

# STATES OF JERSEY



## **DRAFT INTELLECTUAL PROPERTY (REGISTERED RIGHTS) (MISCELLANEOUS PROVISIONS) (JERSEY) LAW 201-**

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**Lodged au Greffe on 3rd July 2015  
by the Minister for Economic Development**

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**STATES GREFFE**





Jersey

**DRAFT INTELLECTUAL PROPERTY  
(REGISTERED RIGHTS) (MISCELLANEOUS  
PROVISIONS) (JERSEY) LAW 201-**

**European Convention on Human Rights**

In accordance with the provisions of Article 16 of the Human Rights (Jersey) Law 2000, the Minister for Economic Development has made the following statement –

In the view of the Minister for Economic Development, the provisions of the Draft Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201- are compatible with the Convention Rights.

Signed: **Senator L.J. Farnham**

*Minister for Economic Development*

Dated: 1st July 2015

## REPORT

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### Overview

Intellectual property (IP) rights support innovative activity and can lead to increases in the profitability of a business investing in such activity. Products and services protected by IP rights ensure that there can be a reward for investment in innovation. IP rights can therefore be a valuable business asset. Ensuring that the laws making provision about IP in Jersey are modern and consistent with international standards is therefore an important policy objective for encouraging businesses of many types to locate and invest in the Island. Membership of the World Trade Organisation (WTO) also requires IP laws to specified standards to be in place and so Jersey must meet these if it desires the wider benefits of WTO membership.

The States approved the new Law making provision compliant with international conventions about unregistered intellectual property rights, particularly copyright, in December 2010, which came into force in December 2012. This was an important milestone underpinning the work to diversify the economy in the area of e-commerce in particular and was the first stage of modernising Jersey's intellectual property laws.

Registered IP rights can, though, also be important to support business activity in the area of e-commerce. For example, trade marks can brand a product or service being offered to the public online. Trade marks can be used to develop loyalty for a brand, often linked to a reputation for quality. Trade Marks are also important to rights holders to protect their products and services from misappropriation by others. Patents may arise in the inventive technical solutions that enable creative content to be delivered to consumers and enjoyed by them at home or on the move.

Registered IP rights can be crucial to other areas that are innovative too. Many goods and services are still made available to the public in the physical world and trade marks can be just as important to these as they are to goods and services sold online. A registered design right can be sought for the shape or visual appeal of any product or part of a product. This includes both 3-dimensional and 2-dimensional products, whether they are industrially produced or handcraft items. New designs might therefore be developed for many things, such as the shape of a car body, the appearance of a piece of jewellery, the configuration of a chair, the pattern on wallpaper or the style of a dress. Patents can apply to both products and processes that involve an inventive step. Businesses offering services to those who wish to acquire or already own IP rights are also affected by the nature of the law about registered IP rights. Ensuring the laws in Jersey about registered IP rights are modern and compliant with international conventions is therefore the priority now.

At the moment there are 3 laws in Jersey making provision about IP rights that arise as a result of registration, namely laws relating to trade marks, patents and registered designs. The laws essentially provide for re-registration of IP first registered in the UK. UK laws comply with the main international conventions and treaties relevant to these types of IP and so in many respects the Jersey laws permitting IP to be re-registered in Jersey will also be consistent with these obligations. But Jersey does not belong to the relevant international conventions and treaties, in particular the most recent version of the Paris Convention for the Protection of Industrial Property. There are a few detailed points in the Jersey laws that would preclude compliance with that Convention. This draft Law therefore brings forward amendments to remove these problems, and so should in due course enable the Island to seek extension of the UK's membership of that Convention to the Island.

These changes to Jersey laws will not in practice make very much difference to the legal framework for registered IP rights in the Island. But extension of the UK's membership of the Paris Convention to Jersey provides certainty for those concerned about the standard of protection in the areas of IP covered by that Convention. Businesses making decisions about whether to locate, invest in or expand their business operations in the Island will know that the relevant laws do indeed meet this important international standard. Compliance with the Paris Convention has another benefit too as it must be in place if Jersey wishes to be part of the WTO. Paris Convention compliance is required by the WTO agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). TRIPS includes additional requirements relating to laws about registered designs, patents and trade marks so this opportunity to update the 3 laws about registered IP rights is therefore also being used to ensure that they comply with TRIPS. The provisions needed to do this are also not very significant, and making these changes does not pre-judge whether or not the Island should seek to have the UK's membership of the WTO extended to the Island. But TRIPS compliant laws ensure that there is no barrier in the IP area to WTO membership. Moreover, ensuring that the Jersey laws are TRIPS compliant delivers another important international standard which many businesses would expect.

Whilst delivering Paris Convention and TRIPS compliance, and so ensuring that WTO membership can be achieved, is the policy objective behind this draft Law, there may in due course be a need to further adjust the 3 laws about registered IP rights for compliance with changes to, or new, international treaties or conventions, or otherwise. One such change, supported by some stakeholders in Jersey, might be to establish a primary registration system for trade marks in particular, possibly in addition to the current option of secondary registration of UK registered trade marks. Some work has already been undertaken to explore the business case for doing this, but more work and consultations with all stakeholders would be needed before any decisions can be made about this.

Given the increasing importance of IP rights to a wide range of businesses, it may, therefore, be important to bring forward certain changes to the laws about IP beyond those in this draft Law by a route that is faster to have effect than the legislative route for a new Law. That is why this draft Law also includes powers to enable provision about the 3 types of IP where rights arise as a result of registration to be amended and updated in various ways by Regulations. This does not, of course, remove the essential scrutiny of any changes by the States, which would need to approve any Regulations in the same way that it approves a new Law.

### **Intellectual property in general**

Intellectual property rights ensure that innovative concepts, and investment in making, developing and commercialising a product or service based on those concepts, cannot easily be undermined by competitors copying what has been done. IP rights are intangible property rights in an idea or the particular expression of an idea and give the owner of the property exclusive rights in relation to exploitation of protected goods and services. IP can also be bought and sold, or the IP rights can be licensed by those who own them for others to exploit what is protected. Some types of IP right provide a monopoly in what is protected, albeit this may only be for a limited period of time. Other types of IP right only provide a right that prevents copying by others. In all cases, though, the IP right is a right in intangible property separate from the physical property and services incorporating that IP that have been developed or made and exploited.

IP rights are therefore often a valuable business asset that can substantially enhance the competitiveness of a business. But some IP rights need to be acquired and maintained in order to exist and all IP rights need to be understood and appreciated in order for the full potential for them to generate income for a business to be realised. The value of IP is, though, often not adequately appreciated by businesses that could or do acquire IP rights. SMEs in particular may not appreciate the importance of IP rights in increasing their profitability. Getting advice from professionals, such as lawyers or patent and trade mark agents, in order to understand the role that IP can have in any business activity may be as important as advice about a number of other areas of law that impinge on a business. There are a number of businesses already operating in Jersey that are well placed to provide this type of advice.

Governments, including in Jersey, must, though, ensure that the legal framework providing protection for IP is appropriate. A key aspect of this is to ensure that the IP laws do at least meet widely accepted international standards that businesses located in, or thinking of investing in, the Island would reasonably expect to apply. Certain types of IP rights, such as copyright, are automatic in that they arise as soon as protectable material has been created. As has been indicated above, the States of Jersey has already enacted and brought into force a new copyright and related unregistered IP rights law (the Intellectual Property (Unregistered Rights) (Jersey) Law 2011) and so business advisers, including those operating through Digital Jersey, are now able to assure businesses that rights in these areas are in line with rights in much of the rest of the world. Indeed, the extension of the UK's membership of the most important international convention in the copyright area, the Berne Convention, to Jersey in January 2014 recognises the care with which the law in this area has been updated to deliver compliance with international norms. That law was also updated to comply with other international conventions and treaties in the copyright area as well as the requirements of the WTO TRIPS Agreement for unregistered IP rights.

This draft Law is about registered IP rights, though, that is rights that do not exist until registration has been applied for and approved. The 3 types of IP covered by the draft Law are registered designs, patents and trade marks. These types of IP apply to different things –

- Registered designs apply to the shape or appearance of a product. What can be protected is the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or ornamentation on the product. The design must be new and have individual character. The design can be for a 3-dimensional product or 2-dimensional ornamentation for any product. A design dictated solely by the product's technical function cannot, though, be registered.
- Patents protect a new and inventive product, or part of a product, or a process for making something. The invention could therefore be about how things work, what they do, how they do it, what they are made of or how they are made. As well as being new, there must be an inventive step, which is something that is not obvious to a person with knowledge and experience in the relevant subject matter area. An invention must be capable of being made or used in some kind of industry. Certain things are specifically excluded from being patentable, such as a method of treatment or diagnosis of a human or animal body, a scientific theory and a way of doing business.

- Trade marks are essentially signs used to distinguish goods and services from those of competitors. This branding of goods and services is often achieved by use of one or more words, or a logo, or a combination of both words and logos. In order to be protected, a trade mark must be distinctive for the goods or services it is to be used with. It must differentiate the goods or services from those of someone else. Certain things cannot be registered as trade marks, such as things that describe the goods or services or any characteristics of them. For example, marks which show the quality, quantity, purpose, value or geographical origin of the goods or services, and something that is deceptive in that it would lead the public to think that the goods or services have a quality that they do not have, cannot be registered.

The draft Law amends current Jersey laws for each of the 3 types of registered IP right rather than make entirely new provision. These registered IP rights are sometimes known as industrial property rights, but industrial property rights are in turn a category of intellectual property rights. Many businesses, may, of course, have an interest in more than one of these types of IP, as well as other types of IP.

There are other types of IP where rights only arise after registration that do not currently exist at all in the Island, in particular IP rights in new plant varieties. Plant varieties are specifically excluded from coming within the scope of what can be protected by a patent in the UK and so there cannot be a patent for a plant variety in Jersey either. Rights in new plant varieties can be obtained in the UK and many other countries though. A law about this type of IP is not essential in order to comply with the Paris Convention, but making it possible to acquire IP rights in new plant varieties is an essential requirement in the WTO TRIPS Agreement. A further draft Law to make provision in the Island for rights in new plant varieties is therefore being developed and will be lodged for approval by the States Assembly later this year.

### **International conventions and treaties**

International conventions and treaties in the intellectual property area making provision about registered IP rights are generally different from those that make provision about unregistered IP rights. As indicated above, this has therefore enabled Jersey to already successfully pursue extension of the UK's membership of the International Convention for the Protection of Literary and Artistic Works (Paris Act 1971) (the Berne Convention) to the Island as a result of the new copyright law provided by the Intellectual Property (Unregistered Rights) (Jersey) Law 2011. The Island became part of the Berne Convention framework in January 2014.

The main international convention relevant to registered designs, patents and trade marks, the 3 types of IP for which laws are updated by this draft Law, is the Paris Convention for the Protection of Industrial Property (Stockholm Act 1967). There are currently 176 Contracting Parties to this Convention. Given that the Jersey laws about these 3 registered IP rights provide a system of secondary registration of UK rights and UK law complies with the requirements of the Paris Convention, in many respects Jersey laws comply too. (The UK has been a contracting party to the Paris Convention (1967) since 1970, first joining the original version of the Convention in 1884.) However, there are a few issues where there would be problems with compliance with the Paris Convention under the existing laws. This draft Law therefore makes some amendments to the existing laws to deliver compliance with the Paris Convention and so enable the Island to seek extension of the UK's membership of this Convention to Jersey.

Compliance with the provisions in the Paris Convention (although not necessarily membership of the Convention) is also a requirement of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), which is part of the Agreement on the World Trade Organisation (WTO). The TRIPS Agreement then requires some additional provision about the 3 types of IP covered by this draft Law. If Jersey is to obtain membership of the WTO by extension of the UK's membership to the Island, then complying with TRIPS is essential, and this would not be possible without some other amendments made to the existing Laws about registered IP rights as made by this draft Law. However, even without Paris Convention and WTO membership, there are likely to be advantages in having laws that can be said to be Paris and TRIPS compliant. The Paris Convention and TRIPS Agreement provide widely accepted international standards for the 3 registered IP rights addressed by this draft Law and so may be considered as a benchmark against which those seeking to invest in the Island would judge Jersey's IP laws.

The Paris Convention does contain a provision whereby the filing of an application for registration of IP in one Contracting Party can, within a specified time, be used to claim a priority date for filing an application in another Contracting Party. This can be a very useful option for those wanting IP rights for what they have developed in more than one country. A Jersey application under the current laws could not, though, be the basis of a claim for priority for an application elsewhere as a Jersey application is not an original application. It is, rather, an application for registration of something already applied for and granted in the UK. Some of the advantages of being within the Paris Convention framework would not, therefore, arise for Jersey on the basis of the amendments made to Jersey laws by this draft Law. The States has, though, been assured by the UK that the secondary registration system operating in Jersey is not a barrier to extension of the UK's membership of the Paris Convention to Jersey. If there were, in due course, to be a primary registration system for one or more types of IP, then there would, though, be an additional benefit from Convention membership as a result of the provisions in the Paris Convention about claims for priority.

There are 3 other international conventions making provision about the types of IP covered by this draft Law for which extension of the UK's membership, or expected membership, to the Island may be appropriate. They make provision about international applications for the relevant IP rights, including the circumstances in which this is possible and the procedures to be followed. International applications do not lead to rights which are international. The rights eventually obtained as a result of registration of the IP are national ones. But international applications do simplify the process for obtaining those rights because the starting point is a single application. The three international conventions are as follows –

- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the Madrid Protocol), which has applied to the UK since 1995.
- The Patent Co-operation Treaty (PCT), which has applied to the UK since 1978.
- The Hague Agreement Concerning the International Registration of Industrial Designs (the Hague Agreement), which does not yet apply to the UK but for which the UK made a legislative change in the Intellectual Property Act 2014 in order to enable accession to the Agreement.

So long as the IP rights in Jersey are provided by a secondary registration system, there is probably no need to make any changes to the Island's laws in order to seek extension of the UK's membership of these international conventions to the Island,

and there could be some advantages to membership for businesses located in Jersey which want to benefit from their provisions. However, it would be necessary to consider what legislative provision is needed if there are any changes to Jersey laws to enable primary registration of one or more types of IP. As already mentioned and as further discussed below in the section explaining the process that has led to this draft Law, this is something that is being considered for some types of IP, but it is not addressed by this draft Law. How any changes to the IP framework would work with membership of these 3 international conventions would therefore be part of the assessment that would need to be made before any decisions on possible changes are made.

It would, though, be appropriate on the basis of this draft Law to seek extension of the UK's membership of the Paris Convention, the Madrid Protocol and the PCT to the Island, and, in due course when the UK has acceded, the Hague Agreement.

### **Current Jersey laws about registered intellectual property rights**

The 3 current Jersey laws about registered IP rights are as follows –

- Registered Designs (Jersey) Law 1957.
- Patents (Jersey) Law 1957.
- Trade Marks (Jersey) Law 2000.

Each law permits registration in Jersey of the relevant IP right that is valid in the UK. The person who is the proprietor of the right in the UK is the person who can apply for registration in Jersey. The Judicial Greffier is the Registrar to whom an application for registration must be made, with a Register of Rights maintained at the Judicial Greffe. There is no examination of the UK right for compliance with the various requirements in UK law that apply before there can be a registration in Jersey, but in each case the secondary registration in Jersey can only remain in force so long as the right remains in force in the UK. The Registrar does have some powers to query whether a registration in Jersey should go ahead and in some circumstances a person who is prejudicially affected by the registration can seek to have it revoked. A registration of IP in Jersey essentially gives the person who has done that the same rights and equivalent remedies as exist in the UK. An action for infringement of an IP right in Jersey can therefore be pursued in the court in Jersey and the activities that infringe the right, essentially exploitation in the course of business of what is protected by the IP right, are the same as in the UK.

In the case of trade marks, there are also criminal offences applying to wilful unauthorised dealing and use in the course of trade of a trade mark that has been registered in Jersey, something that is often referred to as counterfeiting. Border measures can also lead to counterfeit goods being seized by customs, although in this respect the much more important relevant provision is in an EU Regulation that applies to Jersey and which permits such seizures for any counterfeit goods arriving in Jersey directly from outside the EU customs territory. These additional enforcement measures applying to trade marks are an important part of what is necessary for compliance with the TRIPS Agreement which Jersey law largely already complies with. (Some details regarding the application of the EU Regulation to Jersey is dealt with in the Community Provisions (Goods Suspected of Infringing Intellectual Property Rights) (Jersey) Regulations 2014. But action by customs at the border is possible under the EU Regulation which has direct effect in the Island. Action is possible regarding goods infringing IP rights generally, i.e. not just trade marks, but the EU Regulation and Jersey Regulations are about customs matters only. They do not have any effect to confer, or alter any position regarding, IP rights in Jersey.)

The number of registrations for the 3 types of IP under the current laws in Jersey is not that high in the area of patents and very low for registered designs. (Designs do now get some protection without registration under the automatic design right in the Intellectual Property (Unregistered Rights) (Jersey) Law 2011 and so applying for a registered design right may be even less popular.) More trade marks are registered in Jersey though, with well over 9000 UK trade marks having been entered on the Jersey trade marks register. The register would, of course, need to be referred to for the details of the registration and whether or not it is still in force. It may be that there will be more applications for registration of IP in the Island when this draft Law has delivered compliance with international standards for these 3 types of IP. The draft Law will not, however, change the nature of the registration system for all three registered IP rights regarding the link to and re-registration of UK rights and so a significant change to the number of registrations seems unlikely. One of the policy issues that is being explored, as explained further below in the section explaining the process that has led to this draft Law, is whether or not there should be any change to this system of secondary registration. The draft Law is, though, essentially limited to delivering compliance with important international conventions and treaties and providing a mechanism to more easily update the Jersey laws in the future should that be desirable.

### **UK laws about registered intellectual property rights**

The 3 UK laws about registered IP rights relevant to this draft Law are as follows –

- The Registered Designs Act 1949.
- The Patents Act 1977.
- The Trade Marks Act 1994.

All 3 of these Acts have been amended on a number of occasions since their enactment. The most recent amendments to the Registered Designs Act have been made by provisions in the Intellectual Property Act 2014, including to adjust the rules on ownership of rights in a design that has been commissioned and to create a new criminal offence for intentional copying of a registered design to make a product in the course of business. The Patents Act has also been amended by the Intellectual Property Act, including to make provision about marking products protected by a patent with an internet link for information about the patent and providing the Comptroller with a power to revoke a patent after an opinion that the patent is invalid. The Patents Act has also recently been amended by the Legislative Reform (Patents) Order 2014 to ensure that anything done for the purposes of a medicinal product assessment does not infringe a patent. The most recent changes to the Trade Marks Act relate to how it applies in the Isle of Man as set out in The Trade Marks (Isle of Man) Order 2013 (SI 2013 No. 2601). (Unlike the position in Jersey where UK registered trade marks must be registered in Jersey to have effect in Jersey, UK registered trade marks have direct effect in the Isle of Man, subject to the modifications as set out in the 2013 Order.)

Each of the 3 UK laws makes provision for primary registration of IP and grant of the relevant rights. A number of statutory instruments made under each law set out various additional details, including on the fees to be paid both during the process of making an application and after the application has been granted in order to keep the IP rights in force. The rights provided are monopoly rights in that the protection provided can be used to prevent others from exploiting what has been protected. This can be the case even if the other person was not aware of the IP rights, and so can apply even where another person has, say, independently developed the same

invention which has been patented, and even when they have done that earlier than the first person who has been granted rights. This system is therefore referred to as one based on rights given to the first person to file an application. There are, though, some limits to the extent of the protection provided by IP rights, including for the benefit of prior users of what is protected and on the time that rights can last for. Very broadly, the IP rights enable the holder of the rights to take legal action against another person who uses what is protected without his or her permission. Such use is an infringement of the IP rights and the remedies that can be sought, such as seeking damages and the award of an injunction, are in general the same as those that apply to an infringement of any property right.

The time for which the rights can last and some other important provisions applying to each of the 3 types of IP under UK laws is as follows –

- A registered design can last for up to 25 years if renewal fees are paid. The rights are infringed by a person who makes, offers, puts on the market, imports or exports the design, or stocks the product for any of these purposes without permission from the owner of the rights and for commercial gain.
- A patent can be renewed to last for a maximum of 20 years from the date of filing the application. A patent is infringed by a person who copies, manufactures, sells or imports the patented invention without permission from the rights' owner. Certain activities are, though, specifically excluded from amounting to an infringement, such as private, non-commercial use and something done for experimental purposes relating to the subject matter of the invention.
- A registered trade mark can be renewed every 10 years to last forever if a person wishes. The rights are likely to be infringed by a person who uses without permission an identical or similar trade mark for identical or similar goods or services to the one that has been registered. Issues such as the likelihood of confusion among members of the public and where use may damage, or take unfair advantage of, the reputation of the owner of the rights will be taken into account in determining whether there is an infringement. Wilful use of a trade mark without permission in the course of trade (often referred to as counterfeiting) may also amount to a criminal offence.

The 3 UK laws all include the possibility of an application being made based on a claim for a priority date for the application earlier than the actual date by reference to an earlier application made in another country. This provision is, as explained above, part of the Paris Convention, and so also the WTO TRIPS Agreement due the obligations in that Agreement to comply with the Paris Convention, for contracting parties that provide a primary registration system. Article 4 of the Paris Convention sets out the details of how a right of priority must apply to applications, including the time limits that must apply. Thus, each of the three UK laws makes provision about claims for priority. For patents, an application filed in the UK up to 12 months after an application filed in another convention country for the same thing can have the date of filing of that earlier application as a priority date. For registered designs and trade marks similar provision is made but with the maximum time between filing of the application in another convention country and filing in the UK being 6 months.

## **Main features of this draft Law**

As already noted, the draft Law has 2 main aims as follows –

- (1) To make changes to the 3 Jersey laws on registered IP rights for compliance with the relevant provisions of the Paris Convention for the Protection of Industrial Property (1967) (the Paris Convention) and the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement).
- (2) To provide powers to permit the States to make further provision about the three types of registered IP rights by Regulations.

In addition, the draft Law makes some minor drafting changes to the 3 Jersey laws, including for consistency with the relevant UK laws where those have been amended since the 3 Jersey laws were enacted.

In more detail, changes being made by this draft Law for compliance with the Paris Convention and the TRIPS Agreement include –

### *(a) Registered designs*

The main difficulty with the current law concerns compliance with Article 5B of the Paris Convention. Article 5B prevents the forfeiture of protection for industrial designs for failure to work and this is currently permitted by Article 10(1)(d) and (e) of the Registered Designs (Jersey) Law 1957. Compulsory licences would be possible in these circumstances, but such provision does not exist in the UK, so the draft Law simply revokes Article 10(1)(d) and (e).

There could also be a problem with forfeiture of a design being possible as a result of Article 10(1)(c) of the 1957 Law because delays outside the control of the applicant could mean that more than 3 years have elapsed between the date of registration in the UK (which is the UK application or priority date) and the date registration in the UK is determined, which must occur before there can be a registration in Jersey. The draft Law therefore amends Article 10(1)(c) so that the 3 years are measured from the date that the application for registration in the UK is determined.

The use of terminology such as “copyright in a design” in the 1957 Law, which has been revoked and replaced in UK law, may lead to uncertainty about the nature of, and so enforcement of, rights in Jersey and so lead to concerns about compliance with, for example, Articles 26 and 41 of the TRIPS Agreement. Article 9 of the 1957 Law is therefore amended by the draft Law to clarify the effect of a registration in Jersey. Article 5 is amended to clearly permit any extension of the period of registration of a design in the UK and any restoration of a UK registration to be registered in Jersey.

### *(b) Patents*

Article 5A of the Paris Convention does not permit a patent to be forfeit, such as for failure to work, unless the grant of compulsory licences does not solve the problems. Article 9(1)(d) and (e) of the Patents (Jersey) Law 1957, which permit revocation without compulsory licences being tried, is therefore contrary to the Paris Convention. Article 31 of the TRIPS Agreement imposes extensive conditions on compulsory licences making revocation on the grounds in Article 9(1)(d) and (e) of the 1957 Law unlikely to be possible even after the grant of compulsory licences. The draft Law therefore revokes Article 9(1)(d) and (e) of the

1957 Law and introduces new provision to permit compulsory licences to be granted in circumstances essentially as is possible in the UK.

In addition, the new provision on compulsory licences would permit their grant when it is necessary to do so to comply with an international treaty or convention. This would therefore permit such licences in the circumstances covered by Article 31bis of the TRIPS Agreement to enable the production of medicines for export to developing countries.

(c) *Trade marks*

Article 6quinquies of the Paris Convention prevents trade marks that have been registered in their country of origin from being refused a registration except on the grounds indicated. Possible refusal of a trade mark registration under Article 4(5) of the Trade Marks (Jersey) Law 2000 is not so limited. The draft Law therefore amends Article 4(5) to only permit refusal of a registration where this is not contrary to any international convention or treaty that has effect in Jersey.

The protection for well-known trade marks required by Article 6bis of the Paris Convention, and also applied to marks for services by Article 16 of the TRIPS Agreement, requires the possibility of injunctive relief in certain circumstances in Jersey. The draft Law makes new provision to be inserted into the 2000 Law for this purpose. Similar issues arise regarding Articles 6ter and 6septies of the Paris Convention relating to state emblems etc. and unauthorised registration in the name of an agent or representative. The draft Law also makes new provision to be inserted into the 2000 Law on both of these. (In many situations the requirements about well-known marks and so on that must apply in Jersey if it is to comply with the Paris Convention and TRIPS Agreement will be delivered by UK law and the way a Jersey registration is linked to a UK one.)

The enforcement of criminal sanctions for wilful trade mark counterfeiting on a commercial scale, which are required by Article 61 of TRIPS, could be difficult without all those involved in any enforcement action able to seize infringing articles as evidence. Article 26 of the 2000 Law does make appropriate provision where enforcement action is taken by inspectors of weights and measures. The draft Law introduces a new provision about search warrants into the 2000 Law so that enforcement action by police officers is also possible.

The Regulation-making powers are provided by a new Article inserted by the draft Law into each of the 3 Jersey laws about registered IP rights. The new Articles will each provide a power to make provision by Regulations about registered designs, patents and trade marks respectively in the circumstances indicated. These circumstances will mean that it will be possible to make provision in relation to any of the following –

- registration, by first registration or otherwise, and the exercise and enforcement of any title or interest in rights, but so long as the provision is believed by the States to be consistent with any international convention which applies to Jersey;
- giving effect to any international convention which applies, or is to apply, to Jersey;

- implementing any obligation the UK has under EU Treaties, whether or not that obligation applies to Jersey;
- giving effect to any provision that applies in the UK.

The minor amendments being made by this draft Law include the following –

- updating the terminology in the Registered Designs (Jersey) Law 1957 in line with current UK law;
- updating the penalty levels for offences in the Registered Designs (Jersey) Law 1957;
- updating the meaning of “invention” in the Patents (Jersey) Law 1957 in line with current UK law;
- providing consistency between the three Jersey laws regarding the provision on the effect of a registration of IP in Jersey; and
- providing clarity about the registration of assignments and other transfers of and interests in, as well as licences of, trade marks in the Trade Marks (Jersey) Law 2000.

#### **Process leading to proposals in this draft Law**

Given the very technical nature of the provision in this draft Law, and the essential nature of the majority of the provision in the Law if Jersey is to have laws that comply with the TRIPS Agreement, which is in turn an essential requirement if the UK’s membership of the WTO is to be extended to the Island, it was decided to produce a very well-developed draft Law before seeking any external input regarding the detailed provisions in the draft Law. This very well-developed draft Law was then made available in September 2014 to a targeted group of stakeholders for comment.

There were very few comments as a result of this consultative exercise. Regarding the details of the draft Law, one comment received concerned whether or not the new provision on compulsory licences for patents provided by Article 19 of the draft Law should be on application to a person other than the court. It has been decided that such a change would not be appropriate, including because the issues that would need to be decided before a compulsory licence could be granted are essentially the same as those that currently apply to a case that can be made to the court for revocation of a patent.

Another comment received concerned the territory that is considered for where a trade mark is well known when it is to be decided whether or not to grant injunctive relief under the new provision provided by Article 29 of the draft Law. It was proposed that the territory should be just Jersey and not as drafted, that is the UK including Jersey. It has been decided that such a change is appropriate as Jersey will be the jurisdiction where it is necessary to decide whether or not use of a trade mark is likely to cause confusion with a well known mark and so what is well known in Jersey is therefore relevant. A well known mark is now defined in the draft Law as one well known in Jersey.

Two stakeholders queried whether the draft Law would actually make Jersey’s trade marks and designs laws compliant with the Paris Convention without changing the system to one of primary registration. This is an issue that had already been explored with the UK and assurances have been given that Jersey’s system of secondary registration does not preclude extension of the UK’s membership of the Convention to include Jersey.

The feedback from the consultative exercise also included comments about issues relating to the laws about registered IP rights in the Island more generally. In

particular, 2 stakeholders suggested that the draft Law should not be pursued in its present form, but, rather, a more comprehensive review should establish whether or not the Island should establish a primary registry for trade marks and designs in particular. Such an approach is not being pursued as it would significantly delay compliance with the WTO TRIPS Agreement. The Regulation-making powers that are included in the draft Law do, however, permit changes to be made to the nature of the registration system in Jersey in the future, including making provision for primary registration of IP in Jersey, either instead of or as well as a system of secondary registration. Another alternative approach that could be delivered in the future by Regulations would be a system under which rights registered in the UK are automatically recognised in Jersey.

Using Regulations to change the Jersey laws about registered IP rights in the future will be faster than a Law that must have Royal Assent as well as approval by the States Assembly. Adopting this draft Law does not, therefore, necessarily delay making the sort of changes that stakeholders have identified should they be appropriate. Changes as suggested would, moreover, require further consultation of stakeholders in order to inform any decisions taken, but the process of developing what might be possible can commence before the Regulation-making powers are in place. Indeed, some work has already been undertaken to investigate the likely cost of setting up a primary registry for IP. Most recently, Digital Jersey has done some work at a high level to explore whether or not there is a business case for a system of primary registration for trade marks in particular. That work has not, though, provided sufficient evidence to demonstrate a business case given the likely costs of establishing and running a primary registry so more work is needed.

### **Financial and manpower implications**

There are not expected to be any financial or manpower implications arising from the adoption of the draft Law by the States. The Law makes small changes to the existing framework under which a person who owns rights in designs, patents and trade marks first obtained in the UK can apply to have the rights re-registered in Jersey. It is not expected that there will be any significant change in the number of applications for re-registration, or the cost of processing an application for re-registration, as a result of the changes made by this Law. Should there be a dispute about the rights that have been re-registered in Jersey, this may have to be resolved by the court interpreting the laws about registered IP rights as amended, but this is not expected to be any more costly than at the moment. Disputes in the court about IP rights are in any case very rare indeed and there is no reason to expect any change to this as a result of the amendments made by this draft Law. It is therefore currently expected that the costs and required manpower for continuing to operate the secondary registration system for designs, patents and trade marks as a result of the amendments to those laws made by this draft Law will be met from existing resources.

This analysis includes the possible cost of a case under the new provision to be inserted into patents law permitting a compulsory licence to be sought from the court in certain situations. The situations when this would be possible are very similar to those when it would be possible to seek revocation of the registration of a patent in Jersey under the current law and so cases are no more likely than at the moment. There do not appear to have been any cases in Jersey regarding revocation of the registration of a patent and so cases seeking a compulsory licence for a patent are considered to be equally unlikely.

## **Human Rights**

The notes on the human rights aspects of the draft Law in the Appendix have been prepared by the Law Officers' Department and are included for the information of States Members. They are not, and should not be taken as, legal advice.

## APPENDIX TO REPORT

### **Human Rights Note on the Draft Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201-**

These notes on the human rights aspects of the draft Law, the Draft Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201-, have been prepared by the Law Officers' Department.

**These notes are included for the information of States Members. They are not, and should not be taken as, legal advice.**

This Law gives rise to no obvious issues under the Human Rights (Jersey) Law 2000. Intellectual property rights are a creation of statute giving rights and privileges to individuals for innovation and endeavour. The Law gives these rights to further the public good. The extent to which such rights are given, and are subsequently regulated, is a matter for judgement of the public good. The legislature is except in extremis free to make its own judgements in this regard.

Insofar as the granting of compulsory licences might be seen as an interference with a patent holder's licence, the procedure is fully regulated by law and licences will be granted on a public interest basis. Such regulation is plainly within the margin of appreciation given to jurisdictions under the European Convention on Human Rights.

## Explanatory Note

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This Law amends the Registered Designs (Jersey) Law 1957, the Patents (Jersey) Law 1957 and the Trade Marks (Jersey) Law 2000. The majority of the amendments are required to comply with the Paris Convention for the Protection of Industrial Property 1967 (“Paris Convention”), which is administered by the World Intellectual Property Organization and the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (“TRIPS Agreement”). The TRIPS Agreement constitutes Annex 1C of the Marrakesh Agreement establishing the World Trade Organization (“WTO”) done at Marrakesh 15th April 1994. The TRIPS Agreement requires compliance with certain provisions in the Paris Convention. Compliance with the TRIPS Agreement by Jersey is necessary for the United Kingdom’s membership of the WTO to be extended to Jersey. Compliance with the Paris Convention by Jersey will enable the United Kingdom’s membership of the Paris Convention to be extended to Jersey.

### **Part 1 – Registered Designs (Jersey) Law 1957 amended**

*Article 1* is an interpretation provision which defines “principal Law” as the Registered Designs (Jersey) Law 1957.

*Article 2* deletes various definitions which are expressed as having the same meaning as in the Registered Designs Act 1949 of the United Kingdom (“RDA”) but which have been revoked, replaced or amended in that Act and inserts other definitions currently used in that Act. In particular it replaces the definition of “copyright” with “right in a registered design”.

*Article 3* substitutes the existing provision in the principal Law with a more detailed provision concerning registration in Jersey of extensions of copyright in a design where such copyright has been extended in the United Kingdom. The new provision deals with applications to the Judicial Greffier when the period for which the right in a design subsists has been extended in the United Kingdom and where the lapsed right in a design has been restored in the United Kingdom.

*Article 4* substitutes the existing provision in the current Law concerning the effect of registration of a right or of any title or interest in a registered design. References to copyright in a registered design are removed and the language is made consistent with the equivalent provisions dealing with registration in the Patents (Jersey) Law 1957 and in the Trade Marks (Jersey) Law 2000. Such registration gives the person in whom such right, title or interest is vested the same rights and equivalent remedies that the person possesses in the United Kingdom from the date such rights have effect in the United Kingdom for as long as such rights subsist in the United Kingdom. However no action for infringement may be brought in respect of any use prior to the date of registration under the principal Law or, if applicable in the case of extended or restored rights in the United Kingdom, such extension or registration has been registered under the principal Law.

*Article 5* amends the existing provision in the principal Law that allows a court to cancel a registration if (a) more than 3 years have elapsed between the date of registration in the United Kingdom and the date of registration under the principal Law and, (b) on the latter date, the design is being used in Jersey on a commercial scale. The amendment provides that the 3 year period runs from the date that the application for the registration of the design was determined in the United Kingdom. In addition, Article 5 deletes the provisions which allow the court to cancel a registration if more than 3 years have elapsed since the date of registration under the

principal Law and either the design is not being used on a commercial scale in Jersey or the demand in Jersey for the design is not being met to an adequate extent and on reasonable terms. These provisions are incompatible with the Paris Convention and the TRIPS Agreement.

*Articles 6, 7 8 and 9* are consequential amendments arising from the amendments made by *Article 2*.

*Article 10* amends the penalty in the principal Law for offences in connection with false entries in the register of designs or false purported copies of such entries. The current penalty of a maximum term of 2 years imprisonment or a maximum £100 fine, or both, is amended to a maximum term of 2 years imprisonment or a maximum fine of level 2 on the standard scale, or both. Under the Criminal Justice (Standard Scale of Fines) (Jersey) Law 1993 the standard scale of fines is as follows –

Level 1	£50
Level 2	£500
Level 3	£2,000
Level 4	£5,000.

*Article 11* amends the penalty in the principal Law for offences in connection with a false representation by a person who sells a product to the effect that the design of the product is registered in Jersey or who marks a product implying that the right in the registered design subsists when such right has, in fact, expired. The current penalty in each case is a maximum fine of £5. The fine for offences in connection with sale is amended to a maximum fine of level 3 on the standard scale. The fine for offences in connection with marking a product is amended to a maximum fine of level 2 on the standard scale.

*Article 12* is a consequential amendment to the principal Law arising from the amendments made by *Article 2*.

*Article 13* inserts a new Regulation making power in the principal Law allowing the States to make such provision as they think fit, including amendment of the principal Law and any other enactment, with regard to registration of designs. Such provisions can include provisions relating to registration or first registration of a design in Jersey or enforcing or giving effect to rights granted in a country or territory other than in Jersey, giving effect to international treaties and agreements which have effect in Jersey, implementing UK obligations under the EU Treaties and giving effect in Jersey to any provision that applies in the UK.

*Article 14* is a transitional provision to the effect that any act done on or after the date that this Law comes into force pursuant to an agreement or arrangement made before that date will not infringe a design right if it would not have infringed such a right before that date. Conversely, anything done before that date will not infringe a design right from that date if it did not infringe a design right before that date.

## **Part 2 – Patents (Jersey) Law 1957 amended**

*Article 15* is an interpretation provision which defines the “principal Law” as the Patents (Jersey) Law 1957.

*Article 16* updates the definition of “invention” in the principal Law so as to refer to the Patents Act 1977 of the United Kingdom (“UK Patents Act”).

*Article 17* substitutes the existing provision in the principal Law concerning the effect of registration of a patent. The language is made consistent with equivalent provisions

in the Registered Designs (Jersey) Law 1957 and the Trade Marks (Jersey) Law 2000 and the effect is similar to the effect of registration of a right in a registered design as explained with respect to *Article 4* above. In addition the substituted provision continues the existing provision which allows actions for infringement of a patent in certain circumstances to be brought in respects of acts done after the date of publication of the application for a patent under the UK Patents Act and before the grant of a patent under that Act.

*Article 18* deletes provisions which allow the court to cancel a registration if more than 3 years have elapsed since the date of registration under the principal Law and either the patented invention is not being used on a commercial scale in Jersey or the demand in Jersey for the patented article is not being met to an adequate extent and on reasonable terms. These provisions are incompatible with the Paris Convention and the TRIPS Agreement. Provision is made in both the Paris Convention and the TRIPS Agreement for compulsory licences to deal with such situations and these provisions are given effect to by *Article 19*.

*Article 19* inserts a new provision in the principal Law to allow any person to apply to the court for a licence under a patent (referred to as a “compulsory licence”) if more than 3 years have expired from the date of registration of the patent under the principal Law on one of a number of specified grounds. Those grounds relate to (a) demand in Jersey for a patented product not being met on reasonable terms; (b) commercial or industrial activity in Jersey being unfairly prejudiced; and (c) a licence being necessary to comply with any treaty or international convention which has effect in Jersey. Such a licence cannot be granted unless the applicant has tried and been unsuccessful in obtaining a licence from the registered patent holder on reasonable commercial terms and conditions. Except where inconsistent with, or in contravention of, a treaty or international convention to which such a licence would give effect, a licence that is granted under this Article must be predominately for the supply of a market in Jersey and subject to certain statutory conditions, including the condition that it is not exclusive.

*Article 19* also inserts a new provision in the principal Law relating to the grounds which a court must take into account in deciding whether or not to grant a compulsory licence. Provision is also made setting out the circumstances in which a compulsory licence may be cancelled.

*Article 20* amends a provision in the principal Law to make the language consistent with language in the Registered Designs (Jersey) Law 1957 and the Trade Marks (Jersey) Law 2000 concerning rights and remedies.

*Article 21* amends the definition of “convention country” in a provision relating to vessels or aircraft which come to Jersey temporarily. The amendment refers to countries that are bound by the Paris Convention, rather than just countries that are parties to the Convention and adds any other country which is a member of the World Trade Organisation.

*Article 22* inserts a new Regulation making power in the principal Law which is similar to that inserted by *Article 13* in relation to registered designs.

*Article 23* inserts a transitional provision in the principal Law which is similar to that inserted by *Article 14* in relation to registered designs.

### **Part 3 – Trade Marks (Jersey) Law 2000 amended**

*Article 24* is an interpretation provision which defines the “principal Law” as the Trade Marks (Jersey) Law 2000.

*Article 25* amends the principal Law so as to qualify the grounds on which registration of a trade mark may be refused so that refusal is only possible if such refusal does not breach any convention or treaty which has effect in Jersey. This amendment is to comply with the TRIPS Agreement and the Paris Convention.

*Article 26* amends the principal law with respect to the registration of assignments, licences and other titles in a registered trade mark to be consistent with similar provisions in the Registered Designs (Jersey) Law 1957 and in the Patents (Jersey) Law 1957.

*Article 27* amends the principal Law with respect to the effect of registration to be consistent with similar provisions in the Registered Designs (Jersey) Law 1957 and in the Patents (Jersey) Law 1957 (as explained with respect to *Articles 4* and *17* above).

*Article 28* amends the title of Part 3 of the principal Law so as to better reflect the amendments made to that Part as set out below.

*Article 29* inserts 3 new Articles, **Article 13A**, **13B** and **13C** in the principal Law relating to well known trade marks, State emblems and official signs and acts of agents and representatives.

The **new Article 13A** gives rights to the proprietor of a trade mark which is well known in Jersey to apply to the court in Jersey for an injunction to restrain the use of a similar mark in Jersey where use of that other similar mark in Jersey is likely to cause confusion with the proprietor’s trade mark.

The **new Article 13B** allows a competent authority or international organization (as referred to in the Trade Marks Act 1994 (“1994 Act”) of the United Kingdom) to apply to the court in Jersey to restrain the use of a trade mark in Jersey in specified circumstances.

The **new Article 13C** applies where an agent or representative of the proprietor of a trade mark in a Paris Convention country applies for registration of a trade mark under the 1994 Act. The new Article allows the proprietor to restrain by injunction in Jersey the use of such a mark in Jersey where there is unauthorized use of such a mark in the United Kingdom or in Jersey or both.

*Article 30* inserts a provision in the principal Law concerning search warrants to allow seizure of items if an offence relating to unauthorized use of a trade mark is reasonably expected.

*Article 31* inserts a new Regulation making power in the principal Law which is similar to that inserted by *Article 13* in relation to registered designs.

*Article 32* inserts a transitional provision in the principal Law which is similar to that inserted by *Article 14* in relation to registered designs.

*Article 33* sets out the title of this Law and provides that it will come into force 7 days after registration.





Jersey

**DRAFT INTELLECTUAL PROPERTY  
(REGISTERED RIGHTS) (MISCELLANEOUS  
PROVISIONS) (JERSEY) LAW 201-**

**Arrangement**

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Jersey

## **DRAFT INTELLECTUAL PROPERTY (REGISTERED RIGHTS) (MISCELLANEOUS PROVISIONS) (JERSEY) LAW 201-**

**A LAW** to amend further the Registered Designs (Jersey) Law 1957, the Patents (Jersey) Law 1957 and the Trade Marks (Jersey) Law 2000.

<i>Adopted by the States</i>	<i>[date to be inserted]</i>
<i>Sanctioned by Order of Her Majesty in Council</i>	<i>[date to be inserted]</i>
<i>Registered by the Royal Court</i>	<i>[date to be inserted]</i>

**THE STATES**, subject to the sanction of Her Most Excellent Majesty in Council, have adopted the following Law –

### **PART 1**

#### **REGISTERED DESIGNS (JERSEY) LAW 1957 AMENDED**

##### **1 Interpretation**

In this Part, “principal Law” means the Registered Designs (Jersey) Law 1957<sup>1</sup>.

##### **2 Article 1 amended**

- (1) In Article 1(1) of the principal Law –
  - (a) the definitions “article”, “copyright” and “set of articles” shall be deleted;
  - (b) for the definition “design” there shall be substituted the following definition –

“ ‘design’ means the appearance of the whole or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation;”;
  - (c) the following definitions shall be inserted in the appropriate alphabetical order –

“ ‘complex product’ means a product which is composed of at least 2 replaceable component parts permitting disassembly and reassembly of the product;”;

“ ‘product’ means any industrial or handicraft item other than a computer program and includes, in particular, packaging, get-up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product;”.

- (2) For Article 1(3) of the principal Law there shall be substituted the following paragraph –

“(3) References in this Law to the right in a registered design have the same meaning as in section 7 of the Registered Designs Act.”.

### 3 Article 5 substituted

For Article 5 of the principal Law there shall be substituted the following Article –

#### “5 Extension and restoration of rights in designs

- (1) Where –

- (a) the period for which the right in a design subsists has been extended in the United Kingdom; or  
(b) the lapsed right in a design has been restored in the United Kingdom,

the registered proprietor of the design may apply to the Judicial Greffier in such manner as may be prescribed by rules of court for the registration of the extension of the right or registration of the restoration of the right, as the case requires.

- (2) Every application under this Article shall be accompanied by a certificate of the Comptroller-General relating to the registration of the extension of the right or registration of the restoration of the right, in the United Kingdom, as the case requires.
- (3) On receipt of such an application, the Judicial Greffier shall register the extension or restoration of the right, as the case requires, unless it appears doubtful to the Judicial Greffier whether the application should be granted, or any question arises in relation to the application.
- (4) Where paragraph (3) applies, the Judicial Greffier shall present a statement of the matter in question to the Bailiff for the directions of the court, and the court may order such persons to be convened, such evidence to be taken and such enquiries to be made as the court may deem necessary and, subject to the provisions of this Law and to rules of court, shall determine whether the application should be granted.”.

**4 Article 9 substituted**

For Article 9 of the principal Law there shall be substituted the following Article –

**“9 Effect of registration**

- (1) Subject to the provisions of this Law, the registration of a design under this Law or of any title or interest in such a design (including the restoration of the right in a registered design) shall give to the registered proprietor of the design, or any other person in whom any title or interest is vested, as the case may be, the same rights and equivalent remedies in Jersey as are possessed by the registered proprietor or such a person in the United Kingdom, but, save as aforesaid, no registered design or title or interest in such a design shall have effect against any person.
- (2) The rights referred to in paragraph (1) shall have effect in Jersey from the same date from which such rights have effect in the United Kingdom and shall subsist only for as long as such rights subsist in the United Kingdom.
- (3) Notwithstanding paragraph (2), no action for infringement of the right in a registered design may be brought –
  - (a) in respect of any use of the design prior to the date of registration of the design under this Law; or
  - (b) where the right in the design has been extended or the lapsed right restored in the United Kingdom, unless such extension or restoration has been registered under this Law.”.

**5 Article 10 amended**

In Article 10 of the principal Law –

- (a) for paragraph (1)(c) there shall be substituted the following sub-paragraph –
  - “(c) that more than 3 years had elapsed between the date the application for the registration of the design was determined in the United Kingdom and the date of the registration of the design under this Law and that, on the latter date, the design was being used in Jersey on a commercial scale.”;
- (b) sub-paragraphs (d) and (e) of paragraph (1) shall be deleted.

**6 Article 13 amended**

In Article 13 (2) and (3) of the principal Law, for the word “articles” wherever they appear, there shall be substituted the word “products”.

**7 Article 14 amended**

In Article 14(4) and (5) of the principal Law for the word “articles” there shall be substituted the word “products”.

**8 Article 16 amended**

In Article 16 of the principal Law –

- (a) in paragraph (1) –
  - (i) for the word “copyright” there shall be substituted the word “right”,
  - (ii) for the words “an article” there shall be substituted the words “a product”,
  - (iii) for the words “the article” there shall be substituted the words “, or incorporated in, the product”;
- (b) in paragraph (2), for the words “copyright in a design” there shall be substituted the words “the right in a registered design”.

**9 Article 17 amended**

In Article 17 of the principal Law, for the word “copyright” each time it appears there shall be substituted the word “right”.

**10 Article 18 substituted**

For Article 18 of the principal Law there shall be substituted the following Article –

**“18 Falsification of register etc**

- (1) A person is guilty of an offence who –
  - (a) makes or causes to be made a false entry in the register of designs;
  - (b) makes or causes to be made any writing falsely purporting to be a copy of an entry in that register; or
  - (c) produces or tenders, or causes to be produced or tendered, in evidence any such writing,knowing the entry or writing to be false.
- (2) A person guilty of an offence under paragraph (1) is liable to imprisonment for a term of 2 years and a fine.”.

**11 Article 19 substituted**

For Article 19 of the principal Law there shall be substituted the following Article –

**“19 False representation that a design is registered**

- (1) If a person falsely represents that a design applied to, or incorporated in, any product sold by the person is registered in Jersey, the person shall be guilty of an offence and liable to a fine of level 3 on the standard scale.
- (2) For the purposes of paragraph (1), if a person sells a product having stamped, engraved or impressed on it or otherwise applied to it the words ‘registered in Jersey’ or any other word or words expressing or implying that the design applied to, or incorporated in, the product, is registered in Jersey, the person shall be deemed to represent that the design applied to, or incorporated in, the product, is so registered.
- (3) If any person, after the right in a registered design has expired, marks any product to which the design has been applied or in which it has been incorporated with the words ‘registered in Jersey’ or any word or words expressing or implying that the right in the registered design subsists, or causes any such product to be so marked, the person shall be guilty of an offence and liable to a fine of level 2 on the standard scale.”.

**12 Article 20 amended**

In Article 20(1)(a) of the principal Law for the words “copyright in registered designs” there shall be substituted the words “the right in a registered design”.

**13 Article 20A inserted**

After Article 20 of the principal Law there shall be inserted the following Article –

**“20A Regulations**

- (1) The States by Regulations may make such provision with respect to registered designs as they think fit, including amendment of this Law or any other enactment, in relation to any of the following –
  - (a) in so far as any such provision is, in the opinion of the States, consistent with any international treaty or agreement which applies to Jersey relating to registered designs –
    - (i) the registration of a design in Jersey (whether by way of first registration or re-registration), and
    - (ii) the exercise and enforcement of rights in a registered design, including giving effect to such rights granted in a country or territory otherwise than Jersey;
  - (b) giving effect in Jersey to any international treaty or agreement ratified by or on behalf of Jersey or which extends to Jersey, or for the purpose of enabling the ratification or extension of any international treaty or agreement;

- 
- (c) implementing, in Jersey, any obligation of the United Kingdom under the EU Treaties as defined in the European Union (Jersey) Law 1973<sup>2</sup>, whether or not that obligation applies to Jersey;
  - (d) giving effect in Jersey to any provision that applies in the United Kingdom.
- (2) Regulations under paragraph (1) may, without prejudice to the generality of that paragraph, do any of the following –
- (a) confer rights on any person or body with regard to the administration of, and decisions relating to, rights in a design, including allowing the Minister to make provision for such matters by Order;
  - (b) make provision for appeals;
  - (c) make provision for enforcement including civil remedies or criminal penalties for infringement of rights in a registered design;
  - (d) make provision for fees, including allowing the Minister to prescribe fees by Order;
  - (e) make provision for such supplementary, transitional and incidental matters as the States consider to be necessary or expedient.”.

#### 14 Article 22A inserted

After Article 22 of the principal Law there shall be inserted the following Article –

##### “22A Transitional provisions

- (1) Any act done on or after the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201-<sup>3</sup> enters into force pursuant to any agreement or arrangement made before that date shall not constitute infringement of the right in a registered design if it would not have constituted an infringement before that date.
- (2) For the avoidance of doubt, any act done before the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201- came into force shall not be treated as infringing any right in a registered design from that date if the act did not infringe any right in a registered design before that date.”.

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## PART 2

### PATENTS (JERSEY) LAW 1957 AMENDED

#### 15 Interpretation

In this Part, “principal Law” means the Patents (Jersey) Law 1957<sup>4</sup>.

#### 16 Article 1 amended

In Article 1 of the principal Law –

- (a) for the definition “invention” there shall be substituted the following definition –  
“ ‘invention’ has the same meaning as in the Patents Act 1977;”;
- (b) the definition “Statute of Monopolies” shall be deleted.

#### 17 Article 8 substituted

For Article 8 of the principal Law there shall be substituted the following Article –

##### “8 Effect of registration

- (1) Subject to the provisions of this Law, the registration of a patent under this Law or of any title or interest in such a patent (including the restoration of the patent) shall give to the patentee, or any other person in whom any title or interest is vested, as the case may be, the same rights and equivalent remedies in Jersey as are possessed by the patentee or such a person in the United Kingdom, but, save as aforesaid, no patent or title or interest in such a patent shall have effect against any person.
- (2) The rights referred to in paragraph (1) shall have effect in Jersey from the same date from which such rights have effect in the United Kingdom and shall subsist only for as long as such rights subsist in the United Kingdom.
- (3) Notwithstanding paragraph (2), no action for infringement of a right referred to in paragraph (1) may be brought –
  - (a) subject to paragraph (4), in respect of any act done prior to the date of registration of the patent under this Law; or
  - (b) where the term of the patent has been extended or the patent has been restored, unless the order for extension or restoration has been registered under this Law.
- (4) An action for infringement of a patent may be brought in respect of any act done on or after the date which is, or is treated as, the date of publication of the application for registration, extension or registration, as the case may be, under the Patents Act 1977 where –

- (a) the application for registration under this Law was made before the expiration of 6 months after the date of the grant of the patent under that Act;
- (b) the patent has been registered under this Law; and
- (c) the act would, if the patent had been registered under this Law on the date which is, or is treated as, the date of publication of the application under that Act, have infringed not only the patent but also the claims referred to in section 69 of that Act.”.

## 18 Article 9 amended

In Article 9(1) of the principal Law, sub-paragraphs (d) and (e) shall be revoked.

## 19 Articles 9A and 9B inserted

After Article 9 of the principal Law there shall be inserted the following Articles –

### “9A Compulsory licences – applications and grant

- (1) At any time after the expiration of 3 years, or such other period as the Minister may prescribe by Order, from the date of the registration of a patent under this Law, any person may apply to the court for a licence under the patent.
- (2) An application under paragraph (1) shall be on one or more of the following grounds –
  - (a) where the patented invention is a product, that a demand in Jersey for that product is not being met on reasonable terms;
  - (b) that by reason of the refusal of the patentee (‘first patentee’) to grant a licence or licences on reasonable terms –
    - (i) there is prevented or hindered the exploitation in Jersey of any other invention for which another patent has been registered under this Law, such other invention involving an important technical advance of considerable economic significance in relation to the first patentee’s invention, or
    - (ii) the establishment or development of commercial or industrial activities in Jersey is unfairly prejudiced;
  - (c) that by reason of conditions imposed by the person in whose name the patent is registered on –
    - (i) the grant of licences under the patent,
    - (ii) the disposal or use of the patented product, or
    - (iii) the use of the patented process,

- there is unfairly prejudiced the manufacture, use or disposal of materials not protected by the patent or the establishment of commercial or industrial activities in Jersey; or
- (d) that the grant of a licence is necessary to comply with any treaty or international convention which has effect in Jersey.
- (3) The court, after hearing any party with an interest in the matter who is desirous of being heard, may –
- (a) grant such a licence if satisfied of any of the grounds described in paragraph (2); or
- (b) dismiss the application.
- (4) Where the court grants a licence on the ground described in paragraph (2)(c), the court may grant a licence to customers of the applicant as well as to the applicant for the licence.
- (5) An application may be made under paragraph (1) even if the applicant is already the holder of a licence under the patent.
- (6) No person shall be estopped or barred from alleging any of the grounds specified in paragraph (2) by reason of any admission made by him or her, whether in respect of a licence held by that person or otherwise.
- (7) Where an application under paragraph (1) is made in respect of a patent by a person who holds a licence under the patent, the court –
- (a) may, if it orders the grant of a licence to the applicant under this Article, order the existing licence to be cancelled; or
- (b) may, instead of ordering the grant of a licence to the applicant, order the existing licence to be amended.
- (8) A licence must not be granted under this Article unless –
- (a) the applicant has made efforts to obtain a licence from the person in whose name the patent is registered on reasonable commercial terms and conditions; and
- (b) such efforts have not been successful within a reasonable period.
- (9) A licence must not be granted under this Article if the patent in respect of which the application is made is in the field of semi-conductor technology.
- (10) A licence must not be granted under this Article if such grant would be contrary to any treaty or international convention which has effect in Jersey.
- (11) A licence must not be granted on the ground described in paragraph (2)(b) unless the court is satisfied that the person in whose name the other patent is registered is able and willing to grant a licence under that other patent on reasonable terms to –
- (a) the first patentee; and
- (b) any licencees of the first patentee.

- (12) A licence granted on the ground described in paragraph (2)(b) must not be assigned except to a person to whom a patent for the other invention is also assigned.
- (13) A licence granted under this Article –
- (a) must not be exclusive;
  - (b) must not be assigned except to a person to whom there is also assigned the part of the enterprise or goodwill that enjoys the use of the patented invention;
  - (c) must be predominately for the supply of a market in Jersey;
  - (d) must include conditions entitling the patentee to remuneration adequate in the circumstances of the case, taking into account the economic value of the licence; and
  - (e) must be limited in scope and duration to the purpose for which the licence was granted,
- except to the extent that, in the case of a licence granted on the ground described in paragraph (2)(d), such a licence would be inconsistent with, or contravene, the treaty or international convention to which the licence gives effect.

#### **9B Other matters relating to compulsory licences**

- (1) In this Article ‘patented invention’ means the invention which is the subject of an application under Article 9A and ‘patentee’ shall be construed accordingly.
- (2) In determining whether to grant a licence under Article 9A, the court shall take into account –
- (a) the nature of the patented invention;
  - (b) the time which has elapsed since the grant of a patent for the invention in the United Kingdom;
  - (c) any measures taken by the patentee or any licensee of the patentee to make full use of the patented invention;
  - (d) the ability of the person to whom the compulsory licence would be granted to work the patented invention to the public advantage; and
  - (e) the risks to be undertaken by the person to whom the compulsory licence would be granted in providing capital and working the patented invention.
- (3) In determining whether to grant a licence under Article 9A, the court shall not be required to take into account any matters subsequent to the date of the application for the licence.
- (4) Where a licence has been granted under Article 9A the patentee or any other person may apply to the court to have the licence cancelled on the ground that the circumstances which led to the grant of the licence have ceased to exist and are unlikely to recur.

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- (5) Following an application under paragraph (4), the court, after hearing any party with an interest in the matter who is desirous of being heard, may –
    - (a) terminate the licence subject to such terms and conditions as the court thinks are necessary for the protection of legitimate interests of the licensee; or
    - (b) dismiss the application.”.

**20 Article 11 amended**

In Article 11(4) of the principal Law, for the words “privileges and rights” there shall be substituted the words “rights and equivalent remedies”.

**21 Article 21 amended**

For Article 21(3) of the principal Law, there shall be substituted the following paragraph –

- “(3) In this Article, ‘convention country’ means –
  - (a) any country which is bound by the Convention for the Protection of Industrial Property signed at Paris on 20th March 1883 (such Convention also being known as the Paris Convention); and
  - (b) any other country which is a member of the World Trade Organisation.”.

**22 Article 24A inserted**

After Article 24 of the principal Law there shall be inserted the following Article –

**“24A Regulations**

- (1) The States by Regulations may make such provision with respect to patents as they think fit, including amendment of this Law or any other enactment, in relation to any of the following –
  - (a) in so far as any such provision is, in the opinion of the States, consistent with any international treaty or agreement which applies to Jersey relating to patents –
    - (i) the grant or registration of a patent in Jersey (whether by way of first grant, registration or re-registration), and
    - (ii) the exercise and enforcement of any title or interest in a patent, including giving effect to any title or interest in a patent granted or registered in a country or territory otherwise than Jersey;
  - (b) giving effect in Jersey to any international treaty or agreement ratified by or on behalf of Jersey or which

- extends to Jersey, or for the purpose of enabling the ratification or extension of any international treaty or agreement;
- (c) implementing, in Jersey, any obligation of the United Kingdom under the EU Treaties, as defined in the European Union (Jersey) Law 1973<sup>5</sup>, whether or not that obligation applies to Jersey;
  - (d) giving effect in Jersey to any provision that applies in the United Kingdom.
- (2) Regulations under paragraph (1) may, without prejudice to the generality of that paragraph, do any of the following –
- (a) confer rights on any person or body with regard to the administration of, and decisions relating to, any title or interest in a patent, including allowing the Minister to make provision for such matters by Order;
  - (b) make provision for appeals;
  - (c) make provision for enforcement including civil remedies or criminal penalties for infringement of any title or interest in a patent;
  - (d) make provision for fees, including allowing the Minister to prescribe fees by Order;
  - (e) make provision for such supplementary, transitional and incidental matters as the States consider to be necessary or expedient.”.

### 23 Article 26A inserted

After Article 26 of the principal Law there shall be inserted the following Article –

#### “26A Transitional provisions

- (1) Any act done on or after the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201-<sup>6</sup> enters into force pursuant to any agreement or arrangement made before that date shall not constitute infringement of a registered patent if it would not have constituted an infringement before that date.
- (2) For the avoidance of doubt, any act done before the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201- came into force shall not be treated as infringing a patent from that date if the act did not infringe a patent before that date.”.

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## PART 3

### TRADE MARKS (JERSEY) LAW 2000 AMENDED

#### 24 Interpretation

In this Part, “principal Law” means the Trade Marks (Jersey) Law 2000<sup>7</sup>.

#### 25 Article 4 amended

In Article 4 of the principal Law –

- (a) paragraph (2) shall be deleted;
- (b) in paragraph (3)(c) the words “in the case of an application under paragraph (1),” shall be deleted;
- (c) in paragraph (5) after the word “Bailiff” there shall be inserted the following full-out words –
  - “
  - provided that such refusal is not contrary to any convention or treaty which has effect in Jersey.”.

#### 26 Article 6 amended

In Article 6 of the principal Law –

- (a) for the heading there shall be substituted the following heading –

**“6 Registration of assignments etc.”;**

- (b) for paragraph (1) there shall be substituted the following paragraph –

“(1) Where a person becomes entitled by assignment, transmission or other operation of law to a registered trade mark in respect of goods or services, or to a share in such a trade mark, or becomes entitled as a licensee or otherwise to any interest in such a trade mark, and has obtained registration in the United Kingdom of such title or interest in accordance with the law for the time being in force in the United Kingdom in respect of those goods or services, the person may apply to the registrar for the registration of such title or interest in the trade mark in respect of those goods or services.”;

- (c) for paragraph (3) there shall be substituted the following paragraph –

“(3) Subject to paragraphs (4) and (5), on receipt of such an application, the registrar shall register the title or interest in the trade mark in respect of the goods or services for which the application is made and issue a certificate of registration.”.

**27 Article 9 substituted**

For Article 9 of the principal Law there shall be substituted the following Article –

**“9 Effect of registration**

- (1) Subject to the provisions of this Law, the registration of a trade mark under this Law, or of any title or interest in such a trade mark, shall give to the registered proprietor, or any other person in whom any title or interest is vested, as the case may be, the same rights and equivalent remedies in Jersey in relation to the goods and services in respect of which such trade mark, title or interest is registered as are possessed by the registered proprietor, or such other person, in the United Kingdom, but, save as aforesaid, no registered trade mark, title or interest shall have effect as against any person.
- (2) The rights referred to in paragraph (1) shall have effect in Jersey from the same date from which such rights have effect in the United Kingdom and shall subsist only for as long as such rights subsist in the United Kingdom.
- (3) Notwithstanding paragraph (2), no action for infringement of the trade mark may be brought and no offence under Article 25 shall be committed –
  - (a) in respect of any use of the trade mark prior to the date of the registration of the trade mark under this Law; or
  - (b) where the registration of the trade mark in the United Kingdom has been renewed, unless such renewal has been registered under this Law.”.

**28 Part 3 amended**

For the subheading to Part 3 of the principal Law, there shall be substituted the following subheading –

“PROTECTION RELATING TO INTERNATIONAL MATTERS AND AGENTS”.

**29 Articles 13A, 13B and 13C inserted**

After Article 13 of the principal Law there shall be inserted the following Articles –

**“13A Well known trade marks**

- (1) For the purposes of this Article references to a well known trade mark are references to a trade mark as described in section 56(1) of the Trade Marks Act as if, in that subsection, the reference to the United Kingdom were a reference to Jersey.

- (2) Where a proprietor of a well known trade mark is entitled under section 56(2) of the Trade Marks Act to restrain by injunction a trade mark in the circumstances described in that subsection, the proprietor is entitled to restrain by injunction the use of such a trade mark in Jersey regardless of whether –
  - (a) an injunction has been obtained in the United Kingdom; or
  - (b) the person is a registered proprietor.
- (3) Where a proprietor of a well known trade mark (whether or not a registered proprietor) would be entitled to restrain by injunction the use of a trade mark under section 56(2) of the Trade Marks Act if the reference in sub-section (2) to use in the United Kingdom were to use in Jersey, that proprietor shall be entitled to restrain by injunction the use in Jersey of such a trade mark.
- (4) The right to restrain by injunction as referred to in paragraph (2) or (3) is subject to –
  - (a) section 48 of the Trade Marks Act, where applicable; or
  - (b) section 48 of the Trade Marks Act as if the reference in sub-section (1) to use of a registered trade mark in the United Kingdom were, instead to use in Jersey of a registered trade mark under this Law.
- (5) Nothing in this Article affects the continuation of any bona fide use of a trade mark after the date this Law comes into force where such use started before that date.

### **13B State emblems, official signs etc**

- (1) Where a competent authority or international organisation is entitled to restrain by injunction the use in the United Kingdom of a trade mark under section 57(6) or 58(4) of the Trade Marks Act, as the case may be, that authority or organisation shall be entitled to restrain by injunction the use in Jersey of such a trade mark regardless of whether –
  - (a) an injunction has been obtained in the United Kingdom; or
  - (b) the competent authority or international organisation is a registered proprietor.
- (2) Where a competent authority or international organisation (whether or not a registered proprietor) would be entitled to restrain by injunction the use of a trade mark under section 57(6) or 58(4) of the Trade Marks Act, if, in the relevant paragraph, the reference to use in the United Kingdom were to use in Jersey, that authority or organisation shall be entitled to restrain by injunction the use in Jersey of such a trade mark.
- (3) Nothing in this Article affects the rights of a person whose bona fide use of the trade mark in question began before the date that this Article comes into force.

**13C Acts of agents and representatives**

- (1) Where the proprietor of a trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark under section 60(4) of the Trade Marks Act, the proprietor shall be entitled to restrain by injunction the use in Jersey of such a trade mark regardless of whether –
  - (a) an injunction has been obtained in the United Kingdom; or
  - (b) the person is a registered proprietor.
- (2) Where the proprietor of a trade mark (whether or not a registered proprietor) would be entitled to restrain by injunction the use of a trade mark under section 60(4) of the Trade Marks Act, if, in that paragraph, the reference to use in the United Kingdom were to use in Jersey, the proprietor shall be entitled to restrain by injunction the use in Jersey of such a trade mark.
- (3) An application under this Article must be made within the time limits described in section 60(6) of the Trade Marks Act”.

**30 Article 26A inserted**

After Article 26 of the principal Law there shall be inserted the following Article –

**“26A Search warrants**

- (1) Where the Bailiff or a Jurat is satisfied by information on oath given by a police officer that there are reasonable grounds for believing –
  - (a) that an offence under Article 25 has been or is about to be committed in any premises; and
  - (b) that evidence that the offence has been or is about to be committed is in those premises,he or she may issue a warrant authorizing a police officer to enter and search the premises, using any reasonable force necessary.
- (2) The power conferred by paragraph (1) does not extend to authorizing a search for materials of the kinds mentioned in Article 16(2) of the Police Procedures and Criminal Evidence (Jersey) Law 2003<sup>8</sup>.
- (3) A warrant under this Article –
  - (a) may authorize persons to accompany any police officer executing the warrant; and
  - (b) remains in force for 28 days from the date of its issue.
- (4) In executing a warrant issued under this Article a police officer may seize an article if he or she reasonably believes that it is evidence that any offence under Article 25 has been or is about to be committed.

- (5) In this Article ‘premises’ includes land, buildings, fixed or moveable structures, vehicles, vessels, aircraft and hovercraft.”

### 31 Article 31A inserted

After Article 31 of the principal Law there shall be inserted the following Article –

#### “31A Regulations

- (1) The States by Regulations may make such provision with respect to trade marks as they think fit, including amendment of this Law or any other enactment, in relation to any of the following –
- (a) in so far as any such provision is, in the opinion of the States, consistent with any international treaty or agreement which applies to Jersey relating to trade marks –
    - (i) the registration of a trade mark in Jersey (whether by way of first registration or re-registration), and
    - (ii) the exercise and enforcement of any title or interest in a trade mark, including giving effect to such title or interest granted in a country or territory otherwise than Jersey;
  - (b) giving effect in Jersey to any international treaty or agreement ratified by or on behalf of Jersey or which extends to Jersey, or for the purpose of enabling the ratification or extension of any international treaty or agreement;
  - (c) implementing, in Jersey, any obligation of the United Kingdom under the EU Treaties as defined in the European Union (Jersey) Law 1973<sup>9</sup>, whether or not that obligation applies to Jersey;
  - (d) giving effect in Jersey to any provision that applies in the United Kingdom.
- (2) Regulations under paragraph (1) may, without prejudice to the generality of that paragraph, do any of the following –
- (a) confer rights on any person or body with regard to the administration of, and decisions relating to, any title or interest in a trade mark, including allowing the Minister to make provision for such matters by Order;
  - (b) make provision for appeals;
  - (c) make provision for enforcement including civil remedies or criminal penalties for infringement of any title or interest in a trade mark;
  - (d) make provision for fees, including allowing the Minister to prescribe fees by Order;

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- (e) make provision for such supplementary, transitional and incidental matters as the States consider to be necessary or expedient.”.

### 32 Article 36A inserted

After Article 36 of the principal Law there shall be inserted the following Article –

#### “36A Transitional provisions

- (1) Any act done on or after the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201-<sup>10</sup> enters into force pursuant to any agreement or arrangement made before that date shall not constitute infringement of a registered trade mark if it would not have constituted an infringement before that date.
- (2) For the avoidance of doubt, any act done before the date that the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201- came into force shall not be treated as infringing a trade mark from that date if the act did not infringe a trade mark before that date.”.

### 33 Citation and commencement

This Law may be cited as the Intellectual Property (Registered Rights) (Miscellaneous Provisions) (Jersey) Law 201- and shall come into force 7 days after it is registered.

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- <sup>1</sup> *chapter 05.700*
  - <sup>2</sup> *chapter 17.210*
  - <sup>3</sup> *P.69/2015*
  - <sup>4</sup> *chapter 05.575*
  - <sup>5</sup> *chapter 17.210*
  - <sup>6</sup> *P.69/2015*
  - <sup>7</sup> *chapter 05.900*
  - <sup>8</sup> *chapter 23.750*
  - <sup>9</sup> *chapter 17.210*
  - <sup>10</sup> *P.69/2015*