

THE MADRID PROTOCOL – SHOULD JAMAICA SIGN ON?*

Jamaica is an island nation in the Caribbean. It is south of Cuba and is only 4111 sq miles. The population size is 2.7 million. It is a beautiful country known for its warm sunshine and white sand beaches. It has a very rich culture especially in music known as reggae. As part of its cultural matrix, it is common to hear that everything is *Criss*.¹ *Criss* is a part of the Dancehall culture which is indigenous to Jamaica. *Criss* means that everything is great, people are happy or that something is simply wonderful. Although it has its origins in Dancehall culture, for a time it was a household word in Jamaica. *Criss*'s extension as part of the local culture was seized upon by free enterprise and it was registered as a trademark and a domain name by a corporation in Jamaica. It became the first dancehall music station in Jamaica. It registered trademarks, *Crissfm* and eight derivatives of the *Criss* name. *Crisstv* is one of those trademarks. *Crissfm* started to operate in 1980. It did not register *Crisstv* as a domain name. This fact is not surprising as no one foresaw the rise of IPTv in the 21st century. By 2000, *Criss* became a famous mark. This is largely because of its association with the culture especially reggae music.

Criss had problems. There were registrations using the *Criss* name in California, Jamaica and New York. The New York entity is up and running and offering Jamaican content. There were also online infringements at my.space.com out of the former Yugoslavia and Manchester in the United Kingdom. Is *Criss* in danger of losing market share? The short answer is yes.

* M. Georgia Gibson-Henlin (LL. M. University of Toronto), Attorney –at – Law, (Jamaica);
Barrister & Solicitor – Ontario, Canada.

¹ Name changed to protect the identity of the persons

The infringements are online. None of them is about the make-up of a bottle or design. They are doing business as if they are Criss. It is not about a single product and it is likely to get worst. WIPO figures confirm that fact. The infringers have moved from targeting a single product, they are taking up online spaces so that persons are being forced to buy back their brand – cybersquatting. WIPO’s 2007 figures show that for that year there was a 48% over 2005 and 18% over 2006. The infringements are therefore multijurisdictional. Online dispute resolution is extra- jurisdictional and appears to be limited to cybersquatting or its derivatives.

The protection afforded by an international system of registration must be seen as a first line of attack and the best offensive against these infringers. This is because had to enforce its right to use the mark in each country where the infringement occurred. It was both costly and tedious. The international system is governed by the Madrid Protocol Relating to the Madrid Agreement. It was adopted in 1989 (the Protocol). It came into force on December 1, 1995 but only became effective on April 1, 1996.

Business interests in Jamaica would be well advised to lead the drive for an international system to protect their marks. They could inform government policy by stating the business and marketing considerations that underpin the need for protection. Some of these considerations include the following:

1. Identifying for the government the products and services in the sector that require protection.
2. The life of the mark and options for renewal and preservation.

3. Identifying whether there are any common market agreements in the primary and other markets for the products and services.
4. Regional Intergovernmental Organisations that could cause the benefit to be extended to the citizens and nationals of the members states until the individual member states make a decision.
5. Geographical areas where the competitors are likely to be based and/or are marketing their products and whether those competitors have access to the any system of international registration.
6. The potential for infringement.
7. International registration means both protection and enforcement and therefore the costs of these under such a unitary system as less as opposed to a fragmented system.

The Protocol adopts and is in keeping with the various international classifications. There is only one registration. This is filed at the international office. This filing must be done through the applicant's office of origin that is in Jamaica.² The office of origin is the office to which the applicant has the necessary connection. Criss's registration of the mark at JIPO can be the basis for the international application although it could also rely on an application for registration. There is a strict requirement that the international application must be presented at JIPO.

The Protocol simplifies the overall management of the mark because by a single action it can record subsequent changes such as a renewal or assignment. The mark achieves the protection as if it had been registered individually in each country that has been designated. An international registration is a bundle of national registrations, achieved in a single step over a period of at most eighteen (18) months.

² The Jamaica Intellectual Property Office.

There is a legitimate concern for Jamaica. Countries that have signed on to the Protocol have noticed a significant downturn in their registrations especially when like Jamaica they are importers of Intellectual Property. However, this can be counterbalanced by increased protection for local businesses. Further there is likely to be the need for other services such as searches and oppositions. It is not enough to search the trade mark register. There may be common law marks or business names that are similar to marks if Jamaica is designated. By not signing the treaty, entities such as Crissfm may suffer multijurisdictional infringements.