.

(2) The Court shall not, in respect of the same infringement, award the owner of the patent damages and accounts of profits.

(3) The question whether a person has infringed a patent may be referred to the Registrar if the patentee and the person agree to the reference, and the owner may in that reference, make any claim mentioned in subsection (1)(b) or (e).

(4) If it appears to the Registrar on a reference under subsection (3) that the question referred would more properly be determined by the Court, the Registrar may decline to deal with it and the Court shall have jurisdiction to determine the question as if the reference were proceedings brought in the Court.

(5) Except where the context otherwise requires, any reference in the following provisions of this Act -

- (a) to proceedings for infringement and the bringing of such proceedings, includes a reference to a reference under subsection (3);
- (b) to a plaintiff, includes a reference to the owner of the patent; and
- (c) to a defendant, includes a reference to any other party to the reference.

Restrictions
on damages
etc., for
infringe-
ment.

81. - (1) Subject to the following provisions of this section, in proceedings for infringement of a patent -

- (a) damages shall not be awarded; and
- (b) an order for an account of profits shall not be made,

against a defendant who proves that at the date of the infringement, he was not aware and had no reasonable grounds for believing that the patent existed.

(2) For the purposes of subsection (1), a person shall not be taken to have been so aware or to have had reasonable grounds for so believing by reason only of the application to the product of the word "patent" or "patented", or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

(3) In proceedings for infringement of a patent the Court or the Registrar may refuse to award any damages or make any order for an account of profits in respect of an infringement committed during any further period specified under section 27(2), but before the payment of the renewal fee and any additional fee prescribed for the purposes of that subsection.

(4) Where an amendment of the specification of a patent has been allowed under any provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment, unless the Court or the Registrar is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

Infringe-
ment of
partially
valid
patent.

82. - (1) If, in proceedings for infringement of a patent, the validity of a patent is put in issue and it is found that the patent is only partially valid, the Court or the Registrar may, subject to subsection (2), grant relief in respect of the infringement of that part of the patent that is found to be valid.

(2) No relief shall be granted under subsection (1) by way of damages, costs or expenses, unless the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event, the Court or the Registrar may grant relief in respect of that part of the patent which is valid, subject to the discretion of the Court or the Registrar as to costs or expenses and as to the date from which damages should be reckoned.

Use begun
before
priority
date or
filing
date.

83. - (1) Where a patent is granted for an invention, a person who in Jamaica before the [filing date, or as the case may require,] priority date of the invention -

- (a) does in good faith an act which would constitute infringement of the patent if it were in force; or
- (b) makes in good faith effective and serious preparation to do such an act,

has the right to continue to do the act or, as the case may be, to do the act, notwithstanding the grant of the patent; but the right does not extend to granting a licence to another person to do the act.

(2) If the act was done or the preparations were made in the course of a business, the person entitled to the right conferred by subsection (1) may -

- (a) authorize the doing of that act by any of his partners for the time being in that business; and
- (b) assign that right or transmit it on death (or, in the case of the body corporate, on its dissolution), to any person who acquires that part of the business in the course of which the act was done or the preparations were made.

(3) Where a product is disposed of to another person in exercise of the rights conferred by subsection (1) or (2), that other person and any person claiming through him, may deal with the product in the same way as if it had been disposed of by the registered owner of the patent.

Infringement 84. - (1) Section 78 shall apply in respect of a patent
proceedings having two or more joint owners, as if the reference in that
by co-owner. section to the owner of the patent were -

- (a) in relation to any act, a reference to that owner or those owners who, by virtue of section 32 or any agreement referred to in that section, is or are entitled to do that act without it amounting to an infringement; and
- (b) in relation to any consent, a reference to that owner or those owners who, by virtue of section 32 or such agreement, is or are the proper person or persons to give the requisite consent.

(2) Subject to the subsection (3), one of two or more joint owners of a patent may, without the concurrence of the others, bring proceedings in respect of an alleged infringement.

(3) An owner if made a defendant in infringement proceedings shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Infringement 85. - (1) Subject to the provisions of this section, the
proceedings holder of an exclusive licence under a patent shall have the
by exclusive same right as the owner of the patent to bring proceedings
licensee. in respect of an infringement of the patent committed after
the date of the licence; and references to the owner of the
patent in the provisions of this Act relating to infringement
shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings, the Court [or the Registrar] shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee in his capacity as such, as a result of the infringement, so far as it constitutes an infringement of the right of the exclusive licensee in his capacity as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section, the owner of the patent shall be made a party to the proceedings, but if he is made a defendant, he shall not be liable for any costs or expenses unless he enters an appearance and take part in the proceedings.

Unregistered 86. - (1) Where in relation to a transaction, instrument or
transaction, even by which rights in a patent are assigned, mortgaged,
etc., in licensed or transferred by order of the Court, a person
infringement becomes the owner or one of the owners or an exclusive
proceedings. licensee of a patent and the patent is subsequently in-
fringed, the Court [or the Registrar] shall not award him
damages or an order that he be given an account of the
profits in respect of an infringement occurring before the
transaction, instrument or event is registered unless -

- (a) the transaction, instrument or event is registered within the period of six months beginning with the date of registration; or
 - (b) the Court [or the Registrar] is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period
- and that it was registered as soon as practicable thereafter.

Infringement of rights after publication of patent application. 87. - (1) Subject to [subsection (3) and (4)], an applicant for a patent for an invention has, from the date of the publication of the date of the grant of the patent, the same right as he would have had if the patent had been granted on the date of publication of the application, to bring proceedings in the Court [or before the Registrar] for damages in respect of any act which would have infringed the patent.

(2) Subject to subsection [(3) and (4)] -

- (a) references in section 78 to 81 and 84 to 86 to a patent and the owner of a patent, shall be construed, respectively, as including references to any application for a patent and the applicant; and
- (b) references to a patent being in force, being granted, being valid or existing shall be construed accordingly.

(3) The applicant shall be entitled to bring proceedings by virtue of this section in respect of any act only -

- (a) after the patent has been granted; and

- (b) if, the act would, if the patent had been granted on the date of the publication of the application, have infringed the patent and claims in the form in which they were contained in the application immediately before the preparations for its publication were made by the Office.

Certificate
of validity.

88. - (1) Where the validity of a patent is contested in infringement proceedings and the Court or Registrar finds the patent to be wholly or partially valid, the Court or Registrar may certify the finding and the fact that the patent was so contested.

(2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the Court or the Registrar for infringement of the patent concerned or for revocation of the patent, a final order or judgement is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the Court or Registrar otherwise directs, be entitled to his costs or expenses as between the attorney-at-law and own client (other than costs or expenses of any appeal in any such proceedings).

[PART VIII. PATENT ATTORNEYS

Registration, Rights and Privileges

Registration
of patent
attorneys.

89. - (1) There shall be kept at the Office, a Register of Patent Attorneys.

(2) A person who -

- (a) is domiciled or habitually resident in Jamaica;
- (b) is at least [21] years of age; and
- (c) has the prescribed qualifications,

may, on application to the Registrar in the prescribed manner and upon payment of the prescribed fee, be registered as a patent attorney for the purposes of this Act.

(3) A person who is not registered under this section is not authorized to carry on business as a patent attorney.

Privileges.

90. - (1) A patent attorney is authorized to prepare all documents, transact all business and conduct all proceedings for the purposes of this Act and to enjoy such other rights and privileges as may be prescribed.

(2) Any communication between a patent attorney and his client and any record or document made for the purposes of such a communication are privileged to the same extent as a communication between an attorney-at-law and his client.

(3) Nothing in this section shall be construed as authorizing a patent attorney to prepare a document to be issued from or filed in a court or to transact business or conduct proceedings in a court.

Removal

from

register.

91. The name of a patent attorney may be removed from the Register of Patent Attorneys in the prescribed manner and on the prescribed grounds.

Offences

by unregis-
tered per-
sons etc.

92. - (1) A person commits an offence if he -

(a) carries on business, practises or acts as a patent attorney without being a registered patent attorney [or an attorney-at-law];

(b) describes himself or holds himself to be described or held out as a patent attorney or agent for obtaining patents, without being a patent attorney.

(2) Members of a partnership shall not -

(a) carry on business, practise or act as patent attorneys unless each member is a registered patent attorney [or an attorney-at-law]; or

(b) describe themselves or hold themselves out or permit themselves to be so described or held out, as patent attorneys or agents for obtaining patents, unless each member is a registered patent attorney.

(3) A body corporate shall not carry on business, practise, act or describe itself or hold itself out as a patent attorney or agent for obtaining patents.

(4) Subsections (1)(a), (2) and (3) shall not apply to the personal representative of a deceased patent attorney who -

- (a) carries on the patent attorney's business for not more than three years after the patent attorney's death or for any further period (if any) allowed by the Court; and
- (b) is himself a registered patent attorney or employs a registered patent attorney to manage the business on his behalf.

(5) For the purposes of this section, [an individual] [a person] is deemed to carry on business as a patent attorney if he undertakes in Jamaica for gain -

- (a) to apply for or obtain patents in Jamaica or anywhere else;
- (b) to prepare specifications or other documents for the purposes of this Act or the patent law of another country; or
- (c) to give advice (other than advice of a scientific or technical nature) about the validity or infringement of patents.

(6) A person who commits an offence under this section is liable on summary conviction before a Resident Magistrate -

- (a) in the case of an offence committed under subsection (1) or (2), to a fine not exceeding [] dollars; and
- (b) in the case of an offence under subsection (3), to a fine not exceeding [] dollars.

Documents 93. A attorney-at-law shall not prepare a specification or
prepared by a document relating to an amendment of a specification
legal prac- unless -
titioner. (a) he is acting under the instructions of a registered
patent attorney; or
(b) the amendment has been directed by an order of the
Court under this Act.]

PART [IX]. UTILITY MODEL CERTIFICATES

Applicability 94. - (1) Subject to section 17, the provisions of [PART
of provisions III] shall apply, *mutatis mutandis*, to utility model
patents. certificates relating to or applications therefor, as the
case may be.

(2) Where the right to a patent conflicts with the
right to a utility model certificate in the case referred to
in section 3(3), that provision shall apply as if the word
"patent" were replaced by the words "patent or utility model
certificate".

Special pro- 95. - (1) An invention qualifies for a utility model
visions re- certificate if it is new and industrially applicable.

lating to (2) Section 3(1) and 6 shall not apply in the
utility case of inventions for which utility model certificates are
model requested.

certificates. [(3) Section 24 shall not apply in the case of
applications for utility model certificates.]

(4) A utility model certificate shall expire, without
any possibility of renewal, at the end of the seventh year
after the date of the filing of the application.

(5) In proceedings under section 74, the court may
revoke the utility model certificate on the following
grounds -

- (a) that the claimed invention did not qualify for a utility model certificate, having regard to subsection (1) and to sections 4(2)(a), 5 and 7;
- (b) that any description and the claims do not comply with the requirements prescribed by section 9(5) and (6) and the regulations pertaining thereto;
- (c) that any drawing which is necessary for the understanding of the invention has not been furnished;
- (d) that the owner of the utility model certificate is not the inventor or his successor in title.

(6) Section [13(2)] shall not apply in the case of utility model certificates.

Conversion of patent applications or applications for utility model certificates.

96. - (1) At any time before the grant or refusal of a patent, an applicant may, upon payment of of the prescribed fee, convert his application into an application for a utility model certificate, which shall be accorded the filing date of the initial application.

(2) At any time before the grant or refusal of a utility model certificate, the applicant concerned may, upon payment of the prescribed fee, convert his application into a patent application, which shall be accorded the filing date of the initial application.

(3) An application may not be converted under subsection (1) or (2), as the case may be, more than once.

Register of Patents

Provisions as to location and form of register.

97. - (1) A Register of Patents and Designs is to be kept at the Office in the prescribed form.

(2) The Register may be kept wholly or partly in electronic form [,and where it is so kept -

- (a) references in this Act to an entry in the register, are to be construed as including references to a record of particulars kept in electronic form and comprising the Register or part of the Register;

- (b) references in this Act to particulars being registered or entered in the register, are to be construed as including references to the keeping of a record of those particulars as part of the Register in electronic form; and
- (c) references in this Act to the rectification of the Register are to be construed as including references to the rectification of the record of particulars kept in electronic form and comprising the Register or part of the Register.]

Particulars to be registered. 98. - (1) There shall be entered in the register particulars relating to patents in force and registered industrial designs , including such particulars as to -

- (a) assignments and transmissions of patents and designs;
- (b) licences under patents and designs;
- (c) notice of all matters which are required under this Act to be entered in the Register;
- (d) such other particulars affecting the validity or ownership of patents and registered industrial design as the Registrar thinks fit;
- (e) any other prescribed particulars relating to patents or industrial designs.

(2) All documents filed in connection with the registration of particulars shall be available for inspection under section 100.

Register as evidence. 99. - (1) The Register shall be *prima facie* evidence of any matters required or authorized by or under this Act to be entered in it.

(2) If the Register is wholly or partly kept in electronic form, document signed by the registrar reproducing in writing all or any of the particulars comprising the Register, or that of it, is admissible in any proceedings as evidence of those particulars.

Trusts not 100. Notwithstanding anything in section 98, notice of registrable. any trusts, whether expressed, implied or constructive relating to a patent or licence is receivable by the Registrar and shall not be registered.

Registration 101. - (1) Where a person becomes entitled -
of assign- (a) by assignment, transmission or operation of law to a
ment, etc. patent or registered industrial design or to a
share; or
(c) as mortgagee, licensee or otherwise to any other
interest in a patent or registered industrial
design,

he shall apply to the Registrar in the prescribed manner for the registration of his title as owner or as joint owner, or as the case may be, or of notice of his interest in the Register.

(2) Without prejudice to the provisions of subsection (1) an application for registration of the title of any person derived in a manner specified in subsection (1) may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section, the Registrar shall, on proof of title to the Registrar's satisfaction -

- (a) where the person is entitled to a patent or design or a share in a patent or design, register that person in the Register as owner or joint owner of the patent or design, indicating the instrument or event by which the person derives title; or
- (b) where that person is entitled to any other interest in the patent or design, enter in the Register and on any [patent] produced to the Registrar, notice of that interest.

(3) Subject to -

- (a) provisions of this Act relating to joint ownership of patents or designs, as the case may be; and
- (b) any rights vested in any other person of which notice is entered in the Register,

the person or persons registered as grantee or owner of a patent or design shall have power to assign, grant licences under or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence or dealing, so, however, that any equities in respect of the patent or design may be enforced in like manner as in respect of any personal property.

(5) Rules may require the supply to the Registrar for filing of copies of such deeds, licences and documents as may be prescribed, in connection with any application under this section.

Inspection by public. 102. - (1) Subject to the following provision of this section, the Register shall be available for inspection by the public at the Office during the hours that it is normally open for business.

(2) Where a record of particulars is kept in electronic form, subsection (1) is complied with to the extent that the Register consists of those particulars, by giving the public access to a computer terminal which can be used to inspect the particulars either on a screen or in the form of a computer printout.

(3) Except with the approval of the applicant, an application for a patent or a document filed in connection with the application shall not be open to public inspection before the confidentiality period of eighteen months has expired.

(4) The confidentiality period begins -

- (a) on the date of filing of the application; or
- (b) where a request for priority has been made in respect of the application, on the earliest date of filing of any previously [regularly] filed application on which the request is based.

(5) Where a request for priority is withdrawn on or before the prescribed date, then, for the purposes of subsection (3) and to the extent that it is withdrawn, it shall be considered never to have been made.

(6) An application shall not be open to public inspection if it is withdrawn in accordance with the rules on or before the prescribed date.

(7) For the purposes of subsection (5) and (6), the prescribed date shall be a date no later than the date on which the confidentiality period expires.

Rectifica-
tion of
Register.

103. A person aggrieved by -

- (a) the omission of an entry from the Register; or
- (b) an entry made in the Register without sufficient cause; or

- (d) an entry wrongly existing in the Register; or
 - (e) an error or defect in an entry in the Register,
- may apply to the Court for a rectification of the Register.

Supplemental

Information 104. The Registrar may give any person information about -
Registrar (a) a patent or design; or
may give. (b) an application for a patent or for the registration
 of an industrial design, that is open to public
 inspection;
 (c) any prescribed document or matter.

Admissi- 105. A document in respect of which particulars have not
bility of been entered in the Register is not admissible in any
unregistered proceedings in proof of the title of a patent or to an
particulars. interest in a patent unless -
 (a) the Court or the Registrar before which the
 proceedings are brought otherwise directs; or
 (b) the proceedings are for an order for rectification
 of the register under section 88 or to enforce
 equities in relation to a patent or licence.

Protection of Employees - additional powers

Immunity. 106. The Registrar or officers employed to the Office -
 (a) shall not be taken to warrant the validity of any
 patent granted industrial or design registered under
 this Act or any treaty or international convention
 to which Jamaica is a party; or
 (b) shall incur no liability by reason of or in
 connection with any examination or investigation
 required or authorized by this Act or any such
 treaty or convention or any report or other
 proceedings consequent on any such examination.

- Clerical errors. 107. - (1) The Registrar may, subject to any of rules correct any errors of translation, transcription, clerical error or mistake in -
- (a) any specification of a patent or application for a patent or for the registration of an industrial design; or
 - (b) any document filed in connection with a patent or design or such application.
- (2) Where the registrar is requested to correct such an error or mistake, any person may, in accordance with rules give the Registrar notice of opposition to the request, and the Registrar shall determine the matter.
- Destroyed or lost patent. 108. If any patent or certificate of registration of an industrial design is destroyed or lost, the Registrar may issue a certified copy in lieu of the original on payment of the prescribed fee.
- Annual report. 109. - (1) Before the 31st of March in every year, the [Registrar] shall cause to be laid on [both Houses of Parliament] a report with respect to the operation of this Act and the discharge of the Registrar's functions under the Patent Co-operation Treaty or any other relevant international treaty or arrangement, and every such report shall include an account of all fees, salaries and allowances and other money received and paid to the Registrar under this Act and the treaty during the previous year.
- (2) In this section " relevant treaty or arrangement" means a treaty or arrangement relating to patents or industrial designs to which Jamaica is a party and which relates directly to the functions of the office.

PART X - MISCELLANEOUS AND GENERAL

Offences

Falsifica-
tion of
Register.

110. Any person who -

- (a) makes or causes to be made, a false entry in any Register under this Act or a writing falsely purporting to be a copy of an entry in any such Register; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false,

commits an offence and shall be liable on conviction before a Resident Magistrate to a fine not exceeding [dollars] or to imprisonment for a term not exceeding [years] or to both such fine and imprisonment, or on conviction on indictment to imprisonment for a term not exceeding [years].

False
claim as
to patent
rights.

111. - (1) a person who falsely represents -

- (a) that he or another person is the patentee of an invention or the owner of a registered industrial design; or
- (b) that he or another person has applied for a patent for an invention the registration of an industrial design,

commits an offence and shall be liable on summary conviction to a fine not exceeding [dollars].

(2) A person who falsely represents that an article sold by him is patented or incorporates an industrial design registered in Jamaica or is the subject of an application for a patent or the registration of an industrial design in Jamaica, commits an offence and shall be liable on summary conviction to a fine not exceeding [dollars].

(3) For the purposes of this section a person shall be deemed to represent that -

- (a) an article is patented in Jamaica if there is stamped, engraved or impressed on or otherwise applied to, the article the word "patent" or "patented", the words "provisional patent" or some other word or words expressing or implying that a patent for the article has been obtained in Jamaica; and
- (b) an article is the subject of an application for a patent in Jamaica if there are stamped, engraved or impressed on or otherwise applied to the article the words "patent applied for" or "patent pending" or some other words implying that an application for a patent for the article has been made in Jamaica.

(4) It shall be a defence to any prosecution under this section to show that the article was patented or was subject to an application for a patent at the time when and in the country where the words were stamped, engraved or impressed on or otherwise applied to it.

(5) Any person who uses on his places of business or on any document issued by him or otherwise the words "Patent Office", or any other words suggesting that his place of business is or is officially connected with the Patent Office, commits an offence and shall be liable on summary conviction to a fine not exceeding [dollars].

Appeals

Appeal to 112. - (1) An appeal shall lie to the Court under this Act
the Court. against a decision of the Registrar.

(2) Notice of appeal shall be filed in the Court within [twenty-eight] days after the day on which the decision appealed against was given.

(3) In any such appeal, the Court shall have and may exercise the same discretionary powers as are conferred on the Registrar.

(4) Subject to the provisions of section 113, the decision of the Court shall be final -

(a) on an appeal against a decision of the Registrar;

(b) on any application under section [nz31 or nz32].

Appeals to 113. An appeal shall lie to the Court of Appeal -

Court of (a) from any decision of the Court on an appeal under Appeal. section 74;

[(b) with the leave of the Court of Appeal, from any decision of the Court on any appeal against a decision of the Registrar].

Supplemental

Fees. 114. There shall be paid in respect of -

(a) the grant of patents, the registration of industrial designs and application pertaining thereto; and

(b) any other matters relating to patents and industrial designs arising under this Act,

such fees as may be prescribed from time to time, and all such fees [shall be paid into the Consolidated Fund] [shall be retained by the Office to be applied to defray costs associated with the carrying out of its functions under this Act].

Electronic 115. - (1) Subject to such rules as may be prescribed, any submission document, information or fee that is authorized or required of docu- to be submitted to the Registrar under this Act may be ments, etc. submitted in electronic or other form in any manner specified by the Registrar.

(2) Subject to the rules, any document or information received by the Registrar under this Act in electronic form may be entered or recorded by an information storage device, including any system of mechanical or electronic data processing, that is capable of reproducing stored documents or information in intelligible form within a reasonable time.

Service by post. 116. Any notice required or authorized to be given by this Act or rules and any application or other document so authorized if required to be filed, may be given, made or filed by post.

Rules. 117. The Minister may make rules generally for giving effect to the objects and purposes of the Act and for ensuring its due administration and, in particular, but without prejudice to the generality of the foregoing, rules may be made respecting -

- (a) the form and content of applications for patents or the registration of industrial designs;
- (b) the form of the register and of the indexes thereto;
- (c) the registration of assignments, transmissions, disclaimers, judgements or other documents relating to any patent;
- (d) the form and content of any certificate issued pursuant to this Act;
- [(e) the fees or the manner of determining fees that may be charged in respect of -
 - (i) the filing of applications for patents or designs;
 - (ii) the taking of other proceedings under this Act or under any rule made pursuant to this Act; or

- (iii) any services or the use of any facilities provided by the Registrar or any person employed in the Office;
- (f) the fees or manner of determining the fees that shall be paid to maintain in effect an application for a patent or design or to maintain the rights accorded by a patent or design;
- (g) the payment of any prescribed fees, including the time when and the manner in which such fees shall be paid, the additional fees that may be charged for the late payment of such fees and the circumstances in which any fees previously paid may be refunded in whole or in part;]
- (h) the carrying into effect of the terms of any treaty, convention agreement or arrangement that subsists between Jamaica and any other country;
- (i) the carrying into effect of any amendment, modification or revision of the Patent Cooperation Treaty made from time to time, to which Jamaica is party;
- (j) the entry in, the maintenance of, and the removal from the Register, of Patent Attorneys and the qualifications of such entry;
- (k) the submission of documents, information or fees under this Act;
- (l) the entering or recording of any document or information under section 96(2);
- (m) the manner in which an application for a patent or a request for priority may be withdrawn;
- (n) requests for priority and examination;
- (o) any other matter required to be prescribed by any provision of this Act.

(2) Rules may authorize the Registrar to extend, subject to any prescribed terms and conditions, the time fixed by or under this Act for doing anything, where the Registrar is satisfied that the circumstances justify the extension.

Act binds
the Crown. 118. The Act binds the Crown.

Repeal, Saving and Transitional Provisions

Repeal of 119. - (1) The Patent Act and the Designs Act (hereinafter
Patent Act called the repealed Acts) are hereby repealed.

and Designs [(2) Any patent or design registered or any document
Act. made or anything whatsoever done under the repealed Acts so
far as it is in force or subsisting immediately before the
appointed day shall continue and have effect as if it had
been made or done under the corresponding provision of this
Act as if the provision has been in force when the document
was made or thing was done.]

Transitional. 120. The transitional provisions set out in the Schedule
shall have effect for the purposes of the transition to the
provisions of this Act from the lay in force before the
appointed day.]

SCHEDULE

(To be inserted)

MEMORANDUM OF OBJECTS AND REASONS

This Bill seeks to reform the law relating to patents. The existing Act was promulgated in 1857. The deficiencies of the existing law have precluded Jamaica's involvement in international arrangements which require national legislation to accord a level of protection which is consistent with international norms and practices in the field of patent.

Specifically, the Bill when passed will significantly fulfil Jamaica's obligations as a party to the Paris Convention for the Protection of Industrial Property and will reflect the requirements of the Agreement on the Trade Related Aspects of Intellectual property between Jamaica and the United States of America. The Bill also provides for the filing of an international application under the Patent Cooperation Treaty.

Among its main features are -

- (a) inventions which satisfy prescribed the criteria set out in the Bill may be granted a patent utility model certificate, as the case may require thereby conferring on the right holder the exclusive right to exploit the patent or utility model for twenty years or seven years, respectively;
- (b) industrial design which meet the prescribed criteria may also be registered thus providing similar protection to the registered certificate;

- (c) [an applicant] may seek and obtain a right to priority, that is, the grant of a priority date for protection in respect of an application made in Jamaica within a twelve month period of the making of previous applications in relation to the same invention in countries which are parties to the Paris Convention;
- (d) patents utility models and industrial designs may be assigned, mortgaged, transferred or willed. Provision is made for patents to be licensed voluntarily, or compulsorily in clearly defined circumstances. The Crown may acquire rights to the use of patented inventions, subject to the payment of compensation to the patentee;
- (e) the patent system is to be administered by the Registrar of Industrial Property who is mandated to keep a register of patents and designs in which should be entered particulars of activities affecting patents and designs issued under the Act. Provision is made for transactions affecting patents to be registered.
- (f) persons who possess the prescribed criteria will be eligible for registration as patent attorneys;
- (g) the Minister is given wide rule-making power in relation to a variety of matters, including the procedures for application, search and examination and the payment of fees;

- (h) in order to ensure a proper transition from the old system to the new one, appropriate transitional provisions have been included in the Bill.

Phillip Paulwell
Minister of Commerce and Technology
