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ISSUE 450 JUNE 2019

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FROM JAMAICA, WITH PRIORITY

Katherine Van Deusen Hely reveals why the country is a top destination for stealth filings

The world's most famous (if fictional) spy, James Bond, was brought to life by Ian Fleming at his Goldeneye estate on the Caribbean island of Jamaica. And more than 60 years later, Jamaica can still provide Mr Bond's spirit of covertness, albeit in the arguably less exciting world of trade mark filings.

It is no secret that mark owners, especially those involved in rapidly developing and competitive fields, have sought out locations where they can file trade mark applications out of the public eye. These filings, sometimes called "stealth filings" or "submarine filings", allow mark owners to temporarily hide their trade mark filings from competitors and the public at large. All the while, they can still secure early protection of their marks around the world. To this end, mark owners have looked to far-flung locales, including islands in



“ *Most stealth filings remain under wraps until after priority-based applications are filed elsewhere* ”

Jamaica is a popular location to file trade mark applications under the radar

the Caribbean and South Pacific, to begin the process under the radar. For example, since 2013, Apple Inc. has filed more than 25 marks with the UK IPO claiming priority based on an earlier Jamaican filing.

One makes a stealth filing by first filing the mark with a relatively opaque registry and later using that filing to claim Paris Convention priority. This allows up to six months of some protection without publicly broadcasting one's newest mark.

There are two requirements: Paris Convention membership and secrecy. Most nations, including Jamaica, have membership in the Paris Union. Secrecy requires more research: with the rise of online trade mark search, greater scrutiny of the jurisdictions' law and practice has become necessary.

The Jamaica Intellectual Property Office (JIPO) operates a computerised

trade mark database, but data on pending applications is not available online. A search must be performed in JIPO's offices or a request can be made for the registry staff to complete the search. Importantly, the JIPO interprets the applicable rules to allow only proprietors or their agents to see any pre-publication application results when completing a proprietor search. Third parties should learn of a pending application only if it is revealed in a conflict search or cited against an application in an official action. This represents a

departure from the JIPO practice of just a few years ago, when third parties could discover unpublished applications via a proprietor search.

The change is positive for stealth filers and may obviate some of the need for straw-man applicant entities (and the attendant risks). Moreover, the publication timeline in Jamaica is typically greater than six months, meaning most stealth filings remain under wraps until after priority-based applications are filed elsewhere.

In addition to its effective and privacy-conscious registry, as an English-speaking, common-law, Commonwealth nation, it is especially attractive to UK filers and others sharing the common-law tradition. Jamaica's Trade Marks Act is based in part on the UK Trade Marks Act 1994 and mandates use of the Nice Classification system. Applications can be made on an intent-to-use basis and for relatively low official fees (initial filing fee is approximately £45, plus £13 for each additional class). When one needs certified copies of a Jamaican application to claim priority elsewhere, copies can be obtained relatively quickly and at a low cost (approximately £3 per page). Jamaica's location makes communications efficient with both the Americas and Europe. Finally, in comparison to the other usual suspects for stealth filings, Jamaica has a relatively large population, economy and tourism industry, so the filer may find greater long-term value in a Jamaican mark.

For all these reasons, when circumstances demand privacy and protection, Jamaica should be a top contender for stealth filings.



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