



MADRID SYSTEM

JIPO as the Office of a designated Contracting Party (DCP)

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KINGSTON | 10-03-2022



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EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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JIPO AS THE OFFICE OF DESIGNATED CONTRACTING PARTY (DCP)

Role with regard to designations of JM

THE ROLE OF JIPO WITH REGARD TO DESIGNATIONS OF JAMAICA

Role to a large extent determined by the law of Jamaica

Regarding, *e.g.*,

- grounds for refusal
 - absolute grounds
 - relative grounds (conflicting marks)
 - terms too broad or too vague
- republication of the IR in the national IP Journal (at no cost to the IR holder)
- third party opposition or observations
- professional representation
- special requirements re. collective, certification marks – use regulations

GROUNDS FOR REFUSAL OF PROTECTION

General rule – Article 5(1)

- grounds that would apply under the law of Jamaica to marks filed directly with JIPO, provided that they are consistent with the Paris Convention
- these may include both absolute and relative grounds

Non valid grounds

- disagreeing with IB regarding the classification of goods & services ([Rule12](#))
- banning multi-class registration
- accepting registration only for a limited number of goods & services

TIME LIMITS FOR REFUSAL OF A DESIGNATION

Protocol Members may choose

- **One year** from the date of the IB notification (by default)
- **18 months** by Declaration under Art 5(2)(b)
- **18 months+** by Declaration under Art 5(2)(c) in case of opposition provided that
 - before the expiry of the 18-month period the Office has informed the IB of the possibility of opposition
 - the refusal is notified to the IB within one month from the expiry of the opposition period (and in any case no later than 7 months from the date in which the opposition period begins)

Possible opposition after 18 months – Rule 16

- information on that possibility – MF1
- dates on which opposition period begins & ends – MF2

Provisional refusal of protection – Rule 17 – MF3a, MF3b

- *ex officio*, based on opposition, or both

Interim status of the mark (optional) – Rule 18*bis* – MF8

Statement of grant of protection where no refusal – Rule 18*ter*(1) – MF4

Final decision by JIPO after a provisional refusal

- statement of grant of protection – Rule 18*ter*(2) – MF5
- confirmation of total refusal – Rule 18*ter*(3) – MF6

Further decision – Rule 18*ter*(4) – MF7

Invalidation – Rule 19 – MF10

All those notifications are to be sent to the IB preferably **electronically**, possibly through the **Madrid Office Portal**

EX OFFICIO PROVISIONAL REFUSAL – JIPO SHALL INDICATE – RULE 17(2)

- IR number
- grounds for refusal + reference to the law
- details of prior rights (where applicable)
 - filing date and number of the prior application
 - registration date and number (if available)
 - name and address of the holder
 - reproduction of the mark
 - list of goods & services
- scope of the refusal (all or some goods & services) - total (MF3a), partial (MF3b)
- time limit to file a request for review/appeal + competent authority
- whether a local representative will be required

PROVISIONAL REFUSAL BASED ON OPPOSITION – CONTENT – RULE 17(3)

Additional content (as compared to *ex officio* provisional refusal)

- the fact that the refusal is based on an opposition
- name and address of the opponent
- where the opposition is based on prior rights, the list of goods & services on which the opposition is based
- time limit to file a response to the opposition

Two types of irregularities

- those that cannot be rectified
- those that can be rectified

Irregularities that cannot be rectified – Rule 18(1)(a) and 18(1)(b) (shall not be regarded as refusals by the IB)

- IR number is missing (identification not possible)
- no grounds for refusal are indicated
- refusal is received after the time limit has expired

The IB shall inform JIPO and the holder and indicate the reasons

Irregularities that can be rectified – Rule 18(1)(c)

If the JIPO notification

- is not signed
- does not comply with the communication or language requirements
- does not contain details of conflicting marks where applicable
- does not indicate the scope of refusal (all or some goods & services)
- does not contain the name and address of the opponent and the goods & services on which the opposition is based

The IB shall

- record the refusal in the International Register
- invite JIPO to rectify within 2 months
- inform the holder

Special case of irregularity that can be rectified but is not immediately recorded – Rule 18(1)(d)

- if JIPO's notification does not indicate time limit for review, appeal or response

The IB shall not record the refusal in the International Register

- however, if JIPO rectifies within 2 months, the IR will be recorded as having been sent to the IB on the date of the defective notification
- if not rectified, it shall not be regarded as a refusal. JIPO and the holder will be informed

If the Jamaican law so permits, any rectified notification shall include a new, reasonable time limit for filing a review, appeal or response

INTERIM STATUS OF THE MARK – RULE 18*bis*

Optional statement of interim status by JIPO when ...

- *ex officio* examination has been completed but
- opposition by third parties is still possible

May be notified to the IB – MF8 or IR lists

- before the expiry of the refusal period where JIPO has found no grounds for refusal
- anytime between notification of a provisional refusal and final disposition

JIPO - shall indicate the date by which an opposition may still be filed

WIPO - records the statement in the International Register and informs the holder

STATEMENT OF GRANT OF PROTECTION WHERE NO REFUSAL NOTIFIED

Rule 18*ter*(1) – Where :

- all procedures before JIPO have been completed
- JIPO has found no grounds for refusal
- no opposition has been filed

JIPO *shall* - send a statement of grant of protection to the IB, as soon as possible, and before the expiry of the refusal period

Those statements shall be sent to the IB either individually, in MF4, or as IR lists

Through the Madrid Office Portal, several statements may be sent simultaneously, preferably in MF4

FINAL DECISION BY JIPO AFTER A PROVISIONAL REFUSAL – RULES 18ter(2) & 18ter(3)

Statement of grant of protection (after a refusal) – Rule 18ter(2) – Where :

- all procedures before JIPO have been completed, and
- protection is granted for all goods & services (refusal totally withdrawn), or
- protection is granted for some goods & services (partial withdrawal of refusal)

JIPO *shall* notify the scope of protection to the IB in a positive manner – MF5

Confirmation of total provisional refusal – Rule 18ter(2)

- all procedures before JIPO have been completed, and
- total provisional refusal is confirmed

JIPO *shall* send a statement to the IB confirming total provisional refusal – MF6

FURTHER DECISION – RULE 18^{ter}(4)

Where ...

- the time limit has expired with no notification of refusal; or
- JIPO has notified a statement of grant of protection or a final decision (either refusing or granting protection) ...

and ...

- JIPO or another authority in Jamaica takes a further decision that affects the protection of the mark,
- JIPO *shall*, to the extent that it is aware of that decision, send to the IB a further statement indicating the status and, where applicable, the goods & services for which the mark is protected in Jamaica – MF7

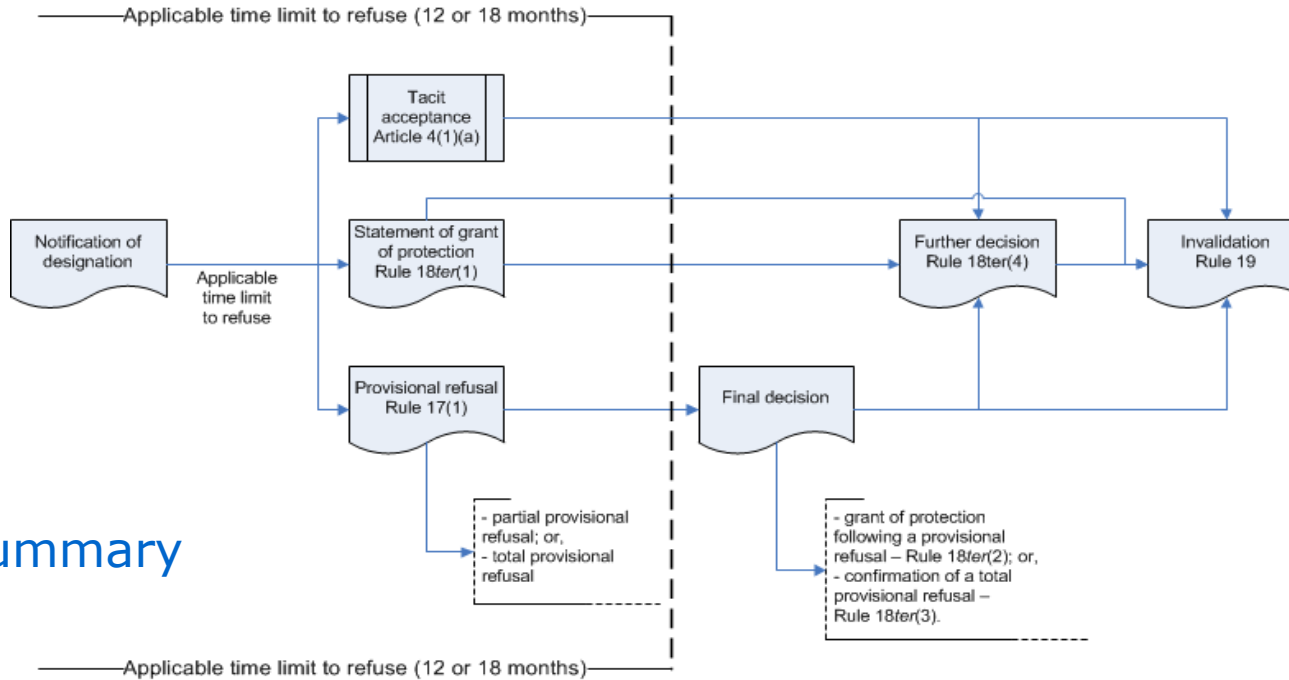
INVALIDATION – RULE 19

Invalidation = any decision by a competent authority **revoking or cancelling** the effects of an IR in Jamaica with regard to all or some goods & services

Where an invalidation has been declared and is no longer subject to appeal ...

- JIPO *shall* notify the IB of the relevant facts – MF10
 - authority having pronounced the invalidation
 - fact that the invalidation is no longer subject to appeal
 - number of the IR and name of the holder
 - scope of the invalidation (if not all goods & services are concerned, those in respect of which the invalidation has been pronounced or not pronounced)
 - date on which the invalidation was pronounced and its date of effect

FINAL SUMMARY



Final summary

JIPO AS THE OFFICE OF A DESIGNATED CONTRACTING PARTY (DCP)

Role with regard to procedures
other than the designation of JM

JIPO's ROLE AS THE OFFICE OF A DCP, WITH RESPECT TO ...

- Limitations – [Rule 27](#)
- Changes in ownership – [Rule 27](#)
- Division and merger of IRs – [Rules 27bis and 27ter](#)
- Corrections concerning an IR – [Rule 28](#)
- Licenses recorded in the International Register – [Rule 20bis](#)
- Restrictions of the holder's right of disposal – [Rule 20](#)
- Replacement – [Article 4bis and Rule 21](#)
- Transformation – [Article 9quinquies](#)

Where the holder of an IR has requested a **limitation** in the list of goods & services **in respect of Jamaica**

JIPO *may* declare that such limitation has no effect in Jamaica – Rule 27(5)
e.g., because it considers that a term is too broad or too vague, or that the change requested is not in fact a limitation but an extension of the list

JIPO's declaration - MF13 - must

- be sent to the IB within 18 months from the IB notification
- indicate the reasons for refusal and the essential provisions of the law
- state which goods & services are affected or not affected, if not all
- state whether a review or appeal is possible

JIPO must also notify any final decision to the IB

The effects in Jamaica of a change in ownership recorded in the International Register is governed by the law of Jamaica

e.g., a Contracting Party may prescribe that a partial change in ownership is not allowed if similar goods & services would remain in the name of different owners; or if the transfer would be likely to mislead the public

Depending on what is provided by law, JIPO may declare that a particular change in ownership has no effect in Jamaica – Rule 27(4)

JIPO' declaration - MF11 - must ...

- be sent to the IB within 18 months from its notification
- indicate the reasons and the essential provisions of the law
- state whether there is a possibility of review or appeal

Effects

if JIPO has declared that the change in ownership has **no effect in Jamaica**, the IR concerned shall remain in the name of the transferor in respect of Jamaica

IB shall

- record JIPO's declaration in the International Register
- record a separate IR for the part that remains in the name of the transferor in respect of Jamaica
- notify the party (holder or Office) that requested the recording of the change in ownership, and the new holder, accordingly
- publish relevant information in the Gazette

DIVISION OF AN INTERNATIONAL REGISTRATION – RULE 27bis

The holder of an IR may request JIPO to divide the IR in respect of Jamaica e.g., after a partial refusal by JIPO (for some g&s in the IR), the holder may request that

- the refused terms be moved into a divisional IR (subject to review or appeal), and
- the acceptable terms, remain in the original IR, and may proceed to protection

The holder must present the request to JIPO in official form [MM22](#)

JIPO shall

- examine the request to make sure that the division meets the JM law requirements
- if applicable, require the payment of a fee for processing the divisional request
- send the official form MM22 to the IB

If OK, IB shall create a divisional IR (for those g&s) with JM as the sole DCP

MERGER OF INTERNATIONAL REGISTRATIONS – RULE 27ter

Merger of IRs resulting from a division – Rule 27bis(2)

- two or more IRs resulting from a division requested through JIPO, may be merged into a single IR at the request of the holder
- the request shall be presented **through JIPO** in official form **MM24**

JIPO shall

- check that the same person or entity is the holder of the IRs to be merged
- make sure that the merger meets the JM law requirements
- if applicable, require the payment of a fee for processing the merger
- send the official form MM24 to the IB

The IB shall record the merger, notify JIPO and inform the holder

CORRECTIONS CONCERNING AN INTERNATIONAL REGISTRATION – RULE 28(3)

Whenever ...

the IB has corrected an error concerning an IR (either *ex officio* or upon the request of the holder or an Office)

JIPO may

declare that protection cannot be granted to the IR as corrected - where there are grounds of refusal of the IR as corrected which did not apply to the IR as originally notified

Rules 16 to 18^{ter}

shall apply *mutatis mutandis*

Time limits

are counted from the date of the notification of correction

LICENSES RECORDED IN THE INTERNATIONAL REGISTER – RULE 20bis

- JIPO may**
- declare that the recording of a particular license in the International Register has no effect in Jamaica
because according to JM law such license would not be allowed (e.g., public could be misled) or certain elements are missing (e.g., licensee's nationality, license duration)
- Declaration**
- shall be sent to IB within 18 months of notification
 - shall indicate
 - the reasons for the recording not having effect
 - goods & services affected or not, if not all
 - essential provisions of the law
 - possible review or appeal
- JIPO shall**
- also notify any final decision to the IB

RESTRICTION OF THE HOLDER'S RIGHT OF DISPOSAL – RULE 20

Restrictions in respect of Jamaica: may result from, *e.g.*

- a court order concerning the disposal of the assets by the holder
- the fact that the IR has been given as security

JIPO - may inform the IB that the holder's rights have been restricted in JM - **MM19**

- must provide a summary statement of the main facts (no copies of court decisions or deeds should be sent to the IB)
- if the restriction is removed, either totally or partially, shall inform the IB accordingly

IB - records the information on restrictions and removals in the International Register and informs the holder

“Replacement” takes place where

- a mark that is the subject of an IR having effects in JM
- is also the subject of a pre-existing national registration in JM in the name of the same person, and
- the relevant goods and services in the JM registration are covered by those in the IR in respect of JM

Automatic effect

- “replacement” takes place automatically, without any action by the holder being required
- the effective date of replacement is the date in which the designation of JM took effect (date of the IR, or of its subsequent designation)

JIPO may be asked to take note of replacement

- for the information of third parties, the holder may request JIPO to take note of replacement in its Register
- JIPO shall verify that the requirements for replacement are met
- if so, JIPO shall take note of replacement and notify the IB of
 - the number of the IR concerned
 - the goods & services replaced
 - the filing & registration dates & numbers of the replaced JM registration

Advantage for the IR holder

- centralized maintenance and management of the IR

Partial replacement

- replacement may concern only some goods & services listed in the national JM registration

Coexistence

- The IR and the JM registration deemed to be replaced shall be able to coexist (if both continue to be renewed)
- JIPO may not require the holder to renounce or request the cancellation of the national JM registration that is deemed to be replaced

Fees

- JIPO may charge a fee for taking note of replacement

TRANSFORMATION – ARTICLE 9quinquies

In case of cancellation of the IR due to ceasing of effect of the basic mark

- If the IR is cancelled by the IB as a result of “ceasing of effect” of the basic mark during the 5-year dependency period, the holder may keep his rights intact in Jamaica by transforming his IR into a Jamaican national application filed directly with JIPO
- The application must be filed with JIPO within 3 months from the date when the IR was cancelled
- The application shall be treated as if it had been filed on the date of the international registration (IR) or subsequent designation (SD)
- Procedure: the TM Amendment Act 2021, Section 26L shall apply



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