

Jamaica
THE PATENTS AND DESIGNS ACT, 2020
(Act 1 of 2020)
Signed on February 27th, 2020

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PART I - Preliminary

1. Short title and commencement

This Act may be cited as the Patents and Designs Act, 2020, and shall come into operation on a day to be appointed by the Minister by notice published in the Gazette.

2. Interpretation

In this Act, unless the context otherwise requires-

"the 1999 Act" means the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs, which was adopted on July 2, 1999, and entered into force on December 23, 2003;

"appointed day" means the day appointed by the Minister pursuant to section 1;

"Convention Country" means a country, other than Jamaica, which is a party to the Paris Convention;

"Court" means the Supreme Court;

"document" means anything in which information of any description is recorded whether on paper, tape, film or other physical medium, or by electronic means or otherwise;

"examiner" means a person or body who is requested by the Registrar to perform functions under section 16 or 20, being a person or body selected by the Registrar pursuant to section 115;

"exclusive licensee" means a licensee under a licence granted by an intellectual property owner and conferring on the licensee the right to exploit the intellectual property in Jamaica, to the exclusion of the intellectual property owner and all other persons;

"exploit", in relation to an invention, includes-

- (a) where the invention is a product-
 - (i) making, selling, offering for sale or otherwise disposing of the product;

- (ii) using or importing the product; or
- (iii) stocking the product for the purpose of doing any of those things mentioned in paragraph (i) or (ii); or
- (b) where the invention is a method or process, using the method or process for doing any act mentioned in paragraph (a), in respect of a product directly obtained by means of the method or process;

"filing date" shall-

- (a) in relation to an application under this Act be construed in accordance with section 11 in relation to patents and utility models or section 88 in relation to registered designs; and
- (b) in relation to a filing in a Convention Country or a WTO Member State, be the date of filing in that Convention State or WTO Member State;

"foreign application" means an application for a patent, utility model or registered design made in an industrial or intellectual property office of any other country, or within a regional industrial or intellectual property office;

"infringement proceedings" means proceedings for the infringement of a patent, utility model or registered design;

"International Bureau" means the International Bureau of the World Intellectual Property Organization, the organization established by the Convention Establishing the World Intellectual Property Organization 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;

"licence" means a licence to exploit or to authorize the exploitation of a patent, utility model or registered design;

"non-voluntary licence" means a licence granted under an order made under section 45;

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

"Paris Convention" means the Paris Convention for the Protection of Industrial Property signed at Paris, France on the 20th day of March, 1883, as amended from time to time and in force in Jamaica;

"patent" means the title granted for the protection of an invention which meets the criteria prescribed in section 4;

"patentee" means a person to whom a patent has been granted under this Act, and where the context so requires, includes a person to whom a patent has been granted under the laws of a Convention Country;

"Patent Cooperation Treaty" means the Patent Cooperation Treaty signed at Washington on the 19th day of June, 1970, and its Regulations together with any further amendments thereto as may be in force in relation to Jamaica;

"priority date" shall be construed in accordance with section 12(6);

"publish" means to make available to the public;

"Register" means the Register of Patents, Register of Utility Models or Register of Designs to be kept under section 99, as the case may require;

"registered" means-

- (a) in relation to a patent, entered in the Register of Patents;
- (b) in relation to a utility model, entered in the Register of Utility Models; and
- (c) in relation to a design, entered in the Register of Designs;

"Registrar" means the Registrar of Industrial Property, designated as such under section 3(2) of the Jamaica Intellectual Property Office Act;

"rules" means the rules made under section 121;

"sealed" means sealed with the seal of the Office;

"TRIPS WTO Agreement" means the Agreement on the Trade Related Aspects of Intellectual Property Rights signed at Uruguay on the 15th day of April 1994, as amended from time to time and in force in relation to Jamaica;

"utility model" means the title granted to protect an invention which meets the criteria specified in section 78(1);

"work" in relation to a patent or a utility model means-

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

"World Trade Organization" or "WTO" means the Organization that came into being on 1st day of January 1995, pursuant to the Marrakesh Agreement;

"WTO member state" means a country, other than Jamaica, which is a member of the World Trade Organization;

"WTO owner" means an owner for the purposes of this section and sections 45, 46, 47, 48, 49 and 50 if-

- (a) the owner is a national of, or is domiciled in a WTO Member State; or
- (b) the owner has a real and effective industrial or commercial establishment in a WTO Member State.

3. Application of Act

(1) This Act shall apply to

- (a) nationals of any Convention Country or WTO member state; and
- (b) nationals of a non-convention country or non-WTO member state, who are domiciled in or have a real and effective commercial establishment in a Convention Country or WTO member state.

(2) With a view to fulfilling obligations under any treaty, convention or arrangement relating to intellectual property, the

Minister may, by order published in the Gazette, extend the application of this Act to a country specified in the order as if it were a Convention Country, or a WTO member state for the purposes of this Act.

PART II - Patentability

4. Conditions for patentability

An invention is patentable only if-

- (a) it is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application; and
- (d) the grant of a patent in relation to the invention is not excluded under section 8.

5. Novelty of invention

(1) An invention that does not form part of the state of the art, shall be taken to be new.

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

(3) In relation to an invention for which an 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 a 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 twelve-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 was obtained-
 - (i) unlawfully from the inventor; or
 - (ii) in breach of confidence, by any person to whom it was made available in confidence by the inventor or any other person to whom the inventor in confidence disclosed it;
 - (b) 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 written evidence, in support of the statement referred to in subparagraph (1), within such period and complying with any such conditions as the Registrar may by notice publish.

(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.

6. Inventive step

An invention shall be taken to involve an inventive step if, having regard to the state of the art, it is not obvious to a person having ordinary skill in the art.

7. Industrial application

An invention shall be taken to be capable of industrial application, if it can be made or used in any kind of industry.

8. Exclusions on grant of patent

A patent shall not be granted under this Act, for-

- (a) plants and animals, (including deoxyribonucleic acid (DNA) and cells), other than micro-organisms;
- (b) essentially biological processes for the production of plants or animals, other than non-biological and micro-biological processes;

- (c) plant and seed varieties;
- (d) the human body in all its developmental stages and all its elements, in whole or in part;
- (e) inventions, the implementation of which would be contrary to public order or morality or would cause serious prejudice to the environment or cause injury to human, animal or plant life or health;
- (f) methods of surgical or therapeutic treatment and of diagnosis applied to the human body or to the bodies of animals;
- (g) a discovery, scientific theory or mathematical method;
- (h) a scheme, rule or method for performing a mental act, doing business, playing a game or a computer program;
- (i) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever; or
- (j) the presentation of information.

PART III - Procedure for Obtaining a Patent

9. Persons who may apply for a grant of a patent

(1) An application for a patent may be made, either alone or jointly, by any of the following persons-

- (a) any person claiming to be the inventor of the invention;
- (b) any person or persons who, by virtue of any Jamaican law, foreign law, treaty or other international agreement, or enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention, entitled to the whole of the property in the invention (and not solely an equitable interest) in Jamaica;
- (c) the successor or successors in title of any person or persons referred to in paragraph (a) or (b);
- (d) any person who is an assignee of a person referred to in paragraph (a), (b) or (c).

(2) Without prejudice to 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 or a WTO member state, may be made by the person claiming to be the inventor or by his 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 referred to in paragraph (a).

10. Requirements for application for patent

(1) An application for a patent shall be filed with the Registrar, in the form set out as Form 1 in the First Schedule, and shall be accompanied by the fee prescribed in Part A of the Second Schedule.

(2) The form referred to in subsection (1) shall, as provided for in this section, include or be accompanied by-

- (a) a request for the grant of a patent;

- (b) a specification containing-
 - (i) a description of the invention;
 - (ii) one or more claims; and
 - (iii) any drawing referred to in the description or in any claim; and
- (c) an abstract.

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

- (a) the application shall contain a declaration by each of the applicants that the applicants or any of the applicants believe that the person named as the inventor is correctly named as such; and
- (b) the request for the grant of a patent shall be accompanied by a statement justifying the right of any applicant who is not the inventor of the patent.

(4) The request for the grant of a patent shall contain-

- (a) the name of each applicant;
- (b) the name of the inventor; and
- (c) the name of the agent (if any) appointed for the purposes of the application; and
- (d) a title indicating the subject of the invention.

(5) The description referred to in subsection (2)(b)(i) 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) state the best method of performing the invention which is known to the applicant at the filing date or, where priority is claimed, the priority date, for which the applicant is entitled to claim protection.

(6) The claim 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 referred to in subsection (2)(c), shall provide technical information and shall not-

- (a) on publication, form a part of the state of the art; and
- (b) be taken into account for the purpose of interpreting the scope of the protection.

11. Filing date for a patent application

(1) Notwithstanding the requirements of section 10, 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) the documents filed-
 - (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 provisions of this Act and the rules made hereunder; and
- (c) the applicant has paid the filing fee prescribed in Part A of the Second Schedule.

(2) If the Registrar finds that the conditions specified in subsection (1) are not satisfied, the Registrar shall, in writing, request that the applicant make any necessary adjustments within thirty days of receipt of the request, and if the adjustments 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 which complies with section 10 or subsection (1) of this section and before the grant of the patent-

- (a) a new application is filed by the original applicant or the original applicant's successor in title in respect of any matter contained in the earlier application; and
- (b) the conditions specified in subsection (1) 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.

12. Right of priority

(1) An applicant in respect of an application made for a patent shall be entitled to a right of priority if-

- (a) the claim for a right of priority under subsection (2) 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 earlier application, the first earlier application; and
- (b) the applicant has fulfilled the requirements under subsections (2), (3) and (4).

(2) An applicant for a patent may claim a right of priority with reference to an earlier application filed by that applicant or that applicant's predecessor in title that was filed in relation to the same invention in a Convention Country or a WTO member state on the application form set out as Form 1 in the First Schedule or, by declaration submitted in the form set out as Form 2 in the First Schedule and upon payment of the fees prescribed in Part A of the Second Schedule.

(3) An applicant who makes a claim to a right of priority shall indicate the filing date of the earlier application referred to in subsection (1) in the Convention Country or the WTO member state.

(4) Where a claim for a right of priority is made the applicant shall within six months of the claim, furnish the Registrar with-

- (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 into English of the earlier application accompanied by-
 - (i) the form set out as Form 3 in the First Schedule and the fee prescribed in Part A of the Second Schedule; and
 - (ii) a declaration by the translator that the translation is to the best of the translator's knowledge, complete and faithful.

(5) Where-

- (a) a claim for a right of priority is withdrawn by the applicant; or
- (b) the Registrar finds that the requirements of this section or the rules have not been met with respect to the claim for the priority, the claim for a right of priority under subsection (2), shall be deemed as having not been made.

(6) Where an applicant for a patent under this Act duly claims a right of priority under this section, the priority to which the applicant is entitled shall-

- (a) take effect from the filing date of the earlier application referred to in subsection (1), or if more than one, the first earlier application hereinafter referred to as the priority date; and
- (b) not be invalidated by reason of any acts of any other person occurring after the priority date and in particular another filing, or the disclosure, publication or exploitation of the invention, and such acts shall not give rise to any third-party rights with respect to the invention or patent.

(7) Where the date taken to be the priority date under subsection (6), or the filing date in Jamaica under section 11 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 (1).

(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 such 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) Notwithstanding anything in this Act to the contrary, where a claim for a right of priority is made after the expiration of the twelve month period immediately following the filing date of the earlier application, but within two months of the expiration of such period, the Registrar shall, upon request of the applicant pursuant to section 110(4), restore the right of priority with respect to that application, if the Registrar finds that the failure to file the application within the priority period was unintentional, or occurred in spite of due care required by the circumstances, having been taken.

(11) The Registrar shall not refuse, totally or in part, a request for restoration of right of priority without giving the applicant the opportunity to make observations on the intended

refusal within a reasonable time.

13. Information on foreign applications

(1) An applicant shall upon that applicant's own initiative or, at the request of the Registrar, furnish the Registrar with the date and number of any foreign application, grant or registration relating to the same or essentially the same invention as that claimed in the application filed with the Registrar.

(2) The applicant shall, upon that applicant's own initiative or at the request of the Registrar in the form set out as Form 4 in the First Schedule and accompanied by the fee prescribed in Part A of the Second Schedule, furnish the Registrar with copies of the following documents relating to the foreign application referred to in subsection (1)-

- (a) any original or notarized communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application, grant or registration;
- (b) the patent or other title of protection granted pursuant to the foreign application;
- (c) any final decision accepting or rejecting the foreign application or grant or refusing the patent requested in the foreign application;
- (d) any final decision invalidating the patent or grant of other title of protection granted in the foreign application.

(3) Documents furnished pursuant to subsections (1) and (2) shall, if not in English, be translated into English and-

- (a) be accompanied-
 - (i) by the form set out as Form 3 in the First Schedule and the fee prescribed in Part A of the Second Schedule; and
 - (ii) by a declaration by the translator that to the best of the translator's knowledge the translation is complete and accurate; and
- (b) such documents may be used only to facilitate the evaluation of the matters referred to in paragraphs (a), (b), (c) and (d) of section 4 in relation to the application filed with the Registrar.

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

14. Mention of inventor

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

(2) A promise or undertaking by the inventor made to any person to the effect that the inventor would make such a declaration pursuant to subsection (1) 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 a grant of patent.

(4) Where a person has been mentioned as sole or joint inventor pursuant to this section, any other person who alleges that the former ought not to have been so mentioned or that the latter ought to have been so mentioned may, at any time, file before the Registrar a notice of opposition and apply for a certificate to the effect that the person ought not to have been so mentioned.

(5) An application made under subsection (4), shall be in the form set out as Form 5 in the First Schedule and accompanied by the fee prescribed in Part A of the Second Schedule.

(6) Where a person makes an application under subsection (4), any person who is mentioned in the patent as sole or joint inventor, shall have a right to be heard by the Registrar.

(7) Following the hearing under this section, the Registrar may issue a certificate and where the Registrar so issues the certificate, the Registrar shall rectify the Register and any undistributed copies of the patent.

15. Application for a patent may be considered as two or more applications

(1) At any time before the Registrar makes a determination pursuant to section 20, with respect to a single application relating to two or more inventions, the application for a patent may at the discretion of the Registrar or at the request of the applicant, in writing, be considered as two or more applications.

(2) In determining the application, reference shall be made to the original application and shall not extend beyond the description in the original application.

(3) Where an application made pursuant to section 10 is considered as two or more applications, the filing date of the original application, shall apply to all such applications, as shall the benefits of any priority enjoyed by the original application.

(4) The application fee prescribed in Part A of the Second Schedule shall be payable in respect of each application referred to in this section.

16. Preliminary examination

(1) Where an application has a filing date and is not withdrawn under section 19, and the application fee has been paid, the Registrar shall conduct a preliminary examination.

(2) For the purpose of the preliminary examination, the Registrar shall determine whether the application is in compliance with the requirements of sections 9 and 10 and the Rules if any, relating thereto.

(3) The Registrar shall, upon completion of the preliminary examination of the application, communicate in writing with the applicant to provide details, where applicable, of any amendments required to be made to the application.

(4) The Registrar may refuse the application if the applicant fails to amend the application as required under subsection (3) before the end of the period specified by the Registrar.

17. Publication of application

(1) Where an application has a filing date and the preliminary examination has been satisfactorily completed, then as soon as possible thereafter, and subject to the payment of the prescribed fee in Part A of the Second Schedule, the Registrar shall-

- (a) unless the application is withdrawn or refused before the preparations for its publication have been completed by the Office, publish it in the Intellectual Property Journal, as filed, (including the original claims and any amendments thereto, and any new claims substituted immediately before the completion of those preparations for its publication); and
- (b) notify the applicant that the application has been published and that the search and substantive examination fee is payable within six months.

(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;
- (b) the publication or exploitation of which would, in the Registrar's opinion, encourage offensive, immoral or anti-social behaviour; or
- (c) the publication of which, would be prejudicial to national security or the safety of the public.

18. Amendment of application

(1) At any time before a patent is granted pursuant to an application under this Act, the applicant may apply to amend the application in the form set out as Form 6 in the First Schedule, upon payment of the prescribed fee in Part A of the Second Schedule.

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

19. Withdrawal of application

(1) An application which has a filing date pursuant to section 11(1), shall be deemed to be withdrawn at the end of one year, unless, before that time the applicant files at the Office-

- (a) one or more claims for the purposes of the application;

- (b) the abstract; and
- (c) the documents required to be filed under section 10(3), as the case may require.

(2) An applicant may file a request with the Registrar for the withdrawal of a patent application at any time before the patent is granted.

(3) Where an application is withdrawn under this section, having already been published under section 17, notification of that withdrawal shall be published by the Registrar.

(4) Where any application is considered withdrawn under this Act for failure to meet the prescribed time limit, the Registrar shall upon request of the applicant, pursuant to section 110(4), reinstate the rights of the applicant with respect to that application, if the Registrar finds that any delay in meeting the prescribed time was unintentional or that the failure to meet the time limit occurred in spite of due care required by the circumstances having been taken.

(5) The registrar shall not refuse a request for reinstatement of rights without giving the applicant the opportunity to make observations on the intended refusal within a reasonable time.

20. Search and substantive examination

(1) Where the Registrar is satisfied that the requirements under section 10 have been complied with, the Registrar shall determine whether the application complies with the requirements of sections 4, 5, 6, 7 and 8 and of any rules made in relation thereto.

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

- (a) may, after prior notification to the applicant and payment by the applicant of the search and substantive examination fee prescribed in Part A of the Second Schedule and upon the submission of a request in the form set out as Form 7 in the First Schedule, refer the application to an examiner to carry out a search and substantive examination to determine whether the application complies with the requirements of sections 4,

5, 6, 7 and 8 and of any rules made in relation thereto;
(b) shall take into account--
 (i) the report of any such search and substantive examination;
 (ii) the results of any international search and substantive examination report and any international preliminary examination report under the Patent Cooperation Treaty carried out in relation to the application.

(3) If the search and substantive examination fee prescribed in Part A of the Second Schedule is not paid within the period prescribed in subsection 17(1)(b), the application shall be deemed to be withdrawn at the end of that period.

21. Search and substantive examination for applications in respect of two or more inventions

Where the examiner forms the opinion that an application relates to two or more inventions which are not so linked as to form a single inventive concept, the examiner shall initially conduct a search and substantive examination in relation only to the first invention specified in the claim to the application, however, the examiner shall proceed to conduct a search and substantive examination in relation to another invention specified in the application if the applicant applies therefor in the form set out as Form 7 in the First Schedule and pays the search and substantive examination fee prescribed in Part A of the Second Schedule in respect of that other invention.

Grant of Patent

22. Grant or refusal of patent

(1) Subject to subsections (2) and (3) and any determination made under section 20(3), where the Registrar is satisfied that the application complies with requirements of sections 4, 5, 6, 7, 8, 9 and 10, the Registrar shall grant a patent for the invention in respect of which the application was made subject to payment by the applicant of the registration fee prescribed in Part A of the Second Schedule.

(2) Where two independent applications are made for the same invention, then--

(a) the person whose application has the earliest filing date; or

(b) if priority is claimed, the person who has the earliest validly claimed priority date, as long as that application has not been withdrawn, is entitled to the grant of the patent.

(3) 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.

(4) A patent granted under subsection (1) shall be sealed, and the patent shall take effect as from the date of filing.

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

(a) make an entry of the patent in the Register, including-

- (i) the filing date of the application; and
- (ii) the date on which the patent is sealed pursuant to subsection (4);

(b) publish a reference to the grant of the patent.

(6) Any person may apply to the Registrar for a copy of the patent, and the Registrar shall make copies available to the person on the payment of the fee prescribed in Part A of the Second Schedule.

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

23. Postponement of grant of patent

(1) At the request of the applicant for a patent, the grant of the 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) Subject to subsection (3), where the Minister certifies that the invention be kept secret, the Registrar may allow a postponement of the time for a grant of a patent beyond six months, subject to such conditions and procedures as may be specified.

(3) The Minister may allow postponement of the grant of a patent only where public order, public safety and national defence is at risk.

24. Term of patent

The term of a patent shall be twenty years from the filing date.

25. Annual Fee

(1) As from the grant of a patent, on each successive anniversary thereafter of the filing date of the application for the patent, the annual fee prescribed in Part B of the Second Schedule shall be payable to the Office by the patentee in order to maintain the patent.

(2) The payment of the annual fee shall be accompanied by the form set out as Form 8 in the First Schedule.

(3) Subject to subsection (4), a patent shall cease to have effect at the end of ninety days after every anniversary referred to in subsection (1), if the annual fee remains unpaid at the expiration of that period.

(4) Notwithstanding subsection (3) the patent shall not cease to have effect if the annual fee and the late fee prescribed in the Second Schedule are paid in full within ninety days after the end of the ninety days period referred to in subsection (3).

Amendments to Patents After Grant

26. Amendment of specification after grant of a patent

(1) Subject to the following provisions of this section, the Registrar may, on an application by the patentee in the form set out as Form 6 in the First Schedule and upon payment of the fee prescribed in Part A of the Second Schedule, allow the specification of the patent to be amended subject to such conditions, if any, as the Registrar thinks fit.

(2) Upon receipt of an application under subsection (1) the Registrar shall cause the application to be published in such manner as the Registrar may determine.

(3) The Registrar shall not allow an amendment under subsection (1) where-

- (a) the amendment would result in the specification disclosing any additional matter or claim, or otherwise extending the protection conferred by the patent; or
- (b) proceedings are pending before the Registrar or the Court in which the validity of the patent is in issue.

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

(5) A person may within thirty days after publication of the application filed under subsection (1), give notice of opposition to an application under this section by the patentee, to the Registrar, in the form set out as Form 5 in the First Schedule, accompanied by the fees prescribed in Part A of the Second Schedule.

(6) Where a person gives notice of opposition under subsection (5), the Registrar shall notify the owner and determine whether to grant the application.

(7) The Registrar may, without an application being made to the Registrar for the purpose, amend the specification of a patent so as to acknowledge a registered trade mark.

27. Details of registration may be amended after grant of patent

At any time after the grant of a patent, the owner of the patent may apply to amend the details of a registration in the form set out as Form 6 in the First Schedule and upon payment of the prescribed fee in Part A of the Second Schedule.

**PART IV - International Application
under the Patent Cooperation Treaty**

28. Interpretation

In this Part, "designated Office", "elected Office", "international application" and "receiving Office" have the same meanings as under the Patent Cooperation Treaty.

29. Receiving office Jamaica

The Office shall be the receiving office in Jamaica.

30. Office shall be the designated office

The Office shall be the designated office in respect of an international application in which Jamaica is designated for the purposes of obtaining a patent under this Act.

31. Office to act as elected office for purposes of international preliminary examination under the treaty

The Office shall act as the elected office in respect of an international application in which Jamaica is designated for the purposes of obtaining a patent under this Act, if the applicant elects to name Jamaica for the purposes of an international preliminary examination under the Patent Cooperation Treaty.

32. Filing of international applications

An international application filed with the Office, shall be-

- (a) in the English Language; and
- (b) accompanied by the international application fee, transmittal fee prescribed in Part A of the Second Schedule and any other fee prescribed in this Act and Rules made hereunder or the Patent Cooperation Treaty.

33. International application

(1) An international application in which Jamaica is designated for the purpose of obtaining a patent for which a filing date has been accorded under the Patent Cooperation Treaty shall, subject to sections 34 and 35, be treated as an application for a patent under this Act.

(2) If the international application or the designation of Jamaica in it, is withdrawn or deemed to have been withdrawn

under the Patent Cooperation Treaty, it shall also be treated as withdrawn under this Act.

34. Treatment of application

(1) The Registrar shall process an international application in accordance with the provisions of this Act, the Patent Cooperation Treaty, the Regulations established thereunder and the Administrative Instructions to the Regulations.

(2) The Registrar shall, on payment of the fee prescribed in Part A of the Second Schedule, publish any translation filed at the Office under subsection (3).

(3) The national phase of the application begins-

- (a) on the expiration of the time limit applicable under Article 22 or 39 of the Patent Cooperation Treaty or such later time period as the Registrar may publish in a notice, 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 fee prescribed in the Second Schedule to publish the translation;
- (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 filed pursuant to the Patent Cooperation 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 filed in accordance with the Patent Cooperation Treaty in a language other than that in which it was originally published.

(4) The application shall be taken to be withdrawn if before the expiration of the time period, conditions referred to in subsection (3)(a) are not satisfied.

(5) In this section, "international phase of the application" means the period from the date of filing of the application in accordance with the Patent Cooperation Treaty and ending when the national phase begins.

35. Adapting Act to international application

(1) Where an international application is accorded a filing date under the Patent Cooperation Treaty the following shall apply-

- (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 Cooperation 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 12(2) and, where in accordance with the Patent Cooperation Treaty extra days are allowed, the period of twelve months specified in section 12(1) shall be treated as altered accordingly;
- (c) any statement of the inventor's name under the Patent Cooperation Treaty shall be treated as a statement filed in an application under section 10(1).

(2) Where an international application which has not otherwise been published under this Act, is published in English in accordance with the Patent Cooperation Treaty, it shall be treated as published for the purposes of section 17.

(3) When the national phase begins, the Registrar shall apply such of the requirements of section 20 to the application as the Registrar considers appropriate, having regard to the examination or search carried out under the Patent Cooperation Treaty.

PART V - Property Rights and Ownership

36. Nature of rights

A patent or an application for a patent is personal property, and may, subject to the provisions of this Act, be disposed of accordingly.

37. Exclusive rights

Subject to the provisions of this Act, a patent confers on a patentee, exclusive rights during the term of the patent to-

- (a) prevent any other person from exploiting the patented invention without the consent of the patentee;
- (b) exploit the invention;
- (c) authorize another person to exploit the invention; and
- (d) assign or mortgage the patent, or grant licences in respect thereof.

38. Co-ownership of a patent

(1) Subject to any agreement to the contrary, where there are two or more patentees-

- (a) each patentee is entitled to an equal undivided share in the patent;
- (b) subject to paragraph (c), each patentee is entitled by himself or by his agent to exercise for his own benefit the exclusive rights given by the patent, without obtaining the consent of or accounting to the other or others; and
- (c) none of the patentees may, without the consent of the other or others, as the case may be-
 - (i) grant a licence under the patent;
 - (ii) assign the patent or any interest in the patent;
 - (iii) mortgage the patent;
 - (iv) amend the specification of the patent; or
 - (v) revoke the patent.

(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) Where there are two or more patentees, the Registrar may, on the application of any of them, give directions as the Registrar

thinks fit, concerning-

- (a) a dealing with the patent or an interest in the patent;
- (b) the grant of licences under the patent; or
- (c) the exercise of a right under section 37, in relation to the patent.

(4) If a patentee fails to do anything necessary to carry out a direction under subsection (3) within twenty-eight days after being asked in writing to do so by one of the other patentees, the Registrar may, on application of one of the other patentees, permit that patentee to carry out the direction in the name of and for and on behalf of the defaulting patentee.

(5) Before giving a direction, the Registrar shall give an opportunity to be heard in the case of an application-

- (a) by a patentee or patentees under subsection (3), to the other patentee or patentees; and
- (b) under subsection (4), to the defaulting patentee.

(6) The Registrar shall not give a direction that-

- (a) affects the legal 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 of an agreement between the patentees.

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

39. Inventions by employees

(1) Subject to section 40 and notwithstanding the provisions of any rule of law, an invention made by an employee shall be taken to belong to the employer-

- (a) if the invention was made-
 - (i) in the course of the normal duties of the employee; or
 - (ii) in the course of duties falling outside the employee's normal duties, but specifically assigned to the employee, and, in either case, the circumstances were such that an invention might reasonably be expected to result from the

- carrying out of the employee's duties; or
- (b) if 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 the employee's duties and the particular responsibilities arising from the nature of the employee's duties, the employee had a special obligation to further the interests of the employer's undertaking.
- (2) An invention made by an employee outside of the circumstances specified in subsection (1), shall 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 the employee 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 may be entitled.

40. Order for compensation of employees

- (1) Where it appears to the Court, on an application made by an employee within the prescribed period that-
- (a) the employee has made an invention belonging 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 invention or the patent for it (or the combination of both) is of outstanding benefit to the employer; and
- (c) by reason of those facts, it is just that the employee should be awarded compensation to be paid by the employer,
- the Court may award the employee such compensation of an amount determined in accordance with section 41.
- (2) Subsection (1) 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.

(3) In this section-

"the prescribed period" in relation to proceedings before the Court, means the period of twenty-one years commencing on the date that the patent was granted; and

"relevant collective agreement" means a collective agreement within the meaning of the Labour Relations and Industrial Disputes 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.

41. Amount of compensation

(1) The award of compensation to an employee under section 40(1), shall be such as to secure to the employee a fair share of the benefit which the employer has derived or may reasonably be expected to derive from the invention or patent or any disposition thereof.

(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 the employer, 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 Government 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 having among its functions that of developing or exploiting inventions resulting from 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 Government 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 belongs to the employer, the Court shall take account of the

following matters-

- (a) the nature of the employee's duties, his remuneration and the other advantages the employee derives or has derived from his employment or has derived in relation to the invention under this Act;
- (b) the effort and skill which the employee has devoted to making the invention;
- (c) the effort and skill which any other person has devoted to making the invention jointly with the employee concerned, and the advice and other assistance contributed by any other employee who is not a joint inventor of the invention; and
- (d) the contribution made by the employer to the making, developing and working of the invention by the provision of advice, facilities and other assistance, by the provision of opportunities and by the employer's managerial and commercial skill and activities.

(5) An order for compensation under section 40, may provide for the payment of a lump sum or for periodical payments, or both.

(6) Where the Court has made an order under section 40, the Court may, on an application made by the employer or the employee, vary, discharge or suspend any provision of the order, or revive any provision so varied, discharged or suspended, and the prescribed period as defined in section 40(3), shall apply to the application as it applies to an application under that section.

42. Enforceability of contracts re employee's inventions

(1) This section applies to any contract (whenever made) relating to inventions made by an employee, being a contract entered into by the employee-

- (a) with the employer alone or with another person; and
- (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 an invention of any description made by the employee at any time which is after the appointed day or the date of the contract; and

(b) in patents for those inventions or applications for such patents, shall be unenforceable against the employee to the extent that such term diminishes the employee's rights.

(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 Government, as that public officer's employer, as it applies to any contract made between an employee and an employer.

43. Non-application of certain sections in particular cases

(1) Sections 39, 40, 41 and 42, shall not apply to-

- (a) an invention made before the appointed day; or
- (b) an invention made by an employee, unless it is at the time it was made-
 - (i) the employee was mainly employed in Jamaica;
 - (ii) the employee was not mainly employed anywhere; or
 - (iii) the employee's 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 the employee was also attached elsewhere.

(2) In sections 39, 40, 41 and 42 and this section, except so far as the context otherwise requires, references to the making of an invention by an employee, are references to the employee 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.

(3) In sections 39, 40, 41 and 42 any references to a patent and to a patent being granted are, respectively, references to a patent or other legal protection for inventions and to its being granted whether under the laws of Jamaica or the law in force in any other country or under any treaty or International Convention to which Jamaica is a party.

(4) For the purposes of sections 39 and 40, the benefit derived or expected to be derived by an employer from a patented

invention shall, where the employer dies before any award is made under section 41, include any benefit derived or expected to be derived from the patented invention by the employer's personal representatives or by any person in whom it was vested by their legal assent.

(5) Where an employee dies before an award is made under section 41 or carried out 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 section 40(1).

(6) In sections 40 and 41 and subsection (4) "benefit" means benefit in money or money's worth.

PART VI - Dealings in Patents Voluntary Dispositions

44. Assignments, voluntary licences and sub-licences

(1) An inventor, or the successor in title of an inventor, may assign any patent granted or to be granted for the invention.

(2) Subsection (3) applies to-

(a) an assignment or mortgage of a patent, or any right in a patent, or of any application for a patent, or any right in such application; or

(b) an assent relating to any patent or any such right or application.

(3) An assignment, mortgage or assent to which this subsection applies shall be void unless such assignment, mortgage or assent is-

(a) in writing; and

(b) signed by or on behalf of -

(i) the assignor or mortgagor;

(ii) in the case of an assent or other application, the personal representative.

(4) 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.

(5) If and to the extent that the conditions of a licence allow, a sub-licence may be granted under it.

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

(7) An assignment or licence referred to under this Act has effect with regard to third parties, only if the assignment or licence is registered under this Act, but need not be recorded for the purposes of proving use.

Non-Voluntary Licences

45. Non-voluntary licence

(1) At any time after the expiration of four years from the date of filing of the application for a patent, or three years from the date of the grant of the patent, whichever is the later, a person may apply to the Court on one or more of the relevant grounds-

- (a) for a licence under the patent; or
- (b) where the applicant is a Government department, for the grant of a licence under the patent to any person specified in the application.

(2) Subject to sections 46 and 47, if the Court is satisfied that any of the relevant grounds are established, the Court may-

- (a) where the application is under subsection (1)(a), order the grant of a licence to the applicant on such terms as the Court thinks fit; or
- (b) where the application is under subsection (1)(b), order the grant of a licence to the person specified in the application on such terms as the Court thinks fit.

(3) An application may be made under this section in respect of a patent, even though the applicant is already the holder of a licence under the patent.

(4) No person shall be stopped or barred from alleging any of the matters specified in the relevant grounds by reason of any admission made by that person, whether in a licence or otherwise, or by reason of the person having accepted a licence.

(5) In this section, "the relevant grounds" means-

- (a) in the case of an application made in respect of a patent whose owner is a WTO owner, the grounds set out in section 46(1);
- (b) in any other case, the grounds set out in section 47(1).

46. Non-voluntary licences - WTO owner

(1) In the case of an application made under section 45 in respect of a patent whose owner is a WTO owner, the relevant grounds are that-

- (a) the patented invention is a product, the demand for which in Jamaica is not being met on reasonable terms;
- (b) by reason of the refusal of the owner of a patent to grant a licence or licences on reasonable terms-
 - (i) the exploitation in Jamaica of any other patented invention which involves a technical advance of considerable economic significance in relation to the invention for which the patent concerned was granted, is prevented or hindered; or
 - (ii) the establishment or development of commercial or industrial activities in Jamaica is unfairly prejudiced;
- (c) by reason of conditions imposed by the owner of the patent-
 - (i) on the grant of a licence under the patent;
 - (ii) on the disposal or use of the patented products;
 - (iii) on the use of the patented process; or
 - (iv) on the manufacture, use or disposal of materials not protected by the patent,the establishment or development of commercial or industrial activities in Jamaica is unfairly prejudiced.

(2) No order shall be made under section 45 in respect of a patent whose owner is a WTO owner unless-

- (a) the applicant has made efforts to obtain a licence from the owner on reasonable commercial terms and conditions; and
- (b) the applicant's efforts have not been successful within ninety days.

(3) No order shall be so made if the patented invention is in the field of semi-conductor technology, unless-

- (a) the exploitation of the patented invention is only authorized for public non-commercial use; or
- (b) the Court has determined that the manner of the exploitation of the patented invention by the owner of the patent, or the owner's licensee, is anti-competitive.

(4) No order shall be made under section 45 in respect of a patent on the ground mentioned in subsection (1)(b)(i) of this section, unless the Court is satisfied that the owner of the patent for the other invention is able and willing to grant the owner of the patent and his licensees a licence under the patent for the other invention on reasonable terms.

(5) A licence granted in pursuance of an order made under section 45 on the ground mentioned in subsection (1)(b)(i) of this section, shall not be assigned except to a person to whom the patent for the other invention is also assigned.

(6) A licence granted in pursuance of an order made under section 45 in respect of a patent whose owner is a WTO owner shall-

- (a) not be exclusive;
- (b) not be assigned, except to a person to whom there is also assigned the part of the enterprise that enjoys the use of the patented invention, or the part of the goodwill that belongs to that part of the enterprise;
- (c) be predominantly for the supply of the market in Jamaica;
- (d) include conditions entitling the owner of the patent to remuneration, adequate in the circumstances of the case, taking into account the economic value of the licence; and
- (e) be limited in scope and in duration to the purpose for which the licence was granted.

47. Non-voluntary licences - other cases

(1) In the case of an application made under section 45, in respect of a patent whose owner is not a WTO owner, the relevant grounds are--

- (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 a demand for the product in Jamaica-
 - (i) is not being met on reasonable terms; or
 - (ii) is being met to a substantial extent by importation from a country which is not a WTO member state;
- (c) where the patented invention is capable of being commercially worked in Jamaica, that it is being prevented or hindered from being so worked-
 - (i) where the invention is a product, by the importation of the product from a country which is not a WTO member state;
 - (ii) where the invention is a process, by the importation of a product obtained directly by the 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 any patented product made in Jamaica is not being supplied;
 - (ii) the working or efficient working in Jamaica of any other patented invention which makes a substantial contribution to the art, is prevented or hindered; or
 - (iii) the establishment or development of commercial or industrial activities in Jamaica is unfairly prejudiced;
- (e) that by reason of conditions imposed by the owner of the patent on the grant of licences under the patent, or on the disposal or use of the patented product or on the use of the patented process, the manufacture, use or disposal of materials not protected by the patent, or the establishment or development of commercial or industrial activities in Jamaica, is unfairly prejudiced.

(2) Where-

- (a) an application is made under this section, on the ground that the patented invention is not being commercially worked in Jamaica or is not being so worked to the fullest extent that is reasonably practicable; and
- (b) it appears to the Court that the time which has elapsed since the publication of the notice of the grant of the patent, has for any reason, been insufficient to enable the invention to be so worked,

the Court may, by order, adjourn the application for such period as will, in its opinion, give sufficient time for the invention to be so worked.

(3) Any licence granted under section 45 on the ground mentioned in subsection (1)(d)(i) of this section, shall contain such provisions as appear to the Court to be expedient for restricting the countries in which any product concerned may be disposed of or used by the licensee.

(4) No order shall be made under section 45, in respect of a patent on the ground mentioned in subsection (1)(d)(ii) of this section, unless the Court is satisfied that the owner of the patent for the other invention is able and willing to grant to

the owner of the patent and his licensees a licence under the patent for the other invention on reasonable terms.

48. Supplementary provisions relating to licences

(1) Where, on an application made under section 45 in relation to a patent, the Court is satisfied that the manufacture, use or disposal of any material not protected by the patent is unfairly prejudiced by reason of conditions imposed by the owner-

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

the Court 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 Court thinks fit.

(2) Where an application is made under section 45 by a person who holds a licence under a patent, the Court may cancel the existing licence and grant a new licence or may amend the existing licence.

49. Exercise of powers on applications for non-voluntary licences

(1) The powers of the Court on an application for a nonvoluntary licence under section 45 in respect of a patent whose owner is not a WTO owner, shall be exercised with a view to securing the following general purposes, that is to say-

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

(2) Subject to subsection (1), the Court shall, in determining whether to make an order in relation to an application for a non-voluntary licence under section 45, take account of the following matters, that is to say-

- (a) the nature of the invention, the time which has elapsed since the publication 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 an order, to work the invention to the public advantage; and
 - (c) the risks to be undertaken by that person in providing capital and working the invention, if the application for an order is granted,
- but shall not be required to take account of matters that occurred subsequent to the making of the application.

50. Opposition to a non-voluntary licence to the Court

(1) The owner of the patent concerned or any other person wishing to oppose an application under section 45, may do so by filing the relevant court documents to oppose the application and the Court may consider any such opposition in deciding whether to grant the application under section 45.

(2) Where an order has been made under section 45 or pursuant to an application under subsection (1) in respect of a patent whose owner is a WTO owner-

- (a) the owner or any other person may apply to the Court to have the order revoked, on the ground that the circumstances which led to the making of the order have ceased to exist and are unlikely to recur;
- (b) any person wishing to oppose an application for revocation under paragraph (a) may do so by filing the relevant court documents to oppose the application; and
- (c) the Court shall consider any documents filed at the court in opposition in deciding whether to grant the application.

(3) If it appears to the Court, on an application for revocation under paragraph (a), that the circumstances which led to the making of the order have ceased to exist and are unlikely to recur, the Court may-

- (a) revoke the order; and
- (b) terminate any licence granted to a person in pursuance of the order, subject to such terms and conditions as the Court thinks necessary for the protection of the legitimate

interests of the person.

- (4) Where an appeal is brought against-
- (a) an order made by the Court in pursuance of an application for a non-voluntary licence under section 45;
 - (b) a revocation made by the Court under this section; or
 - (c) the refusal of the Court to make such an order for revocation, the Attorney-General or such other counsel as the Attorney-General may appoint, shall be entitled to appear and be heard.

51. Special provisions re patented inventions worked in a country

(1) The Court may not (otherwise than in the public interest) make an order in respect of a patent pursuant to an application for a non-voluntary licence under section 45, if the invention 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 work is being met by importation from that country.

(2) In subsection (1), "relevant country" means a country other than a WTO member state whose law makes 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.

PART VII - Use of Patented Invention by Government

52. Use of invention in service of Government

(1) Subject to sections 54 and 57, and any rules in relation thereto, but notwithstanding any other provision of this Act, the Government or any person authorized in writing by the Government (hereinafter referred to as an "authorized person") may, pursuant to an order made under section 53, use for the service of the Government, any invention specified in subsection (2).

(2) Subsection (1) applies to any invention which-

(a) is a patented invention; and

(b) in the opinion of the Minister, is necessary in the public interest, including national security, national health, national nutrition or the development of other vital sectors of the society.

(3) Anything done by virtue of subsection (1), shall not amount to an infringement of the patent concerned.

(4) For the purposes of this section and section 57 -

(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 service of the Government;

(b) the power of the Government or an authorized person to sell a patented invention shall not, in the case of a patent relating to an integrated circuit, extend to the sale of the invention to the public.

(5) The right conferred by this section to use an invention may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the rights holder, on reasonable commercial terms and conditions, and such efforts have not been successful within a period of ninety days.

(6) The requirement under subsection (5) to make efforts to obtain authorization may be waived by a party in the case of a national emergency or other circumstance of extreme urgency or in case of public non-commercial use.

(7) 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 Government.

53. Minister may allow for the use of invention in service of the Government

(1) The Minister may, by order published in the Gazette, allow for any use pursuant to section 52(2) of any invention.

(2) Where the Minister makes an order under subsection (1), such use shall for the purposes of this Part, be deemed to be a use for the service of the Government.

54. Minister shall inform owner of order in respect of patent

Where an order is made under section 53(1), the Minister shall use the Minister's best efforts to inform the rightful owner of that patent as soon as practicable that the order has been made.

55. Rights of third parties in respect of Government

(1) In relation to an invention which is being used pursuant to an order under section 53(1) by the Government, the provisions of any licence, assignment or agreement made, whether before or after the appointed day, between the patentee or any person from whom the patentee derives title and any person, other than the Government, 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.

(2) The reproduction or publication of any model, document or information in connection with the use referred to in subsection (1), shall not be deemed to be an infringement of any copyright or registered design right subsisting in the model, document or information referred to in that subsection.

(3) The patentee or other person having an interest in the patent may apply to the Minister for the variation or revocation of an order made under section 53(1), on any of the grounds set out in

subsection (4), and the applicant shall have the right to be heard on the matter.

(4) The grounds referred to in subsection (3) are-

- (a) the use of the invention in the service of the Government is no longer necessary in the public interest, and the circumstances that had made it necessary are unlikely to recur; or
- (b) the terms of the order are not being complied with.

(5) The Minister shall in writing notify the applicant of the Minister's decision on the application, and provide the reasons therefor if the application is refused.

56. Reference of disputes regarding Government use

(1) Any dispute as to-

- (a) the exercise by the Government or an authorized person of the powers conferred by section 52; or
- (b) the terms for the use of an invention for the services of the Government under that section,

may be 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 the Government or an authorized person is a party, that party may-

- (a) if the patentee is a party to the proceedings, apply for revocation of the patent upon any ground on which a patent may be revoked under section 59;
- (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 may have regard to-

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

57. Patentee's right to compensation

(1) Where an invention is used for the service of the Government under section 52, the Government shall-

- (a) pay to the owner of the patent such compensation as may be agreed or determined by an agreed method; or
- (b) in the absence of an agreement referred to in paragraph (a), such compensation as may be determined by a reference to the Court under section 56, on the application of either party.

(2) When determining the compensation, the Court may take into account any compensation from the Government that a person having an interest in the invention or the patent has received directly or indirectly, for the use of the invention.

PART VIII - Revocation and Surrender of Patents Revocation

58. Revocation by Registrar

(1) At any time, within twelve months after the grant of a patent, any interested person may apply to the Registrar, in the form set out as Form 9 in the First Schedule and upon the payment of the fees prescribed in Part A of the Second Schedule, for an order revoking the patent on any one or more of the grounds specified in section 59.

(2) Where an application is made under this section, the applicant shall notify the patentee within fourteen days after filing the application, and the Registrar shall give the patentee an opportunity to be heard before deciding the case.

(3) The Registrar may consult with an examiner, in such manner as the Registrar may determine, with respect to an application under this section.

(4) If, on an application under this section, the Registrar is satisfied that any of the grounds specified in section 59 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 specify, the specification is amended to the Registrar's satisfaction.

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

59. Grounds for revocation by the Registrar

(1) Subject to the provisions of this Act, a patent may, on the application of any person interested pursuant to section 58, be revoked by the Registrar on any of the following grounds-

- (a) the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (b) the patent was obtained in contravention of the rights of the person who has made the application under section 58(1) to the Registrar or, of any person under or through whom that person claims;
- (c) the invention was not patentable by virtue of section 4;
- (d) 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;
- (e) the scope of any claim of the specification is not sufficiently and clearly defined, or is not based on the matter disclosed in the specification;
 - (f) the patent was granted on false information or a false representation; or
 - (g) the patent was granted contrary to law.

(2) For the purpose of subsection (1)(e) or (f), no account shall be taken of any secret use of the invention.

(3) 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.

60. Procedure for surrender

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

(2) On receipt of an 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 by any interested party.

(3) The fee for advertisement of surrender by the Registrar is the fee prescribed in Part A of the Second Schedule.

(4) Any interested person may, within fourteen days of the publication of the advertisement, give notice of opposition to the surrender to the Registrar, in the form set out as Form 5 in the First Schedule, accompanied by the fees prescribed in Part A of the Second Schedule and the Registrar shall then notify the patentee thereof.

(5) After hearing the patentee and any opponent (if desirous of being heard), the Registrar may accept the offer if the Registrar is satisfied that the patent may properly be surrendered and the patent shall cease to have effect from the date when the Registrar accepts the offer.

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

61. Record of revocation or surrender

The Registrar shall enter in the Register of Patents, particulars of any revocation or surrender of a patent under this Part.

PART IX - Infringement of Patent

Infringement of Patent

62. Acts constituting infringement of patent

(1) Subject to section 63, 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 or authorizes to be done in Jamaica any of the following acts in relation to the invention-

- (a) where the invention is a product, making, disposing of, offering to dispose of, using or importing the product, or keeping it, whether for disposal or otherwise;
- (b) where the invention is a process-
 - (i) using or offering for use, the process in Jamaica -when the person knows, or it would be 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) disposing, offering to dispose of, using or importing any product obtained directly by means of that process or keeping any such product whether for disposal or otherwise.

(2) Subject to section 64, a patent is also infringed by a person who, in Jamaica, while the patent is in force and without the consent of the owner of the patent, supplies or offers to supply to, or authorizes the supply or the offer to supply to, 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 the purpose of putting the invention into effect in Jamaica, when-

- (a) the person knows; or
- (b) it would be 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).

63. International exhaustion

The rights conferred by the registration of a patent shall not extend to an act in respect of an invention which has been put on the market in any country by the owner of the patent or with the consent of the owner.

64. Exception to infringement

(1) An act shall not constitute an infringement of a patent, if that act-

- (a) permits the working of an invention intended for medical or therapeutic use for the purpose of obtaining the necessary regulatory approvals in Jamaica or a foreign country before the expiry of the patent, in anticipation of the introduction into the market of a medicinal or therapeutic product after the patent has expired;
- (b) is done privately and for purposes which are non-commercial;
- (c) is experimentation on the invention for non-commercial purposes, such as in order to test or improve that invention;
- (d) is done for experimental, educational or research purposes, relating to the subject matter of the invention;
- (e) consists of the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a registered medical practitioner or registered dental practitioner, or consists of dealing with a medicine so prepared;
- (f) consists of the use, exclusively for the needs of a relevant ship, of a product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, in a case where the ship has temporarily, or accidentally entered the internal or territorial waters of Jamaica;
- (g) consists of the use of a product or process in the body or operation of an aircraft or vessel which has temporarily, or accidentally, entered or is crossing Jamaica (including the air space above it or its territorial waters) or the use of accessories for such an aircraft or vessel;
- (h) consists of the use of an exempted aircraft which has lawfully entered or is lawfully crossing Jamaica, or of the importation into Jamaica or the use or storage in Jamaica of any part or accessory for such an aircraft; or
- (i) constitutes the import and resale of a patented product from another country, where it was put on the market by the owner

or with the owner's consent in the required legal manner.

(2) For the purposes of section 62(2), a person who does an act in relation to an invention, which is prevented only by virtue of paragraph (b), (c), (d) or (e) of subsection (1) from constituting an infringement of a patent for the invention, shall not be treated as a person entitled to work the invention however-

- (a) the reference in subsection 62(2) to a person entitled to work an invention includes a reference to a person entitled under section 52; and
- (b) a person entitled to do an act in relation to the invention without it constituting an infringement under this section, shall, so far as concerns that act, be treated as a person entitled to work the invention.

(3) In this section-

"exempted aircraft" means an aircraft to which section 18 of the Civil Aviation Act applies;

"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 aircraft or vessel" means an aircraft or vessel registered in or belonging to any country which is a party to the Paris Convention, other than Jamaica;

"relevant ship" means a ship registered in or belonging to any country which is party to the Paris Convention, other than Jamaica.

Infringement Proceedings

65. Power to institute proceedings

(1) Subject to the provisions of this section and section 67, 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 any one or more of the following-

- (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 a successful application made under subsection (1), award the owner of the patent, both damages and an account of profits.

66. Burden of proof

(1) For the purposes of proceedings for infringement of a patent relating to a process, the burden of establishing that a product was not made by the process shall lie on the defendant where-

- (a) the product is new; or
- (b) a substantial likelihood exists that the product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

(2) In proceedings under this Part, the Court shall take into account the legitimate interests of the defendant in not disclosing his manufacturing and business secrets.

67. Infringement proceedings by co-owner

(1) Section 62 shall apply in respect of a patent having two or more joint owners, as if the reference in that 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 38 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 38 or such agreement, is or are the proper person or persons to give the requisite consent.

(2) Subject to 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, but shall not do so unless the others are made parties to the proceedings.

(3) An owner, if made a defendant in infringement proceedings, shall not be liable for costs, unless the owner enters an appearance or files an acknowledgment of service and takes part in the proceedings.

68. Infringement proceedings by exclusive licensee

(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the owner of the patent to bring proceedings in respect of an infringement of the patent committed after the date of the licence, and other 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 shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee, as a result of the infringement.

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

69. Restrictions on damages etc., for infringement

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

- (a) damages may not be awarded; and
- (b) an order for an account of profits may not be made, if a defendant proves that at the date of the infringement, the defendant was not aware or 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) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before allowing the amendment, unless the Court is satisfied that the specification of the patent, as published, was framed in good faith and with reasonable skill and knowledge.

70. Use begun before priority date or filing date

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

- (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 that person's partners for the time being in that business; and
- (b) assign that right or bequeath it on death (or, in the case of a 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 that other person, may deal with the product in the same way as if it had been disposed of by the owner of the patent.

71. Relief for infringement of partially valid patent

(1) If, in proceedings for infringement of a patent, the validity of the patent is put in issue and it is found that the patent is only partially valid, the Court 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) in the form of damages or costs, unless the claimant proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge, and in that event, the Court may grant relief in respect of that part of the patent which is valid, subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

(3) As a condition of relief under this section, the Court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 18, and an application may be so made, whether or not all other issues in the proceedings have been determined.

72. Unregistered transaction, etc., in infringement proceedings

(1) Subsection (2) shall apply in any case where, in relation to a transaction, instrument or event by which rights in a patent are assigned, licensed or transferred, a person becomes the owner or one of the owners or an exclusive licensee of a patent, and the patent is subsequently infringed.

(2) The Court shall not award costs to a person referred to in subsection (1) or order that that person be given an account of the profits in respect of an infringement occurring before the transaction, instrument or event is registered, unless-

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

73. Infringement of rights after publication of patent application

(1) Subject to subsection (3), an applicant for a patent for an invention has, from the date of the publication of the application until the date of the grant of the patent, the same right as that applicant would have had if the patent had been granted on the date of publication of the application, to bring proceedings in the Court for damages in respect of any act which would have infringed the patent.

(2) Subject to subsection (3)-

- (a) references in sections 62, 63, 64, 65, 67, 68, 69, 70, 71 and 72 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 have, if the patent had been granted on the date of the publication of the application, infringed not only the patent, but also the claims (as interpreted by the description and any drawings referred to in the description or claims) in the form in which they were contained in the application immediately before the preparations for its publication were made by the Office.

74. Certificate of validity

- (1) If, in any proceedings before the Court, the validity of a

patent is contested to any extent, and that patent is found by the Court to be wholly or partially valid, the Court may grant an order certifying the validity of the patent and the fact that the validity of the patent was so contested.

(2) Where an order certifying the validity of a patent is granted under this section, then a party-

- (a) if in any subsequent proceedings before the Court for infringement of the patent concerned or for revocation of the patent; and
 - (b) relying on the validity of the patent as found in the proceedings referred to in subsection (1),
- shall, unless the Court otherwise directs, be entitled to costs as between the party and his attorney-at-law, when final judgement has been given in favour of the party.

PART X - Utility Models

75. Application for a utility model

An application made to the Registrar to register a utility model in respect of an invention, shall be in the form set out as Form 10 in the First Schedule, accompanied by the fee prescribed in Part A of the Second Schedule.

76. Conversion of utility model applications into patent applications

(1) At any time before the grant or refusal of a patent, an applicant may, in the form set out as Form 11 in the First Schedule accompanied by the fee prescribed in Part A of the Second Schedule, apply to the Registrar to convert the application into an application for a utility model, and the application shall be accorded the filing date of the initial application.

(2) At any time before the grant or refusal of a utility model the applicant may apply to the Registrar to convert the application into an application for a patent, which shall be accorded the filing date of the initial application.

(3) An application made under subsection (2) shall be in the form set out as Form 11 in the First Schedule accompanied by the fees prescribed in Part A of the Second Schedule.

(4) An initial application under subsection (1) or (2) may not be converted, more than once.

77. Application of patent provisions to utility models

Except as otherwise provided under this Part, the provisions of this Act relating to patents and patent applications shall, apply with the necessary modification to utility models and applications in respect thereof.

78. Special provisions relating to utility model

(1) An invention qualifies for a utility model if it is new and capable of industrial application.

(2) Sections 4, 6, 20, 24 and 25 and Part IV, shall not apply to utility models.

79. Duration of utility model

A utility model shall expire without the possibility of renewal at the end of the tenth year after the date of the filing of the application.

80. Grounds for revocation of a utility model

An application for the revocation of a utility model may be made to the Registrar in the form set out as Form 9 in the First Schedule and accompanied by the fee prescribed in Part A of the Second Schedule and only on the grounds-

- (a) that the claimed invention did not qualify for a utility model under this Part; or
- (b) mentioned in section 59 (a), (b), (d), (e), (f) or (g).

**PART XI - Protected Designs Application
for Registration of Designs**

81. Interpretation in this Part

In this Part-

"Common Regulations" mean the Common Regulations under the 1999 Act, and the 1960 Act of the Hague Agreement, as last revised;

"design" means-

- (a) any composition of lines or colours; or
- (b) any three dimensional form, (whether or not associated with lines or colours),

which gives a special appearance to the product of industry or handicraft and serves as a pattern for a product of industry or handicraft;

"designer" in relation to a design, means the person who creates it and in relation to a computer generated design, the person who creates or commissions its creation;

"international application" means an application for international registration;

"international registration" means the international registration of a design effected according to the 1999 Act;

"Locarno Agreement" means the Agreement establishing an International Classification for Industrial Design signed at Locarno on the 8th day of October, 1968.

82. Application of Part

Design protection is not applicable to anything in a design which serves solely to obtain a technical or functional result, to the extent that it leaves no freedom as regards arbitrary features of appearance.

83. Registrable design

(1) A design is registrable if it is new, has individual character and is not contrary to public order or morality.

(2) A design is new if, before the filing date of an application for registration under this Act or before the priority date properly claimed for the design, the design has not been made available to the public anywhere or at anytime (through description, use or in any other manner), or there has not been prior disclosure of the design in Jamaica.

(3) Account shall not be taken of a disclosure referred to in subsection (2) which occurred earlier than the applicable date referred to in subsection (2), if such disclosure occurred within the period of twelve months immediately prior to such date, and was due to or made in consequence of-

- (a) the matter having been obtained unlawfully or by any person from the designer or from any other person to whom the matter was made available in confidence by the designer;
- (b) a breach of confidence by any person who obtained the matter in confidence from the designer or from any other person to whom it was made available, or who obtained it, from the designer; or
- (c) the designer having displayed the design at a local, regional or international exhibition, and the applicant-
 - (i) states, on filing the application that the design has been so displayed; and
 - (ii) files, within the prescribed period, written evidence in support of the statement complying with any prescribed conditions.

(4) Paragraphs (i) and (ii) of subsection(3)(c) shall not apply to international applications.

(5) A design has individual character if the overall impression it produces on the informed user differs from the overall impression produced on the informed user by any design which has been made available to the public before the date on which the application for the registration of the design was filed or is treated as filed.

(6) In determining the extent to which a design has individual character, the degree of freedom of the designer in creating the design shall be taken into consideration.

(7) A design shall not be registrable under this Act if it involves the use of-

- (a) a representation of the Coat of Arms of Jamaica, national flag of Jamaica, armorial bearings, official signs or hallmarks, or other national symbol or emblem of Jamaica, or anything, the heraldic elements of which, in the opinion of the Registrar, imitates any such flag, armorial bearings or other emblem, sign or hallmark, unless consent is obtained from the Government of Jamaica;
- (b) the country name of Jamaica or abbreviations or homonyms thereof, the map of Jamaica or national colours of Jamaica, unless the Registrar is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the country Jamaica;
- (c) the name of another country, or abbreviations or homonyms thereof, unless the Registrar is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the relevant country;
- (d) the flag, armorial bearings or any other state emblems, official signs or hallmarks of a Convention Country, or anything, the heraldic elements of which, in the opinion of the Registrar, imitates any such flag, armorial bearings or other emblem, sign or hallmark, unless the authorization of the competent authority of that country is obtained;
- (e) the emblems, abbreviations and names of an international organization, unless consent is obtained from that organization;
- (f) an unregistered trade mark or other sign used in the course of trade in Jamaica, unless consent is obtained from the trade mark owner;
- (g) a trade mark registered in Jamaica, unless consent is obtained from the trade mark owner;
- (h) a copyright work, unless consent is obtained from the copyright owner;
- (i) the image or likeness of a n individual, unless consent is obtained from the individual;
- (j) the traditional knowledge or traditional cultural expressions of indigenous or local communities, unless authorization is

obtained from the relevant community or where it is not practicable to obtain such authorization the Registrar is satisfied that such use is not likely to mislead the public as to the existence of a connection between the origin, nature or quality of the articles to which the design is to be applied and the relevant community.

84. Who may apply to register design

(1) An application for the registration of a design may be made by any person claiming to be the designer or (if the designer is not the owner) the owner of the design and may be made by that person alone or jointly with any other person.

(2) Subject to subsection (1), an application may be made 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.

85. Application for registration of design

(1) Subject to subsection (6), an application for the registration of a design shall be filed with the Registrar in accordance with this section in the form set out as Form 12 in the First Schedule and shall be accompanied by the fees prescribed in Part A of the Second Schedule.

(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 class and kind of products, under the Locarno Agreement or as may otherwise be prescribed to which the design shall 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 design.

(3) An application may also contain a request accompanied by the fee prescribed in Part A of the Second Schedule that upon examination and subsequent acceptance of the application for registration the full publication of the 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) Where a request for deferment of publication is made under subsection (3), the Registrar shall publish a notice of deferment, which shall contain information identifying the applicant, the filing date of the application, the length of time for which deferment has been requested, and any other particulars as may be prescribed.

However, no representation of the design or any file relating to the application shall be open to the public for inspection.

(5) At the expiry of the period of deferment, after examination and subsequent acceptance of the application for publication, the applicant shall pay the publication fee prescribed in Part A of the Second Schedule within one month and the Registrar shall fully publish the application, but if the applicant fails to pay the publication fee pursuant to section 90(4) within one month of the expiry of the period of deferment, the Registrar may treat the application as withdrawn.

(6) An international application filed at the Office shall be filed with the Registrar in accordance with the Common Regulations, in the form set out in the Common Regulations and shall be accompanied by the fees prescribed in the Common Regulations and the transmittal fee prescribed in Part A of the Second Schedule.

(7) An international application may be made for designs (not exceeding one hundred in total) provided that the designs referred to therein, belong to the same class of the Locarno Agreement.

(8) Each design referred to in the same international application shall be in relation to one single product and belong to one single class and sub-class of the Locarno Agreement.

86. Effects of international registration designating Jamaica

(1) The international registration shall from the filing date, have the same effect in Jamaica as a regularly filed application for the grant of protection of the design under this Act.

(2) Where the Office has not communicated to the International Bureau a refusal in accordance with Article 12 of the 1999 Act, the international registration shall have the same effect as a grant of protection for the design under this Act from the filing date of the international registration.

(3) Where the Office has communicated to the International Bureau a refusal and has subsequently withdrawn in part or in whole, that refusal, the international registration shall, to the extent that the refusal is withdrawn, have the same effect in Jamaica as a grant of protection for the design under this Act from the filing date of the international registration.

87. Withdrawal of application for design

An application to register a design, may be withdrawn by the application in writing before the application is determined.

88. Filing date of design application

Subject to the provisions of this section, the filing date of an application for the registration of a design, shall be the earliest date on which an application, accompanied by the fee prescribed in Part A of the Second Schedule, is submitted to the Registrar.

89. Right of priority for design

(1) Subject to subsections (2), (3) and (4) the provisions of sections 12 and 13 shall apply with the necessary modification to applications under this Part.

(2) Where the date of the earlier filing is more than six months before the filing date of the international application, the priority claim shall not be included in the international registration.

(3) The provisions of subsection 12(4) shall not apply to international applications under this Part.

(4) The provisions of subsections 12(10) and 12(11) shall not apply to applications for registration of design.

90. Examination and publication of applications

(1) Subject to subsection (5), after assigning a filing date, the

Registrar shall upon payment of the prescribed fees in Part A of the Second Schedule examine whether the application satisfies the requirements of sections 83 and 84 and the rules prescribed in relation thereto.

(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 an application in the form set out as Form 13 in the First Schedule, and accompanied by the fee prescribed in Part A of the Second Schedule within the prescribed period, for the necessary corrections to be made and if the corrections are not so made, the application shall be refused.

(3) The applicant may at any time before the design is registered, make an application under subsection (2), to amend the particulars of the application.

(4) Where the Registrar is satisfied that the requirements referred to in subsection (1) have been met, the Registrar shall forthwith publish the application upon payment of the prescribed fee in Part A of the Second Schedule, unless the applicant has filed a request for deferment, in which case the application will be published at the expiry of the period of deferment upon payment of the publication fee.

(5) The Office shall not examine the international application filed through the Office pursuant to this Part, but shall transmit the international application to the International Bureau within one month of receipt of payment by the applicant of the transmittal fee prescribed in Part A of the Second Schedule.

(6) An international registration under this Part shall be published by the International Bureau in the International Designs Bulletin and such publication shall be deemed to be sufficient publication for the purposes of this Part.

91. Infringement of rights after publication of application for registration

(1) Subject to subsection (2), after an application is published and until the registration of the design, the applicant has the same privileges and rights as the applicant would have had if the

design had been registered, however, 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 design could not validly have been registered at the time the act was done.

(2) The applicant shall be entitled to bring proceedings by virtue of subsection (1) only after the design has been registered.

92. Opposition to application

(1) Any interested person may, within two months after the date of publication of the application, file with the Registrar, a notice of opposition to the registration of the design on the grounds that-

- (a) one or more of the requirements of sections 84 and 85 and rules prescribed in relation thereto are not met; or
- (b) the applicant does not have a right to the registration of the design.

(2) A notice of opposition filed under subsection (1) shall be in the form, set out as Form 14 in the First Schedule and shall be accompanied by the fees prescribed in Part A of Second Schedule.

(3) An interested person filing a notice of opposition under subsection (1) shall provide the applicant with a copy of the notice of opposition within fourteen days thereafter.

93. Registration of design

Where the registration of the design-

- (a) has not been opposed within two months after the date of publication of the application; or
- (b) has been opposed and the opposition has been decided in the applicant's favour,

the Registrar shall issue a certificate of registration of the design to the applicant.

94. Duration of registration; renewal fees

(1) Subject to the provisions of this Part, the initial registration of a design shall be in force for a period of five years from the filing date.

(2) The registration of a design may be renewed in the form set out as Form 15 in the First Schedule or in the case of an international application, the relevant form set out in the Common Regulations, and upon payment of the fee prescribed in Part A of the Second Schedule or in the case of an international application, the relevant fee prescribed in the Common Regulations in respect of each renewal.

(3) Subject to subsection (2), a registration of a design may be renewed for two consecutive periods of five years each within six months prior to expiration of the registration of the design.

(4) Subject to subsection (5), if the initial or any renewal period expires without an application for renewal or further renewal, the right in a registered design under this Part, shall cease and the Registrar shall, in accordance with such rules as may be prescribed, notify the owner of that fact.

(5) If during the six months immediately following the end of the expired period for renewal, an application for renewal is made and the prescribed renewal fee and late fee prescribed in Part A of the Second Schedule are paid, the right shall be treated as if it had never expired, with the result that-

- (a) anything done under or in relation to the right during that further period, shall be treated as valid; and
- (b) an act which would have constituted an infringement of the right if it had not expired, shall be treated as an infringement.

95. Ownership of design right

(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 (4), a design is created by an employee, in the course of that employment the employer is the first owner of any design right in the design.

(4) Subject to subsection (5), where an employee, under a contract of service is not required to engage in the creation of designs and the employee creates a design, then the employee is the first owner of the design right.

(5) The employer is the first owner of any design right in the design, where the employee referred to in subsection (4), creates a design by the use of information or means that the employer puts at the employee's disposal.

(6) An employee described in subsection (5) is entitled, subject to subsection (7), to compensation calculated with due regard given to the economic importance of the design the employee created.

(7) If an employer and employee fail to agree on the amount of the compensation, such compensation shall be determined by the Court.

96. Rights conferred by registration of design

(1) The registration of a design gives the owner the exclusive right to exploit the design and to prevent other persons from performing any of the following acts during the term of such registration-

- (a) reproducing the design in manufacturing of a product;
- (b) importing, offering for sale, or exposing for sale, or selling a product in or by which the design is reproduced; and
- (c) stocking any product described in paragraph (a) or (b) for the purpose of sale.

(2) An act described in paragraph (a) or (b) of subsection (1), does not fall outside the ambit of that subsection by reason only that-

- (a) a reproduction of a design differs from the protected design in minor respects; or
- (b) the reproduction concerns a type of product that is different from the protected design.

(3) The registered owner of a design may, subject to subsection (4), 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 with any necessary modification as those applicable under section 62 in relation to an infringement of patent.

(4) The rights conferred by the registration of a design, shall not extend to an act in respect of an article which has been put on the market in any country by the owner of the registered design or with the consent of the owner.

(5) In this section, "exploitation", in relation to a registered design, means making, selling, importing or otherwise distributing for commercial purposes, articles incorporating the design.

97. Infringement

(1) Subject to subsection (2), the right in a registered design is infringed by a person who, without consent of the registered owner does anything which by virtue of section 95 is the exclusive right of the owner.

(2) The right in a registered design is not infringed by -

- (a) an act which is done privately and for purposes which are not commercial;
- (b) an act which is done for experimental purposes;
- (c) an act of reproduction for teaching purposes or for the purpose of making citations, provided that the act of reproduction is compatible with fair trade practice, does not unduly prejudice the normal exploitation of the design, and is accompanied by mention of the source;
- (d) the use of equipment on ships or aircraft which are registered in another country but which are temporarily in Jamaica;
- (e) the importation into Jamaica of spare parts or accessories for the purpose of repairing such ships or aircraft; or
- (f) the carrying out of repairs on such ships or aircraft.

98. Revocation of registration of design

Subject to the provisions of this Part, the registration of a design may on the application of any interested person in the

form set out as Form 9 of the First Schedule and upon payment of the fee prescribed in Part A of the Second Schedule, be revoked by the Registrar on the ground that the requirements of sections 83 or 84, were not met.

**PART XII - Register of Patents, Register of Utility Models
and Register of Designs**

99. Provisions as to location and forms of Registers

The Register of Patents, the Register of Utility Models and the Register of Designs, shall be kept by the Registrar at the Office.

100. Particulars to be registered

(1) There shall be entered in the Register of Patents, Register of Utility Models and the Register of Designs, particulars relating to patents in force, registered utility models and registered designs, as the case may be, including-

- (a) particulars as to licences, assignments and transmissions of patents, utility models and registered designs;
- (b) changes of name, changes of address, mergers and other changes in legal nature of registered proprietors;
- (c) other particulars affecting the validity or ownership of patents, utility models and registered designs as the Registrar thinks fit; and
- (d) any other prescribed particulars relating to patents, utility models or registered designs.

(2) An applicant or proprietor may at any time, in the form set out as Form 16 in the First Schedule accompanied by the fee prescribed in Part A of the Second Schedule, request that any of the particulars mentioned in subsection (1) be entered in the Register.

(3) All documents filed in connection with the registration of particulars for patents, utility models and registered designs, shall be available for inspection under section 104.

101. Registers as evidence

(1) The Registers kept pursuant to section 99 shall be prima facie evidence of any matter required or authorized by or under this Act, to be entered in the Registers.

(2) If the Registers are wholly or partly kept in electronic form, a document signed and sealed by the Registrar reproducing in writing all or any of the particulars comprising the

Registers, or that part of the Registers as the case may be, is admissible in any proceedings as evidence of those particulars.

102. Trusts not registrable

Notice of any trusts, whether expressed, implied or constructive, relating to a patent, utility model or a registered design, shall not be registered.

103. Registration of assignment, etc

(1) Where a person becomes entitled-

- (a) by assignment, transmission or operation of law, to a patent, utility model or registered design or an application in relation to such patent, utility model or registered design or to a share in a patent, utility model or registered design; or
- (b) as licensee or otherwise, to any other interest, in a patent, utility model or registered design or an application in relation to such patent, utility model or registered design, such person shall apply to the Registrar in the form set out as Form 16 in the First Schedule and accompanied by the fee prescribed in Part A of the Second Schedule for the registration of that person's title as owner or as joint owner, as the case may be or notice of that person's 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, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under subsection (1), and the Registrar is satisfied as to the matters referred to in that subsection, the Registrar shall enter the particulars of the applicant in the Register as owner or joint owner of the patent, utility model or registered design (as the case may be), indicating the instrument or event by which the person derives title.

(4) Subject to-

- (a) the provisions of this Act relating to joint ownership of

patents, utility models or registered designs, as the case may be; and

- (b) any rights vested in any other person of which notice is required to be entered in the Register,

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

(5) The Registrar may require an applicant under this section to furnish the Registrar with such supporting documents and information as the Registrar considers necessary in connection with the application.

104. Inspection by public

(1) Subject to the provisions of this section, the Registers shall be available for inspection by the public at the Office-

- (a) during the hours that the Office is normally open for business; and
- (b) upon payment of the fee prescribed in Part A of the Second Schedule.

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

(3) Documents may be inspected pursuant to this section, upon payment of the fee prescribed in Part A of the Second Schedule.

105. Rectification of Register

A person aggrieved by-

- (a) the omission of an entry from the Register;
- (b) an entry made in the Register without sufficient cause;
- (c) an entry wrongly existing in the Register; or
- (d) an error or defect in an entry in the Register,

may apply to the Registrar for a rectification of the Register in the form, prescribed as Form 17 in the First Schedule accompanied

by the fee prescribed in Part A of the Second Schedule.

106. The Treaty or 1999 Act shall prevail

(1) Where there is a conflict between a provision in the Patent Cooperation Treaty and a provision in this Act, or where this Act is silent on any aspect concerning international applications or international registrations for patents, the Patent Cooperation Treaty, the Regulations thereunder and the Administrative Instructions under the Regulations shall prevail.

(2) Where there is a conflict between a provision in the 1999 Act and a provision in this Act or where this Act is silent on any aspect concerning international applications or international registrations for designs, the 1999 Act shall prevail.

Supplemental

107. Registrar may give information

The Registrar may give any person information regarding-

- (a) a patent, utility model or registered design;
- (b) an application for a patent, utility model or for the registration of a design; or
- (c) any prescribed document or matter.

108. Admissibility of unregistered particulars

A document in respect of which particulars have not been entered in the Register is not admissible in any proceedings in proof of the title to a patent, utility model or registered design, or to an interest in a patent, utility model or registered design, unless-

- (a) the Court or the Registrar before which the proceedings are brought so directs; or
- (b) the proceedings are for an order for rectification of the register under section 105 or to enforce equities in relation to a patent, utility model or registered design.

109. Immunity

The Registrar or officers employed to the Office shall not-

- (a) be taken to warrant the validity of any patent granted or design registered under this Act or any treaty or international convention to which Jamaica is a party; or

- (b) incur any personal 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.

110. Clerical errors and extensions of time

- (1) The Registrar may, upon application in the form set out as Form 6 or Form 13, as the case may determine, in the First Schedule and upon payment of the fee prescribed in Part A of the Second Schedule, correct any error of translation, transcription, clerical error or mistake in-
 - (a) any specification of a patent or application for a patent or utility model or for the registration of a design or application therefor; or
 - (b) any document filed in connection with a patent, utility model or registered design.
- (2) Where the Registrar is requested to correct such an error or mistake, any person may, in accordance with rules prescribed, give the Registrar notice of opposition in the form set out as Form 5 in the First Schedule, accompanied by the fee prescribed in Part A of the Second Schedule for a determination by the Registrar of the matter.
- (3) The Registrar may extend any period imposed by the Registrar under this Act for the doing of anything.
- (4) Any person who requests the Registrar to extend any period imposed under this Act for the doing of anything under this Act, shall do so in the form set out as Form 18 in the First Schedule accompanied by the fee prescribed in Part A of the Second Schedule.

111. Destroyed or lost certificates of registration of patents, designs and utility models

- (1) If a certificate of registration evidencing the grant of a patent or a design or a utility model is destroyed or lost, the Registrar may, on application by the owner, issue a certified copy in lieu of the original, upon payment of the fee prescribed in Part A of the Second Schedule.
- (2) An application made pursuant to this section shall be in the form set out as Form 19 in the First Schedule.

PART XIII - Offences

112. Falsification of Register

- (1) Any person who knowingly-
 - (a) makes or causes to be made, a false entry in any Register under this Act, or makes or causes to be made 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.

- (2) A person who knowingly commits an offence under this section shall be liable on conviction-
 - (a) before a Parish Judge, to a fine not exceeding five hundred thousand dollars or to imprisonment for a term not exceeding six months; or
 - (b) in the Circuit Court, to a fine or to imprisonment for a term not exceeding three years.

113. False claim as to patent rights, etc

- (1) A person who falsely represents that person or another person-
 - (a) is the patentee of an invention or the owner of a utility model or a registered design; or
 - (b) has applied for a patent, utility model or the registration of a design,commits an offence and shall be liable on summary conviction before a Parish Judge, to a fine not exceeding five hundred thousand dollars or to imprisonment for a term not exceeding six months.

- (2) A person who falsely represents that an article-
 - (a) sold by that person is patented or incorporates a registered design or utility model; or
 - (b) is the subject of an application for a patent, utility model or the registration of a design,commits an offence and shall be liable on summary conviction before a Parish Judge to a fine not exceeding five hundred thousand dollars or to imprisonment for a term not exceeding six months.

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

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

(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 properly applied to it.

PART XIV -Miscellaneous

114. Appeals

(1) Where any person is aggrieved by any decision or act of the Registrar, that person may-

- (a) within the time provided by or under this Act; or
- (b) within three months from the day the person became aware of the decision or act; or
- (c) within such further time as the Court may allow in accordance with the rules of Court, appeal the decision of the Registrar.

(2) Rules of Court may make provisions for the appointment of advisors to assist the Court in proceedings under this Act for any matter in relation thereto.

115. Selection of examiners

The Registrar may select persons or bodies (whether internal or external to the Office) to perform the functions of examiners under this Act, who in the opinion of the Registrar, possess the required skills, knowledge and experience to perform those functions.

116. Person may request search

(1) Any person may at any time request a search in the form set out as Form 20 in the First Schedule, accompanied by the fee prescribed in Part A of the Second Schedule.

(2) A request made under subsection (1) shall include as the case may determine, information regarding-

- (a) the title of the invention or design;
- (b) the description of the invention or design;
- (c) the abstract;
- (d) the claims;
- (e) any key words;
- (f) the name of the applicant or owner;
- (g) the application or registration number; and
- (h) any other information deemed necessary.

117. Fees

There shall be paid in respect of-

- (a) applications for the grant of patents and utility models and the registration of designs; and
 - (b) any other matters relating to patents and utility models and registered designs, arising under this Act,
- such fees as may be prescribed from time to time by the Minister.

118. Electronic documents and communications

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 an intelligible form within a reasonable time.

119. Notice may be sent by registered mail or electronic mail

Any notice required or authorized to be given by this Act or the rules, may be sent by registered mail or electronic mail.

120. Address for service within Jamaica

Every applicant shall provide and every application shall include an address for service within Jamaica.

121. Rules

- (1) The Minister may make rules generally for giving effect to the objects and purposes of this Act and for ensuring its due administration and, in particular, but without prejudice to the generality of the foregoing, rules may be made with respect to-
 - (a) the form and content of applications and registrations of patents, utility models and designs;
 - (b) the form of the Registers and of the indices thereto;
 - (c) the registration of assignments, licences or transmissions or other documents relating to any patent, utility model or registered design;
 - (d) the form and content of any certificate issued pursuant to this Act;
 - (e) the fees or the manner of determining the payment of fees that may be charged in respect of any matter under this Act;
 - (f) the carrying into effect of any treaty or other international agreement or arrangement relating to patents, utility models or designs to which Jamaica is a party or any amendment, modification or revision thereof made from time to time;

- (g) the submission of, or the entering or recording of, information or any document under this Act;
- (h) the manner in which an application for a patent, utility model or registered design or a request for priority may be withdrawn;
- (i) requests for priority and examination;
- (j) the appointment of advisors or an examination committee consisting of persons with expertise in patents;
- (k) the procedure to be followed in any proceeding or other matter before the Registrar, including the mode of giving evidence and in particular-
 - (i) empowering the Registrar to compel the attendance of witnesses and the discovery and production of documents; and
 - (ii) authorizing the rectification of irregularities of procedure; and
- (l) any other matter required to be prescribed by any provision of this Act.

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

122. Excluded days for period for filing

Where the last day of the period for filing an application is a Saturday, Sunday or public general holiday (within the meaning of Holidays (Public General) Act) or the Office is not open for the filing of applications in the country where protection is claimed, the period for filing the application shall be extended until the next following day that does not fall on any of such days.

123. Minister may amend monetary penalties

The Minister may, by order subject to affirmative resolution, amend or vary any monetary penalty imposed by this Act.

124. Act binds the Crown

This Act binds the Crown.

Repeal, Saving and Transitional Provisions

125. Repeal of Patent Act and Designs Act

The Patent Act, 1857 and the Designs Act, 1937 (hereinafter called the repealed Acts) are hereby repealed.

126. Saving

Any patent or design registered, or any document 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 to have effect as if it had been made or done under the corresponding provision of this Act, as if the provision was in force when the document was made or thing was done.

127. Transitional

(1) Notwithstanding their repeal by this Act, the repealed Acts, shall, as the case may require, continue in force and govern-

- (a) applications made for the grant of patents or the registration of designs before the appointed day; and
- (b) patents granted and designs registered before the appointed date.

(2) Nothing in this Act shall affect any proceedings commenced before the appointed day for the revocation or infringement of a patent or registered design.

(3) The Rules made under the repealed Acts, shall, except where they are inconsistent with this Act, continue to have effect as though made under this Act until expressly repealed by the rules or any other enactment.

(4) Upon the coming into force of this Act, the Office shall exercise all the powers of the Attorney General in respect of petitions for Letters Patent filed under the Patent Act, 1857, which are pending as at the date of the coming into force of this Act.