

TRADE MARKS ACT

CHAPTER 82:81

Act
8 of 2015

Current Authorised Pages

<i>Pages</i> <i>(inclusive)</i>	<i>Authorised</i> <i>b</i>	<i>O.</i>
1–223	..	

Index of Subsidiary Legislation

	<i>Page</i>
Trade Marks Regulations (LN 137/2020)	107
Trade Marks (Border Enforcement Measures) Regulations (LN 138/2020) ...	184
Trade Marks (International Registration) Regulations (LN 290/2020) ...	191

Note on Act No. 8 of 2015

Act No. 8 of 2015 which repealed and replaced the Trade Marks Act, Chap. 82:81 took effect on 25th June 2020 by LN 141/2020.

CHAPTER 82:81

TRADE MARKS ACT

ARRANGEMENT OF SECTIONS

SECTION

PART I

PRELIMINARY

1. Short title and commencement.
2. Act inconsistent with Constitution.
3. Interpretation.

PART II

REGISTRATION OF TRADE MARKS

4. Registered trade marks.
5. Application for registration.
6. Division of application for registration.
7. Classification of goods and services.
8. Absolute grounds for refusal of registration.
9. Relative grounds for refusal of registration.
10. Raising of relative grounds in case of honest concurrent use.
11. Claim to priority of Convention application.
12. Claim to priority from other relevant overseas application.
13. Examination of application.
14. Publication and opposition proceedings.
15. Withdrawal, restriction or amendment of application.
16. Registration of trade mark.
17. Revocation of acceptance.
18. Registration of a series of trade marks.
19. Duration.
20. Renewal of registration.
21. Alteration of registered trade mark.
22. Cancellation of registered trade mark.
23. Revocation of registration.

ARRANGEMENT OF SECTIONS—*Continued*

SECTION

24. Grounds for invalidity of registration.
25. Effect of acquiescence.
26. Amendment of other documents.
27. Rights conferred by registered trade mark.
28. Acts constituting infringement of a registered trade mark.
29. Acts not constituting infringement.
30. Exhaustion of rights conferred by registered trade marks.
31. Registration subject to disclaimer or limitation.
32. Action for infringement.
33. Order for erasure of offending sign.
34. Order for delivery up of infringing goods, materials or articles.
35. Meaning of “infringing goods, material or articles” and “counterfeit goods and trade mark”.
36. Order as to disposal of infringing goods, material or articles.
37. Remedy for groundless threats of infringement proceedings.

PART III

REGISTERED TRADE MARK AS OBJECT OF
PROPERTY

38. Nature of registered trade mark.
39. Co-ownership of registered trade mark.
40. Assignment of registered trade mark.
41. Registration of transactions affecting registered trade mark.
42. Trust and equities.
43. Application for registration of trade mark as object of property.

PART IV

LICENSING

44. Licensing of registered trade mark.
45. Exclusive licences.
46. General provisions as to rights of licensees in case of infringement.
47. Exclusive licensee having rights and remedies of assignee.
48. Use of trade marks on the internet.

SECTION

PART V

OFFENCES

- 49. Counterfeiting a trade mark.
- 50. Falsely applying a registered trade mark to goods or services.
- 51. Making or possessing of article for committing offence.
- 52. Importing or selling of goods with falsely applied trade mark.
- 53. Falsification of Register.
- 54. Falsely representing trade mark as registered.
- 55. Forfeiture and destruction of goods on conviction.
- 56. Enforcement measures.

PART VI

INTERNATIONAL MATTERS

The Madrid Protocol

- 57. Power to make provision giving effect to Madrid Protocol, etc.
- 58. Protection of well-known trade marks.
- 59. Permitted use of well-known trade marks.
- 60. National emblems, etc., of Convention countries: Article 6ter of Paris Convention and TRIPS Agreement.
- 61. Emblems, etc., of certain international organisations: Article 6ter of Paris Convention and TRIPS Agreement.
- 62. Notification under Article 6ter of Paris Convention and TRIPS Agreement.
- 63. Acts of agent or representative: Convention country.

PART VII

COLLECTIVE MARKS

- 64. Collective marks.
- 65. Registration of collective marks.
- 66. Rules governing use of collective marks.
- 67. Controller's discretion regarding rules.
- 68. Rules to be open to inspection.
- 69. Amendment of rules.
- 70. Rights of authorised users regarding infringement of a collective mark.

ARRANGEMENT OF SECTIONS—*Continued*

SECTION

- 71. Grounds for revocation of registration of collective marks.
- 72. Grounds for invalidity of registration.

PART VIII

CERTIFICATION MARKS

- 73. Certification marks.
- 74. Registration of certification marks.
- 75. Rules governing use of certification mark.
- 76. Controller's discretion regarding Rules.
- 77. Rules to be open to inspection.
- 78. Amendment of rules.
- 79. Consent to assignment of registered certification mark.
- 80. Rights of authorised users regarding infringement of a certification mark.
- 81. Grounds for revocation of registration.
- 82. Grounds for invalidity of registration.

PART IX

REGISTER OF TRADE MARKS

- 83. The Register.
- 84. Inspections of, and extract from, Register.
- 85. Rectification or correction of Register.

PART X

POWERS AND DUTIES OF CONTROLLER

- 86. Costs awarded by Controller.
- 87. Extensions of time.
- 88. Hearing before exercise of Controller's discretion.
- 89. Security for costs.
- 90. Evidence before Controller.
- 91. Disobedience to summons an offence.
- 92. Refusal to give evidence an offence.
- 93. Exclusion of liability in respect of official acts.

SECTION

- 94. Jurisdiction of Court.
- 95. Recognition of agents.

PART XI

BORDER ENFORCEMENT MEASURES

- 96. Interpretation of Part XI (Border Enforcement Measures).
- 97. Restriction of importation of infringing goods.
- 98. Security for liability or expense of seizure.
- 99. Secure storage of seized goods.
- 100. Notice of seizure.
- 101. Inspection, release, etc., of seized goods.
- 102. Forfeiture of seized goods by consent.
- 103. Compulsory release of seized goods to importer.
- 104. Compensation for failure to take action.
- 105. Actions for infringement of registered trade mark.
- 106. Retention of control of seized goods.
- 107. Disposal of seized goods ordered to be forfeited.
- 108. Insufficient security.
- 109. Detention and examination of counterfeit goods.
- 110. Powers of search in relation to vessels, aircraft and vehicles.
- 111. Examination of packages, etc.
- 112. Power to remove packages and goods to police station or Customs area.
- 113. Search of persons and baggage.
- 114. Obstruction.
- 115. Immunity of Officers.

PART XII

MISCELLANEOUS

- 116. Practice Directions.
- 117. Registration to be *prima facie* evidence.
- 118. Certificate of validity.
- 119. Certificate of Controller.
- 120. Costs of proceedings before Court.

ARRANGEMENT OF SECTIONS—*Continued*

SECTION

- 121. Burden of proving use of trade mark.
- 122. Offence committed by partnership or body corporate.
- 123. Regulations.

PART XIII

TRANSITIONAL

- 124. Interpretation of Part XIII (Transitional).
- 125. Existing registered marks.
- 126. Effects of registration: infringement.
- 127. Infringing goods, materials or articles.
- 128. Rights and remedies of licensee or authorised user.
- 129. Co-ownership of registered mark.
- 130. Assignment of registered mark.
- 131. Licensing of registered trade mark.
- 132. Pending applications for registration.
- 133. Conversion of pending application.
- 134. Claim to priority from overseas application.
- 135. Renewal of registration.
- 136. Pending application for registration for alteration of registered mark.
- 137. Revocation for non-use.
- 138. Application for rectification and correction.
- 139. Rules as to use of certification mark.
- 140. Certificate of validity.

PART XIV

REPEAL

- 141. Repeal Ch. 82:81.
-

CHAPTER 82:81

TRADE MARKS ACT

**An Act to repeal and replace the Trade Marks Act, Chap. 82:81
and to provide for the law relating to trade marks and
related matters.**

*[ASSENTED TO 12TH JUNE 2015]

WHEREAS it is enacted by section 13(1) of the Constitution of the Republic of Trinidad and Tobago (“the Constitution”) that an Act of Parliament to which that section applies may expressly declare that it shall have effect even though inconsistent with sections 4 and 5 of the Constitution and, if any Act does so declare, it shall have effect accordingly: Preamble.

And whereas it is provided in section 13(2) of the Constitution that an Act of Parliament to which that section applies is one the Bill for which has been passed by both Houses of Parliament and at the final vote thereon in each House has been supported by the votes of not less than three-fifths of all the members of that House:

And whereas it is necessary and expedient that the provisions of this Act shall have effect even though inconsistent with sections 4 and 5 of the Constitution:

ENACTED by the Parliament of Trinidad and Tobago as follows: Enactment.

PART I

PRELIMINARY

1. (1) This Act may be cited as the Trade Marks Act. Short title and commencement.
(2) This Act came into operation on 25th June 2020.
2. This Act shall have effect even though inconsistent with sections 4 and 5 of the Constitution. Act inconsistent with Constitution.

*See section 1(2) for the date on which this Act came into force. (LN 141/2020).

Interpretation.

3. (1) In this Act, unless the context otherwise requires—

“business” includes a trade or profession;

“business identifier” means any sign capable of being represented graphically which is used to identify any business;

“certification mark” has the meaning assigned to it in section 73(2);

“collective mark” has the meaning assigned to it in section 64(2);

Ch. 82:76.

“Controller” means the Controller of the Intellectual Property Office as referred to under section 3 of the Patents Act;

“Convention country” means—

(a) a country or territory, other than Trinidad and Tobago, which is a—

- (i) party to the Paris Convention; or
- (ii) member of the World Trade Organisation; and

(b) in any other provision of this Act, a country or territory which is a—

- (i) party to the Paris Convention; or
- (ii) member of the World Trade Organisation;

“counterfeit goods” and “counterfeit trade mark” have the meanings assigned to them in section 35;

“Court” means the High Court;

“dilution” in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is any—

- (a) competition between the proprietor of the trade mark and any other party; or
- (b) likelihood of confusion on the part of the public;

“earlier trade mark” means—

- (a) a registered trade mark or an international trade mark (Trinidad and Tobago), the application for registration of which was made earlier than the

trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks; or

- (b) a trade mark which, at the date of application for registration of the trade mark in question or, where appropriate, of the priority claimed in respect of the application, was a well-known trade mark, and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“exclusive licence” means a licence, whether general or limited, authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence, and the expression “exclusive licensee” shall be construed accordingly;

“former Act” means the Trade Marks Act repealed by section 141; Ch. 82:81.

“geographical indication” has the meaning assigned to it in section 2 of the Geographical Indications Act; Ch. 82:78.

“infringement proceedings” means proceedings relating to the infringement of a registered trademark;

“infringing goods, materials or articles” has the meaning assigned to it in section 35;

“Intellectual Property Office” has the meaning assigned to it in section 2 of the Patents Act; Ch. 82:76.

“International Classification” means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as may be revised from time to time;

“Minister” means the Minister with responsibility for intellectual property rights;

“National Classification” means the system of classification of goods utilised prior to October 20, 1994;

Ch. 78:01.

“Officer” has the meaning assigned under section 2 of the Customs Act;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as may be revised from time to time;

“prescribed” means prescribed by the Regulations;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“proprietor” means—

- (a) in relation to a registered trade mark, the person in whose name the trade mark is registered; or
- (b) in relation to an unregistered trade mark that is a well-known trade mark, the person to whom the trade mark belongs;

“Register” means the Register referred to in section 83;

“Regulations” means Regulations made under section 123;

“sign” includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

“trade” includes any business or profession;

“trade mark” means, except in relation to a certification trade mark, any sign capable of being represented graphically and which is capable of distinguishing goods or services dealt with or provided in the course of trade by a person, from goods or services so dealt with or provided by any other person;

“trade name” means the name or designation identifying and distinguishing an enterprise or its goodwill;

“TRIPS Agreement” means the Agreement on Trade Related Aspects of Intellectual Property Rights, set out in Annex 1C to the WTO Agreement, as revised or amended from time to time;

“well-known trade mark” means—

- (a) any registered trade mark that is well known in Trinidad and Tobago; or

(b) any unregistered trade mark that is well known in Trinidad and Tobago and that belongs to a person who is—

- (i) a national of a Convention country;
or
- (ii) domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Trinidad and Tobago;

“WTO” means the World Trade Organisation;

“WTO Agreement” means the World Trade Organisation Agreement signed in Marrakesh in 1994 as revised or amended from time to time.

(2) References in this Act to a trade mark include any trade mark which relates to a service that is ancillary to goods or services dealt with or provided in the course of trade by a person, whether or not the service is provided for money or money’s worth.

(3) References in this Act to a trade mark include, unless the context otherwise requires, a collective mark or a certification mark.

(4) References in this Act to use, or any particular description of use, of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use, or that description of use, otherwise than by means of a graphic representation.

(5) References in this Act to registration are, unless the context otherwise requires, to registration in the Register.

(6) In this Act, a sign is taken to be applied to goods, material or any other thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing.

(7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Trinidad and Tobago, it shall be relevant to take into account any matter from

which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to, or recognised by any relevant sector of the public in Trinidad and Tobago;
- (b) the duration, extent and geographical area of any—
 - (i) use of the trade mark; or
 - (ii) promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;
- (c) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory; and
- (e) any value associated with the trade mark.

(8) Where it is determined that a trade mark is well known to any relevant sector of the public in Trinidad and Tobago, the trade mark shall be deemed to be well known in Trinidad and Tobago.

(9) In subsections (7) and (8), “relevant sector of the public in Trinidad and Tobago” includes any of the following:

- (a) all actual consumers and potential consumers in Trinidad and Tobago of the goods or services to which the trade mark is applied;

- (b) all persons in Trinidad and Tobago involved in the distribution of the goods or services to which the trade mark is applied; and
- (c) all businesses and companies in Trinidad and Tobago dealing in the goods or services to which the trade mark is applied.

PART II

REGISTRATION OF TRADE MARKS

4. (1) A registered trade mark is a property right obtained by the registration of a trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.

Registered trade marks.

(2) No proceedings shall lie to prevent or recover damages for the infringement of an unregistered trade mark as such and nothing in this Act affects the law relating to passing off, or rights under the Protection Against Unfair Competition Act and the Geographical Indications Act.

Ch. 82:36.

Application for Registration of a Trade Mark

5. (1) An application for registration of a trade mark shall be made in the prescribed manner to the Controller.

Application for registration.

- (2) An application under subsection (1) shall—
 - (a) contain a request for the registration of a trade mark;
 - (b) state the name and address of the applicant;
 - (c) contain a clear representation of the trade mark;
 - (d) list the goods or services in relation to which the applicant seeks to register the trade mark; and
 - (e) state—
 - (i) that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services; or

- (ii) that the applicant has a *bona fide* intention that the trade mark should be so used.

(3) An application under subsection (1) shall be accompanied by such fees as may be prescribed.

(4) The date of an application under subsection (1) shall be the earliest date on which—

- (a) all the requirements under subsection (2) have been satisfied; and
- (b) all the fees payable under subsection (3)—
 - (i) have been paid; or
 - (ii) are treated by the Controller as paid.

Division of
application for
registration.

6. (1) Subject to subsection (2) and the Regulations, an application under section 5 may, at the request of the applicant, be divided into two or more separate applications.

(2) A request under subsection (1) shall be—

- (a) made to the Controller—
 - (i) in the prescribed manner; and
 - (ii) before the trade mark is registered; and
- (b) accompanied by the prescribed fee.

Classification
of goods and
services.

7. (1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Controller, whose decision shall be final.

Grounds for Refusal of Registration

Absolute
grounds for
refusal of
registration.

8. (1) Subject to subsection (2), the following shall not be registered:

- (a) a sign which does not satisfy the definition of a trade mark in section 3;
- (b) a trade mark which is devoid of any distinctive character;

- (c) a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; or
- (d) a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(4) A trade mark shall not be registered if it is—

- (a) contrary to public policy or to morality; or
- (b) of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services.

(5) A trade mark shall not be registered if, or to the extent that, its use is prohibited in Trinidad and Tobago by any written law.

(6) A trade mark shall not be registered if, or to the extent that, the application is made in bad faith.

(7) Notwithstanding subsection (2), a trade mark shall not be registered if it contains or consists of a geographical

indication and the trade mark is used or intended to be used in relation to goods or services not originating from the place indicated in the geographical indication.

(8) Subsection (7) shall apply—

(a) whether or not the trade mark has, or is accompanied by—

(i) an indication of the true geographical origin of the goods or services, as the case may be; or

(ii) an expression such as “kind”, “type”, “style”, “imitation” or the like; and

(b) irrespective of the language in which the geographical indication is expressed in the trade mark.

(9) A trade mark shall not be refused registration by virtue of subsection (7) if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or its predecessor in title, either—

(a) before the commencement of this Act; or

(b) before the geographical indication in question is protected in its country of origin.

(10) A trade mark shall not be refused registration by virtue of subsection (7) if the geographical indication in question has—

(a) ceased to be protected; or

(b) fallen into disuse,

in its country of origin.

(11) A trade mark shall not be registered in the cases specified in sections 60 and 61.

9. (1) A trade mark shall not be registered if it is identical to an earlier trade mark and the goods or services for which the trade mark is sought to be registered are identical to the goods or services for which the earlier trade mark is protected.

Relative
grounds for
refusal of
registration.

(2) A trade mark shall not be registered if there exists a likelihood of confusion on the part of the public because the trade mark is—

- (a) identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
- (b) similar to an earlier trade mark and is to be registered for goods or services identical to, or similar to those for which the earlier trade mark is protected.

(3) Where an application for registration of a trade mark is made and the trade mark is—

- (a) identical to, or similar to an earlier trade mark; and
- (b) to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

the trade mark shall not be registered if—

- (c) the earlier trade mark is well-known in Trinidad and Tobago and—
 - (i) use of the trade mark in relation to the goods or services for which the trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
 - (ii) there exists a likelihood of confusion on the part of the public because of such use; and
 - (iii) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use; or
- (d) the earlier trade mark is well-known in Trinidad and Tobago and would—
 - (i) cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

- (ii) take unfair advantage of the distinctive character of the earlier trade mark.

(4) A trade mark shall not be refused registration by virtue of subsection (3) if the application for the registration of the trade mark was filed before the earlier trade mark became well-known in Trinidad and Tobago, unless it is shown that the application was made in bad faith.

(5) In deciding whether any such application was made in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of, or reason to know of, the earlier trade mark.

(6) A trade mark shall not be registered if, or to the extent that, its use in Trinidad and Tobago is liable to be prevented by virtue of—

- (a) any rule of law, in particular the law of passing off, protecting an unregistered trade mark or other sign used in the course of trade; or
- (b) an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of design.

(7) A person entitled under subsection (6) to prevent the registration of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(8) Notwithstanding subsections (1) to (4), the Controller shall register a trade mark where the proprietor of the earlier trade mark, or of an earlier right in relation to the trade mark, consents to the registration.

(9) The Controller may, in his discretion, register any trade mark referred to in subsection (3) or (6) where the proprietor of the earlier trade mark or other earlier right fails to give to the Controller notice of opposition to the registration in accordance with section 14.

(10) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 3 and whose registration expires, shall continue to be taken into account in determining the registrability of a trade mark for a period of one year after its expiration, unless the Controller is satisfied that there was no bona fide use of the trade mark during the two years immediately preceding the expiration.

(11) Where separate applications are made by different persons to be registered as proprietors respectively, of trade marks that are identical or nearly resemble each other in respect of the same, similar or related goods or services or description of goods or services, the Controller may refuse to register any of them until their rights have been determined by the Court.

10. (1) Where, on an application for the registration of a trade mark, it appears to the Controller—

Raising of
relative grounds
in case of
honest
concurrent use.

(a) that there is an earlier trade mark in relation to which the conditions set out in section 9(1), (2) or (3) apply; or

(b) that there is an earlier right in relation to which the conditions set out in section 9(6) is satisfied,

but the applicant shows to the satisfaction of the Controller that there has been honest concurrent use in the course of trade in Trinidad and Tobago of the trade mark for which registration is sought, the Controller shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) Nothing in this section shall affect the—

(a) refusal of registration on the grounds mentioned in section 8; or

(b) making of an application for a declaration of invalidity under section 24(3).

Claim to
priority of
Convention
application.

Priority

11. (1) Subject to subsection (6), where—

- (a) a person has filed an application for the registration of a trade mark in a Convention country in respect of certain goods or services;
- (b) the application is the first application for the registration of the trade mark to be filed in any Convention country in respect of those goods or services (referred to in this section as “the first Convention application”); and
- (c) within six months after the date on which the first Convention application is filed, the person or his successor in title applies under this Act for the registration of the trade mark in respect of all or any of those goods or services,

the person or his successor in title may, when filing the application under this Act, claim a right of priority for the registration of the trade mark in respect of all or any of the goods or services for which registration was sought in the first Convention application.

(2) Where any person claims the right of priority referred to in subsection (1), the person shall have priority from the date on which the first Convention application was filed.

(3) Where the right of priority referred to in subsection (1) is claimed in respect of a trade mark, the registrability of the trade mark in Trinidad and Tobago shall not be affected by any use of the trade mark in Trinidad and Tobago in the period between—

- (a) the date on which the first Convention application was filed; and
- (b) the date on which the application under this Act was filed.

(4) Any filing which in a Convention country is equivalent to a regular national filing under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) For the purposes of subsection (4), “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the Convention country, whatever may be the subsequent result of the application.

(6) Where a subsequent application concerning the same subject as an earlier Convention application is filed in the same or a different Convention country, and these are the first two applications concerning that subject to be filed in any Convention country, and—

- (a) the earlier application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) the earlier application has not yet served as a basis for claiming a right of priority,

the date on which the subsequent application was filed, rather than the date of the earlier application, shall be considered the starting date of the period of priority under subsection (2), and the earlier application shall not thereafter serve as a basis for claiming priority.

(7) A right of priority arising under this section may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the applicant’s successor in title shall be construed accordingly.

12. (1) The Minister may, on the advice of the Controller, by Order, confer on a person who has filed an application for the registration of a trade mark in a country or territory with which the State has entered into a treaty, convention, arrangement, or engagement for the reciprocal protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

Claim to priority from other relevant overseas application.

(2) An Order under this section may make provisions corresponding to those set out in section 11 or such other provisions as appear to the Minister to be appropriate.

(3) An Order made under this section shall be subject to negative resolution of Parliament.

Registration Procedure

Examination of
application.

13. (1) The Controller shall examine whether an application for registration of a trade mark satisfies the requirements of this Act.

(2) For the purpose of subsection (1), the Controller shall, to such extent as he considers necessary, carry out a search of earlier trade marks.

(3) If it appears to the Controller that the requirements for registration are not met or that additional information or evidence is required to meet those requirements, the Controller shall inform the applicant and give him an opportunity, within such period as may be prescribed, to make representations, to amend the application or to furnish additional information or evidence.

(4) If the applicant responds within the period referred to in subsection (3) but fails to satisfy the Controller that those requirements are met, or to amend the application or furnish additional information or evidence so as to meet them, the Controller may refuse to accept the application.

(5) If the applicant fails to respond within the period referred to in subsection (3), the application shall be treated as withdrawn.

(6) If it appears to the Controller that the requirements for registration are met, the Controller shall accept the application.

(7) Where the application is treated as withdrawn under subsection (5), the Controller may reinstate the application in such manner and in such conditions as may be prescribed.

Publication and
opposition
proceedings.

14. (1) Where the Controller accepts an application under section 13, he shall cause the application, as accepted, to be published in the prescribed manner.

(2) A person may, within the prescribed time from the date of the publication of the application, give notice to the Controller of opposition to the registration.

(3) A notice under subsection (2) shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition and such other matter as may be prescribed.

(4) Where an application has been published, any person may, at any time before the registration of the mark, make observations in writing to the Controller as to whether the mark should be registered and the Controller shall inform the applicant of any such observations.

(5) A person who makes observations does not thereby become a party to any proceedings in relation to the application.

15. (1) An applicant may at any time withdraw his application or restrict the goods or services covered by the application.

Withdrawal, restriction or amendment of application.

(2) If an application has been published, the withdrawal or restriction shall also be published.

(3) Subject to subsection (1), an application may only be amended at the request of the applicant, by correcting—

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes,

where the correction does not substantially affect the identity of the mark or extend the goods or services covered by the application.

16. (1) Where an application has been accepted and—

- (a) no notice of opposition is given within the period referred to in section 14(2); or
- (b) all opposition proceedings are withdrawn or decided in favour of the applicant,

the Controller shall register the trade mark.

Registration of trade mark.

(2) A trade mark, when registered, shall be registered as of the date of the application for registration, and that date is deemed, for the purposes of this Act, to be the date of registration.

(3) On the registration of a trade mark, the Controller shall issue to the applicant a certificate of registration.

Revocation of acceptance.

17. (1) Notwithstanding section 16(1) if, before a trade mark is registered, the Controller is satisfied—

- (a) that the application for registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- (b) that, in the special circumstances of the case, the trade mark should not be registered,

the Controller may revoke the acceptance of the application.

(2) If the Controller revokes the acceptance of an application—

- (a) the application shall be taken to have never been accepted; and
- (b) section 13 shall apply in relation to the application.

Series of Trade Marks

Registration of a series of trade marks.

18. (1) A person may make a single application under section 5 for the registration of a series of trade marks in respect of the same goods or services, or of similar goods or services which fall within a single class in accordance with the system of classification referred to in section 7.

(2) For the purposes of this Act, “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) If the application meets all the requirements under this Act, the Controller shall register the trade marks as a series in one registration.

Duration, Renewal and Alteration of Registered Trade Mark

19. (1) A trade mark shall be registered for a period of ten years from the date of registration. Duration.

(2) Registration may be renewed in accordance with section 20 for further periods of ten years.

20. (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the fee referred to in subsection (3) or the fees referred to in subsection (4), as the case may be. Renewal of registration.

(2) A request for renewal shall be made not later than six months after the date of expiration of the registration.

(3) Where the request for renewal is made on or before the date of expiration of the registration, the fee payable shall be the prescribed renewal fee.

(4) Where the request for renewal is made within the period of six months after the date of expiration of the registration, the fees payable shall be the prescribed renewal fee and the prescribed late renewal fee.

(5) Renewal shall take effect from the expiration of the previous registration.

(6) If the registration is not renewed in accordance with this section and the Regulations, the Controller shall remove the trade mark from the Register.

(7) Upon the filing of a renewal application, if the goods in respect of such application to be renewed were classified under the National Classification, the renewal application shall be accompanied by an amendment to reclassify the goods from the National Classification to the International Classification.

21. (1) Subject to subsection (2), a registered trade mark shall not be altered in the Register, either during the period of registration or on renewal. Alteration of registered trade mark.

(2) The Controller may, at the request of the proprietor, allow the alteration of a registered trade mark where the trade mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the trade mark.

Cancellation, Revocation and Invalidity

Cancellation of
registered trade
mark.

22. A registered trade mark may be cancelled by the proprietor in respect of some or all of the goods or services for which it is registered.

Revocation of
registration.

23. (1) The registration of a trade mark may be revoked on any of the following grounds:

- (a) that, within the period of five years following the date of completion of the registration procedure, it has not been put to bona fide use in the course of trade in Trinidad and Tobago, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that its use has been suspended for a continuous period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered; or
- (d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is likely to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1)—

- (a) “use of a trade mark” includes use in a form differing in elements which do not alter the

distinctive character of the trade mark in the form in which it was registered; and

- (b) “use of a trade mark in Trinidad and Tobago” includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Trinidad and Tobago solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the grounds mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiration of the five-year period and prior to the application for revocation.

(4) Any commencement or resumption of use referred to in subsection (3) after the expiration of the five-year period but within the period of three months before the making of the application for revocation shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application may be made.

(5) An application for revocation may be made by any person to the Controller or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; or
(b) if, in any circumstances other than those referred to in paragraph (a), the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

(6) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor are deemed to have ceased to that extent from—

- (a) the date of the application for revocation; or

- (b) an earlier date, if the Controller or the Court is satisfied that the grounds for revocation existed at an earlier date.

Grounds for
invalidity of
registration.

24. (1) The registration of a trade mark may be declared invalid on the grounds that the trade mark was registered in breach of section 8.

(2) Where the registered trade mark was registered in breach of section 8 in that it is a trade mark referred to in subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered.

(3) The registration of a trade mark may be declared invalid on the ground—

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 9(1), (2) or (3) apply; or
(b) that there is an earlier right in relation to which the condition set out in section 9(6) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(4) The registration of a trade mark may be declared invalid on the ground of fraud in the registration or on the ground that the registration was obtained by misrepresentation.

(5) An application for a declaration of invalidity may be made by any person to the Controller or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; or
(b) if, in any circumstances other than those referred to in paragraph (a), the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

(6) An application for a declaration of invalidity of the registration of a trade mark on the ground that it was in breach of section 8(7) shall not be made after the expiration of five years from—

- (a) the date of registration of the trade mark; or
- (b) the date on which use of the trade mark by the person who applied for its registration or his predecessor in title became generally known in Trinidad and Tobago,

whichever is the earlier, unless the applicant shows to the satisfaction of the Controller or the Court that the registration of the trade mark was applied for in bad faith.

(7) An application for a declaration of invalidity of the registration of a trade mark on the ground that there is an earlier trade mark in relation to which the conditions set out in section 9(3) apply—

- (a) shall not be made after the expiration of five years from the commencement of this Act or the date of completion of the registration procedure, whichever is the later, unless the applicant for the declaration shows that—
 - (i) the registration of the later trade mark was applied for in bad faith; or
 - (ii) the later trade mark was never used; and
- (b) shall not be granted if the registration of the later trade mark was applied for before the earlier trade mark became well-known in Trinidad and Tobago, unless the applicant for the declaration shows that the registration of the later trade mark was applied for in bad faith.

(8) In deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark.

(9) Where the ground of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(10) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

(11) Subsection (10) shall not affect transactions past and closed.

(12) The use of a trade mark by the proprietor in a form differing in elements which do not alter the distinctive character of the trade mark in the form in which it was registered in Trinidad and Tobago shall not entail invalidation of the registration and shall not diminish the protection granted to the trade mark.

Effect of
acquiescence.

25. (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use in the course of trade or a registered trade in Trinidad and Tobago being aware of that use, there shall cease to be any entitlement, on the basis of that earlier trade mark or other right—

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

(3) For the purposes of subsection (1), in deciding whether the registration of the later trade mark was applied for in bad faith, it shall be relevant to consider whether the applicant for

the registration of the later trade mark had, at the time his application was made, knowledge of, or reason to know of, the earlier trade mark or the right.

Miscellaneous

26. (1) At the written request of a person, or an agent of a person, who has—

Amendment of other documents.

- (a) made an application, other than an application for the registration of a trade mark; or
- (b) filed a notice or other document for the purposes of this Act,

the Controller may amend the application, notice or document in accordance with subsection (2).

(2) The Controller may amend an application, notice or document under subsection (1)—

- (a) to correct a clerical error or an obvious mistake; or
- (b) if the Controller is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

Rights and Remedies of Proprietor of Registered Trade Mark

27. (1) The proprietor of a registered trade mark has the exclusive rights to—

Rights conferred by registered trade mark.

- (a) use the trade mark; and
- (b) authorise other persons to use the trade mark,

in relation to the goods or services for which the trade mark is registered.

(2) The proprietor has the right to obtain relief under this Act for infringement of his trade mark.

(3) The acts amounting to infringement of a registered trade mark are set out in section 28, and references in this Act to the infringement of a registered trade mark shall be construed accordingly.

(4) The rights under subsections (1) and (2) shall accrue to the proprietor as from the date of registration of the trade mark, except that—

- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 49, 50, 51 or 52 is committed by anything done before the date on which the trade mark is in fact registered.

(5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.

Acts
constituting
infringement of
a registered
trade mark.

28. (1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade, a sign which is identical to the trade mark in relation to goods or services which are identical to those for which it is registered.

(2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which—

- (a) is identical to the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- (b) is similar to the trade mark and is used in relation to goods or services identical to or similar to those for which the trade mark is registered,

and if, as a result of such use of the sign, there exists a likelihood of confusion on the part of the public.

(3) A person infringes a registered trade mark which is well-known in Trinidad and Tobago if—

- (a) without the consent of the proprietor of the trade mark, he uses in the course of trade, a sign which is identical to, or similar to the trade mark in

relation to goods or services which are not similar to those for which the trade mark is registered;

- (b) the use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor;
- (c) there exists a likelihood of confusion on the part of the public because of such use; and
- (d) the interests of the proprietor are likely to be damaged by such use.

(4) For the purposes of this section and sections 29, 30 and 32, a person uses a sign if, in particular, he—

- (a) applies it to goods or the packaging thereof;
- (b) offers or exposes goods under the sign for sale;
- (c) puts goods on the market under the sign;
- (d) stocks them under the sign for the purpose of offering or exposing them for sale or putting them on the market;
- (e) offers or supplies services under the sign;
- (f) imports or exports goods under the sign;
- (g) uses the sign on an invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium; or
- (h) uses the sign in advertising.

(5) Notwithstanding subsection (4), a person who—

- (a) applies a sign to any material used or intended to be used for labelling or packaging goods; or
- (b) uses a sign on any document described in subsection (4)(g), or in advertising,

is deemed not to use the sign if, at the time of such application or use, he does not know, or does not have reason to believe, that the proprietor or a licensee of the registered trade mark did not consent to such application or use of the sign.

(6) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as any document described in subsection (4)(g), or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

Acts not
constituting
infringement.

29. (1) Notwithstanding section 28, a person does not infringe a registered trade mark where—

(a) he uses—

- (i) his name or the name of his place of business; or
- (ii) the name of his predecessor in business or the name of his predecessor's place of business;

(b) he uses a sign to indicate—

- (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or
- (ii) the time of production of goods or of the rendering of services; or

(c) he uses the trade mark to indicate the intended purpose of goods, in particular as accessories or spare parts, or services,

and such use is in accordance with honest practices in industrial or commercial matters.

(2) Notwithstanding section 28, a person does not infringe a registered trade mark by using an unregistered trade mark that is identical to, or similar to the registered trade mark in relation to goods or services identical to, or similar to those for which the trade mark is registered if he, or he and his predecessor in title, have continuously used in the course of trade the

unregistered trade mark in relation to those goods or services from a time before—

- (a) the date of registration of the registered trade mark; or
- (b) the date the proprietor of the registered trade mark, or a predecessor in title, or a person who was a registered user of the trade mark under the former Act, first used the trade mark,

whichever is the earlier.

(3) Notwithstanding section 28, a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

(4) Notwithstanding section 28, a person who uses a registered trade mark does not infringe the trade mark if such use—

- (a) constitutes fair use in comparative commercial advertising or promotion;
- (b) is for a non-commercial purpose; or
- (c) is for the purpose of news reporting or news commentary.

30. (1) Notwithstanding section 28, a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market, whether in Trinidad and Tobago or outside Trinidad and Tobago, under that trade mark by the proprietor of the registered trade mark or with his express or implied consent, conditional or otherwise.

Exhaustion of rights conferred by registered trade marks.

(2) Subsection (1) does not apply where—

- (a) the condition of the goods has been changed or impaired after they have been put on the market; and
- (b) the use of the registered trade mark in relation to those goods has caused dilution in an unfair manner of the distinctive character of the registered trade mark.

Registration
subject to
disclaimer or
limitation.

31. (1) An applicant for registration of a trade mark, or the proprietor of the registered trade mark, may—

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 27 are restricted accordingly.

Infringement Proceedings

Action for
infringement.

32. (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In infringement proceedings, all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of any other property right.

Order for
erasure of
offending sign.

33. (1) Subject to subsection (3), where a person is found to have infringed a registered trade mark, the Court may make an order requiring him—

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears to the Court likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered up to such person as the Court

may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

(3) Where a person who is found to have infringed a registered trade mark has in his possession, custody or control any infringing goods, the Court shall order that the infringing goods be delivered up to such person as the Court may direct for destruction if the—

- (a) claimant applies to the Court for such an order; and
- (b) Court is of the view that there are no exceptional circumstances which justify the refusal of such an order.

34. (1) The Court may, in addition to any relief granted under sections 32 and 33 in any action for an infringement of a registered trade mark, order any infringing goods, material or articles in the possession of the defendant or before the Court to be delivered up to the claimant.

Order for delivery up of infringing goods, material or articles.

(2) No order shall be made under this section unless the Court also makes, or it appears to the Court that there are grounds for making, an order under section 36.

(3) A person to whom any infringing goods, material or articles are delivered up pursuant to an order under this section shall, if an order under section 36 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

35. (1) In this Act, the expressions “infringing goods”, “infringing material”, “infringing articles”, “counterfeit goods” and “counterfeit trade mark” shall be construed in accordance with this section.

Meaning of “infringing goods, material or articles” and “counterfeit goods and trade mark”.

(2) Goods are “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and the—

- (a) application of the sign to the goods or their packaging was an infringement of the registered trade mark; or

- (b) goods are proposed to be imported into Trinidad and Tobago and the application of the sign in Trinidad and Tobago to them or their packaging would be an infringement of the registered trade mark; or
 - (c) sign has otherwise been used in relation to the goods in such a way as to infringe the registered mark.
- (3) Material is “infringing material”, in relation to a registered trade mark, if it bears a sign identical or similar to that mark and either—
 - (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or
 - (b) it is intended to be so used and such use would infringe the registered trade mark.
- (4) “Infringing articles”, in relation to a registered trade mark, means articles—
 - (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark; and
 - (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.
- (5) Goods are “counterfeit goods”, in relation to a registered trade mark, if—
 - (a) they are infringing goods in relation to that mark; and
 - (b) the sign borne by them or their packaging is a counterfeit trade mark.
- (6) A sign is a “counterfeit trade mark”, in relation to a registered trade mark, if the sign—
 - (a) is identical to, or so nearly resembling the registered trade mark as to be calculated to deceive; and

(b) is applied to goods or services—

- (i) without the express or implied consent (conditional or otherwise) of the proprietor of the registered trade mark; and
- (ii) to falsely represent the goods or services to be the genuine goods or actual services of the proprietor or a licensee of the registered trade mark.

36. (1) Where infringing goods, material or articles have been delivered up pursuant to an order under section 34, an application may be made to the Court for—

Order as to disposal of infringing goods, material or articles.

- (a) an order that they be destroyed or forfeited to such person as the Court may think fit; or
- (b) a decision that no such order should be made.

(2) In considering what order, if any, should be made, the Court shall have regard to the—

- (a) adequacy of other remedies; and
- (b) need to ensure that no infringing goods, material or articles are disposed of in a manner that would adversely affect the claimant.

(3) Notwithstanding subsection (2), where the infringing goods are counterfeit goods, the Court shall order that the goods be destroyed if the—

- (a) claimant applies to the Court for such an order; and
- (b) Court is of the view that there are no exceptional circumstances which justify the refusal of such an order.

(4) The Court shall issue directions as to the service of notice on persons having an interest in the goods, material or articles.

(5) Any person having an interest in the goods, material or articles is entitled—

- (a) to appear in proceedings for an order under this section, whether or not that person is served with notice; and

(b) to appeal against any order made, whether or not that person appears in the proceedings.

(6) An order made under this section shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(7) Subject to subsection (3), where there is more than one person interested in the goods, material or articles, the Court may direct that the goods, material or articles be sold, or otherwise dealt with, and the proceeds divided, and shall make any other order as it thinks just.

(8) If the Court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up, is entitled to their return.

Remedy for
groundless
threats of
infringement
proceedings.

37. (1) Where a person threatens another with infringement proceedings other than proceedings relating to the—

- (a) application of the mark to goods or to material used or intended to be used for labelling or packaging goods;
- (b) importation of goods to which, or to the packaging of which, the mark has been applied; or
- (c) supply of services under the mark,

any aggrieved person may bring proceedings for relief under this section.

(2) A person may apply for the following relief:

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) damages in respect of any loss the claimant has sustained by the threats.

(3) The claimant is entitled to the relief referred to in subsection (2) unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned.

(4) If the defendant showed that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned, the claimant is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

PART III

REGISTERED TRADE MARK AS OBJECT OF PROPERTY

38. A registered trade mark is personal property.

Nature of registered trade mark.
Co-ownership of registered trade mark.

39. (1) Where a registered trade mark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) Subsections (3) to (8) apply where two or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor shall not, without the consent of the other or others —

(a) grant a licence to use the registered trade mark; or

(b) assign or charge his share in the registered trade mark.

(5) Infringement proceedings may be brought by any co-proprietor, but he shall not, without the leave of the Court, proceed with the action unless the other, or each of the others, is either joined as a claimant or added as a defendant.

(6) A co-proprietor who is added as a defendant under subsection (5) is not liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in subsection (5) affects the granting of interlocutory relief on the application of a single co-proprietor.

(8) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations.

Assignment of
registered trade
mark.

40. (1) A registered trade mark is assignable and transmissible in the same way as other personal property and is so assignable or transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by, or on behalf of the assignor or a personal representative, as the case may be.

(4) Where the assignor or personal representative is a body corporate, subsection (3) may be satisfied by the affixing of its seal.

(5) Subsections (1) to (4) apply to assignment by way of security as they apply to any other assignment.

(6) A registered trade mark may be the subject of a charge in the same way as other personal property.

(7) Nothing in this Act shall be construed as affecting the assignment or transmission of an unregistered trade mark as part of the goodwill of a business.

- 41.** (1) On application being made to the Controller by—
- (a) a person claiming to be entitled to an interest in, or under a registered trade mark by virtue of a registrable transaction; or
 - (b) any other person claiming to be affected by such a transaction,

Registration of transactions affecting registered trade mark.

the prescribed particulars of the transaction shall be entered in the Register.

(2) The following are registrable transactions under subsection (1):

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant of a licence under a registered trade mark;
- (c) the granting of any security interest, whether fixed or floating, over a registered trade mark or any right in or under it;
- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and
- (e) an order of the Court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for the registration of the prescribed particulars of a registrable transaction referred to in subsection (2)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction.

(4) A person who becomes the proprietor or a licensee of a registered trade mark by virtue of any registrable transaction referred to in subsection (2)(a), (c), (d) or (e) is not entitled to

damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the date of the application for the registration of the prescribed particulars of the transaction.

(5) For the avoidance of doubt, subsections (3) and (4) shall not apply to any registrable transaction relating to—

- (a) a licence under a registered trade mark; or
- (b) any right in or under the licence.

Trust and
equities.

42. (1) No notice of any trust shall be entered in the Register, and the Controller shall not be affected by any such notice.

(2) Subject to this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal property.

Application for
registration of
trade mark as
object of
property.

43. (1) The provisions of sections 38, 39, 40 and 42 shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.

(2) For the purposes of subsection (1), the reference in section 39(1) to the granting of a registration shall be construed as a reference to the making of an application for the registration of a trade mark.

(3) Any person claiming to be—

- (a) entitled to an interest in or under an application for registration of a trade mark by virtue of a registrable transaction; or
- (b) affected by a registrable transaction,

shall give to the Controller notice of the prescribed particulars of the transaction.

(4) The following are registrable transactions under subsection (3):

- (a) an assignment of an application for registration of a trade mark or any right in it;
- (b) the grant of a licence under an application for registration of a trade mark;

- (c) the grant of any security interest, whether fixed or floating, over an application for registration of a trade mark or any right in or under it;
- (d) the making by a personal representative of an assent in relation to an application for registration of a trade mark or any right in or under it; and
- (e) an order of the Court or other competent authority transferring an application for registration of a trade mark or any right in or under it.

(5) The Controller shall maintain a record of each notice given to him under subsection (3).

(6) Until the notice referred to in subsection (3) has been given to the Controller in respect of a transaction referred to in subsection (4)(a), (c), (d) or (e), the transaction is ineffective as against a person acquiring a conflicting interest in or under the application for registration of a trade mark in ignorance of the transaction.

(7) Subsection (6) does not apply to any registrable transaction relating to—

- (a) a licence under an application for registration of a trade mark; or
- (b) any right in or under the licence.

PART IV LICENSING

44. (1) A licence to use a registered trade mark may be general or limited.

Licensing of
registered trade
mark.

(2) A limited licence may, in particular, apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

(4) Where the grantor is a body corporate, subsection (3) may be satisfied by the affixing of its seal.

(5) Subject to subsection (7), a licence to use a registered trade mark is binding on every successor in title to the interest of the grantor, unless—

(a) any person who, in good faith and without any notice of the licence, has given valuable consideration for the interest in the registered trade mark; or

(b) the licence provides otherwise,

and any reference in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(6) A person is deemed to have notice of a licence if the prescribed particulars of the grant of the licence are entered in the Register under section 41(1).

(7) Where the licence so provides, a sub-licence may be granted by the licensee and references in this Act to a licence or licensee include references to a sub-licence or sub-licensee.

Exclusive
licences.

45. Section 44 applies, with the necessary modifications, to an exclusive licence.

General
provisions as to
rights of
licensees in case
of infringement.

46. (1) This section applies to the rights of a licensee in relation to infringement of a registered trade mark.

(2) This section does not apply where the licensee has a right to bring proceedings in his own name under section 47(1).

(3) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(4) If the proprietor refuses, or fails within two months, to take infringement proceedings after being called upon to do so

by the licensee in accordance with subsection (3), the licensee may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee shall not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant.

(6) Subsection (5) does not affect the granting of interlocutory relief on an application by a licensee alone.

(7) A proprietor who is added as a defendant under subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) In infringement proceedings brought by the proprietor of a registered trade mark—

- (a) any loss suffered or likely to be suffered by licensees shall be taken into account; and
- (b) the Court may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(9) This section applies in relation to an exclusive licensee if or to the extent that he has, by virtue of section 47(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

47. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

Exclusive licensee having rights and remedies of assignee.

(2) Where or to the extent that the provision referred to in subsection (1) is made, the licensee is entitled, subject to the provisions of the licence and to the provisions of this section, to bring infringement proceedings against any person, other than the proprietor, in his own name.

(3) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark, and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(4) In an action brought by an exclusive licensee by virtue of this section, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(5) Where infringement proceedings brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee shall not, without the leave of the Court, proceed with the action, unless the other is either joined as a claimant or added as a defendant, but this does not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(6) A person who is added as a defendant as mentioned in subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Where infringement proceedings are brought which relate wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—

- (a) the Court shall, in assessing damages, take into account—
 - (i) the terms of the licence; and
 - (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;
- (b) no account of profits shall be directed by the Court, if an award of damages has been made; and
- (c) the Court may, if an account of profits is directed, apportion the profits between them as

the Court considers just, subject to any agreement between them.

(8) Subsection (7) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action, and if only one is a party, the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(9) The proprietor of a registered trade mark, before applying for an order under section 34, shall notify any exclusive licensee who has a concurrent right of action and the Court may on application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(10) The provisions of subsections (5) to (9) shall have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

48. (1) The use of a sign on the Internet shall constitute use in Trinidad and Tobago only if the use has a commercial effect in Trinidad and Tobago.

Use of trade marks on the internet.

(2) In determining whether use of a sign on the Internet has a commercial effect in Trinidad and Tobago, the Controller shall take into account all relevant circumstances including—

- (a) circumstances indicating that the user of the sign is doing, or has undertaken significant plans to do, business in Trinidad and Tobago in relation to goods or services which are identical or similar to those for which the sign is used on the Internet;
- (b) the level and character of commercial activity of the user in relation to Trinidad and Tobago;
- (c) the connection of an offer of goods or services on the Internet with Trinidad and Tobago;
- (d) the connection of the manner of use of the sign on the Internet with Trinidad and Tobago; and

- (e) the relation of the use of the sign on the Internet to a right in that sign in Trinidad and Tobago.

PART V

OFFENCES

Counterfeiting a trade mark.

49. (1) Any person who counterfeits a registered trade mark commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and imprisonment for a term of ten years.

(2) A person who—

- (a) makes a sign identical to or so nearly resembling a registered trade mark as to be calculated to deceive; or
- (b) falsifies a genuine registered trade mark, whether by alteration, addition, effacement, partial removal or otherwise,

without the consent of the proprietor of the registered trade mark shall be deemed to counterfeit a registered trade mark.

Falsely applying a registered trade mark to goods or services.

50. (1) Any person who falsely applies a registered trade mark to goods or services commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and to imprisonment for ten years on indictment.

(2) For the purposes of this section and sections 52, 56 and 57, a person falsely applies a registered trade mark to goods or services if—

- (a) without the consent of the proprietor of the registered trade mark, the person applies the trade mark or a sign likely to be mistaken for that trade mark to the goods or services; and
- (b) in the case of an application to goods, the goods are not the genuine goods of the proprietor or licensee of the registered trade mark.

(3) For the purposes of subsection (2), a trade mark shall be deemed to be applied to goods or services if it is used in any—

- (a) sign or advertisement; or
- (b) invoice, catalogue, business letter, business paper, price list or other commercial document, including any such document in any medium,

and the goods are delivered, or services provided, as the case may be, to a person in pursuance of a request or order made by reference to the trade mark as so used.

(4) For the purposes of subsection (2)—

(a) a sign shall be deemed to be applied to goods if—

- (i) it is applied to the goods themselves; or
- (ii) it is applied to any covering, label, reel or thing in or with which the goods are sold, offered or exposed for sale or kept in possession for the purpose of trade or manufacture; and

(b) a sign shall be deemed to be applied to goods or services if it is used in a manner that is likely to lead persons to believe that it refers to, describes or designates the goods or services.

(5) In subsection (4)—

“covering” includes any stopper, glass, bottle, vessel, box, capsule, case, frame or wrapper;

“label” includes any band or ticket.

51. Any person who—

- (a) makes an article specifically designed or adapted for making copies of a registered trade mark or a sign likely to be mistaken for that trade mark; or
- (b) has such an article in his possession, custody or control,

Making or possessing of article for committing offence.

knowing or having reason to believe that it has been, or is to be, used for, or in the course of, committing an offence against section 49 or 50, commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and to imprisonment for ten years.

Importing or
selling of goods
with falsely
applied trade
mark.

52. (1) Subject to subsection (2), a person who—

- (a) imports into Trinidad and Tobago for the purpose of trade or manufacture;
- (b) sells or offers or exposes for sale; or
- (c) has in his possession for the purpose of trade or manufacture,

any goods to which a registered trade mark is falsely applied, commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and to imprisonment for a term of ten years.

(2) It is a defence to a charge under subsection (1) if the person proves that—

- (a) having taken all reasonable precautions against committing an offence under this section, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark and on demand made by, or on behalf of the prosecution, he gave all the information in his power with respect to the persons from whom he obtained the goods; or
- (b) he had acted innocently.

Falsification of
Register.

53. Any person who—

- (a) makes, or causes to be made, a false entry in the Register;
- (b) makes, or causes to be made, any thing false purporting to be a copy of an entry in the Register; or

- (c) produces or tenders or causes to be produced or tendered in evidence any thing referred to in paragraph (b),

knowing or having reason to believe that the entry or thing, as the case may be, is false commits an offence and is liable on conviction on indictment to a fine of one hundred thousand dollars and to imprisonment for a term of five years.

54. (1) Any person who—

- (a) falsely represents that a mark is a registered mark, collective mark or certification mark; or
(b) makes a false representation as to the goods or services for which a mark is registered,

Falsely
representing
trade mark as
registered.

knowing or having reason to believe that the representation is false commits an offence and is liable on summary conviction to a fine of ten thousand dollars.

(2) For the purposes of this section, the use in the course of trade in Trinidad and Tobago in relation to a mark of—

- (a) the word “registered”; or
(b) any other word or symbol importing a reference, express or implied, to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Trinidad and Tobago and that the mark is in fact so registered for the goods or services in question.

55. (1) Subject to subsection (2), where any person commits an offence under any provision of this Part, the Court may, where it considers appropriate, order the person to forfeit to the State all or any—

Forfeiture and
destruction of
goods on
conviction.

- (a) goods in relation to which; or
(b) articles by means of which,

the offence was committed.

(2) Where any person commits an offence under section 50 or 52 in relation to a registered trade mark, the Court

shall, unless it is of the view that there are exceptional circumstances for deciding otherwise, order to be forfeited to the State and destroyed any goods which satisfy all of the following conditions:

- (a) the goods are goods in relation to which—
 - (i) the offence was committed; and
 - (ii) the trade mark has been falsely applied; and
 - (b) the goods or their packaging bear the trade mark or sign giving rise to the false application of the trade mark.
- (3) Any—
- (a) forfeiture of goods or articles under subsection (1); or
 - (b) forfeiture and destruction of goods under subsection (2),

shall be in addition to any penalty or punishment that the Court may impose for the offence committed.

Enforcement
measures.

56. (1) Any police officer may arrest without a warrant any person who, in any street or public place—

- (a) sells or offers or exposes for sale; or
- (b) has, or is reasonably suspected of having, in his possession for the purpose of trade or manufacture,

any goods to which a registered trade mark is falsely applied.

(2) Any police officer or Officer designated by the Comptroller may, pursuant to a warrant issued under subsection (3)—

- (a) stop, search and board, whether forcibly or otherwise, any conveyance in which he reasonably suspects there are goods to which a registered trade mark has been falsely applied; and

(b) seize, remove or detain any such goods and anything which appears to him—
(i) to be or to contain; or
(ii) to be likely to be or to contain,
evidence of any offence under section 49, 50, 51 or 52.

(3) If information is given upon oath to a Magistrate that there is reasonable cause for suspecting that there is in any premises or conveyance—

- (a) any goods which are the subject of an offence under section 49, 50, 51 or 52;
- (b) any material or article which has been used in the commission of an offence under section 49, 50, 51 or 52; or
- (c) any document which is evidence that an offence under section 50, 51, 52, 53 or 55 has been committed,

the Magistrate may issue, either unconditionally or subject to such conditions as the Magistrate thinks fit, a warrant authorising a police officer to enter and search the premises or conveyance for any goods, material, article or document referred to in the warrant, whether specifically or in any general category, and to seize any such goods, material, article or document found at the premises or conveyance.

(4) If any goods, material, article or document has been seized under subsection (3) and—

- (a) in proceedings brought under section 49, 50, 51 or 52, no order is made as to the disposal of the goods, material, article or document; or
- (b) no such proceedings are instituted within six months of the seizure,

the goods, material, article or document shall be returned to the person in whose possession it was when it was seized or, if it is not reasonably practicable to return it to that person, shall be disposed of in such manner as the Magistrate may order.

(5) No action or other legal proceeding shall lie against the State or any officer or employee thereof for anything which is in good faith done or omitted to be done in the exercise of any power, duty or function under this section.

(6) In this section—

“conveyance” includes any vehicle, vessel or aircraft in which persons or goods can be carried;

“document” means anything in which information of any description is recorded;

“premises” includes any land, building or structure.

PART VI

INTERNATIONAL MATTERS

The Madrid Protocol

Power to make provision giving effect to Madrid Protocol, etc.

57. (1) The Minister may make regulations to give effect to the provisions of the Madrid Protocol or of any treaty, convention, arrangement or engagement relating to trade marks to which Trinidad and Tobago is a party.

(2) Regulations under subsection (1) may, in particular, provide for—

- (a) the making of applications for international registrations by way of the Intellectual Property Office as the office of origin;
- (b) the procedures to be followed where the basic application or registration in Trinidad and Tobago fails or ceases to be in force;
- (c) the procedures to be followed where the Intellectual Property Office receives from the International Bureau or any body specified in the rules, a request for extension of protection to Trinidad and Tobago;
- (d) the effects of a successful request for extension of protection to Trinidad and Tobago;
- (e) the transformation of an international application for registration into a national application for registration;

- (f) the communication of information to the International Bureau;
- (g) the payment of fees and amounts in respect of applications for international registrations, extensions of protection and renewals of international registrations; and
- (h) the application of section 37 and Parts V and XI to an international trade mark (Trinidad and Tobago).

(3) For the purposes of this section—

“basic application” has the meaning assigned by Article 2(1) of the Madrid Protocol;

“basic registration” has the meaning assigned by Article 2(1) of the Madrid Protocol;

“international application” has the meaning assigned by Article 2(2) of the Madrid Protocol;

“International Bureau” has the meaning assigned by Article 2(1) of the Madrid Protocol;

“international registration” has the meaning assigned by Article 2(1) of the Madrid Protocol;

“international trade mark (Trinidad and Tobago)” means a trade mark which is entitled to protection in Trinidad and Tobago under the Madrid Protocol;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989, as revised or amended from time to time.

The Paris Convention, the TRIPS Agreement and Well-known Marks: Supplementary Provisions

58. (1) A well-known trade mark is entitled to protection under this section whether or not the —

Protection of well-known trade marks.

- (a) trade mark has been registered in Trinidad and Tobago, or an application for the registration of the trade mark has been made to the Controller; and

(b) proprietor of the trade mark carries on business, or has any goodwill, in Trinidad and Tobago.

(2) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Trinidad and Tobago, in the course of trade and without the proprietor's consent, of any trade mark which, or an essential part of which, is identical with, or similar to, the proprietor's trade mark in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Trinidad and Tobago, in the course of trade and without the proprietor's consent, of any trade mark which, or an essential part of which, is identical with, or similar to, the proprietor's well-known trade mark in relation to any goods or services, where the use of the trade mark would—

- (a) indicate a connection between those goods or services and the proprietor, and is likely to damage the interests of the proprietor;
- (b) cause dilution in an unfair manner of the distinctive character of the proprietor's well-known trade mark; or
- (c) take unfair advantage of the distinctive character of the proprietor's well-known trade mark.

(4) Subject to subsections (6) and (7), the proprietor of a well-known trade mark is entitled to restrain by injunction the use in Trinidad and Tobago, without the proprietor's consent, of any business identifier which, or an essential part of which, is identical with, or similar to, the proprietor's well-known trade mark where the use of the business identifier would—

- (a) indicate a connection between the business in respect of which it is used and the proprietor, and is likely to damage the interests of the proprietor;
- (b) cause dilution in an unfair manner of the distinctive character of the proprietor's well-known trade mark; or

(c) take unfair advantage of the distinctive character of the proprietor's well-known trade mark.

(5) If the Court grants an injunction under subsection (4) restraining the use by any business of any business identifier, the Court may make such other order as the Court deems fit in respect of any entry in any record maintained by any person, body or authority which associates that business with that business identifier.

(6) The proprietor is not entitled to the right referred to in subsection (2), (3) or (4) if the use of the trade mark or business identifier, as the case may be, began before the proprietor's trade mark became well-known in Trinidad and Tobago, unless the trade mark or business identifier has been used in bad faith.

(7) The proprietor ceases to be entitled to the right referred to in subsection (2), (3) or (4) if the proprietor has acquiesced for a continuous period of five years in the use of the trade mark or business identifier, as the case may be, in Trinidad and Tobago, being aware of that use, unless the trade mark or business identifier has been used in bad faith.

(8) In deciding whether the trade mark or business identifier, as the case may be, has been used in bad faith, it shall be relevant to consider whether the person who used the trade mark or business identifier had, at the time he began to use the trade mark or business identifier, knowledge of, or reason to know of, the proprietor's well-known trade mark.

(9) Nothing in subsection (2) affects the continuation of any use referred to therein in good faith of a trade mark that began before the commencement of this Act.

(10) Nothing in subsection (3) or (4) shall affect the continuation of any use referred to therein in good faith of a trade mark or business identifier, as the case may be, that began before the commencement of this Act.

(11) For the purposes of this section and sections 59, 60, 61 and 63, “use”, in relation to a trade mark, means use within the meaning of section 28(4).

Permitted use of well-known trade marks.

59. (1) Notwithstanding section 58, the proprietor of a well-known trade mark is not entitled to restrain by injunction the use, in Trinidad and Tobago in accordance with honest practices in industrial or commercial matters, by any person of—

(a) the name of—

- (i) the person himself;
- (ii) the person’s place of business;
- (iii) the person’s predecessor in business; or
- (iv) the place of business of the person’s predecessor in business;

(b) any sign to indicate—

- (i) the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services; or
- (ii) the time of production of goods or of the rendering of services; or

(c) the trade mark to indicate the intended purpose of goods, in particular as accessories or spare parts, or services.

(2) Notwithstanding section 58, the proprietor of a well-known trade mark shall not be entitled to restrain by injunction the use, in Trinidad and Tobago, of any registered trade mark in relation to goods or services for which the latter is registered.

(3) Notwithstanding section 58, the proprietor of a well-known trade mark shall not be entitled to restrain by injunction the use, in Trinidad and Tobago, of the trade mark if the use—

- (a) constitutes fair use in comparative commercial advertising or promotion;
- (b) is for a non-commercial purpose; or

(c) is for the purpose of news reporting or news commentary.

60. (1) A trade mark which consists of, or contains, the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Controller that use of the flag in the manner proposed is permitted without such authorisation.

National emblems, etc., of Convention countries: Article 6ter of Paris Convention and TRIPS Agreement.

(2) A trade mark which consists of, or contains, the armorial bearings or any other State emblem of a Convention country which is protected under the Paris Convention or the TRIPS Agreement shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of, or contains, an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention or the TRIPS Agreement, be registered in relation to goods or services of the same or a similar kind, as those in relation to which it indicates control and warranty in relation to goods and services, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other State emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a State emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use in the course of trade of the trade mark in Trinidad and Tobago without their authorisation.

Emblems, etc.,
of certain
international
organisations:
Article 6ter of
Paris
Convention and
TRIPS
Agreement.

61. (1) This section shall apply to—
(a) the armorial bearings, flags or other emblems;
and
(b) the abbreviations and names,
of international organisations of which one or more Convention
countries are members.

(2) A trade mark which consists of, or contains, any
emblem, abbreviation or name which is protected under the Paris
Convention or the TRIPS Agreement shall not be registered
without the authorisation of the international organisation
concerned, unless it appears to the Controller that the use of the
emblem, abbreviation or name in the manner proposed—

- (a) does not suggest to the public that a connection
exists between the organisation and the trade
mark; or
- (b) is not likely to mislead the public as to the
existence of a connection between the user and
the organisation.

(3) The provisions of this section as to emblems of an
international organisation apply equally to anything which from
a heraldic point of view imitates any such emblem.

(4) Where, by virtue of this section, the authorisation of
an international organisation is or would be required for the
registration of a trade mark, that organisation is entitled to
restrain by injunction any use in the course of trade of the trade
mark in Trinidad and Tobago without its authorisation.

(5) Nothing in this section affects the rights of a person
whose *bona fide* use of the trade mark in question began before
August 1, 1964.

Notification
under
Article 6ter of
Paris
Convention and
TRIPS
Agreement.

62. (1) For the purposes of section 60, State emblems of a
Convention country, other than the national flag, shall be
regarded as protected under the Paris Convention or the TRIPS
Agreement only if, or to the extent that—

- (a) the country in question has notified Trinidad and
Tobago in accordance with Article 6ter (3) of the

Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, sign or hallmark;

- (b) the notification remains in force; and
- (c) Trinidad and Tobago has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(2) For the purposes of section 61, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention or the TRIPS Agreement only if, or to the extent that—

- (a) the organisation in question has notified Trinidad and Tobago in accordance with Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) Trinidad and Tobago has not objected to it in accordance with Article 6ter (4) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention, or under that Article as applied by the TRIPS Agreement, shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Controller shall keep and make available for public inspection by any person, during the hours when the Intellectual Property Office is open for business and free of charge, a list of—

- (a) the state emblems and official signs or hallmarks; and

(b) the emblems, abbreviations and names of international organisations,

which are for the time being protected under the Paris Convention or the TRIPS Agreement by virtue of a notification under Article 6ter (3) of that Convention or under that Article as applied by the TRIPS Agreement.

Acts of agent or representative:
Convention country.

63. (1) Subsections (2) to (6) apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the trade mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application is not opposed and is granted, the proprietor may —

- (a) apply for a declaration of the invalidity of the registration; or
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) Notwithstanding the rights conferred by this Act in relation to a registered trade mark, the proprietor may, by injunction, restrain any use in the course of trade of the trade mark in Trinidad and Tobago which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) shall be made within three years of the proprietor becoming aware of the registration.

(7) No injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

PART VII
COLLECTIVE MARKS

64. (1) The provisions of this Act shall apply to collective marks subject to the provisions of this Part.

Collective marks.

(2) A collective mark is a sign used, or intended to be used, in relation to goods or services dealt with or provided in the course of trade by members of an association to distinguish those goods or services from goods or services so dealt with or provided by persons who are not members of the association.

(3) In relation to a collective mark, the reference in the definition of “trade mark” in section 3 to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade by members of an association which is the proprietor of the mark from those so dealt with or provided by persons who are not members of the association.

65. (1) Notwithstanding section 8(1)(c), a collective mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered.

Registration of collective marks.

(2) The proprietor of a mark under subsection (1) is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, including, by a person who is entitled to use a geographical name.

(3) A collective mark shall not be registered if the public is likely to be misled as regards the character or significance of the mark, including, if it is likely to be taken to be something other than a collective mark.

(4) The Controller may require that a mark in respect of which application is made for registration as a collective mark include some indication that it is a collective mark.

(5) Notwithstanding section 15(3), an application may be amended so as to comply with subsections (3) and (4).

Rules governing use of collective marks.

66. (1) An applicant for registration of a collective mark shall, within the prescribed period following the date of the application, file with the Controller rules governing the use of the mark and pay the prescribed fee.

(2) The rules under subsection (1) shall specify—

- (a) the persons authorised to use the mark;
- (b) the conditions of membership of the association; and
- (c) where they exist, the conditions of use of the mark, including any sanctions against misuse,

and further requirements with which the rules shall comply may be imposed by Regulations.

(3) A collective mark shall not be registered unless the rules governing the use of the mark —

- (a) comply with subsection (2); and
- (b) are not contrary to public policy or to accepted principles of morality.

(4) An application for registration of a collective mark shall be deemed to be withdrawn if an applicant fails to comply with subsection (1).

Controller's discretion regarding rules.

67. (1) If it appears to the Controller that the requirements under section 66(3) are not satisfied, he shall inform the applicant and give him an opportunity, within such period as the Controller may specify, to make representations or to file amended rules.

(2) If the applicant responds within the specified period but fails to satisfy the Controller that the requirements under section 66(3) are satisfied, or to file rules that have been amended so as to satisfy those requirements, the Controller may refuse the application.

(3) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Controller that the requirements under section 66(3), and any other requirements for registration are satisfied, he shall accept the application and shall proceed in accordance with section 14.

(5) The Controller shall publish a notice that the rules governing the use of the collective mark are open to public inspection in accordance with section 68 and notice of opposition may be given and observations may be made relating to the matters mentioned in section 66(3), in addition to any other grounds on which the application may be opposed or observations made.

68. The rules governing the use of a registered collective mark shall be open to public inspection in the same manner as the Register.

Rules to be open to inspection.

69. (1) An amendment of the rules governing the use of a registered collective mark is of no effect unless the amended rules are filed with the Controller and accepted by him.

Amendment of rules.

(2) Before accepting any amended rules, the Controller shall publish a notice that the amended rules have been filed and are open to public inspection in accordance with section 68 and notice of opposition may be given, and observations may be made, relating to the matters mentioned in section 66(3).

70. (1) Section 28(5) and section 97 apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark.

Rights of authorised users regarding infringement of a collective mark.

(2) Section 46 has effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

(3) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to request the proprietor to take infringement proceedings in respect of any matter which affects his interests.

(4) Subject to subsection (5), if the proprietor—

(a) refuses to do so; or

(b) fails to do so within two months after being called upon,

the authorised user may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought under this section, the authorised user shall not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant.

(6) Subsection (5) does not affect the granting of interlocutory relief on an application by an authorised user alone.

(7) A proprietor who is added as a defendant under subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) In infringement proceedings brought by the proprietor of a registered collective mark any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court which may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of the authorised users.

Grounds for
revocation of
registration of
collective
marks.

71. (1) In addition to the grounds of revocation provided for in section 23, the registration of a collective mark may be revoked on the ground that—

(a) the manner in which the mark has been used by the proprietor has caused it to become likely to mislead the public in the manner referred to in section 65(3);

(b) the proprietor has failed to observe, or to secure the observance of, the rules governing the use of the mark; or

(c) an amendment of the rules has been made so that the rules—

(i) no longer comply with section 66(2) and any further requirements imposed by Regulations; or

- (ii) are contrary to public policy or to accepted principles of morality.

72. In addition to the grounds of invalidity provided for in section 24, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of section 65(3) or section 66(3).

Grounds for
invalidity of
registration.

PART VIII

CERTIFICATION MARKS

73. (1) The provisions of this Act shall apply to certification marks subject to the provisions of this Part.

Certification
marks.

(2) A certification mark is a sign used, or intended to be used, to distinguish goods or services—

- (a) dealt with or provided in the course of trade; and
- (b) certified by the proprietor of the certification mark in relation to origin, material, mode of manufacture of goods, or performance of services, quality, accuracy or other characteristics,

from other goods or services dealt with or provided in the course of trade but not so certified.

(3) In relation to a certification mark, the reference in the definition of “trade mark” in section 3(1) to distinguishing goods or services dealt with or provided in the course of trade by a person from those so dealt with or provided by any other person shall be construed as a reference to distinguishing goods or services dealt with or provided in the course of trade and which are certified in the manner referred to in subsection (2)(b) from those which are not so certified.

74. (1) Notwithstanding section 8(1)(c), a certification mark which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be registered.

Registration of
certification
marks.

(2) The proprietor of a mark under subsection (1) is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, including, by a person who is entitled to use a geographical name.

(3) A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

(4) A certification mark shall not be registered if the public is likely to be misled as regards the character or significance of the mark, including if it is likely to be taken to be something other than a certification mark.

(5) The Controller may require that a mark in respect of which application is made for registration as a certification mark include some indication that it is a certification mark.

(6) Notwithstanding section 15(3), an application may be amended so as to comply with subsections (4) and (5).

Rules
governing use
of certification
mark.

75. (1) An applicant for registration of a certification mark shall within the prescribed period file with the Controller the rules governing the use of the mark.

(2) The rules under subsection (1) shall specify—

- (a) who is authorised to use the mark;
- (b) the characteristics to be certified by the mark;
- (c) how the certifying body is to test those characteristics and to supervise the use of the mark; and
- (d) the fees, if any, to be paid in connection with the use of the mark and the procedures for resolving disputes,

and further requirements with which the rules shall comply may be imposed by Regulations.

(3) A certification mark shall not be registered unless—

- (a) the rules governing the use of the mark—
 - (i) comply with subsection (2); and

- (ii) are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(4) An application for registration of a certification mark shall be deemed to be withdrawn if an applicant fails to comply with subsection (1).

76. (1) If it appears to the Controller that the requirements under section 75(3) are not satisfied, he shall inform the applicant and give him an opportunity, within such period as the Controller may specify, to make representations or to file amended rules.

Controller's
discretion
regarding
Rules.

(2) If the applicant responds within the specified period but fails to satisfy the Controller that the requirements under section 75(3) are satisfied, or to file rules that have been amended so as to satisfy those requirements, the Controller may refuse the application.

(3) If the applicant fails to respond within the specified period, the application shall be treated as withdrawn.

(4) If it appears to the Controller that the requirements under section 75(3), and any other requirements for registration, are satisfied, he shall accept the application and shall proceed in accordance with section 14.

(5) The Controller shall publish a notice that the rules governing the use of the certification mark are open to public inspection in accordance with section 77 and notice of opposition may be given and observations may be made relating to matters mentioned in section 75(3), in addition to any other ground on which the application may be opposed or observations made.

77. The rules governing the use of a registered certification mark shall be open to public inspection in the same manner as the Register.

Rules to be
open to
inspection.

Amendment of
rules.

78. (1) An amendment of the rules governing the use of a registered certification mark is of no effect unless and until the amended rules are filed with the Controller and accepted by him.

(2) Before accepting any amended rules, the Controller may in any case where it appears to him expedient to do so cause them to be published and if he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in section 75(3).

Consent to
assignment of
registered
certification
mark.

79. (1) The assignment or other transmission of a registered certification mark is of no effect without the written consent of the Controller.

Rights of
authorised users
regarding
infringement of
a certification
mark.

80. (1) Section 28(5) and section 97 apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark.

(2) In infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court which may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of authorised users.

Grounds for
revocation of
registration.

81. (1) In addition to the grounds of revocation provided for in section 23, the registration of a certification mark may be revoked on the ground that—

- (a) the proprietor has begun to carry on such a business as referred to in section 74(3);
- (b) the manner in which the certification mark has been used by the proprietor has caused it to become likely to mislead the public in the manner referred to in section 74(4);
- (c) the proprietor has failed to observe, or to secure the observance of, the rules governing the use of the certification mark;

- (d) an amendment of the rules has been made so that the rules—
 - (i) no longer comply with section 75(2) and any further conditions imposed by Regulations; or
 - (ii) are contrary to public policy or to accepted principles of morality; or
- (e) the proprietor is no longer competent to certify the goods or services for which the certification mark is registered.

82. In addition to the grounds of invalidity provided for in section 24, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of section 74(3), 74(4) or 75(3).

Grounds for
invalidity of
registration.

PART IX

REGISTER OF TRADE MARKS

83. (1) The Controller shall maintain a Register of Trade Marks. The Register.

(2) There shall be entered in the Register in accordance with this Act—

- (a) registered trade marks;
- (b) such particulars of registrable transactions affecting a registered trade mark as may be prescribed; and
- (c) such other matters relating to registered trade marks as may be prescribed.

(3) The Register may be kept, in whole or in part, in electronic form.

(4) Any record of a particular or other matter made electronically for the purpose of keeping the Register is taken to be an entry in the Register.

84. (1) The Register shall be available at the Intellectual Property Office for inspection by any person during the hours when the Intellectual Property Office is open for business.

Inspections of,
and extract
from, Register.

(2) If the Register, or any part of the Register is kept in electronic form, subsection (1) is satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he can read on a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

(3) Any person who applies for a certified copy of an entry in the Register or a certified extract from the Register shall be entitled to obtain such a copy or extract on payment of the prescribed fee and any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of the prescribed fee.

(4) In relation to any portion of the Register kept otherwise than in documentary form, the right to a copy or extract conferred by subsection (3) is a right to a copy or extract in a form in which it can be taken away.

(5) In this section, “certified copy” or “certified extract” means a copy or extract, respectively, which is certified by the Controller and sealed with the seal of the Controller.

Rectification or
correction of
Register.

85. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the Register.

(2) An application for rectification shall not be made in respect of a matter affecting the validity of the registration of a trade mark.

(3) An application for rectification may be made either to the Controller or to the Court, except that —

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court; and
- (b) if in any other case the application is made to the Controller, he may at any stage of the proceedings refer the application to the Court.

(4) Except where the Controller or the Court directs otherwise, the effect of rectification of the Register is that the error or omission in question shall be deemed never to have been made.

(5) The Controller may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the Register.

(6) The Controller may remove from the Register matters appearing to him to have ceased to have effect.

PART X

POWERS AND DUTIES OF CONTROLLER

86. (1) The Controller may award costs in respect of the matters, and in the amounts, provided for in the Regulations, against any party to proceedings brought before him. Costs awarded by Controller.

(2) The Regulations may provide for the taxation of the costs, or any part of the costs, by the Controller.

(3) A party desirous to obtain costs or to have the costs taxed shall apply to the Controller in accordance with the Regulations.

(4) If a party is ordered to pay the costs of another party, the costs may be recovered in a court of competent jurisdiction as a debt due by the first party to the other party.

87. (1) If the Controller is satisfied that the circumstances justify it, he may, upon receiving a written request and upon payment of the prescribed fee, extend the time for doing any act or taking any proceeding under this Act, other than the filing of a notice of opposition. Extensions of time.

(2) Where an extension is granted under subsection (1), the Controller shall give notice to the parties concerned.

(3) An extension under subsection (1) may be granted—
(a) subject to such terms as the Controller may direct; and

- (b) notwithstanding that the time for doing the act or taking the proceeding has expired.

Hearing before
exercise of
Controller's
discretion.

88. Where any discretionary or other power is given to the Controller by this Act, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without giving to the applicant or registered proprietor an opportunity of being heard or making representation in writing.

Security for
costs.

89. If a person who neither resides nor carries on business in Trinidad and Tobago—

- (a) gives notice of opposition under section 14; or
(b) applies to the Controller under section 23 or 24 for the registration of a trade mark to be revoked or to be declared invalid, as the case may be,

the Controller may require the person to give security for the costs for the proceedings and may, if security is not given, dismiss the proceedings.

Evidence
before
Controller.

90. The Controller may, for the purposes of any proceedings before him under this Act—

- (a) summon witnesses, including independent expert witnesses;
(b) receive evidence on oath, whether orally or otherwise; and
(c) require the production of documents or articles.

Disobedience to
summons an
offence.

91. (1) A person who has been summoned to appear as a witness before the Controller shall not, without lawful excuse, fail to appear in obedience to the summons.

(2) A person who has been required by the Controller to produce a document or article shall not, without lawful excuse, fail to produce the document or article.

(3) Any person who contravenes subsection (1) or (2), commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for one year.

92. (1) A person who appears before the Controller shall not, without lawful excuse, refuse to be sworn or to make an affirmation, or to produce documents or articles, or to answer questions, which he is lawfully required to produce or answer.

Refusal to give evidence an offence.

(2) A person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for one year.

93. (1) The Controller shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which Trinidad and Tobago is a party.

Exclusion of liability in respect of official acts.

(2) The Controller is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings shall lie against an officer of the Intellectual Property Office in respect of any matter for which, by virtue of this section, the Controller is not liable.

94. (1) The Court shall have jurisdiction in cases of disputes relating to the application of this Act.

Jurisdiction of Court.

(2) An appeal lies to the Court from any decision of the Controller under this Act.

95. Except as otherwise provided by the Regulations, any act required or authorised by this Act to be done by, or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by, or to an agent authorised by that person in the prescribed form.

Recognition of agents.

PART XI

BORDER ENFORCEMENT MEASURES

Interpretation
of Part XI
(Border
Enforcement
Measures).

Ch. 78:01.

Ch. 50:10.

- 96.** (1) In this Part, unless the context otherwise requires—
- “aircraft” has the meaning assigned under section 2 of the Customs Act;
- “Comptroller” means the Comptroller of Customs and Excise referred to in section 2 of the Customs Act;
- “conveyance” means any vessel, train, vehicle or aircraft in which persons or goods can be carried;
- “Customs area” has the meaning assigned to it in section 2 of the Customs Act;
- “goods” includes all kinds of goods, wares, merchandise and livestock;
- “goods in transit” means goods imported, whether or not landed or transshipped within Trinidad and Tobago, which are to be carried to another country either by the same or another conveyance;
- “importer” has the meaning assigned under section 2 of the Customs Act;
- “infringement action” means an action for an infringement of a registered trade mark arising from the importation of seized goods;
- “master” has the meaning assigned under section 2 of the Shipping Act;
- “objector”, in relation to seized goods, means the person who gave the notice under section 97 as a result of the giving of which the goods were seized;
- “proprietor”, in relation to a registered trade mark, includes a licensee of the trade mark;
- “retention period”, in relation to seized goods, means—
- (a) the period specified in a notice given under section 100 in respect of the goods; or
 - (b) if that period has been extended under section 100, that period as so extended;

“seized goods” means goods seized under section 97;

“vehicle” includes any vehicle in which persons or goods can be carried by land however drawn or propelled or set or kept in motion;

“vessel” includes any ship or boat or other description of vessel used in navigation.

(2) Any act, matter or thing required by this Part to be done or performed by, with, to or before the Comptroller, if done or performed by, with, to or before any Officer appointed by the Comptroller for that purpose shall be deemed to be done or performed by the Comptroller.

97. (1) A person who is the proprietor or a licensee of a registered trade mark may give the Comptroller a written notice—

Restriction of importation of infringing goods.

(a) stating that he is—

- (i) the proprietor of the registered trade mark; or
- (ii) a licensee thereof having the power to give such a notice;

(b) stating that goods which, in relation to the registered trade mark, are infringing goods, are expected to be imported;

(c) providing sufficient information—

- (i) to identify the goods;
- (ii) to enable the Comptroller to ascertain when and where the goods are expected to be imported; and
- (iii) to satisfy the Comptroller that the goods are infringing goods; and

(d) stating that he objects to such importation.

(2) A notice given under subsection (1) shall be supported by such documents and information, and accompanied by such fee, as may be prescribed.

(3) A notice under subsection (1) shall remain in force until the end of the period of sixty days commencing on the day on which the notice was given, unless it is withdrawn, before the end of that period, by letter given to the Comptroller—

- (a) by the licensee, if the person giving the notice is a licensee of the registered trade mark and he has power to withdraw the notice; or
- (b) by the proprietor of the registered trade mark in any other case.

(4) If—

- (a) a notice has been given under this section in respect of a registered trade mark;
- (b) the notice has not lapsed or been withdrawn; and
- (c) a person imports goods, not being goods in transit, which bear a sign that, or whose packaging bears a sign that, in the opinion of the Comptroller is identical with or similar to the registered trade mark in question,

the Comptroller may seize the goods.

Security for
liability or
expense of
seizure.

98. The Comptroller may refuse to seize goods under section 97 unless—

- (a) the objector has deposited with the Comptroller a sum of money that, in the opinion of the Comptroller, is sufficient to—
 - (i) reimburse the State for any liability or expense it is likely to incur as a result of the seizure of the goods; and
 - (ii) pay such compensation as may be ordered by the Court under section 104(2) or 105(6); or
- (b) the objector has given security, to the satisfaction of the Comptroller, for the reimbursement of the State for any such liability or expense and the payment of such compensation.

99. Seized goods shall be taken to such secure place as the Comptroller directs.

Secure storage
of seized
goods.

100. (1) As soon as is practicable after goods are seized under section 97, the Comptroller shall give to the importer and the objector, either personally or by post, a written notice identifying the goods and stating that they have been seized.

Notice of
seizure.

(2) A notice under subsection (1) shall state that the goods shall be released to the importer unless—

- (a) an infringement action in respect of the goods is instituted by the objector within a specified period from the date specified in the notice, being no more than one month from the date of the notice; and
- (b) the objector gives written notice to the Comptroller within the specified period stating that the infringement action has been instituted.

(3) The date specified for the purposes of subsection (2)(a) shall not be earlier than the date on which the notice is given.

(4) The objector may, by written notice given to the Comptroller before the end of the specified period referred to in subsection (2)(a), request that the period be extended.

(5) Subject to subsection (6), if—

- (a) a request is made in accordance with subsection (4); and
- (b) the Comptroller is satisfied that it is reasonable that the request be granted,

the Comptroller may extend the specified period by such period as he thinks fit.

(6) A decision on a request made in accordance with subsection (4) shall be made within ten working days after the request is made, but such a decision shall not be made after the end of the specified period referred to in subsection (2)(a).

Inspection,
release, etc., of
seized goods.

101. (1) The Comptroller may permit the objector or the importer to inspect the seized goods.

(2) If the objector gives the requisite undertakings, the Comptroller may permit the objector to remove a sample of the seized goods from the custody of the Comptroller for inspection by the objector.

(3) If the importer gives the Comptroller the requisite undertakings, the Comptroller may permit the importer to remove a sample of the seized goods from the custody of the Comptroller for inspection by the importer.

(4) The requisite undertakings are undertakings in writing that the person giving the undertaking shall—

- (a) return the sample to the Comptroller at a specified time that is satisfactory to the Comptroller;
- (b) take reasonable care to prevent damage to the sample; and
- (c) deposit with the Comptroller a security, in the amount of which the Comptroller shall determine, upon his satisfaction that the security deposit can be used to offset the cost of the sample if the goods are used for testing purposes.

(5) A person under this section who does not return the sample in accordance with subsection (4) commits an offence and is liable to a fine of ten thousand dollars unless the Comptroller is satisfied that the sample had to be used for testing purposes.

(6) If the Comptroller permits inspection of the seized goods, or the removal of a sample by the objector, in accordance with this section, the Comptroller is not liable to the importer for any loss or damage suffered by the importer arising out of—

- (a) damage to any of the seized goods incurred during that inspection; or

- (b) anything done by the objector or any other person to, or in relation to, a sample removed from the custody of the Comptroller or any use made by the objector of such a sample.

102. (1) Subject to subsection (2), the importer may, by written notice to the Comptroller, consent to the seized goods being forfeited to the State.

Forfeiture of seized goods by consent.

(2) A notice under subsection (1) shall be given before any infringement action in relation to the seized goods is instituted.

(3) If the importer gives a notice under subsection (1), the seized goods shall be forfeited to the State and shall be disposed of—

- (a) in the manner prescribed; or
- (b) if no manner of disposal is so prescribed, as the Comptroller directs.

103. (1) The Comptroller shall release seized goods, not being goods forfeited to the State under section 102, to the importer on the expiration of the retention period for the goods if the objector has not, before the expiration of that period—

Compulsory release of seized goods to importer.

- (a) instituted an infringement action in relation to the goods; and
- (b) given written notice to the Comptroller stating that the action has been instituted.

(2) If—

- (a) an infringement action has been instituted in relation to the seized goods; and
- (b) at the end of a period of ninety days commencing on the day on which the action was instituted, there is not in force an order of the Court in which the action was instituted preventing the release of the goods,

the Comptroller shall release the goods to the importer.

(3) If the objector gives written notice to the Comptroller stating that he consents to the release of the seized goods, the Comptroller shall release the goods to the importer.

Compensation
for failure to
take action.

104. (1) Where goods have been seized pursuant to a notice given under section 97 and the objector concerned fails to take infringement action within the retention period for the goods, a person aggrieved by such seizure may apply to the Court for an order of compensation against the objector.

(2) Where the Court is satisfied that the applicant had suffered loss or damage as a result of the seizure of the goods, the Court may order the objector to pay compensation in such amount as the Court thinks fit to the applicant.

Actions for
infringement of
registered trade
mark.

105. (1) The Court in which an infringement action is pending may, on the application of a person having a sufficient interest in the subject matter of the action, allow the person to be joined as a defendant to the action.

(2) The Comptroller is entitled to be heard on the hearing of an infringement action.

(3) In addition to any relief that may be granted apart from this section, the Court may—

- (a) at any time, order that the seized goods be released to the importer subject to such conditions, if any, as the Court thinks fit;
- (b) order that the seized goods not be released to the importer before the end of a specified period; or
- (c) order that the seized goods be forfeited to the State.

(4) The Court shall not make an order under subsection (3)(a) if it is satisfied that the State or any statutory authority, person or entity is required or permitted under any other law to retain control of the seized goods.

(5) The Comptroller shall comply with an order made under subsection (3).

(6) If—

- (a) the action is dismissed or discontinued, or if the Court decides that the relevant registered trade mark was not infringed by the importation of the seized goods; and
- (b) a defendant to the infringement action satisfies the Court that he has suffered loss or damage as a result of the seizure of the goods,

the Court may order the objector to pay compensation in such amount as the Court thinks fit to that defendant.

106. Notwithstanding section 103, in a case in which no order has been made under section 105(3) in relation to seized goods, the Comptroller is not obliged to release or dispose of the goods if the State is required or permitted, under any other law, to retain control of the goods.

Retention of control of seized goods.

107. If the Court orders that seized goods are to be forfeited to the State, the goods shall be disposed of—

Disposal of seized goods ordered to be forfeited.

- (a) in the manner prescribed; or
- (b) if no manner of disposal is so prescribed, as the Comptroller directs.

108. (1) If the reasonable expenses incurred by the Comptroller in relation to any action taken by the Comptroller under this Part, or taken in accordance with an order of the Court under this Part, exceed the amount deposited, or the amount of the security given, under section 98, the amount of the excess is a debt due to the State.

Insufficient security.

(2) The debt created by subsection (1) is due by the objector, or, if there are two or more objectors, by the objectors jointly and severally.

109. (1) Notwithstanding section 97(4), an Officer may—

- (a) detain any goods—
 - (i) that are imported into, or that are to be exported from, Trinidad and Tobago; and

Detention and examination of counterfeit goods.

(ii) that are not goods in transit; or
(b) examine any goods, including goods in transit, which he reasonably suspects are counterfeit goods in relation to a registered trade mark.

(2) As soon as practicable after goods are detained under subsection (1)(a), the Officer shall give—

(a) to the importer, exporter or consignee, as the case may be, of the detained goods; and
(b) to the proprietor of the registered trade mark, a written notice identifying the goods, stating that they have been detained and setting out the matters referred to in subsection (3).

(3) The detained goods shall be released to the importer, exporter or consignee, as the case may be, of the goods, unless, within the prescribed period, the proprietor of the registered trade mark—

(a) in the case of goods that are imported into Trinidad and Tobago and that are not goods in transit—

- (i) gives the Comptroller a written notice referred to in section 97(1);
- (ii) submits the documents and information, and pays the fee referred to in section 97(2) to the Comptroller; and
- (iii) deposits with the Comptroller the sum of money referred to in section 98(a) or gives the security referred to in section 98(b); or

(b) in the case of goods that are to be exported from Trinidad and Tobago or goods in transit that are consigned to a person with a commercial or physical presence in Trinidad and Tobago—

- (i) institutes an action for the infringement of his trade mark;
- (ii) serves on the Comptroller an order of the Court authorising the further detention of the goods; and

(iii) deposits with the Comptroller a sum of money that, in the opinion of the Comptroller, is sufficient to—

(A) reimburse the State for any liability or expense it has incurred and is likely to further incur as a result of the detention of the goods; and

(B) pay such compensation to any person who suffers loss or damage as a result of the detention of the goods as may be ordered by the Court,

or gives security, to the satisfaction of the Comptroller, for the reimbursement of the State for any such liability or expense and the payment of such compensation.

(4) Every order of the Court authorising the further detention of goods under subsection (3)(b)(ii) shall be subject to the condition that the proprietor of the registered trade mark complies with subsection (3)(b)(iii) within the prescribed period under subsection (3).

(5) Where the Court has made an order authorising the further detention of goods under subsection (3)(b)—

(a) the detained goods shall be taken to such secure place as the Comptroller directs; and

(b) sections 101, 102 and 104 to 108 shall apply, with the necessary modifications, to the further detention of the goods, and for the purposes of such application—

(i) any reference to the objector shall be read as a reference to the proprietor of the registered trade mark;

(ii) any reference to the importer shall be read as a reference to the exporter or consignee, as the case may be, of the detained goods;

- (iii) any reference to the seized goods shall be read as a reference to the detained goods;
- (iv) any reference to the seizure of goods shall be read as a reference to the detention or further detention of the goods;
- (v) any reference to the import or importation of goods shall be read—
 - (A) in the case of goods that are to be exported from Trinidad and Tobago, as a reference to the export of the goods; or
 - (B) in the case of goods in transit that are consigned to a person with a commercial or physical presence in Trinidad and Tobago, as a reference to the import or export, of the goods by the consignee;
- (vi) any reference to infringement action shall be read as a reference to an action for the infringement of the registered trade mark under subsection (3)(b)(i); and
- (vii) any reference to the retention period shall be read as a reference to the prescribed period under subsection (3).

Powers of search in relation to vessels, aircraft and vehicles.

110. (1) The Comptroller may board any conveyance in Trinidad and Tobago and may search all parts of the conveyance for goods liable to be seized under section 97 or detained under section 109.

(2) For the more effective exercise of the powers conferred by this section, the Comptroller may do all or any of the following:

- (a) require the master of any vessel in Trinidad and Tobago to heave to;

- (b) by direction to the master of any vessel or the pilot of any aircraft in Trinidad and Tobago, require the vessel or aircraft, as the case may be, not to proceed until so authorised;
- (c) require any documents which ought to be on board any vessel or aircraft, being documents relating to any goods therein, to be brought to him for inspection;
- (d) break open and forcibly enter any place or receptacle in any conveyance to which he cannot otherwise reasonably obtain access;
- (e) by direction to the master of any vessel in Trinidad and Tobago, require the vessel to proceed to any specified anchorage, wharf or place to which the vessel may lawfully go;
- (f) by direction to the master of any vessel in Trinidad and Tobago, require him to move or discharge any cargo or other goods therein;
- (g) require the person in charge of a vehicle—
 - (i) to stop and not to proceed until so authorised; or
 - (ii) to bring the vehicle to any police station or Customs area;
- (h) direct that the removal of any goods from or placed in any vessel be prohibited until so authorised; and
- (i) require the master of any vessel or the pilot of any aircraft to produce a complete manifest of the whole cargo of the vessel or aircraft and a complete list of stores carried by that vessel or aircraft.

(3) The Comptroller may exercise, in respect of any vehicle or any vessel not exceeding 75 tons net tonnage, the powers which are conferred upon the Comptroller by subsection (2) other than the powers conferred by paragraph (d) of that subsection.

(4) If any vessel or aircraft fails to comply with any lawful requisition or direction given or made under this section, the Comptroller may take all such steps as appear to him necessary to secure such compliance.

(5) Any person who contravenes this section or who fails to comply with any lawful requisition or direction given or made thereunder commits an offence and is liable on summary conviction to a fine of ten thousand dollars and to imprisonment for one year.

(6) The Comptroller may exercise the powers conferred by this section in respect of a vessel under way if he reasonably suspects that it is not in transit through Trinidad and Tobago.

Examination of
packages, etc.

111. (1) Any goods, package, box, chest or other article which is being or has recently been imported and in regard to which a reasonable suspicion exists that it is or that it contains goods liable to be seized under section 97 or detained under section 109 may be—

- (a) examined and searched by the Comptroller;
- (b) subjected to such tests or analysis as the Comptroller thinks fit;
- (c) forcibly opened by, or by order of, the Comptroller to facilitate the examination and search except that any person in charge of the package, box, chest or other article shall be afforded every reasonable facility for being present at the opening, examination and search; or
- (d) marked, locked, sealed or otherwise secured by the Controller pending examination and search.

(2) Any person, other than the Comptroller, who removes, opens, breaks or tampers with any mark, lock, seal or other means of securing any goods, package, box, chest or other article referred to in subsection (1)(d) commits an offence and is liable on conviction to a fine of ten thousand dollars and to imprisonment for one year.

112. (1) For the more convenient exercise of the powers conferred by section 109, the Comptroller may remove any package, box, chest or other article or any goods to a police station or Customs area or may require it to be so removed by the owner thereof or his agent or any person having the custody, charge or control thereof.

Power to remove packages and goods to police station or Customs area.

(2) Any person who fails to comply with any such requisition commits an offence and is liable on conviction to a fine of ten thousand dollars and to imprisonment for one year.

(3) Upon the failure by a person to comply with such a requisition, the Comptroller may remove the goods in the manner provided by subsection (1) and all the expenses of such removal shall be recoverable as a fine from that person or from the owner of the goods.

113. (1) Any person landing or being about to land or having recently landed from any vessel or aircraft, or leaving any vessel or aircraft in Trinidad and Tobago whether for the purpose of landing or otherwise, or entering or having recently entered Trinidad and Tobago by land, sea or air, shall —

Search of persons and baggage.

- (a) on demand by the Comptroller, either permit his person and goods and baggage to be searched by the Comptroller for any goods liable to be seized under section 97 or detained under section 109 or, together with the goods and baggage, accompany the Comptroller to a police station or an examination station, and there permit his person and goods and baggage to be searched in the presence and under the supervision of the Comptroller for any goods liable to be seized under section 97 or detained under section 109; or
- (b) on demand by the Comptroller, permit his person and goods and baggage to be searched by the Comptroller for any goods liable to be seized under section 97 or detained under section 109.

(2) Whenever it is necessary to cause a woman to be searched, the search shall be made by another woman and with strict regard to decency.

(3) The goods and baggage of any person who requests to be present when they are searched shall not be searched in his absence, unless he fails to be present after being given reasonable opportunity to be present.

(4) Any person who refuses to comply with any lawful demand made under this section may be arrested without warrant by the officer making the demand.

Obstruction.

114. Any person who—

(a) refuses an Officer access to any vessel, aircraft, vehicle or place which the officer is entitled to under this Part; or

(b) obstructs or hinders an Officer in the execution of any power conferred upon him by this Part,

commits an offence and is liable on summary conviction to a fine of fifteen thousand dollars and to imprisonment for one year.

Immunity of Officers.

115. No action or other legal proceedings shall lie against an Officer for anything which is, in good faith, done or omitted to be done in the exercise of any power, duty or function under this Part.

PART XII

MISCELLANEOUS

Practice Directions.

116. The Controller may issue Practice Directions relating to the procedures under this Act.

Registration to be *prima facie* evidence.

117. In all legal proceedings relating to a registered trade mark, including proceedings for rectification of the Register—

(a) the register shall be *prima facie* evidence of anything contained therein;

(b) the registration of the prescribed particulars of any registrable transaction under section 41 shall be *prima facie* evidence of the transaction; and

- (c) the registration of a person as proprietor of a registered trade mark shall be *prima facie* evidence of—
 - (i) the validity of the original registration; and
 - (ii) any subsequent assignment or other transmission of the registration.

118. (1) If in proceedings before the Court the validity of the registration of a trade mark is contested and it is found by the Court that the trade mark is validly registered, the Court may certify to that effect.

Certificate of validity.

(2) If the Court certifies the validity of the registration under subsection (1) and in subsequent proceedings—

- (a) the validity of the registration is again questioned; and
- (b) the proprietor obtains judgment in his favour, he is entitled to his costs as between Attorney-at-law and client unless the Court directs otherwise.

(3) Subsection (2) does not extend to the costs of an appeal in any such proceedings.

119. A certificate purporting to be under the hand of the Controller as to any entry, matter or thing which he is authorised to make or do under this Act, shall be *prima facie* evidence of—

Certificate of Controller.

- (a) the entry having been made, and of the contents; or
- (b) the matter or thing having been done or not done, as the case may be.

120. In all proceedings before the Court under this Act, the Court may award to any party, including the Controller, such costs as it may consider reasonable, but the Controller shall not, except in a case in which he has appeared in the proceedings, be ordered to pay the costs of any other of the parties.

Costs of proceedings before Court.

Burden of
proving use of
trade mark.

121. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

Offence
committed by
partnership or
body corporate.

122. (1) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners but without prejudice to any liability of the partners under subsection (3).

(2) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(3) Where a partnership commits an offence under this Act, every partner, other than a partner who is proved to have been ignorant of, or to have attempted to prevent the commission of the offence, also commits the offence and is liable to be proceeded against and punished accordingly.

(4) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate commits the offence and is liable to be proceeded against and punished accordingly.

Regulations.

123. The Minister may make Regulations subject to the negative resolution of Parliament—

- (a) for the forms to be used for any purpose relating to the registration of a trade mark or any other proceedings before the Controller under this Act;
- (b) prescribing fees in respect of applications, registration and other matters under this Act;
- (c) for the remission of fees;
- (d) in relation to the division of an application for the registration of a trade mark, including the—
 - (i) circumstances in which the application may be divided;

- (ii) conditions to be satisfied before a request for the division may be granted; and
- (iii) effect of dividing the application;
- (e) for the classification of goods and services for the purposes of the registration of trade marks;
- (f) to provide that a sign specified shall not be registered as a trade mark, or shall not be so registered unless such conditions as may be prescribed are satisfied;
- (g) for the manner of claiming priority under section 11;
- (h) to provide for opposition proceedings and for related matters;
- (i) in relation to amendments to applications and the making of objections to such amendments;
- (j) for the issuance of notices with respect to the expiration and renewal of the registration of trade marks;
- (k) to provide for the restoration of the registration of a trade mark which has been removed from the Register;
- (l) for the publication of an alteration of a registered trade mark and the making of objections by any person claiming to be affected by it;
- (m) to provide for the manner and effect of a cancellation of a registered trade mark;
- (n) for protecting the interests of persons having a right in a registered trade mark that is cancelled;
- (o) for the publication and entry in the Register of a disclaimer or limitation;
- (p) for the amendment of registered particulars relating to a licence;
- (q) as to the removal of particulars from the Register—
 - (i) where it appears from the registered particulars that the licence was granted

- for a fixed period and that period has expired; or
- (ii) where no fixed period is indicated and, after such period as may be prescribed, the Controller has notified the parties of his intention to remove the particulars from the Register;
- (r) for the amendment of, or removal from, the Register of particulars relating to a security interest;
- (s) for the publication by the Controller of the particulars of any application for the registration of a trade mark, including a representation of the mark, and such other information relating to trade marks as the Controller thinks fit;
- (t) for the times at which, and the manner in which, notices are to be given under this Act;
- (u) for the practice and procedure of any proceedings or other matter before the Controller;
- (v) for the manner of filing of applications or other documents;
- (w) requiring persons to make statutory declarations in support of any application, notice or request;
- (x) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (y) for the service of documents;
- (z) for the rectification of irregularities of procedure;
- (aa) for time limits and extensions thereto for anything required to be done in connection with any proceedings under this Act;
- (ab) for the giving of evidence in proceedings before the Controller;

- (ac) for the reinstatement of—
- (i) any application which is treated as withdrawn; or
 - (ii) a trade mark,
- and the conditions for such reinstatement; and
- (ad) generally for carrying out the provisions of this Act.

PART XIII
TRANSITIONAL

124. (1) In this Part—
“existing registered mark” means a mark or certification mark registered under the former Act immediately before the commencement of this Act.

Interpretation
of Part XIII
(Transitional).

(2) For the purposes of this Part—

- (a) an application under the former Act shall be treated as pending on the date of the commencement of this Act if it was made but not finally determined before that date; and
- (b) the date on which an application under the former Act was made shall be the date of filing under the former Act.

125. (1) Any existing registered mark, whether registered in Part A or B of the Register kept under the former Act, is a registered trade mark for the purposes of this Act.

Existing
registered
marks.

(2) Any existing registered mark registered as a certification trade mark in the Register kept under the former Act is a registered certification mark for the purposes of this Act.

(3) Any existing registered mark registered as a series of trade marks in the Register kept under the former Act is registered as a series of trade marks in the Register for the purposes of this Act.

(4) Any entry in the Register kept under the former Act indicating that an existing registered mark is associated with any other mark shall cease to have effect on the commencement of this Act.

(5) A condition entered on the Register kept under the former Act in relation to an existing registered mark immediately before the commencement of this Act shall cease to have effect on the commencement of this Act.

(6) Notwithstanding section 141, proceedings under section 47 of the former Act which are pending immediately before the commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.

(7) A disclaimer or limitation entered on the Register kept under the former Act in relation to an existing registered mark immediately before the commencement of this Act shall be deemed to be transferred to the Register and have effect as if entered on the Register in pursuance of section 31.

Effects of
registration:
infringement.

126. (1) Sections 27 to 30 apply in relation to an existing registered mark as from the commencement of this Act and subject to subsection (3), section 32 applies in relation to infringement of an existing registered mark committed on or after the commencement of this Act.

(2) Notwithstanding section 141, the former Act continues to apply in relation to infringements committed before the commencement of this Act.

(3) It is not an infringement of—

- (a) an existing registered mark; or
- (b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue on or after the commencement of this Act, any use which did not amount to infringement of the existing registered mark under the former Act.

127. Section 34 shall apply to infringing goods, material or articles whether made before, on or after the commencement of this Act.

Infringing goods, materials or articles.

128. (1) Section 46 shall apply to licences granted before the commencement of this Act, but only in relation to infringements committed on or after the date of commencement.

Rights and remedies of licensee or authorised user.

(2) Section 80(2) applies only in relation to infringements committed on or after the commencement of this Act.

129. (1) Subject to subsection (2), the provisions of section 39 apply as from the commencement of this Act to an existing registered mark of which two or more persons were immediately before that date registered as joint proprietors.

Co-ownership of registered mark.

(2) Where the relations between the joint proprietors remain as described in section 68 of the former Act there shall be taken to be an agreement to exclude the operation of section 39(1) and (3).

130. (1) Section 40 shall apply to transactions and events occurring on or after the date of commencement of this Act in relation to an existing registered mark and notwithstanding section 141, the former Act continues to apply in relation to transactions and events occurring before that date.

Assignment of registered mark.

(2) Entries in the Register kept under the former Act relating to the assignment and transmission of registered marks and of applications for registration of marks shall be deemed to be transferred on commencement of this Act to the Register and have effect as if made under section 41.

(3) Provision may be made by Regulations for putting entries referred to in subsection (2) in the same form as is required for entries made under this Act.

(4) An application for registration under section 34 of the former Act which has not been determined by the Controller before the commencement of this Act, shall be treated as an application for registration under section 41.

(5) The Controller may require the applicant to amend his application so as to conform with the requirements of this Act.

(6) An application for registration under section 34 of the former Act which has been determined by the Controller but not finally determined before the commencement of this Act shall notwithstanding section 141, be dealt with under the former Act and subsections (2) and (3) shall apply in relation to any resulting entry in the Register.

(7) Where, before the date of commencement of this Act a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration on or after that date shall be made under section 41.

Licensing of
registered trade
mark.

131. (1) Section 44 shall apply only in relation to licences granted on or after the commencement of this Act and notwithstanding section 141, the former Act continues to apply in relation to licences granted before the commencement of this Act.

(2) Existing entries under section 37 of the former Act shall be deemed transferred on the commencement of this Act to the Register and have effect as if made under section 41.

(3) Provision may be made by Regulations for putting entries referred to in subsection (2) in the same form as is required for entries made under this Act.

(4) An application under the former Act for registration as a registered user which is pending before the Controller immediately before the commencement of this Act shall be treated as an application for registration of a licence under section 41(1).

(5) The Controller may require the applicant to amend his application so as to conform with the requirements of this Act.

(6) An application for registration as a registered user which has been determined by the Controller but not finally determined before the date of commencement of this Act shall be dealt with under the former Act and subsections (2) and (3) shall apply in relation to any resulting entry in the Register.

(7) Any proceedings pending immediately before the commencement of this Act under section 41 of the former Act shall be dealt with under the former Act and any necessary alteration made to the Register.

132. (1) Subject to section 133, an application for registration of a mark under the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and, if registered, the mark shall be treated for the purposes of this Part as an existing registered mark.

Pending applications for registration.

(2) The power of the Minister under section 123 to make Regulations regulating practice and procedure is exercisable in relation to an application referred to in this section.

(3) Section 32 of the former Act shall be disregarded in dealing with an application for registration on or after the commencement of this Act.

133. (1) In the case of an application for registration of a trade mark under the former Act which—

Conversion of pending application.

(a) has not been advertised under section 20 of the former Act; and

(b) is pending,

immediately before the commencement of this Act, the applicant may give notice to the Controller to have the registrability of the mark determined in accordance with the provisions of this Act.

(2) The notice under subsection (1) shall be—

(a) in the prescribed form;

- (b) accompanied by the prescribed fee; and
- (c) given no later than six months after the commencement of this Act.

(3) A notice under this section is irrevocable and has the effect that the application shall be treated as if made immediately after the commencement of this Act.

Claim to
priority from
overseas
application.

134. (1) Section 12 applies to an application for registration made on or after the commencement of this Act notwithstanding that the Convention application was made before the commencement of this Act.

(2) Where, before the commencement of this Act, a person has duly filed an application for protection of a trade mark in a foreign State, to which section 76 of the former Act applies, which is not a Convention country (referred to in this paragraph as a “relevant overseas application”), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application.

(3) If the application for registration under this Act is made within the six months period referred to in subsection (2)—

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the relevant overseas application; and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in Trinidad and Tobago in the period between the date of filing of the relevant overseas application and the date of the application under this Act.

(4) Any filing which in a foreign State referred to in subsection (2) is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be deemed to give rise to the right of priority.

(5) For the purposes of subsection (4), a “regular national filing” means a filing which is adequate to establish the

date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

(6) A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, shall be considered the relevant overseas application, of which the filing date is the starting date of the period of priority, if at the time of the subsequent application—

- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) it has not yet served as a basis for claiming a right of priority,

and the previous application may not thereafter serve as a basis for claiming a right of priority.

(7) The Minister may make Regulations to provide for the manner of claiming a right to priority on the basis of a relevant overseas application.

(8) A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (2) to the applicant's "successor in title" shall be construed accordingly.

(9) Nothing in this section shall affect proceedings on an application for registration under the former Act made before the commencement of this Act.

135. Notwithstanding section 141, section 20 applies where the renewal of an existing registered mark falls due on or after the commencement of this Act and the former Act continues to apply in any other case.

Renewal of
registration.

136. An application under section 49 of the former Act which is pending on the date of commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.

Pending
application for
registration for
alteration of
registered mark.

Revocation for
non-use.

137. (1) An application under section 35 of the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and any necessary alteration shall be made to the Register.

(2) Subject to subsection (3), an application under section 23(1)(a) or (b) may be made in relation to an existing registered mark at any time on or after the commencement of this Act.

(3) No application referred to in subsection (2) for the revocation of the registration of an existing registered mark registered under section 13A of the former Act may be made until more than five years after the commencement of this Act.

Application for
rectification
and correction.

138. (1) An application under section 46 or section 48 of the former Act which is pending on the commencement of this Act shall be dealt with under the former Act and any necessary alteration made to the Register.

(2) An application under section 24 of this Act may be made in relation to an existing registered mark at any time on or after the commencement of this Act and the provisions of this Act shall be deemed to have been in force at all material times.

Rules as to use
of certification
mark.

139. (1) Rules governing the use of an existing registered certification mark submitted to the Controller in pursuance of section 50 of the former Act shall be treated after the commencement of this Act as if filed under section 75.

(2) Any request for amendment of the rules which was pending on the commencement of this Act shall be dealt with under the former Act.

Certificate of
validity.

140. A certificate given before the commencement of this Act under section 56 of the former Act shall have effect as if given under section 118.

PART XIV

REPEAL

Repeal
Ch. 82:81.

141. The Trade Marks Act is repealed.

SUBSIDIARY LEGISLATION

TRADE MARKS REGULATIONS

ARRANGEMENT OF REGULATIONS

REGULATION

PART I

PRELIMINARY

1. Citation.
2. Interpretation.
3. Fees.
4. Filing of documents.
5. Forms.
6. Size of documents.
7. Signature on documents.
8. Service of documents.
9. Furnishing of address.
10. Address for service.
11. Agents.

PART II

REGISTRATION OF TRADE MARKS

Division 1—Registrability of Trade Marks

12. Representation of President.
13. Trinidad and Tobago National Emblems, etc.
14. Registration of mark consisting of armorial bearings, etc.

Division 2—Application for Registration

15. Application for registration.
16. Representation of trade marks.
17. Division of application for registration.
18. Claim to priority.
19. Specification.
20. Translation and transliteration.

ARRANGEMENT OF REGULATIONS—*Continued*

REGULATION

21. Deficiencies in application.

Division 3—Amendment of Application

22. Amendment of application.

23. Amendment of application after publication.

Division 4—Examination of Application for Registration

24. Examination report and applicant's response.

Division 5—Publication

25. Publication of application.

Division 6—Opposition to Registration

26. Notice of opposition.

27. Contents of notice of opposition.

28. Counter-statement.

29. Evidence in support of opposition.

30. Evidence in support of application.

31. Evidence in reply by opponent.

32. Further evidence.

33. Exhibits.

34. Original exhibits.

35. Opposition hearing.

36. Controller's decision in opposition proceedings.

37. Extension of time in opposition proceedings.

38. Costs in uncontested oppositions.

Division 7—Registration

39. Certificate of registration.

PART III

REGISTER

40. Entry in Register of particulars of registered trade mark.

41. Registration subject to disclaimer or limitation.

42. Application to change name or address in Register.

43. Death of applicant before registration.

44. Removal of matter from Register.

45. Certificate of validity.

REGULATION

46. Extract from Register.

PART IV

RENEWAL OF REGISTRATION OF TRADE MARK

47. Renewal of registration.
48. Notice of renewal.
49. Notice of non-compliance.
50. Removal of trade mark from Register.
51. Restoration of registration.

PART V

REGISTRABLE TRANSACTIONS

52. Entry in Register of particulars of registrable transactions.
53. Application to register or give notice of transaction.

PART VI

ALTERATION OF REGISTERED TRADE MARK

54. Application to alter registered trade mark.

PART VII

**REVOCATION, INVALIDATION, RECTIFICATION AND
CANCELLATION**

55. Application for revocation, declaration of invalidity and rectification.
56. Counter-statement.
57. Further procedure.
58. Intervention by third parties.
59. Application to cancel registered trade mark or registration in relation to certain goods or services.

PART VIII

COLLECTIVE MARKS AND CERTIFICATION MARKS

60. Application of Regulations to collective marks and certification marks.
61. Filing of rules.

ARRANGEMENT OF REGULATIONS—*Continued*

REGULATION

- 62. Opposition to registration.
- 63. Amendment of rules.
- 64. Opposition to amendment of rules.

PART IX

EVIDENCE AND PROCEDURE

- 65. Right of affected party to be heard.
- 66. Hearing before Controller to be in public.
- 67. Evidence in proceedings before Controller.
- 68. Statutory declarations.
- 69. Notice of seal of officer taking declaration.

PART X

COSTS

- 70. Application for costs.
- 71. Scale of costs.

PART XI

EXTENSION OF TIME AND REINSTATEMENT OF APPLICATIONS, RIGHTS AND OTHER MATTERS

- 72. Request for extension of time.
- 73. Where non-compliance with time caused by act of person employed in the Intellectual Property Office.
- 74. Reinstatement of application, right or other matter.
- 75. Change of commencement date of period for filing evidence.

PART XII

ELECTRONIC ONLINE SYSTEM

- 76. Establishment of electronic online system.
- 77. Registration as account holder.
- 78. Identification name and authentication code.
- 79. Obligation to inform Controller of change of particulars.
- 80. Security measures.
- 81. Duty of person using electronic online system.

REGULATION

- 82. Cancellation of registration as account holder.
- 83. Documents to be signed, made on oath or attested.

PART XIII

HOURS OF BUSINESS AND EXCLUDED DAYS

- 84. Hours of business and excluded days.
- 85. Extension of period where interruption in postal service or operations.

PART XIV

MISCELLANEOUS

- 86. General certificates by Controller.
- 87. Case management conference.
- 88. Production of documents, information or evidence.
- 89. Irregularities and correction of clerical errors.
- 90. Appeal.
- 91. Application to Court.
- 92. Order of Court.
- 93. Trade Marks Journal.

PART XV

TRANSITIONAL PROVISIONS

- 94. Pending applications for registration.
- 95. Savings.
- 96. Commencement.

FIRST SCHEDULE—FEES.

SECOND SCHEDULE—DESCRIPTION OF FORMS.

THIRD SCHEDULE—SCALE OF COSTS.

137/2020.

TRADE MARKS REGULATIONS

made under section 123

PART I

PRELIMINARY

- Citation. **1.** These Regulations may be cited as the Trade Marks Regulations.
- Interpretation. **2.** (1) In these Regulations—
“account holder” means a person registered as an account holder by the Controller under regulation 77;
- Act No. 8 of 2015. “Act” means the Trade Marks Act;
“approved form” means a form approved by the Controller;
“authentication code” means an identification or identifying code, password or any other authentication method or procedure that may be assigned to or approved for an account holder by the Controller;
- Ch. 82:76. “Controller” means the Controller of the Intellectual Property Office as referred to under section 3(2) of the Patents Act;
“electronic online system” means the electronic online system established under regulation 76;
“folio” means one hundred words, with each figure being counted as one word;
- Ch. 82:81. “former Act” means the Trade Marks Act repealed by section 141 of the Act;
“identification name” means an identification name assigned to an account holder by the Controller under regulation 78;
“Intellectual Property Office” means the Intellectual Property Office established under section 3(1) of the Patents Act;
“specification” means the specification of goods or services in respect of which—
 (a) a trade mark; or

(b) a transaction in relation to a registered trade mark or an application for the registration of a trade mark,

is registered or proposed to be registered;

“National Emblems” has the meaning assigned under the National Emblems of Trinidad and Tobago (Regulation) Act; Ch. 19:04.

“Trade Marks (International Registration) Regulations” means the Trade Marks (International Registration) Regulations made under section 57 of the Act;

“Trade Marks Journal” means the journal by that name published under regulation 93.

(2) Unless the context otherwise requires, the word “month”, wherever it occurs in any decision, direction or other document issued by the Controller, means calendar month.

(3) Any period of time fixed by these Regulations or by any decision, direction or other document for the doing of any act shall be reckoned in accordance with subregulations (4), (5) and (6).

(4) Where the act is required to be done within a specified period from or after a specified date, the specified period begins immediately after that date.

(5) Where the act is required to be done within or not less than a specified period before a specified date, the period ends immediately before that date.

(6) Where the act is required to be done within a specified number of clear days before or after a specified date, at least that number of days shall intervene between the day on which the act is done and that date.

3. (1) The fees specified in the First Schedule are payable to the Controller in respect of the matters specified in that Schedule. Fees.
Schedule.

(2) Any fee in the First Schedule shall be paid at the same time as the filing of the matter in question.

Filing of
documents.

4. (1) The Controller may refuse to accept or process any document filed at the Intellectual Property Office that fails to comply with the Act or these Regulations.

(2) A document filed at the Intellectual Property Office shall—

- (a) be in English; or
- (b) where the document is not in English, be accompanied by an English translation of the document.

(3) A document filed at the Intellectual Property Office which is not filed using the electronic online system shall—

- (a) be filed using durable paper; and
- (b) be in writing that is legible and permanent.

(4) Where the Controller refuses to accept any document that does not comply with subregulation (2) or (3), the Controller shall give the applicant a notice stating the manner in which the document does not comply with subregulation (2) or (3), as the case may be.

(5) Where any document filed at the Intellectual Property Office is a copy, the Controller may—

- (a) decide whether to accept or process the document; and
- (b) require the original to be filed with the Intellectual Property Office within one month.

(6) The Controller may require the filing of a hard copy of a document filed using the electronic online system.

Forms.

5. (1) The Controller shall publish on the Intellectual Property Office's website and in the Trade Marks Journal—

- (a) the approved forms to be used for any purpose relating to the registration of a trade mark or any other proceedings before the Controller under the Act;
- (b) the Controller's directions relating to the use of an approved form; and

(c) any amendment or modification of any approved form or direction.

(2) An approved form may be modified on the direction of the Controller—

- (a) for use in a case other than the case for which it is intended;
- (b) for carrying out any transaction by means of the electronic online system; or
- (c) for any other purpose that the Controller considers necessary.

(3) The Controller may accept, in lieu of an approved form, any other document which is filed with the Intellectual Property Office for any purpose for which the approved form was published, if the document—

- (a) complies with regulation 4(2) and every direction of the Controller relating to the use of the approved form; and
- (b) is in a format that is acceptable to the Controller.

(4) Any reference in these Regulations to a numbered form shall be construed as a reference to the current version of the approved form bearing the corresponding number which is—

- (a) described in the Second Schedule; and
- (b) published in the Trade Marks Journal.

Second
Schedule.

6. Subject to any directions that may be given by the Controller, all forms, notices and other documents required or authorised by the Act or these Regulations to be given or sent to, filed with or served on the Controller, other than by means of the electronic online system, shall be given, sent, filed or served using letter size paper.

Size of
documents.

7. (1) A document to be signed for or on behalf of a partnership shall be signed by—

Signature on
documents.

- (a) any partner or associate or secretary or senior officer stating that he signs on behalf of the partnership; or

(b) any other person who satisfies the Controller that he is authorised to sign the document on behalf of the partnership.

(2) A document to be signed for or on behalf of a body corporate shall be signed by a director or secretary or other senior officer of the body corporate, or by any other person who satisfies the Controller that he is authorised to sign the document on behalf of the body corporate.

(3) A document to be signed by or on behalf of an unincorporated body or association of persons may be signed by any person who appears to the Controller to be authorised to sign.

(4) For the purposes of this regulation, “document” means a document to be given or sent to, filed with or served on the Controller in respect of any matter under the Act or these Regulations.

Service of documents.

8. (1) Where the Act or these Regulations authorise or require any document to be given or sent to, filed with or served on the Controller or Intellectual Property Office, the giving, sending, filing or service may be effected on the Controller or Intellectual Property Office by—

- (a) personal delivery;
- (b) facsimile transmission, where the original of the document transmitted is filed with the Controller within one month of the transmission; or
- (c) electronic communication, by sending an electronic communication of the document using the electronic online system.

(2) Where the Act or these Regulations authorise or require any document to be given or sent to or served on any party other than the Controller or Intellectual Property Office, the giving, sending or service may be effected on that party by—

- (a) sending the document by personal delivery;

- (b) facsimile transmission, where the original of the document transmitted shall be sent or served within one month of the transmission; or
- (c) electronic communication.

(3) Where the Act or these Regulations authorise or require any notice or other document to be given or sent to or served on any party by the Controller or Intellectual Property Office, the Controller or Intellectual Property Office may effect the giving, sending or service on the party—

- (a) by sending the notice or other document by personal delivery;
- (b) by sending the notice or other document by facsimile transmission where the original of the document so transmitted is sent to or served by the Controller within one month of such transmission; or
- (c) by electronic communication, by sending an electronic communication of the notice or other document using the electronic online system.

(4) Where any person has attempted to send any document by facsimile transmission under subregulation (1), the date of transmission of an application for registration transmitted by facsimile transmission shall be the date of application, where the original of the application is received by the Controller within one month.

(5) Notwithstanding the availability of an address for service filed in accordance with regulation 10, where any notice or other document to be given, sent or served by the Controller or Intellectual Property Office, is sent to a person by electronic communication using the electronic online system under subregulation (3)(c), it shall be taken to have been duly given, sent to or served on the person.

(6) Service of any notice or other document under the Act or these Regulations on a person by electronic

communication using the electronic online system may be effected only if the person is registered as an account holder in accordance with regulation 77.

(7) This regulation shall not apply to notices and documents to be served in proceedings in court.

(8) For the purpose of this regulation, “personal delivery” includes delivery by hand or by post.

Furnishing of
address.

9. (1) Where a person is, by the Act or these Regulations, required to furnish the Controller with an address, the address furnished shall be as full as possible for the purpose of enabling a person to find easily the place of business of the person whose address is given.

(2) The Controller may require the address to include the name of the street, the number of the block of building, the number of the premises or name of premises, if any, and the postal code.

Address for
service.

10. (1) For the purposes of any proceedings before the Controller, an address for service in Trinidad and Tobago shall be filed in accordance with subregulation (2) or (5) by or on behalf of—

- (a) an applicant for registration of a trade mark;
- (b) a person opposing an application for registration of a trade mark;
- (c) an applicant applying to the Controller under section 23 of the Act for the revocation of registration of a trade mark, under section 24 of the Act for a declaration of invalidity of the registration of a trade mark, or under section 85 of the Act for the rectification of the Register;
- (d) every person granted leave to intervene under regulation 58;
- (e) every proprietor of a registered trade mark which is the subject of an application to the

Controller for the revocation of the registration of the mark, a declaration of invalidation of the registration, or the rectification of the Register; and

(f) every other party to any proceedings before the Controller.

(2) Where a form is required to be filed under these Regulations for any matter in relation to the proceedings, being a form, which requires the furnishing of an address for service, the address for service shall be filed on that form.

(3) The filing of an address for service in accordance with subregulation (2) shall be effective only for the matter for which the form is filed.

(4) Notwithstanding subregulation (3)—

(a) where the address for service is filed on Form TM 2 or TM 12, the filing of the address for service shall be effective for the purposes of all proceedings in respect of the trade mark in relation to which that form is filed;

(b) where the address for service is filed on Form TM 6, TM 17 or TM 18, the filing of the address for service shall be effective for the purposes of the proceedings in relation to which that form is filed; and

(c) where the address for service is filed on Form TM 9 or TM 13, the filing of the address for service shall be effective for the purposes of all renewal applications or proceedings in respect of the trade mark in relation to which that form is filed.

(5) In a case where subregulation (2) or (4) does not apply, the address for service shall be filed on Form TM 1.

(6) Where an address for service is not filed as required by subregulation (1), the Controller may send to the person

concerned notice to file an address for service within two months from the date of the notice and if that person fails to do so—

- (a) in the case of an applicant referred to in subregulation (1)(a) or (c), the application shall be treated as withdrawn;
- (b) in the case of a person referred to in subregulation (1)(b) or (d), he shall be deemed to have withdrawn from the proceedings in question; and
- (c) in the case of the proprietor referred to in subregulation (1)(e) or a party referred to in subregulation (1)(f), he shall not be permitted to take part in the proceedings in question.

(7) An application requesting the Controller to alter an address for service shall be made on Form TM 1.

(8) Anything sent to, or served on, a person at his address for service shall be taken to have been duly sent to, or served on, the person.

(9) Subject to any filing to the contrary under subregulation (1) or (7) or regulation 42, the Controller—

- (a) may treat the address for service of an applicant for registration of a trade mark as that of the proprietor upon registration of that trade mark; and
- (b) may treat the trade or business address in Trinidad and Tobago of a person as his address for service.

Agents.

11. (1) The Controller, in dealing with any matter under the Act or these Regulations in respect of which a person has been authorised to act as an agent on behalf of another, may require the personal signature of either the agent or his senior officer.

(2) The Controller may, by notice in writing sent to an agent, require the agent to produce evidence of his authority.

(3) Where a person who has become a party to any proceedings before the Controller appoints an agent for the first time or substitutes one agent for another, the newly appointed agent shall file with the Controller in Form TM 1 his name together with an address for service in Trinidad and Tobago.

(4) Regulations 10(2) to (5) and (7) shall, with the necessary modifications, apply in relation to the filing by an agent of his name and address for service under subregulation (3).

(5) Where there is a change in the name or address for service of an agent or both and the agent remains the same legal entity after such change, the agent may file one Form TM 1 in respect of such change in name or address for service or both for all the matters under the Act for which the agent has been appointed.

(6) Any act required or authorised by the Act in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may not be done by or to the newly appointed agent referred to in subregulation (3) until he has complied with that subregulation or, in the case of a change in the name or address for service of the agent or both, until he has filed Form TM 1 in respect of such change.

PART II

REGISTRATION OF TRADE MARKS

Division 1—Registrability of Trade Marks

12. The Controller shall refuse to register a trade mark which consists of or contains any representation of the President or any colourable imitation thereof.

Representation
of President.

13. The Controller shall refuse to register a trade mark which consists of or contains—

Trinidad and
Tobago National
Emblems, etc.

- (a) any representation of the National Emblems, or of any crest, armorial bearing, insignia, or device so nearly resembling any of the foregoing as to be likely to be mistaken for them;

- (b) the words “Trinidad and Tobago Government”, or any word, letter or device if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had the Trinidad and Tobago Government’s patronage or authorisation, whether or not such be the case; or
- (c) the words “Red Cross” or “Geneva Cross”, any representation of the Red Cross or Geneva Cross, any representation of the Swiss Federal cross in white on a red background or silver on a red background, or any representation similar to any of the foregoing,

unless it appears to the Controller that consent to its registration and use of the person or authority entitled to give consent has been obtained.

Registration of mark consisting of armorial bearings, etc.

14. (1) Where a representation of the name, initials, abbreviation of the name, armorial bearings, state emblems, insignia, official signs, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate, government body, statutory board, institution or person appears on a trade mark which is the subject of an application for registration, the Controller, before proceeding to register the mark, may require the applicant to furnish the Controller with the consent to the registration and use of the matter in question of such official or other person as appears to the Controller to be entitled to give consent.

(2) The Controller shall refuse to register the mark if no such consent is furnished within the time specified by the Controller.

Division 2—Application for Registration

Application for Registration.

15. An application for the registration of a trade mark shall be made on Form TM 2 (referred to in this Part as “the application form”) and shall contain a clear indication of the nature of the mark.

16. (1) The applicant shall provide a clear and durable representation of the mark in the space provided for that purpose in the application form.

Representation
of trade marks.

(2) Where the representation exceeds the space in size, the representation shall be provided on a separate sheet of paper to be annexed to the application form.

(3) Where an application is for the registration of a series of trade marks, a representation of each trade mark in the series shall be provided in the application form.

(4) Where the Controller reasonably believes that the representation provided by the applicant does not sufficiently show the particulars of the mark or does not allow all features of the mark to be properly examined, the Controller may, by notice in writing, require the applicant to provide, within such time as the Controller may specify in the notice, any or all of the following:

- (a) another representation of the mark consisting of a single view of the mark or of several different views of the mark;
- (b) a description of the mark expressed in words;
- (c) such other information as the Controller may require.

(5) The Controller may at any time, if dissatisfied with any representation of a trade mark, require another representation satisfactory to him to be filed before proceeding with the application, and the applicant shall substitute the representation by filing with the Controller Form TM 16.

17. (1) Subject to the provisions of this regulation, an application for registration of a trade mark (referred to in this regulation as the original application) may, at the request of the applicant made on Form TM 4 at any time after the date of the original application but before the registration of the trade mark, be divided into two or more separate applications for registration of the trade mark.

Division of
application for
registration.

(2) Where the original application is made in respect of two or more goods or services, a request under subregulation (1) may be made to divide the original application into two or more separate applications, each in respect of—

- (a) one or more classes of those goods or services, being classes of goods or services to which the original application relates; or
- (b) one or more of those goods or services included in one or more of the classes of goods or services to which the original application relates.

(3) Where the applicant makes a request under subregulation (1), the request shall contain, for each separate application and each class of goods or services in respect of which that separate application is made, a specification in accordance with regulation 19 setting out the goods or services to which that separate application relates.

(4) Upon the division of the original application into two or more separate applications—

- (a) each separate application shall have the same date as the original application;
- (b) any notice of opposition to the registration of any trade mark which is a subject of the original application shall—
 - (i) if the notice relates only to some, but not all, of the goods or services in respect of which the original application is made, be treated as having been given in relation only to each separate application made in respect of any of the goods or services to which the notice relates; or
 - (ii) subject to subparagraph (i), be treated as having been given in relation to all of the separate applications, and the opposition proceedings shall continue as if the notice had been so given; and

- (c) any notice given to the Controller under section 43(3) of the Act shall—
 - (i) if the notice relates only to some (but not all) of the goods or services in respect of which the original application is made, be treated as having been given in relation only to each separate application made in respect of any of the goods or services to which the notice relates; or
 - (ii) subject to subparagraph (i), be treated as having been given in relation to all of the separate applications.

18. (1) Where a right of priority is claimed by reason of an application for the registration of a trade mark filed in a Convention country under section 11 of the Act or in another country or territory in respect of which provision corresponding to that set out in section 11 of the Act is made under section 12 of the Act (referred to in this regulation as “the priority application”), particulars of that claim shall be included in the application form at the time of filing the application form.

Claim to priority.

- (2) The particulars referred to in subregulation (1) are—
 - (a) the country or territory in which—
 - (i) the priority application; or
 - (ii) where there is more than one priority application, each priority application, was filed;
 - (b) the date on which—
 - (i) the priority application; or
 - (ii) where there is more than one priority application, each priority application, was filed;
 - (c) where the right of priority is claimed in respect of one or more, but not all of the goods or services for which registration was sought in the

priority application, the goods or services in respect of which the right of priority is claimed; and

- (d) where the right of priority is claimed through more than one priority application, the goods or services in respect of which the right of priority is claimed through each priority application.

(3) The Controller may require the applicant, who claims priority in accordance with regulation 18(1) and (2) to furnish the certified copy of the application for the priority of which is claimed within three months from the filing date of the present application verifying to the satisfaction of the Controller—

- (a) the date of filing of the priority application;
(b) the country or territory, or the registering or competent authority;
(c) the representation of the mark; and
(d) the goods and services covered by the priority application.

(4) Where the certified copy referred to in subregulation (3) is not in the English language, there shall be annexed to the certified copy a translation in English of the contents of the certified copy certified or verified to the satisfaction of the Controller.

Specification.

19. (1) Goods and services shall be classified for the purposes of the registration of trade marks in accordance with the International Classification as in force on the date of the application for registration of the trade mark.

(2) Every application shall contain, for each class of goods or services to which the application relates—

- (a) the class number as set out in the International Classification as in force on the date of that application; and

- (b) a specification of those goods or services which—
 - (i) is appropriate to that class;
 - (ii) is described in such a manner as to indicate clearly the nature of those goods or services; and
 - (iii) complies with any other requirement of the Controller.

(3) An application may be made in respect of more than one class of goods or services as set out in the International Classification as in force on the date of that application, and in such a case, the specification shall set out the classes in consecutive numerical order and list under each class the goods or services to which the application relates.

20. (1) Where a trade mark contains or consists of a word or words in characters other than Roman, or in a language other than English, there shall, unless the Controller otherwise directs, be endorsed on the application form—

Translation and transliteration.

- (a) a translation and, if the case requires, a transliteration, in English, of each word and of the words taken together as a whole to the satisfaction of the Controller; and
- (b) the language to which each word belongs.

(2) The Controller may, at any time, require a copy of the translation or transliteration, certified or verified to the satisfaction of the Controller, to be filed with the Controller.

21. (1) Where an application for registration of a trade mark does not satisfy any requirement under section 5(2) or (3) of the Act, the Controller shall send the applicant a notice requiring the applicant to remedy the deficiency.

Deficiencies in application.

(2) Where the Controller has sent the applicant a notice under subregulation (1), the applicant shall remedy all deficiencies set out in the notice within six months from the date of the notice or the application shall be treated as withdrawn.

(3) In accordance with section 5(4) of the Act, an application for registration of a trade mark shall not be treated as made unless—

- (a) all the requirements under section 5(2) of the Act have been satisfied; and
- (b) all the fees payable under section 5(3) of the Act—
 - (i) have been paid; or
 - (ii) are treated by the Controller as paid.

(4) Subject to subregulation (1), where an application for registration does not comply with regulation 15(1) or 19(2)(a), the Controller shall send the applicant a notice requiring the applicant to remedy the deficiency.

(5) If the applicant fails to remedy all deficiencies set out in the notice under subregulation (4) within six months from the date of the notice, the application shall be treated as withdrawn.

Division 3—Amendment of Application

Amendment of
Application.

22. (1) An application to amend an application for registration shall be made on—

- (a) Form TM 14, if it is made to correct or change the name or other particulars of the applicant, and the change does not affect the representation of the trade mark;
- (b) Form TM 15, if paragraph (a) does not apply and the amendment, or any of the amendments, pertains to—
 - (i) the class number or specification of any goods or services to which the application for registration relates; or
 - (ii) the particulars of any claim to a right of priority included in the application for registration; or
- (c) Form TM 16, if subparagraphs (a) and (b) do not apply.

(2) Before acting on an application to amend an application for registration, the Controller may require the applicant to furnish such proof as the Controller thinks fit.

23. (1) Where an application is made for an amendment of an application for registration which has been published, and the amendment affects the representation of the trade mark or the goods or services covered by the application for registration, the amendment or a statement of the effect of the amendment shall also be published.

Amendment of
application after
publication.

(2) Any person who wishes to oppose the amendment shall, within three months from the date of publication of the amendment or statement referred to in subregulation (1), file with the Controller a notice of opposition to the amendment in Form TM 6.

(3) The notice of opposition shall contain a statement of the grounds upon which the person opposes the amendment, including, where relevant, how the amendment would be contrary to section 15(3) of the Act.

(4) Regulations 26 and 28 to 38 shall apply with the necessary modifications to any proceedings arising from the notice of opposition.

(5) For the purposes of the application of the regulations referred to in subregulation (4)—

- (a) any reference to the application for registration shall be read as a reference to the application for amendment referred to in subregulation (1);
- (b) any reference to the date of publication of the application for registration shall be read as a reference to the date of publication of the amendment or statement referred to in subregulation (1);
- (c) any reference to the notice of opposition shall be read as a reference to the notice of opposition referred to in subregulations (2) and (3); and
- (d) any reference to the opponent shall be read as a reference to the person referred to in subregulations (2) and (3).

Division 4—Examination of Application for Registration

Examination
report and
applicant's
response.

24. (1) If, in the course of an examination of an application for registration, it appears to the Controller that the requirements for registration are not met or that additional information or evidence is required to meet those requirements, the Controller shall give a written notice of this to the applicant.

(2) If, within three months from the date of the written notice of the Controller, the applicant fails to—

- (a) make representations in writing;
- (b) apply to the Controller for a hearing;
- (c) apply to amend the application; or
- (d) furnish the additional or any other information or evidence,

the application shall be treated as withdrawn.

(3) If the applicant requests a hearing to make representations, the Controller shall give notice to the applicant of a date on which he will hear the applicant's arguments.

(4) For the purposes of the hearing, the applicant shall file with the Controller his written submissions and bundle of authorities at least fourteen days before the date of the hearing.

(5) The decision of the Controller, in respect of the representations of the applicant given either during the hearing or in writing, shall be communicated to the applicant in writing or in such other manner as the Controller thinks fit.

(6) Where the applicant wishes to appeal against the decision of the Controller—

- (a) the applicant shall, within one month from the date of the decision, by filing Form TM 3 with the Controller, request the Controller to state the Controller's grounds of decision; and
- (b) the Controller shall, within two months from the date of the request, send the grounds of decision to the applicant.

(7) The date on which the Controller's grounds of decision are sent to the applicant shall be deemed to be the date of the Controller's decision for the purpose of an appeal to the High Court.

Division 5—Publication

25. (1) An application which has been accepted for registration shall be published in the Trade Marks Journal at such times and in such manner as the Controller may direct.

Publication of application.

(2) In the case of an application with which the Controller proceeds only after the applicant has lodged the written consent to the proposed registration of the proprietor of, or the applicant for the registration of, another trade mark, the words "By Consent" and the number of that other mark shall appear in the publication.

(3) In the case of an application for the registration of a series of trade marks, the Controller may, if he thinks fit, publish, together with the publication of the application, a statement of the manner in which the several trade marks differ from one another.

Division 6—Opposition to Registration

26. A person (referred to in this Division as "the opponent") may, within three months from the date of publication of the application for registration, file with the Controller a notice opposing the registration in Form TM 6 (referred to in this Division as a "notice of opposition") and shall forthwith serve a copy of the notice of opposition on the applicant.

Notice of opposition.

27. The notice of opposition shall contain a statement of the grounds upon which the opponent opposes the registration.

Contents of notice of opposition.

28. (1) Within two months from the date of receipt of the copy of the notice of opposition from the opponent, the applicant shall file with the Controller a counter-statement in Form TM 7 and shall forthwith serve a copy of the counter-statement on the

Counter-statement.

opponent (referred to in this Division as “the counter-statement”) setting out—

- (a) the grounds on which he relies as supporting his application; and
- (b) the facts alleged in the notice of opposition which he admits, if any.

(2) If the applicant does not comply with subregulation (1), he shall be deemed to have withdrawn his application, unless he obtains an extension of time.

(3) A request for an extension of time to file the counter-statement shall be made by the applicant to the Controller, in writing, within two months from the date of receipt of the notice of opposition from the opponent.

(4) The total extension of time which the Controller may allow to file the counter-statement shall not exceed four months from the date of receipt by the applicant of the notice of opposition.

Evidence in support of opposition.

29. (1) Within two months from the date of receipt of the counter-statement from the applicant, the opponent shall file with the Controller a statutory declaration setting out the evidence he wishes to adduce in support of his opposition.

(2) When the opponent files his statutory declaration with the Controller, the opponent shall forthwith send to the applicant a copy of the statutory declaration.

(3) If the opponent fails to comply with subregulation (1) or (2), he shall be treated as having withdrawn his opposition, unless he obtains an extension of time.

(4) Subject to subregulation (5), a request by the opponent for an extension of time to file his statutory declaration shall be made to the Controller, in writing, within two months from the date of receipt of the counter-statement from the applicant.

(5) A request by the opponent for a further extension of time to file the statutory declaration shall be made to the Controller by filing Form TM 32 before the expiry of the last extended period allowed by the Controller under this Regulation.

30. (1) Within four months from the date of receipt by the applicant of the copy of the opponent's statutory declaration referred to in regulation 29, the applicant shall file with the Controller a statutory declaration setting out the evidence he wishes to adduce in support of his application and shall forthwith send a copy of the statutory declaration to the opponent.

Evidence in support of application.

(2) If the applicant fails to comply with subregulation (1), he shall be treated as having withdrawn his application, unless he obtains an extension of time.

(3) Subject to subregulation (4), a request by the applicant for an extension of time to file his statutory declaration shall be made to the Controller, in writing, within two months from the date of receipt by the applicant of the copy of the opponent's statutory declaration referred to in regulation 29.

(4) A request by the applicant for a further extension of time to file his statutory declaration shall be made to the Controller by filing Form TM 32 before the expiry of the last extended period allowed by the Controller under this regulation.

31. (1) Within two months from the date of receipt by the opponent of the copy of the applicant's statutory declaration referred to in regulation 30, the opponent shall file with the Controller a statutory declaration setting out his evidence in reply and shall forthwith send a copy of the statutory declaration to the applicant.

Evidence in reply by opponent.

(2) The opponent's statutory declaration under subregulation (1) shall be confined to matters strictly in reply to the applicant's statutory declaration referred to in regulation 30.

(3) Subject to subregulation (4), a request by the opponent for an extension of time to file his statutory declaration setting out his evidence in reply shall be made to the Controller, in writing, within two months from the date of receipt by the opponent of the copy of the applicant's statutory declaration referred to in Regulation 30.

(4) The extension of time which the Controller may allow to file the opponent's statutory declaration pursuant to a request under subregulation (3) shall not exceed six months in the first request from the date of receipt by the opponent of the copy of the applicant's statutory declaration by filing Form TM 32.

Further
evidence.

32. No further evidence may be filed by either party except that, in any proceedings before the Controller, the Controller may at any time, if he thinks fit, give leave to either party to file further evidence upon such terms as to costs or otherwise as the Controller may think fit.

Exhibits.

33. (1) Where there are exhibits to any evidence filed in an opposition, the party who is relying on the exhibits in support of his case shall, at the request of the other party, send a copy of each exhibit to that other party.

(2) If such copy or other original cannot conveniently be furnished, the original shall be filed with the Controller in order that they may be open to inspection.

Original
exhibits.

34. The original exhibits to any evidence filed in an opposition shall be produced at the opposition hearing unless the Controller otherwise directs.

Opposition
hearing.

35. (1) Upon completion of the filing of evidence by the parties, the Controller shall—

- (a) give notice to the parties of a date on which he will hear arguments on the case; or
- (b) if the parties agree, dispense with the hearing and proceed with the determination of the matter based on written submissions filed with the Controller.

(2) The parties shall file with the Controller their written submissions and bundles of authorities—

- (a) at least one month before the date of hearing; or

(b) at such time that the Controller directs, if the parties agree to dispense with the hearing in accordance with subregulation (1)(b);

and shall forthwith exchange with one another their respective written submissions and bundles of authorities.

(3) Any party who intends to appear at the hearing shall file with the Controller Form TM 8 no later than seven days before the hearing.

(4) Any party who does not file with the Controller Form TM 8 seven days before the hearing may be treated as not desiring to be heard, and the Controller may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or make such other order as he thinks fit.

(5) If, after filing with the Controller Form TM 8, a party does not appear at the hearing, the Controller may proceed with the hearing in the absence of that party, or may, without proceeding with the hearing, give his decision or make such other order as he thinks fit.

(6) Any decision made by the Controller pursuant to a hearing in which any party does not appear may, on the application of the party that did not appear, be set aside by the Controller on such terms as he thinks fit.

(7) An application under this regulation to set aside any decision under subregulation (6) shall be made within seven days after the proceedings have been dismissed or after the hearing, as the case may be.

36. (1) The Controller shall, within three months from the date of the hearing inform the parties of his decision and the grounds for the decision.

Controller's
decision in
opposition
proceedings.

(2) If the parties agree to dispense with the hearing in accordance with regulation 35(1)(b), the Controller shall, within three months from the filing of the written submissions, inform the parties of his decision and the grounds for the decision.

Extension of
time in
opposition
proceedings.

37. Where any extension of time is granted to any party, the Controller may, if he thinks fit, without giving the party a hearing, grant a reasonable extension of time to the other party in which to take any subsequent step.

Costs in
uncontested
oppositions.

38. Where an opposition is uncontested by the applicant, the Controller, in deciding whether costs should be awarded to the opponent, shall consider whether proceedings may have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was filed.

Division 7—Registration

Certificate of
registration.

39. Upon the registration of a trade mark, the Controller shall issue to the applicant a certificate of registration.

PART III
REGISTER

Entry in
Register of
particulars of
registered trade
mark.

40. (1) There shall be entered in the Register in respect of each registered trade mark the following particulars:

- (a) the date of the filing of the application for registration;
- (b) the actual date of registration, that is, the date of the entry in the Register;
- (c) the priority date, if any, accorded pursuant to a claim to a right to priority under section 11 or 12 of the Act;
- (d) the name and address of the proprietor;
- (e) the address for service;
- (f) any disclaimer or limitation of rights notified to the Controller under regulation 41;
- (g) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the Controller has been notified on Form TM 30;
- (h) the goods or services in respect of which the trade mark is registered;

- (i) where the trade mark is a collective mark or certification mark, that fact;
- (j) where the trade mark is registered with the consent of the proprietor of an earlier trade mark or other earlier right, that fact; and
- (k) where the trade mark is registered pursuant to a transformation application, the number of the corresponding international registration and —
 - (i) the date of that international registration in accordance with the Madrid Protocol; or
 - (ii) where the request for extension of protection to Trinidad and Tobago was made subsequent to that international registration, the date of recordal of that request in accordance with the Madrid Protocol.

(2) In this regulation —

“corresponding international registration”, in relation to a transformation application, means the international registration referred to in the Trade Marks (International Registration) Regulations;

“international registration” means the registration of a trade mark in the International Register;

“International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau of the World Intellectual Property Organisation;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June 1989, as revised or amended from time to time;

“transformation application” means an application referred to in regulation 26(1)(b) of the Trade Marks (International Registration) Regulations.

Registration
subject to
disclaimer or
limitation.

41. Where the applicant for registration of a trade mark or the proprietor of a registered trade mark by Form TM 22—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the Controller shall make the appropriate entry in the Register and publish the disclaimer or limitation.

Application to
change name or
address in
Register.

42. (1) An application by—

- (a) the proprietor of a registered trade mark;
- (b) a licensee of a registered trade mark; or
- (c) any person having an interest in or charge on a registered trade mark registered under regulation 53,

to change his name or address appearing in the Register shall be filed with the Controller on Form TM 14.

(2) The Controller may at any time, on a request filed on Form TM 1 by any person who has filed an address for service under regulation 10 or 11, change that address in the Register.

Death of
applicant before
registration.

43. If an applicant for the registration of a trade mark dies after the date of his application and before the date the trade mark is entered in the Register, the Controller—

- (a) after the expiration of the time referred to in regulation 26 to file a notice of opposition; or
- (b) after the determination of any opposition to the registration,

may, on being satisfied that the applicant is dead, enter in the Register, in place of the name of the deceased applicant, the name, address and other particulars of the person owning the trade mark, on such ownership being proved to the satisfaction of the Controller.

44. (1) Before removing from the Register any matter which appears to the Controller to have ceased to have effect, the Controller—

Removal of
matter from
Register.

- (a) may, if he considers it appropriate, publish in the Trade Marks Journal, his intention to remove that matter; and
- (b) shall send notice of his intention to any person who appears to him to be likely to be affected by the removal.

(2) Within three months from the date on which his intention to remove the matter is published under subregulation (1)(a), any person may file with the Controller a notice of opposition to the removal in Form TM 6.

(3) Within three months from the date on which notice of his intention to remove the matter is sent to any person under subregulation (1)(b), that person may file with the Controller a notice of opposition to the removal in Form TM 6.

(4) If the Controller is satisfied after considering any opposition to the removal that the matter has not ceased to have effect, he shall not remove it.

(5) Where there has been no response to the Controller's publication or notice, he may remove the matter.

(6) If the Controller is satisfied after considering any opposition to the removal that the entry or any part thereof has ceased to have effect, he shall remove the entry or that part of the entry, as the case may be.

45. (1) Where the Court has certified, in accordance with section 118 of the Act, that a registered trade mark has been validly registered, the proprietor of the registered trade mark may request the Controller on Form TM 23 to add to the entry in the Register a note that a certificate of validity has been granted in the course of the proceedings named in the form.

Certificate of
validity.

(2) A copy of the certificate shall be sent with the request, and the Controller shall so note in the Register and publish the note in the Trade Marks Journal.

Extract from
Register.

46. Any person may request from the Controller a certified copy of or an extract from, or an uncertified copy of or an extract from, any entry in the Register.

PART IV

RENEWAL OF REGISTRATION OF TRADE MARK

Renewal of
registration.

47. (1) Subject to subregulation (2), an application for the renewal of registration of a trade mark shall be made no later than six months after the date of expiry of the registration.

(2) Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of the application for its registration, an application for the renewal of its registration shall be made no later than six months after the actual date of its registration.

(3) An application for the renewal of registration of a trade mark shall—

- (a) if made on or before the date of expiry of the registration, be in Form TM 9; or
- (b) if made within six months after the date of expiry of the registration, be in Form TM 13 and be accompanied by the additional late payment fee specified in the First Schedule.

(4) Notwithstanding subregulation (3)(b), where—

- (a) a trade mark is registered—
 - (i) within six months before; or
 - (ii) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration; and

- (b) an application for the renewal of its registration is made not later than six months after the actual date of its registration,

the application for the renewal of its registration shall be in Form TM 9.

48. (1) Subject to subregulations (2) and (3), the Controller shall, no more than six months before the date of expiry of the registration of a trade mark, send a notice in writing to the proprietor and to the proprietor's agent, notifying them of the date of expiry of the registration.

Notice of renewal.

(2) Subject to subregulation (3), where a trade mark is registered—

- (a) within six months before; or
- (b) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration, the Controller shall, within one month after the actual date of its registration, send a notice in writing to the proprietor—

- (i) where an application for the renewal of registration of the trade mark has previously been made in accordance with regulation 47, at the address for service as indicated in the application; or
- (ii) in any other case, at the proprietor's address for service,

notifying him of the date of expiry of its registration.

(3) The Controller need not send any notice referred to in subregulation (1) or (2) if an application for the renewal of registration of the trade mark has been made in accordance with regulation 47.

49. (1) If, in the course of an examination of an application for renewal of registration, it appears to the Controller that the application is not in order, the Controller shall give written notice of this to the applicant.

Notice of non-compliance.

(2) If the applicant fails to—

- (a) respond in writing to the Controller on the notice; or

- (b) comply with any requisition of the Controller set out in the notice,

within the time specified in the notice, the Controller may treat the application as having been withdrawn.

(3) If the applicant wishes to have an extension of time to do any act referred to in subregulation (2)(a) or (b), he shall file with the Controller a request for an extension of time in Form TM 31 before the expiry of the time specified in the notice or any extended period previously allowed by the Controller.

Removal of
trade mark from
Register.

50. The Controller may remove a trade mark from the Register if—

- (a) no application for the renewal of registration of the trade mark is filed in accordance with regulation 47; or
- (b) where an application for the renewal of registration of the trade mark is filed in accordance with regulation 47, the applicant for the renewal of registration—
- (i) fails to comply with any direction of the Controller relating to the renewal; or
- (ii) notifies the Controller that he wishes to withdraw or abandon the application.

Restoration of
registration.

51. (1) An application for restoration of a trade mark which has been removed from the Register under regulation 50 shall be filed with the Controller on Form TM 11 within six months from the date of the removal of the trade mark from the Register.

(2) The application for restoration filed on Form TM 11 shall contain a statement of the reasons for the failure to renew the registration.

(3) The Controller may, in any case, require the applicant for restoration to furnish such additional evidence or information, by statutory declaration or otherwise, as he thinks fit, within such time as the Controller may specify.

(4) The Controller may restore the trade mark to the Register and renew its registration if he is satisfied that it is just to do so, and upon such conditions as he may think fit to impose.

PART V

REGISTRABLE TRANSACTIONS

52. (1) The prescribed particulars of a transaction to which section 41 of the Act applies to be entered in the Register are—

Entry in Register of particulars of registrable transactions.

(a) in the case of an assignment of a registered trade mark or any right in it—

- (i) the name and address of the subsequent proprietor;
- (ii) the date of the assignment; and
- (iii) where the assignment is in respect of any right in the trade mark, a description of the right assigned;

(b) in the case of the grant of a licence under a registered trade mark—

- (i) the name and address of the licensee;
- (ii) where the licence is an exclusive licence, that fact;
- (iii) where the licence is limited, a description of the limitation; and
- (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;

(c) in the case of the grant of any security interest over a registered trade mark or any right in or under it—

- (i) the name and address of the grantee;
- (ii) the nature of the interest, whether fixed or floating; and
- (iii) the extent of the security and the right in or under the trade mark secured;

- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it—
 - (i) the name and address of the person in whom the trade mark or any right in or under it vests by virtue of an assent; and
 - (ii) the date of the assent; and
- (e) in the case of an order of the Court or other competent authority transferring a registered trade mark or any right in or under it—
 - (i) the name and address of the transferee;
 - (ii) the date of the order; and
 - (iii) where the transfer is in respect of a right in the trade mark, a description of the right transferred.

(2) In each of the cases mentioned in subregulation (1), there shall be entered in the Register the date on which the entry is made.

Application to register or give notice of transaction.

53. (1) An application to register particulars of a transaction to which section 41 of the Act applies shall be made, and a notice to be given to the Controller of particulars of a transaction to which section 43 of the Act applies shall be—

- (a) in the case of any assignment or transaction, other than a transaction referred to in paragraphs (b) to (f), on Form TM 12;
- (b) in the case of the grant of a licence, on Form TM 24;
- (c) in the case of an amendment to a licence, on Form TM 25;
- (d) in the case of a termination of a licence, on Form TM 26;
- (e) in the case of the grant, amendment or termination of any security interest, on Form TM 30; and
- (f) in the case of the making by personal representatives of an assent in relation to, or of an order of the Court or other competent authority

transferring, a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, on Form TM 10.

(2) Where an application under subregulation (1) is filed other than by means of the electronic online system, the application shall be—

- (a) signed by or on behalf of all the parties to the assignment or transaction, in the case of an assignment or transaction referred to in subregulation (1)(a);
- (b) signed by or on behalf of the personal representative, in the case of the making by a personal representative of an assent referred to in subregulation (1)(f);
- (c) accompanied by any documentary evidence which, in the Controller's view, is sufficient to establish the transaction, in the case of an order of the Court or other competent authority referred to in subregulation (1)(f); and
- (d) signed by or on behalf of the grantor of the licence or security interest, in any other case.

(3) Where an application under subregulation (1) is filed by means of the electronic online system, the application shall be authorised by all relevant parties and be validated by such means as the Controller considers fit.

(4) Where an application under subregulation (1) is not signed in accordance with subregulation (2)(a), (b) or (d), or not authorised and validated in accordance with subregulation (3), the application shall be accompanied—

- (a) in the case of an assignment, of a registered trade mark or an application for registration of a trade mark, referred to in subregulation (1)(a), at the option of the applicant, by—
 - (i) a certified copy of the contract of assignment;

- (ii) a certified extract of the contract of assignment, being an extract, which shows the change in the ownership of the registered trade mark or application for registration;
 - (iii) a certificate of transfer of the registered trade mark or application for registration in such form as the Controller may require, being a certificate signed by all parties to the assignment;
 - (iv) a transfer document relating to the registered trade mark or application for registration in such form as the Controller may require, being a document signed by all parties to the assignment; or
 - (v) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the assignment;
- (b) in the case of a grant of a licence, under a registered trade mark or an application for registration of a trade mark, referred to in subregulation (1)(b), at the option of the applicant, by—
- (i) a certified extract of the licence contract, being an extract which shows the parties to the contract and the rights which are licensed under the contract;
 - (ii) a statement of the licence containing such information as the Controller may require, being a statement signed by both the person granting the licence and the licensee; or
 - (iii) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the grant of the licence;

- (c) in the case of an amendment to, or a termination of, a licence, under a registered trade mark or an application for registration of a trade mark referred to in subregulation (1)(c) or (d), at the option of the applicant, by—
- (i) a statement of the amendment or termination of the licence, as the case may be, containing such information as the Controller may require, being a statement signed by both the person granting the licence and the licensee; or
 - (ii) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the amendment or termination of the licence, as the case may be; or
- (d) in any other case, by a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the transaction.

(5) Where an application under subregulation (1) is filed by means of the electronic online system, the document referred to in subregulation (4)(a)(i), (ii), (iii), (iv) or (v) shall be filed within such time as the Controller may specify.

(6) The Controller shall refuse to accept an application under subregulation (1) if subregulation (2), (3), (4) or (5) is not complied with and in such event, the Controller may require a fresh application to be made.

(7) The Controller may require the applicant to furnish such other document, instrument and information in support of the application as the Controller thinks fit, within such time as the Controller may specify.

(8) If the applicant wishes to have an extension of time to comply with the requirement referred to in subregulation (7), he shall file with the Controller a request for an extension of time

in Form TM 31 before the expiry of the time specified by the Controller or any extended period previously allowed by the Controller.

(9) Where the transaction is effected by an instrument chargeable with duty, the application shall be subject to the Controller being satisfied that the instrument has been duly stamped.

PART VI

ALTERATION OF REGISTERED TRADE MARK

Application to
alter registered
trade mark.

54. (1) The proprietor of a registered trade mark may apply to the Controller on Form TM 16 for such alteration of his mark as is permitted under section 21 of the Act.

(2) The proprietor shall provide to the Controller such evidence in respect of the application as the Controller may require.

(3) Where the Controller proposes to allow such alteration, he shall publish the mark as altered in the Trade Marks Journal.

(4) Any person claiming to be affected by the alteration may, within three months from the date of the publication of the alteration, file with the Controller a notice of opposition to the alteration in Form TM 6.

(5) The notice of opposition shall contain a statement of the grounds upon which the person opposes the alteration, including, where relevant, how the alteration would be contrary to section 21(2) of the Act.

(6) Regulations 26 and 28 to 38 shall apply, with the necessary modifications, to any proceedings arising from the notice of opposition.

(7) For the purposes of the application of the regulations referred to in subregulation (6)—

- (a) any reference to the applicant shall be read as a reference to the proprietor;

- (b) any reference to the application for registration shall be read as a reference to the application for alteration referred to in subregulation (1);
- (c) any reference to the date of publication of the application for registration shall be read as a reference to the date of publication of the alteration;
- (d) any reference to the notice of opposition shall be read as a reference to the notice of opposition referred to in subregulation (4); and
- (e) any reference to the opponent shall be read as a reference to the person referred to in subregulation (4).

PART VII

**REVOCATION, INVALIDATION, RECTIFICATION AND
CANCELLATION**

55. (1) An application to the Controller for—

- (a) the revocation of the registration of a trade mark under section 23 of the Act; or
- (b) a declaration of invalidity of the registration of a trade mark under section 24 of the Act, shall be made on Form TM 17.

Application for
revocation,
declaration of
invalidity and
rectification.

(2) An application to the Controller for the rectification of an error or omission in the Register under section 85 of the Act shall be made—

- (a) in the case of an application by the proprietor of a registered trade mark to amend any information in the Register relating to that trade mark, on—
 - (i) Form TM 14, if the amendment pertains to the name or other particulars of the proprietor;
 - (ii) Form TM 15, if subparagraph (i) does not apply and the amendment, or any of the amendments, pertains to—
 - (A) the class number or specification of any goods or services; or

(B) the particulars of any claim to a right of priority; or

(iii) Form TM 16, if subparagraphs (i) and (ii) do not apply; or

(b) in the case of an application by any other person to amend any information in the Register relating to that trade mark, on Form TM 17.

(3) The application shall be accompanied by a statement of the grounds on which the application is made.

(4) The applicant shall, if he is not the proprietor of the registered trade mark, serve a copy of the application and statement on the proprietor or the agent on record forthwith as he files these documents with the Controller.

Counter-statement.

56. (1) Within two months from the date of receipt of the copies of the application and statement from the applicant, the proprietor may file with the Controller a counter-statement in Form TM 7 setting out—

(a) the grounds on which he relies as supporting his registration; and

(b) the facts alleged in the application which he admits, if any.

(2) The proprietor or the agent on record shall serve on the applicant a copy of the counter-statement forthwith as he files the counter-statement with the Controller.

(3) In the case of an application for revocation of the registration of a trade mark on the ground referred to in section 23(1)(a) or (b) of the Act, the proprietor shall file, together with the counter-statement, evidence of the use by him of the trade mark, and shall also serve this on the applicant forthwith.

(4) A request for an extension of time to file the counter-statement shall be made by the proprietor to the Controller in writing within two months from the date of receipt of the copies of the application and statement.

(5) The total extension of time which the Controller may allow to file the counter-statement shall not exceed four months from the date of receipt by the proprietor of the copies of the application and statement.

(6) In the case of an application for revocation on the ground referred to in section 23(1)(a) or (b) of the Act, the application shall be granted where no counter-statement has been filed within the time allowed.

57. (1) Upon an application being made under regulation 55 and a counter-statement being filed under regulation 56, regulations 29 to 38 shall apply, with the necessary modifications, to further proceedings thereon except that, in the case of an application for revocation on the ground of non-use under section 23(1)(a) or (b) of the Act, the application shall be granted where no evidence of use has been filed under regulation 56(3). Further procedure.

(2) For the purposes of the application of regulations 29 to 38—

- (a) references in those regulations to the applicant shall be treated as references to the proprietor;
- (b) references in those regulations to the application shall be treated as references to the proprietor's registration;
- (c) references in those regulations to the opponent shall be treated as references to the applicant for revocation or a declaration of invalidity of the registration; and
- (d) the reference in regulation 30(2) to the withdrawal of the application shall be treated as a reference to the admission by the proprietor to the facts alleged by the applicant in his application for revocation or a declaration of invalidity of the registration.

58. (1) Any person, other than the registered proprietor, claiming to have an interest in a registered trade mark which is the subject of an application under regulation 55 may apply to the Controller on Form TM 18 for leave to intervene. Intervention by third parties.

(2) The Controller may, after hearing the parties concerned if he so required, refuse leave to intervene, or grant leave to intervene upon such terms, including any undertaking as to costs, as he thinks fit.

(3) Any person granted leave to intervene shall, subject to the terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings in question.

Application to cancel registered trade mark or registration in relation to certain goods or services.

59. (1) The proprietor may cancel his registered trade mark by filing with the Controller—

- (a) a notice in Form TM 20 if the cancellation relates to all the goods or services in respect of which the trade mark is registered; or
- (b) a notice in Form TM 21 if the cancellation does not relate to all the goods or services in respect of which the trade mark is registered.

(2) A notice under subregulation (1) shall have no effect unless the proprietor in that notice—

- (a) gives the name and address of every other person having a right in the mark, if any; and
- (b) certifies that each such person—
 - (i) has been given not less than three months' notice of the proprietor's intention to cancel the mark; or
 - (ii) is not affected by the cancellation or if affected, consents to the cancellation.

(3) The Controller, if satisfied that the notice complies with subregulation (2) and is otherwise regular, shall make the appropriate entry in the Register.

PART VIII

COLLECTIVE MARKS AND CERTIFICATION MARKS

Application of Regulations to collective marks and certification marks.

60. (1) Except as provided in this Part, the provisions of these Regulations shall apply in relation to collective marks and certification marks as they apply in relation to ordinary trade marks.

(2) In case of doubt in applying the provisions of these Regulations, any party may apply to the Controller for directions.

(3) The address of the applicant for the registration of a collective mark or certification mark shall be deemed to be the trade or business address of the applicant for the purposes of regulation 10(9)(b).

61. Within nine months from the date of the application for the registration of a collective mark or certification mark, the applicant shall file with the Controller in duplicate—

Filing of rules.

- (a) Form TM 5; and
- (b) a copy of the rules governing the use of the mark.

62. (1) Any person may, within three months from the date of the publication of an application for registration of a collective mark or certification mark, give written notice to the Controller in Form TM 6 opposing the registration.

Opposition to registration.

(2) Regulations 26 to 38 shall apply, with the necessary modifications, to the proceedings for opposition.

(3) In case of doubt, any party may apply to the Controller for directions.

63. (1) An application for the amendment of the rules governing the use of a registered collective mark or certification mark shall be filed with the Controller on Form TM 19.

Amendment of rules.

(2) The application shall be accompanied by a copy of the amended rules with the amendments shown in red, and both shall be filed in duplicate.

(3) Where it appears expedient to the Controller that the amended rules should be made available to the public, the Controller may publish a notice indicating where copies of the amended rules may be inspected.

Opposition to
amendment of
rules.

64. (1) Any person may, within three months from the date of the publication of the notice referred to in regulation 63(3), file with the Controller—

- (a) a notice of opposition to the amendment to the rules in Form TM 6; and
- (b) a statement indicating why the amended rules do not comply with the requirements under the Act.

(2) The person filing the notice and statement under subregulation (1) shall forthwith, serve copies of the notice and statement on the proprietor.

(3) Regulations 26 and 28 to 38 shall, with the necessary modifications, apply to the proceedings in relation to collective marks or certification marks as they apply to an opposition to an application for registration of a trade mark.

(4) For the purposes of the application of the regulations referred to in subregulation (3)—

- (a) references in those regulations to the applicant shall be treated as references to the applicant for the amendment of the rules;
- (b) references in those regulations to the date of the publication of the application for registration shall be treated as references to the date of the publication of the notice referred to in regulation 63(3);
- (c) references in those regulations to the notice of opposition shall be treated as references to the notice and statement referred to in subregulation (1); and
- (d) references in those regulations to the opponent shall be treated as references to the person who filed the notice and statement referred to in subregulation (1).

PART IX

EVIDENCE AND PROCEDURE

65. (1) Without prejudice to any of the provisions of the Act or these Regulations requiring the Controller to hear any party to proceedings under the Act or these Regulations, or to give such party an opportunity to be heard, the Controller shall, before exercising any power given to the Controller by the Act or these Regulations adversely to any party, give that party an opportunity to be heard.

Right of
affected party to
be heard.

(2) The Controller shall give that party at least ten days' notice of the date on which he may be heard.

(3) The Controller shall notify that party of his decision made in the exercise of his power.

66. The hearing before the Controller of any dispute between two or more parties relating to any matter under the Act or these Regulations shall be in public unless the Controller, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

Hearing before
Controller to be
in public.

67. (1) In any proceedings before the Controller under the Act or these Regulations, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Regulations or directed by the Controller.

Evidence in
proceedings
before
Controller.

(2) Any such statutory declaration may, in the case of an appeal to the Court, be used before the Court in lieu of evidence by affidavit, and if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) The Controller may, in any particular case, take oral evidence in lieu of, or in addition to a statutory declaration and shall, unless the Controller otherwise directs, allow any witness to be cross-examined on his statutory declaration or oral evidence.

Statutory
declarations.

68. Any statutory declaration filed under the Act or these Regulations, or used in any proceedings under the Act or these Regulations, shall be made and subscribed as follows:

- (a) in Trinidad and Tobago, before any Justice of the Peace, or any Commissioner of Affidavits or other officer authorised by law to administer an oath for the purpose of any legal proceedings;
- (b) in any other part of the Commonwealth, before any court, judge, justice of the peace, notary public or any officer authorised by law to administer an oath for the purpose of any legal proceedings; and
- (c) elsewhere, before a consulate, vice-consulate, or other person exercising the functions of a Trinidad and Tobago consular officer, or before a notary public, judge or magistrate.

Notice of seal of
officer taking
declaration.

69. Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by regulation 68 to take a declaration, may be admitted by the Controller without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

PART X

COSTS

Application for
costs.

70. (1) For the purposes of section 86 of the Act, a party to proceedings before the Controller who desires to obtain costs shall apply to the Controller for an award of costs in relation to the proceedings—

- (a) during the proceedings; or
- (b) within one month from—
 - (i) the day on which the Controller makes a decision in the proceedings that ends those proceedings; or

- (ii) the date of the Controller's notice to the party that the proceedings have been withdrawn, discontinued or dismissed, as the case may be.

(2) Before awarding costs in respect of the proceedings, the Controller shall give each party to the proceedings an opportunity to be heard in relation to the award of costs.

71. The provisions in the Third Schedule shall apply in relation to scale of costs.

Scale of costs.
Third Schedule.

PART XI

EXTENSION OF TIME AND REINSTATEMENT OF APPLICATIONS, RIGHTS AND OTHER MATTERS

72. (1) Any period of time—

- (a) prescribed by these Regulations; or
- (b) specified by the Controller for doing any act or taking any proceedings,

Request for
extension of
time.

may, at the request of the person or party concerned, be extended by the Controller by such period and upon such terms as the Controller considers fit.

(2) The Controller may, upon receiving the request for extension of time, require particulars from the person or party concerned as to the nature of the request for extension of time.

(3) The Controller may refuse to grant the extension if the person requesting the extension fails to show a good and sufficient reason for the extension.

(4) Subregulations (1) to (3) shall not apply to the following matters:

- (a) the remedying of a deficiency under regulation 21;
- (b) the filing of a notice of opposition to an amendment of an application which has been published under regulation 23(2);

- (c) the doing of any act referred to in regulation 24(2)(a), (b), (c) or (d);
- (d) the filing of a notice of opposition under regulation 26;
- (e) the filing of a counter-statement under regulation 28;
- (f) the filing of any statutory declaration under regulation 29, 30 or 31;
- (g) the filing of a notice of opposition to the removal of any matter from the Register under regulation 44(2);
- (h) the doing of any act referred to in regulation 49(2)(a) or (b);
- (i) the filing of an application for the restoration of a registration under regulation 51(1);
- (j) the compliance with a requirement referred to in regulation 51(4);
- (k) the compliance with a requirement referred to in regulation 53(7);
- (l) the filing of a notice opposing the alteration of a registered trade mark under regulation 54(4);
- (m) the filing of a counter-statement to a notice referred to in paragraph (l);
- (n) the filing of a counter-statement to an application for revocation or declaration of invalidity of the registration of a trade mark, or rectification of the Register under regulation 56;
- (o) the filing of a notice opposing the registration of a collective mark or certification mark under regulation 62;
- (p) the filing of a counter-statement to a notice referred to in paragraph (o);
- (q) the filing of a notice of opposition to an amendment to rules governing the use of a registered collective or certification mark under regulation 63(1);

- (r) the filing of a counter-statement to a notice referred to in paragraph (q);
- (s) the filing of an application under regulation 74(2) for the reinstatement of an application treated as withdrawn;
- (t) the filing of a notice of opposition in respect of a pending application for registration referred to in regulation 94; and
- (u) the filing of a counter-statement to a notice referred to in paragraph (t).

73. (1) Where, by reason of an act or omission of any person employed in the Intellectual Property Office, an act or step in relation to an application for the registration of a trade mark or any other proceedings before the Controller, required to be done or taken within a period of time, has not been so done or taken, the Controller may, notwithstanding the provisions of these Regulations, extend the period for doing the act or taking the step by such period as the Controller considers fit.

Where non-compliance with time caused by act of person employed in the Intellectual Property Office.

(2) Notwithstanding the provisions of these Regulations, the period of time for doing an act or taking a step under subregulation (1) may be extended although the period has expired.

74. (1) Any person whose—

- (a) application is treated as withdrawn; or
- (b) right has been abrogated, or matter has ceased to be in force or to exist,

Reinstatement of application, right or other matter.

by reason that he has failed to comply with any procedural requirement in any proceedings or other matter before the Controller within the time limit under the Act or specified by the Controller for complying with that requirement, may request for the reinstatement of the application, right or matter, as the case may be, in accordance with subregulations (2), (3) and (4).

(2) A request for the reinstatement of any application, right or matter referred to in subregulation (1)—

- (a) shall be made on Form TM 27 and filed with the Controller within six months from the date the application was treated as withdrawn, the right was abrogated, or the thing ceased to be in force or to exist, as the case may be;
- (b) shall not be made unless, and shall state that—
 - (i) the omission which led to the application being treated as withdrawn was unintentional; or
 - (ii) the failure to comply with a time limit which led to—
 - (A) the right being abrogated; or
 - (B) the matter ceasing to be in force or to exist, was unintentional; and
- (c) where the omission, or the failure to comply with a time limit, relates to the filing of any document or matter, shall be accompanied by that document or matter not filed or not filed on time, as the case may be.

(3) Subject to subregulation (4), where a request is filed under subregulation (2), the Controller shall allow the reinstatement unless there is a good and sufficient reason to refuse the request.

(4) The Controller shall not allow the reinstatement unless the requirements of subregulation (2) are satisfied.

(5) Subregulations (1) to (4) do not allow the reinstatement of—

- (a) any claim to a right of priority under section 11 of the Act or regulation 18(1); or
- (b) any application which is treated as withdrawn, any right which has been abrogated or anything

which has ceased to be in force or to exist by reason of—

- (i) any acquiescence by a proprietor of an earlier trade mark or other earlier right under section 25 of the Act, or under section 25 of the Act read with the Trade Marks (International Registration) Regulations;
- (ii) a failure to comply with the time limit for—
 - (A) any act under section 14 of the Act or Division 6 of Part II of these Regulations, or under the Trade Marks (International Registration) Regulations or regulations 29 to 38 of these Regulations read with the Trade Marks (International Registration) Regulations, in any opposition proceedings;
 - (B) any act under section 23 of the Act or Part VII of these Regulations, or under section 23 of the Act and regulations 55 to 58 of these Regulations read with the Trade Marks (International Registration) Regulations, in any proceedings for the revocation of the registration of a trade mark;
 - (C) any act under section 24 of the Act or Part VII of these Regulations, or under section 24 of the Act and regulations 55 to 58 of these Regulations read with the Trade Marks (International Registration) Regulations, in any proceedings for a declaration of invalidity of the registration of a trade mark;

- (D) any act under section 85 of the Act or Part VII of these Regulations in any proceedings for the rectification of an error or omission in the Register, being proceedings commenced by any person other than the proprietor of a registered trade mark in respect of any information in the Register relating to that trade mark;
- (E) the filing of a request under subregulation (2); or
- (F) the filing of Form TM 3 under regulation 24(6)(a); or
- (iii) a failure to pay the fee for the renewal of registration of a trade mark under regulation 47(3) or 51.

Change of commencement date of period for filing evidence.

75. Where the period within which any party to any proceedings before the Controller may file evidence under these Regulations is to commence upon the expiry of any period in which any other party may file evidence and that other party notifies the Controller that he does not wish to file any, or any further evidence, the Controller may direct that the period within which the first-mentioned party may file evidence shall begin on such date as may be specified in the direction, and the Controller shall notify all parties to the dispute of that date.

PART XII

ELECTRONIC ONLINE SYSTEM

Establishment of electronic online system.

76. (1) There shall be established an electronic online system for the purposes of these Regulations.

- (2) The Controller may—
 - (a) accept the filing of documents;
 - (b) obtain information in any form; and
 - (c) issue any document or approval;

by means of electronic records or in electronic form.

(3) Where the Controller decides to perform any of the functions under the Act or these Regulations by means of electronic records or in electronic form, the Controller may specify—

- (a) the manner and format in which such electronic records shall be filed, created, retained, issued or provided;
- (b) such control processes and procedures, as may be appropriate to ensure adequate integrity, security and confidentiality of electronic records or payments; or
- (c) any other required attributes for electronic records or payments that are currently specified for corresponding paper documents.

(4) The Controller may permit a person to have online access to the electronic database or databases for the purpose of examining any information, form, or document that the person is authorised to access under the Act or any other enactment.

(5) Any information, forms, or documents that are required to be signed by a person for filing with the Controller under the Act may be filed with the Controller if signed by electronic signature approved by the Controller, or by an electronically transmitted or reproduced signature.

(6) The electronic online system may be used—

- (a) for carrying out any of the transactions as directed by the Controller;
- (b) by any person for giving, sending to, filing with, or serving on the Controller or Intellectual Property Office any document, other than—
 - (i) a form that is not used for carrying out any of the transactions referred to in subparagraph (a); or
 - (ii) a notice or document to be served in proceedings in court; and

- (c) by the Controller or Intellectual Property Office for giving, sending to, or serving on, any person any notice or other document, other than a notice or document to be served in proceedings in court.

Registration as account holder.

77. (1) Any person who desires to make use of the electronic online system—

- (a) to carry out any transaction as directed by the Controller referred to in regulation 76(6)(a); or
(b) for giving, sending to, filing with, or serving on the Controller or Intellectual Property Office any document referred to in regulation 76(6)(b),

shall, in accordance with the procedures set out in practice directions issued by the Controller, apply to the Controller to be registered as an account holder.

(2) The Controller may register a person as an account holder on such terms and with such restrictions pertaining to the use of the electronic online system as the Controller thinks fit.

Identification name and authentication code.

78. (1) Upon registration of a person as an account holder, the person shall be assigned such number of identification names and authentication codes as the Controller may determine.

(2) The Controller may cancel the identification name and authentication code assigned to an account holder if, to the knowledge of the Controller, the authority of the account holder as agent has been revoked or terminated.

Obligation to inform Controller of change of particulars.

79. An account holder shall, in accordance with such procedure as may be laid down in practice directions issued by the Controller, inform the Controller of any change in the particulars furnished in his application for registration as an account holder under regulation 77.

80. (1) An account holder shall ensure the confidentiality and security of each identification name and authentication code assigned to him and shall not—

Security measures.

- (a) divulge the identification name and authentication code to any other person who has no authority to use the identification name and authentication code; or
- (b) permit any other person who has not been so authorised to use the identification name and authentication code.

(2) When using the electronic online system, an account holder shall not circumvent any security or authentication mechanism in the system.

81. A person shall only use the electronic online system in accordance with these Regulations and any practice directions issued by the Controller.

Duty of person using electronic online system.

82. The Controller may cancel—

Cancellation of registration as account holder.

- (a) the registration of an account holder; and
- (b) any identification name and authentication code issued to the account holder,

if the Controller is satisfied that the account holder has contravened regulation 80 or 81 or any term or restriction imposed by the Controller.

83. (1) Where any document to be given, sent, filed or served using the electronic online system—

Documents to be signed, made on oath or attested.

- (a) is to be signed or made on oath or by affirmation, it shall be signed, made on oath or affirmed in the usual way on the original paper document; or
- (b) is to be attested, it shall be attested in the usual way in which the original paper document is attested.

(2) The giving, sending, filing or service of a document using the electronic online system shall be effected by sending a true and complete electronic image of the original paper document.

PART XIII

HOURS OF BUSINESS AND EXCLUDED DAYS

Hours of
business and
excluded days.

84. (1) Subject to subregulations (4) and (7), any business done under the Act or these Regulations—

- (a) on any day after the hours of business of the Intellectual Property Office for that class of business; or
- (b) on any day which is an excluded day for that class of business,

shall be taken to have been done on the next following day which is not an excluded day for that class of business.

(2) Where the time for doing any business under the Act or these Regulations expires on an excluded day for the doing of that class of business, that time shall be extended to the next following day which is not an excluded day for the doing of that class of business.

(3) For the avoidance of doubt, where the time for—

- (a) carrying out any transaction referred to in regulation 76(6)(a);
- (b) giving, sending to, filing with or serving on the Controller or Intellectual Property Office any document referred to in regulation 76(6)(b); or
- (c) giving, sending to or serving on any person by the Controller or Intellectual Property Office any notice or other document referred to in regulation 76(6)(c),

expires on an excluded day, that time shall be extended to the next following day which is not an excluded day, notwithstanding the availability of the electronic online system.

(4) Where a document—

- (a) is transmitted to the Intellectual Property Office by means of the electronic online system; and
- (b) is received, by the server of that system set up to receive such transmissions, at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Intellectual Property Office any document by means of that system,

that document shall be treated as sent to or filed with, and received by, the Intellectual Property Office at that time and on that day.

(5) For the purposes of subregulation (4), the document shall be treated as sent to or filed with, and received by, the Intellectual Property Office if and only if the last byte of the transmission containing the document is received by the server referred to in that subregulation.

(6) Any person who sends or files a document by means of the electronic online system may produce a record of transmission issued through that system as evidence of—

- (a) the sending or filing of that document; and
- (b) the date and time when the sending or filing took place.

(7) Subject to subregulation (4) of regulation 8, where a document referred to in that subregulation—

- (a) is transmitted to the Controller or Intellectual Property Office by means of facsimile transmission; and
- (b) is received—
 - (i) by any facsimile machine designated by the Intellectual Property Office for the receipt of such transmissions; and
 - (ii) at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the

Intellectual Property Office that document by means of facsimile transmission,

that document shall be treated as sent to or filed with, and received by, the Intellectual Property Office at that time and on that day.

(8) For the purposes of subregulation (5)—

- (a) a document shall be treated as sent to or filed with, and received by, the Intellectual Property Office if and only if all sheets comprising the complete document are received by the facsimile machine referred to in that subregulation; and
- (b) the date and time of receipt of the document, as recorded by the facsimile machine referred to in that subregulation, shall, until the contrary is proved, be treated as the date and time when the document was sent to or filed with, and received by, the Intellectual Property Office.

(9) In the Act and these Regulations, “excluded day”, in relation to any specific class of business, means any day on which the Intellectual Property Office shall be taken to be closed for the purposes of the transaction by the public of that class of business.

Extension of period where interruption in postal service or operations.

85. (1) Where, on any day, there is an interruption in—

- (a) the postal service of Trinidad and Tobago;
- (b) the operation of the Intellectual Property Office;
- or
- (c) the operation of the electronic online system,

the Controller may issue a practice direction to declare that day as one on which there has been an interruption and, where any period of time specified in the Act or these Regulations for the giving, sending, filing or serving of any notice, application or

other document expires on a day so declared, the period shall be extended to the first day next following, not being an excluded day, which is not so declared.

(2) If in any case the Controller is satisfied that the failure to give, send, file or serve any notice, application or other document within the period specified in the Act or these Regulations was wholly or mainly attributable to a failure of or delay in the postal service of Trinidad and Tobago or the electronic online system, the Controller may, if he thinks fit and upon such terms as he may direct, extend the period so that it ends on the day of the receipt by the addressee of the notice, application or other document or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day.

(3) The Controller shall give notice of an extension referred to in subregulation (2) to all parties to the matter.

PART XIV

MISCELLANEOUS

86. (1) Any person who desires to obtain a certificate referred to in section 119 of the Act in relation to any entry, matter or thing which the Controller is authorised to make or do under the Act or these Regulations may file with the Controller Form TM 28.

General
certificates by
Controller.

(2) Before giving the certificate, the Controller may require the person to furnish evidence to show that he has an interest in the entry, matter or thing.

87. Notwithstanding anything in these Regulations, at any stage of any application to, or proceedings before, the Controller, the Controller may direct the applicant or parties to attend a case management conference in order that the Controller may make such order or give such direction as he thinks fit for the just, expeditious and economical disposal of the matter.

Case
management
conference.

Production of documents, information or evidence.

88. Notwithstanding anything in these Regulations, at any stage of any application to or proceedings before the Controller, the Controller may direct the applicant or any party to produce or file, within such period as the Controller may specify, any document, information or evidence which the Controller may reasonably require.

Irregularities and correction of clerical errors.

89. (1) Any irregularity in procedure which, in the opinion of the Controller, is not detrimental to the interests of any person or party may be corrected on such terms as the Controller may direct.

(2) Any correction of clerical errors shall be made on Form TM 16 and accompanied by the fee specified in the First Schedule.

Appeal.

90. The following decisions of the Controller are subject to appeal to the Court:

- (a) a decision referred to in regulation 36; and
- (b) a decision in opposition proceedings under regulation 44, 54, 62 or 64.

Application to Court.

91. A person who makes an application to the Court under the Act shall, as soon as practicable, file a copy of the application with the Controller.

Order of Court.

92. (1) Where an order is made by the Court in any matter under the Act, the person or persons in whose favour the order is made shall, as soon as practicable, file a copy of the order with the Controller.

(2) If the order is to rectify or alter the Register, the person in whose favour the order is made or, if there is more than one, such one of them, as the Controller may direct, shall file with the Controller Form TM 29.

(3) The Controller shall rectify or alter the Register in accordance with such order.

93. (1) The Controller shall publish an electronic journal, to be called the Trade Marks Journal, which shall contain—

Trade Marks Journal.

- (a) all matters that are required to be published in that Journal under these Regulations;
- (b) the Practice Directions issued by the Controller under the Act or these Regulations; and
- (c) such other information as the Controller thinks fit.

(2) The Trade Marks Journal shall be published weekly, unless the Controller otherwise directs.

PART XV

TRANSITIONAL PROVISIONS

94. (1) Where an application for registration of a trade mark made under the former Act, is advertised on or after the coming into effect of these Regulations, the period within which a notice of opposition to the registration may be filed shall not exceed four months from the date of advertisement, and such period shall not be extended.

Pending applications for registration.

(2) The period within which a counter-statement to the notice of opposition referred to in subregulation (1) may be filed shall not exceed four months from the date of the Controller's letter forwarding the copy of the notice of opposition, and such period shall not be extended.

95. Except as provided by regulation 94, where—

Savings.

- (a) immediately before the coming into effect of these Regulations, or any time or period prescribed by the revoked Trade Marks Rules, which were made under the former Act, has effect in relation to any act or proceeding and has not expired; and
- (b) the corresponding time or period prescribed by these Regulations would have expired or would expire earlier,

the time or period prescribed by the revoked Trade Mark Rules, and not by these Regulations, shall apply to that act or proceeding, and such time or period may be extended by the Controller by such period and upon such terms as the Controller considers fit.

PART XVI

COMMENCEMENT

Commencement. *96. These Regulations come into force on such day as the Trade Marks Act is proclaimed.

*The Trade Marks Act came into force on 25th June 2020. (LN 141/2020).

FIRST SCHEDULE

FEES

Regulation 3.

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
1. Filing of address for service, or request to substitute or alter address for service on record	10(5), 10(7), 11(3), 11(5) 42(2)	\$50.00 in respect of each trade mark number	1
2. Application to register a trade mark, collective mark or certification mark	15(1)	\$1,400 for first class \$150 for each additional class	2
3. Application to amend an application for registration of a trade mark, or by a proprietor of a registered trade mark to rectify an error or omission in the Register relating to that trade mark, or correct a clerical error—			
(a) where the application is made in relation only to any matter other than the name or other particulars of the applicant or proprietor, the class number or specification of any goods or services, or the particulars of any claim to a right of priority or to correct a clerical error	16(5), 22(1)(c), 54(1), 55(2)(a)(iii), 89(2)	\$150 in respect of each trade mark number	16
(b) where the application is made—	22(1)(b), 55(2)(a)(ii)	\$150	15

FIRST SCHEDULE—Continued

Regulation 3.

FEES

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
(i) in relation only to the class number or specification of any goods or services, or the particulars of any claim to a right of priority; or			
(ii) in relation to the class number or specification of any goods or services, the particulars of any claim to a right of priority, and in relation to any matter other than the name or other particulars of the applicant or proprietor			
4. Application to change name or other particulars of person in an application for registration or in Register	22(1)(a), 42(1), 55(2)(a)(i)	\$400 (for the first mark) \$150 for each additional mark	14
5. Request to the Controller to state grounds of decision relating to an application to register a trade mark	24(6)(a)	\$700 in respect of each trade mark number	3

FIRST SCHEDULE

FEES

Regulation 3.

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
6. Filing of notice of opposition to—	23(2), 26, 44(2), 44(3), 54(4), 62(1), 64(1)(a)	\$1,400	6
(a) an amendment of an application for registration of a trade mark which has been published, where the amendment affects the representation of the trade mark or the goods or services covered by the application for registration			
(b) the registration of a trade mark, collective mark or certification mark			
(c) the removal of any matter from the Register			
(d) the alteration of a registered trade mark			
(e) an application to amend the rules governing the use of a registered collective mark or certification mark			

FIRST SCHEDULE—Continued

Regulation 3.

FEEs

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
7. Filing of a counter-statement to—	28(1), 56(1)	\$700	7
(a) a notice of opposition to registration of a trade mark, collective mark or certification mark			
(b) an application to alter a registered trade mark			
(c) an application for revocation or a declaration of invalidity of a registration, or for rectification of Register			
(d) an application to amend the rules governing the use of a registered collective mark or certification mark			
8. Filing of notice of attendance at hearing	35(3)	\$350	8
9. Request to enter in the Register and to publish a note of a certificate of validity made under section 118 of the Act	45(1)	\$150 in respect of each trade mark number	23

Trade Marks

Chap. 82:81

177

Trade Marks Regulations

[Subsidiary]

FIRST SCHEDULE

FEES

Regulation 3.

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
10. Application for renewal of registration of a trade mark	47(3)(a), 47(4)	\$1,400	9
11. Late application for renewal of registration of a trade mark	47(3)(b)	\$2,100 (comprising \$1,400 for renewal fee and \$700 for late renewal fee)	13
12. Application to restore trade mark to the Register	51(1)	\$2,100 (comprising \$1,400 for renewal fee and \$700 for late renewal fee)	11
13. Application to register change of ownership	53(1)(a)	\$350 in respect of each trade mark number	12
14. Application to register the grant of a licence	53(1)(b)	\$350 in respect of each trade mark number	24
15. Application to register an amendment of a licence	53(1)(c)	\$350 in respect of each trade mark number	25
16. Application to register the termination of a licence	53(1)(d)	\$350 in respect of each trade mark number	26
17. Application to register the grant, amendment or termination of any security interest	53(1)(e)	\$350 in respect of each trade mark number	30
18. Application to register the making of an assent, or an order of the Court or other competent authority	53(1)(f)	\$350 in respect of each trade mark number	10

FIRST SCHEDULE—Continued

Regulation 3.

FEES

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
19. Application for the revocation, or a declaration of invalidity, of the registration of a trade mark, or by any person other than the proprietor of a registered trade mark for the rectification of an error or omission in the Register relating to that trade mark	55(1), 52(2)(b)	\$350	17
20. Application for leave to intervene in proceedings	58(1)	\$350 in respect of each trade mark number	18
21. Application for cancellation of a trade mark—			
(a) where the cancellation relates to all the goods or services in respect of which the trade mark is registered	59(1)(a)	\$350 in respect of each trade mark number	20
(b) where cancellation relates to some of the goods or services in respect of which the trade mark is registered	59(1)(b)	\$350 in respect of each trade mark number	21
22. Filing of rules relating to a collective mark or certification mark	61(a)	\$350 in respect of each trade mark number	5

FIRST SCHEDULE

FEES

Regulation 3.

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
23. Filing of amended rules relating to a collective mark or certification mark	63(1)	\$350 in respect of each trade mark number	19
24. Issue of a certificate under section 119 of the Act	86(1)	\$350 in respect of each trade mark number	28
25. Filing of a copy of an order of the Court for alteration or rectification of the Register	92(2)	\$350	29
26. Request to make any entry in the Register, or to rectify any entry therein, for which no fee is expressly provided	—	\$100	29
27. Inspection of— (a) any notice of opposition; (b) any application for revocation or for a declaration of invalidity of a registration or for rectification of the Register; (c) any counter-statement, or any decision, given in relation to any opposition proceedings; or (d) any counter-statement, or decision, given in relation to any application for revocation or for a declaration of invalidity of a registration or for the rectification of the Register	—	\$50	—

FIRST SCHEDULE—Continued

Regulation 3.

FEES

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
28. Inspection of Register	—	\$50	—
29. For certifying office copies, manuscripts or printed matter	—	\$10 per page \$100 for certification	—
30. Request to enter a disclaimer or limitation in the Register	41	\$50 in respect of each trade mark number	22
31. Request for an extension of time under Regulations 49(3) and 53(8)	49(3), 53(8)	1st Extension- \$100 2nd Extension- \$200 Other - \$300	31
32. Request for an extension of time to file statutory declaration under Regulation 29(5) or 30(4)	29(5), 30(4)	\$150	32
33. Request for reinstatement of application, right or matter	74(2)(a)	\$350 in respect of each trade mark number	27
34. Request to divide an application for registration of a trade mark made in respect of 2 or more goods or services (referred to in this item as the original application) into 2 or more separate applications, each in respect of one or more of those goods or services	17(1)	\$350 for each additional application that the original application is divided into	4

SECOND SCHEDULE

DESCRIPTION OF FORMS

Regulation 5.

<i>Form</i>	<i>Description of Form</i>
TM 1	Request to appoint or change an agent or to enter or change an address for service.
TM 2	Application to register a trade mark, collection mark or certification mark.
TM 3	Request for grounds of decision.
TM 4	Request to divide an application for registration.
TM 5	Filing of rules governing the use of a collective mark or certification mark.
TM 6	Notice of opposition.
TM 7	Counter-statement.
TM 8	Notice to the Controller of attendance at hearing.
TM 9	Application for renewal of registration.
TM 10	Assent by personal representatives or order of the Court or other competent authority.
TM 11	Application for restoration and renewal of registration removed from the Register.
TM 12	Application to register a change of ownership.
TM 13	Late application for renewal of registration.
TM 14	Request to change the name, or other particulars of applicant for registration, proprietor or other interested person.
TM 15	Application to amend the specification, class number or the priority claim of a trade mark application or registration.
TM 16	Application to amend a trade mark application, registration (excluding change of name/address/address for service and amendments pertaining to the specification, class number or the priority claim), or correct a clerical error.
TM 17	(1) Application for revocation or declaration of invalidity of registration of trade mark or protection of a protected international trade mark in Trinidad and Tobago; or (2) Rectification of the Register by persons other than the proprietor of the trade mark.

SECOND SCHEDULE—Continued

Regulation 5.

DESCRIPTION OF FORMS

<i>Form</i>	<i>Description of Form</i>
TM 18	Application to intervene in proceedings.
TM 19	Application to amend the rules governing the use of a collective mark or certification mark.
TM 20	Notice to cancel registration.
TM 21	Notice to partial cancellation of the specification of goods or services for which the mark is registered.
TM 22	Request by registered proprietor of trade mark for entry of disclaimer or limitation in the Register.
TM 23	Request by registered proprietor for entry on the Register of a note of a certificate of validity by the Court under section 118 of the Act.
TM 24	Application to register a licensee.
TM 25	Application to amend a licence.
TM 26	Application to terminate a licence.
TM 27	Request for reinstatement.
TM 28	Request for Controller's general certificate.
TM 29	Notice of order of court for alteration or rectification of Register.
TM 30	Application to register the grant, amendment or termination of security interest or memorandum relating to a trade mark.
TM 31	Request for extension of time.
TM 32	Request for extension time to file statutory declaration.

THIRD SCHEDULE

SCALE OF COSTS

Regulation 7.

<i>Item</i>	<i>Matter</i>	<i>Amount</i>
INSTITUTION OF PROCEEDINGS		
1.	Drawing and filing notice of opposition, application for revocation of registration of a trade mark, application for declaration of invalidity of registration of a trade mark, or application for rectification of an entry in the Register, all including a statement of grounds	\$1,500
2.	Drawing and filing counter-statement	\$1,500
3.	Preparing and filing evidence for opposition and revocation, invalidation or rectification proceedings	\$2,500–\$4,000 per statutory declaration
INTERLOCUTORY PROCEEDINGS		
4.	Preparing for all interlocutory proceedings	\$2,500–\$4,000
5.	Attending all interlocutory proceedings	\$2,500–\$4,000
FULL HEARINGS		
6.	Preparing for hearing	\$1,000–\$3,000
7.	Attendance at hearing	\$2,500–\$4,000
8.	General and travelling expenses of witness required to attend the hearing—	
	(a) Where the witness is an expert witness	\$1,000–\$2,000 per day
	(b) Where the witness is not an expert witness	\$500–\$1,000 per day

**TRADE MARKS (BORDER ENFORCEMENT
MEASURES) REGULATIONS**

ARRANGEMENT OF REGULATIONS

REGULATION

1. Citation.
2. Interpretation.
3. Notice under section 97(1) of the Act: infringing goods.
4. Time and manner of giving notice.
5. Further information and evidence.
6. Change in particulars.
7. Refusal to seize goods.
8. Period for instituting action for registered trade mark.
9. Period for extension of retention period.
10. Disposal of forfeited goods under section 102(3)(a) of the Act.
11. Prescribed period under section 109(3) of the Act: suspected counterfeit goods.
12. Commencement.

SCHEDULE.

**TRADE MARKS (BORDER ENFORCEMENT
MEASURES) REGULATIONS**

138/2020.

made under section 123

1. These Regulations may be cited as the Trade Marks (Border Enforcement Measures) Regulations.

Citation.

2. In these Regulations—

Interpretation.

“Act” means the Trade Marks Act;

Act No. 8 of 2015.

“Comptroller” means the Comptroller of Customs and Excise referred to in section 2 of the Customs Act;

Ch. 78:01.

“Controller” means the Controller of the Intellectual Property Office as referred to under section 3 of the Patents Act;

Ch. 82:76.

“Officer” has the meaning assigned under section 2 of the Customs Act.

3. (1) A notice to the Comptroller under section 97(1) of the Act shall be in the form set out in the Schedule.

Notice under section 97(1) of the Act: infringing goods.

(2) The notice shall be accompanied by—

- (a)** a statutory declaration that the particulars in the notice are true;
- (b)** a fee of \$500.00;
- (c)** a copy of the certificate of registration issued by the Controller under section 16(3) of the Act in relation to the registered trade mark specified in the notice;
- (d)** evidence that the registration of the registered trade mark was duly renewed at all times; and
- (e)** where the notice is given by a person as agent for the proprietor or licensee of the registered trade mark, whichever is appropriate, evidence of the authority of the person giving the notice.

(3) The proprietor or licensee of the registered trade mark may appoint another person to act as his agent for the purpose of giving the notice in writing.

Time and manner of giving notice.

4. A notice to the Comptroller under section 97(1) of the Act shall be delivered to the Customs and Excise Division during such time as the Office of the Customs and Excise Division is open for business.

Further information and evidence.

5. A person who has given a notice under section 97(1) of the Act to the Comptroller shall, as and when required by the Comptroller, give to the Comptroller such information and evidence within such time and in such form as the Comptroller may reasonably require.

Change in particulars.

6. A person who has given a notice under section 97(1) of the Act to the Comptroller shall notify the Comptroller in writing of any change in the particulars specified in the notice or affecting the notice within seven days of the change and further notice shall be given as the Comptroller may require.

Refusal to seize goods.

7. An Officer may refuse to seize goods to which a notice under section 97(1) of the Act relates if the person who has given the notice fails to comply with—

- (a) any requirement by the Comptroller under these Regulations; or
- (b) any provision of these Regulations.

Period for instituting action for registered trade mark.

8. A notice given by the Comptroller under section 100(1) of the Act shall for the purposes of section 100(2)(a) specify a period not exceeding ten working days after the service of the notice on the objector.

Period for extension of retention period.

9. Where under section 100(5) of the Act, the Comptroller extends the period specified by him pursuant to section 100(2)(a), the period of the extension shall not exceed ten working days after the expiry of the period originally specified.

Disposal of forfeited goods under section 102(3)(a) of the Act.

10. For the purposes of section 102(3)(a) of the Act, the prescribed manner of disposal of forfeited goods shall be such manner of disposal, including destruction, as the Comptroller may from time to time direct pursuant to the Customs Act.

11. (1) For the purposes of section 109(3) of the Act, the prescribed period shall be—

- (a) two working days after the Comptroller has given the written notice referred to in section 109(2) of the Act to the proprietor of the registered trade mark; or
- (b) where—
 - (i) the detained goods are goods that are to be exported from Trinidad and Tobago or are goods in transit; and
 - (ii) the proprietor of the registered trade mark has complied with section 109(3)(b)(iii) of the Act,

Prescribed period under section 109(3) of the Act: suspected counterfeit goods.

within ten working days after the Comptroller has given the proprietor of the registered trade mark the written notice referred to in section 109(2) of the Act.

(2) Upon the written request of the proprietor of the registered trade mark given to the Comptroller before the end of the prescribed period, the Comptroller may extend the prescribed period if he considers it reasonable to do so for a further period not exceeding ten working days after the expiry of the applicable period under subregulation (1).

***12.** These Regulations come into force on such day as the Trade Marks Act is proclaimed.

Commencement.

*The Trade Marks Act came into force on 25th June 2020. (LN 141/2020).

SCHEDULE

Regulation 3(1). *NOTICE UNDER SECTION 97(1) OF THE TRADE MARKS ACT,
NO. 8 OF 2015*

Please read these instructions before completing the notice

1. This notice may only be given by the proprietor, licensee of a registered trade mark or appointed person to act as his agent.

2. Unless otherwise indicated, the notice must provide sufficient particulars of all matters specified therein and in Appendices 1 and 2 to enable the Comptroller of Customs and Excise to act on it.

Please follow the instructions in the Explanatory Notes below when completing the notice

3. A statutory declaration that the contents of the notice are true is to be enclosed with the notice.

4. A fee of \$500.00 is payable on giving the notice to the Comptroller of Customs and Excise.

5. A copy of the certificate of registration for the trade mark, as well as the certificate of renewal, where applicable, is to be enclosed with the notice.

6. You are required to provide the Comptroller of Customs and Excise with security, whether by way of deposit of money, an instrument of guarantee or otherwise, that is sufficient to—

- (a) reimburse the State for any liability or expense which it is likely to incur as a result of the seizure of the goods; and
- (b) compensate any person suffering damage as a result of the seizure,

in accordance with section 98 of the Trade Marks Act. Please note that you will be responsible for any liability or expense which exceeds the amount of the security.

7. Please note that the notice lapses within sixty (60) days commencing on the day of the giving of the notice.

NOTICE

To the Comptroller of Customs and Excise:

1. I, _____ (1), hereby give you notice that (2) _____
 - (a) is the _____ (3) of a trade mark registered in Trinidad and Tobago, a representation of which is set out in Appendix 1; and
 - (b) object to the import into Trinidad and Tobago of the goods described in Appendix 2.
2. To the best of my knowledge and belief—
 - (a) the importer of the goods is _____ (4); and
 - (b) the particulars of the time and place where the goods are expected to be imported into Trinidad and Tobago are as follows (5):
3. The goods are infringing goods because _____ (6).
4. The goods are not goods in transit because _____ (7).

5. I hereby request that the said goods be dealt with in accordance with Part XI (Border Enforcement Measures) of the Trade Marks Act.

Date:

Signature:

Designation: (8)

Notes:

- (1) State the name and address of the person giving the notice.
- (2) State the name and address of the proprietor or licensee on whose behalf the notice is given.
- (3) State “proprietor” or “licensee”, as applicable.
- (4) State the name and address of the importer.
- (5) State—
 - (a) the estimated date of arrival of the goods;
 - (b) the name of the port, airport or checkpoint by which the goods are expected to be imported into Trinidad and Tobago;
 - (c) the name of the ship or the flight number of the aircraft by which the goods are expected to be imported into Trinidad and Tobago; and

SCHEDULE—Continued

- (d) where available—
- (i) the country of origin of the goods; and
 - (ii) any other information which may indicate the actual time when and place where the goods will be imported into Trinidad and Tobago.
- (6) State the grounds on which it is claimed that the goods are infringing goods within the meaning of section 35 of the Trade Marks Act.
- (7) State the grounds on which it is claimed that the goods are not goods in transit within the meaning of section 96 of the Trade Marks Act.
- (8) State the designation of the person giving the notice, i.e., “proprietor”, “licensee”, “agent of proprietor” or “agent of licensee”. If the notice is given on behalf of a company, insert the name of the company and the designation within the company of the person giving the notice.

APPENDIX 1

Representation of Registered Trade Mark.

APPENDIX 2

Provide sufficient information to describe and identify the goods, including, where available, particulars of—

- (a) the quantity and value of the goods;
 - (b) the number of packages;
 - (c) any mark used;
 - (d) any relevant bill of lading or air waybill; and
 - (e) any relevant consignment reference number.
-

**TRADE MARKS (INTERNATIONAL REGISTRATION)
REGULATIONS**

ARRANGEMENT OF REGULATIONS

REGULATION

PART I

PRELIMINARY

1. Citation.
2. Interpretation.
3. Fees.
4. Forms.
5. Electronic Online System.

PART II

**INTERNATIONAL REGISTRATIONS DESIGNATING
TRINIDAD AND TOBAGO**

6. Entitlement to protection.
7. Request for division of international registration designating Trinidad and Tobago.
8. Effects of a protected international trade mark in Trinidad and Tobago.
9. Protected international trade mark in Trinidad and Tobago as object of property.
10. Notification of transactions.
11. Licensing.
12. Priority.
13. Examination.
14. Publication.
15. Notice of opposition.
16. Counter-statement.
17. Further procedures.
18. Notifications of refusal.
19. Protection.

ARRANGEMENT OF REGULATIONS—*Continued*

REGULATION

20. Revocation and invalidity.
21. Effect of acquiescence.
22. Certificate of validity of contested registration.
23. Importation of infringing goods.
24. Offences.
25. Falsely representing trade mark as protected international trade mark in Trinidad and Tobago.

PART III

TRANSFORMATION OF INTERNATIONAL REGISTRATIONS INTO NATIONAL APPLICATION

26. Transformation application.
27. Procedure for transformation application.

PART IV

CONCURRENT REGISTRATIONS

28. Effects of international registration where trade mark is also registered under the Act.

PART V

INTERNATIONAL APPLICATIONS ORIGINATING IN TRINIDAD AND TOBAGO

29. Application for international registration.
30. Notification to the International Bureau.

PART VI

MISCELLANEOUS

31. Evidence of certain matters relating to international registration.
32. Agents.
33. Burden of proving use of a protected international trade mark in Trinidad and Tobago.
34. Communication of information to International Bureau.
35. Application of Trade Marks Regulations.

FIRST SCHEDULE—FEES.

SECOND SCHEDULE—DESCRIPTION OF FORMS.

**TRADE MARKS (INTERNATIONAL REGISTRATION)
REGULATIONS**

290/2020.

made under section 57

PART I

PRELIMINARY

1. These Regulations may be cited as the Trade Marks (International Registration) Regulations. Citation.

2. (1) In these Regulations—

Interpretation.

“Act” means the Trade Marks Act;

Act No. 8 of
2015.

“applicant” means the natural person or legal entity in whose name the international application is filed;

“approved form” means a form approved by the Controller;

“electronic online system” means the electronic online system established under regulation 76 of the Trade Marks Regulations;

“*Gazette*” refers to the periodical *Gazette* referred to in Rule 32 of the Regulations under the Protocol;

“holder” means the natural person or legal entity in whose name the international registration is recorded in the International Register;

“international registration designating Trinidad and Tobago” means an international registration in which a request has been made, either in the relevant international application or subsequently, for extension of protection to Trinidad and Tobago under the Madrid Protocol;

“International Register” has the meaning assigned by Article 2 of the Madrid Protocol and Rule 1 of the Regulations under the Protocol;

“Office of Origin” has the meaning assigned by Article 2(2) of the Madrid Protocol;

“protected international trade mark in Trinidad and Tobago” has the meaning under regulation 19, and references to “protection” and “protected” shall be construed accordingly; “Register” means the Register referred to in section 83 of the Act;

“Regulations under the Protocol” means the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as in force on February 1, 2020 as may be revised from time to time;

“Trade Marks (Border Enforcement Measures) Regulations” means the Trade Marks (Border Enforcement Measures) Regulations made under section 123 of the Act;

“Trade Marks Journal” means the journal by that name published under regulation 93 of the Trade Marks Regulations;

“Trade Marks Regulations” means the Trade Marks Regulations made under section 123 of the Act.

Fees.
First Schedule.

3. (1) The fees set out in the First Schedule shall be payable to the Controller in respect of the matters set out in that Schedule.

(2) Unless otherwise provided for in these Regulations, or the Controller permits or directs otherwise, where a fee specified in the First Schedule in respect of any matter—

(a) the fee shall be paid at the same time as the filing of the form corresponding to the matter; and

(b) if the fee is not paid, the form shall not be treated as filed.

(3) Fees payable under these Regulations shall be paid using the mode of payment permitted or directed by the Controller.

Forms.

4. (1) The Controller shall publish on the Intellectual Property Office’s website and in the Trade Marks Journal—

(a) the approved forms referred to in these Regulations;

- (b) the Controller's directions relating to the use of an approved form; and
- (c) any amendment or modification of any approved form or direction.

(2) An approved form may be modified on the direction of the Controller—

- (a) for use in a case other than the case for which it is intended;
- (b) for carrying out any transaction by means of the electronic online system; or
- (c) for any other purpose that the Controller considers necessary.

(3) The Controller may accept, in lieu of an approved form, any other document which is filed with the Intellectual Property Office for any purpose for which the approved form was published, if the document—

- (a) complies with every direction of the Controller relating to the use of the approved form; and
- (b) is in a format that is acceptable to the Controller.

(4) Any reference in these Regulations to a numbered form shall be construed as a reference to the current version of the approved form bearing the corresponding number which is—

- (a) described—
 - (i) in the Second Schedule; or
 - (ii) in the Second Schedule to the Trade Marks Regulations; and
- (b) published in the Trade Marks Journal.

Second
Schedule.

5. (1) Unless the Controller permits otherwise in a particular case, the electronic online system shall be used by a person for giving or sending to, filing with or serving on the

Electronic
Online System.

Controller or the Intellectual Property Office any document, other than a notice or document to be served in proceedings in Court.

(2) The electronic online system may be used by the Controller or the Intellectual Property Office for giving or sending to, or serving on a person, any notice or other document, other than a notice or document to be served in proceedings in Court.

(3) The Controller may issue practice directions specifying—

- (a) the manner in which a document is to be given or sent to, filed with or served on the Controller or the Intellectual Property Office under subregulation (1);
- (b) the manner in which the Controller or the Intellectual Property Office may give, send or serve a notice or document under subregulation (2);
- (c) the procedures and conditions for the setting-up, operation and use of the electronic online system; and
- (d) in the event of any malfunction of the electronic online system, the manner in which a document is to be given or sent to, filed with or served on the Controller or the Intellectual Property Office under subregulation (1), or in which the Controller or the Intellectual Property Office may give, send or serve a notice or document under subregulation (2).

(4) The Controller—

- (a) may correct any error or omission in any document or information that has occurred as a result of any malfunction of the electronic online system; and
- (b) shall maintain a record of the correction so made.

PART II

INTERNATIONAL REGISTRATIONS DESIGNATING
TRINIDAD AND TOBAGO

6. (1) Subject to regulations 13 to 19, an international registration designating Trinidad and Tobago shall be entitled to become protected where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration of a trade mark under the Act, including any imposed by the Trade Marks Regulations.

Entitlement to protection.

(2) For the purposes of subregulation (1), sections 5 and 7 of the Act and regulations 10, 15, 16, 18, 19, 20 and 21 of the Trade Marks Regulations shall be disregarded.

7. (1) Subject to this regulation, the holder of an international registration designating Trinidad and Tobago (referred to in this regulation as a “principal registration”) for two or more goods or services (referred to in this regulation as “the subject goods or services”) may make a request to the International Bureau through the Controller, to divide the principal registration into two international registrations designating Trinidad and Tobago (referred to in this regulation as “divisional registration”), each for—

Request for division of international registration designating Trinidad and Tobago.

- (a) one or more classes of goods or services to which the subject goods or services belong; or
- (b) one or more of the subject goods or services.

(2) A request made under subregulation (1) shall—

- (a) be made before the date the principal registration becomes a protected international trade mark in Trinidad and Tobago;
- (b) be made on the International Bureau’s official forms;
- (c) specify the name of the holder of the principal registration;

- (d) specify the number of the principal registration given by the International Bureau;
- (e) contain, for each divisional registration sought and each class of goods or services for which the divisional registration is sought, a specification in accordance with section 6 of the Act and regulation 19 of the Trade Marks Regulations setting out the goods or services to which that divisional registration relates; and
- (f) be accompanied by the address for service in Trinidad and Tobago of the holder of the principal registration, if the address has not been furnished to the Controller under regulation 13(7) or filed with the Controller under regulation 16(1)(b).

(3) The Controller shall notify the International Bureau of a request for a division of a principal registration that is made in accordance with subregulation (2).

(4) Where the Controller is notified by the International Bureau that the principal registration has been divided into two divisional registrations, the Controller shall—

- (a) record the details of each divisional registration in the Register, and for this purpose, each divisional registration shall be recorded in the Register as having the same date as the principal registration; and
- (b) inform the holder of the principal registration of the details of each divisional registration by notice, in writing, sent to the address—
 - (i) furnished to the Controller under regulation 13(7) or filed with the Controller under regulation 16(1)(b) as the holder's address for service in Trinidad and Tobago; or

- (ii) accompanying the request made under subregulation (1) as the holder's address for service in Trinidad and Tobago, as the case may be.

(5) Upon the division of the principal registration into two divisional registrations by the International Bureau—

(a) any notice of opposition to the conferring of protection on the principal registration filed with the Controller shall—

- (i) if the notice relates only to some, but not all, of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or
- (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations,

and the opposition proceedings are to continue as if the notice had been so given; and

(b) any notice given to the Controller under section 43(3) of the Act claiming an interest in or under the principal registration shall—

- (i) if the notice relates only to some, but not all, of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or
- (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations.

Effects of a protected international trade mark in Trinidad and Tobago.

8. (1) The proprietor of a protected international trade mark in Trinidad and Tobago has, subject to these Regulations, the same rights and remedies as are given by, or under sections 27 to 30 and 32, 33, 34 and 36 of the Act to the proprietor of a registered trade mark.

(2) Subregulation (1) is subject to the provisions relating to acts not amounting to infringement and exhaustion which are applicable to a registered trade mark by virtue of sections 29 and 30 of the Act, respectively.

(3) For the purposes of the application of section 27 of the Act—

- (a) the rights of the proprietor shall have effect as of the date on which the protected international trade mark in Trinidad and Tobago is to be treated as registered under regulation 19 or 28; and
- (b) a protected international trade mark in Trinidad and Tobago shall be treated as being in fact registered when it becomes protected under regulation 19.

(4) For the purposes of subregulation (1), references in sections 28 and 29 of the Act to goods or services in respect of which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago.

(5) Where the holder of an international registration designating Trinidad and Tobago, by notice, in writing, sent to the Controller—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred in Trinidad and Tobago by the international registration shall be subject to a specified territorial or other limitation,

the Controller shall enter the disclaimer or limitation in the Register and shall publish the disclaimer or limitation.

(6) Where a protected international trade mark in Trinidad and Tobago is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of section 27 of the Act are restricted accordingly.

(7) The remedy for groundless threats of infringement proceedings given by section 37 of the Act applies to a protected international trade mark in Trinidad and Tobago as it applies in relation to a registered trade mark.

(8) For the purposes of subregulation (7)—

- (a) the reference in section 37(4) of the Act to the registration of the trade mark shall be treated as a reference to the protection of a protected international trade mark in Trinidad and Tobago; and
- (b) the reference in section 37(5) of the Act to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is a protected international trade mark in Trinidad and Tobago or is the subject of an international application or international registration designating Trinidad and Tobago.

9. (1) Where a person is, by the Act or these Regulations, required to furnish the Controller with an address, the address furnished shall be as full as possible for the purpose of enabling a person to find easily the place of business of the person whose address is given.

Protected international trade mark in Trinidad and Tobago as object of property.

10. (1) The following are notifiable transactions for the purposes of this regulation:

Notification of transactions.

- (a) the grant of a licence under a protected international trade mark in Trinidad and Tobago; and

(b) the granting of any security interest, whether fixed or floating, over a protected international trade mark in Trinidad and Tobago and any right in, or under it.

(2) On application being made to the Controller by—

(a) a person claiming to be entitled to an interest in, or under a protected international trade mark in Trinidad and Tobago by virtue of a notifiable transaction; or

(b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the Register.

(3) The following are relevant transactions for the purposes of this regulation:

(a) an assignment of a protected international trade mark in Trinidad and Tobago or any right in it;

(b) the making by personal representatives of an assent in relation to a protected international trade mark in Trinidad and Tobago or any right in, or under it; or

(c) an order of the Court or other competent authority transferring a protected international trade mark in Trinidad and Tobago or any right in, or under it.

(4) Until—

(a) in the case of any notifiable transaction referred to in subregulation (1)(b), an application has been made for the registration of the relevant particulars of the transaction; or

(b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in, or under, the protected international trade mark in Trinidad and Tobago in ignorance of it.

(5) A person who becomes the proprietor of a protected international trade mark in Trinidad and Tobago by virtue of any notifiable transaction referred to in subregulation (1)(b) or relevant transaction is not entitled to damages, an account of profits or statutory damages under section 32(2) of the Act in respect of any infringement of the protected international trade mark in Trinidad and Tobago occurring after the date of the transaction and before the transaction is recorded in the International Register.

(6) For the avoidance of doubt, subregulation (4) shall not apply to any relevant transaction relating to—

- (a) a licence under a protected international trade mark in Trinidad and Tobago; or
- (b) any right in, or under the licence.

(7) In this regulation, “relevant particulars” means—

- (a) in the case of the grant of a licence under a protected international trade mark in Trinidad and Tobago—
 - (i) the name and address of the licensee;
 - (ii) where the licence is an exclusive licence, that fact;
 - (iii) where the licence is limited, a description of the limitation; and
 - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;
- (b) in the case of the grant of any security interest over a protected international trade mark in Trinidad and Tobago or any right in, or under it—
 - (i) the name and address of the grantee;
 - (ii) the nature of the interest, whether fixed or floating; and
 - (iii) the extent of the security and the right in, or under the trade mark secured.

Licensing.

11. (1) Sections 44 to 47 of the Act shall, with the necessary modifications, apply in relation to licences to use a protected international trade mark in Trinidad and Tobago as they apply in relation to licences to use a registered trade mark.

(2) The reference in section 44(2) of the Act to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which a trade mark is protected in Trinidad and Tobago.

Priority.

12. (1) Subject to subregulation (2), section 11 of the Act shall apply so as to confer a right of priority in relation to protection of an international registration designating Trinidad and Tobago as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Regulations under the Protocol.

Examination.

13. (1) Upon receiving from the International Bureau notification of an international registration designating Trinidad and Tobago, the Controller shall examine whether it satisfies the requirements of regulation 6.

(2) For the purposes of subregulation (1), the Controller may carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) Where the mark to which the international registration relates contains or consists of a word or words in characters other than Roman or in a language other than English, the Controller may require the holder to file with the Controller a copy of a translation or, if the case requires, transliteration of each word in English, certified or verified to the satisfaction of the Controller.

(4) If it appears to the Controller that the requirements of regulation 6 are not met, or are met only in relation to some of the goods or services in respect of which protection in Trinidad

and Tobago has been requested, he shall give notification of refusal to the International Bureau.

(5) The notification of refusal shall specify a period within which the holder may make representations.

(6) If the holder requires an extension of time to make representations, he shall file with the Controller his request for an extension of time in Form TM 31 of the Trade Marks Regulations before the expiry of the period in question or any extended period previously granted by the Controller.

(7) A holder making representations shall file with the Controller an address for service in Trinidad and Tobago in Form TM 1 of the Trade Marks Regulations.

(8) The request referred to in subregulation (6) and the address for service referred to in subregulation (7) may be filed using the electronic online system.

(9) A request by the holder to the Controller to change or correct an address for service shall be made in Form TM 1 of the Trade Marks Regulations.

(10) The following shall be notified to the Controller in Form TM 1 of the Trade Marks Regulations:

- (a) any appointment of an agent for a matter for which no form is prescribed; and
- (b) any change of an agent for a matter.

14. Where, following examination, it appears to the Controller that the requirements of regulation 6 are met in relation to some or all of the goods or services comprised in the international registration, the Controller shall publish the particulars of the international registration in the Trade Marks Journal. Publication.

15. (1) A person (referred to in these Regulations as “the opponent”) may, within three months from the date of the publication of the international registration in the Trade Marks Notice of opposition.

Journal, file with the Controller a notice opposing the conferring of protection on the international registration (referred to in these Regulations as “the notice of opposition”) in Form TM 6 of the Trade Marks Regulations.

(2) The opponent shall enter an address for service in Trinidad and Tobago in the form referred to in subregulation (1).

(3) Regulations 26 and 27 of the Trade Marks Regulations shall, with the necessary modifications, apply to the filing and contents of a notice of opposition.

(4) For the purposes of applying regulation 26 of the Trade Marks Regulations—

- (a) a reference in that regulation to the date of the publication of the application for registration shall be treated as a reference to the date of publication of the international registration in the Trade Marks Journal; and
- (b) a reference in that regulation to the applicant shall be treated as a reference to the holder.

(5) Upon filing of a notice of opposition, the Controller shall, within five months from the date of the publication of the international registration in the Trade Marks Journal, give notification of refusal to the International Bureau stating the matters relating to the opposition.

Counter-
statement.

16. (1) Within two months from the date of the Controller’s notification of refusal based on opposition to the International Bureau, the holder shall file with the Controller—

- (a) a counter-statement in Form TM 7 of the Trade Marks Regulations setting out the grounds on which he relies as supporting the international registration designating Trinidad and Tobago, and the facts alleged in the notice of opposition which he admits, if any (referred to in these Regulations as “a counter-statement”); and

(b) an address for service in Trinidad and Tobago in Form TM 1 of the Trade Marks Regulations.

(2) The holder shall forthwith serve on the opponent a copy of both documents.

(3) A request for an extension of time to file a counter-statement shall be made to the Controller, in writing, within two months from the date of the Controller's notification of refusal based on opposition to the International Bureau.

(4) The total extension of time for which the Controller may allow to file a counter-statement shall not exceed four months from the date of the Controller's notification of refusal based on opposition to the International Bureau.

(5) For the avoidance of doubt, if the holder fails to comply with subregulation (1) or (3) in relation to any class of goods or services in respect of which protection is opposed, the Controller shall be entitled to treat the holder's request for protection in Trinidad and Tobago in respect of those goods or services as withdrawn, and the refusal shall subsist in respect of those goods or services.

17. (1) Upon the filing of a notice of opposition under regulation 15 and a counter-statement under regulation 16, regulations 29 to 38 of the Trade Marks Regulations shall, with the necessary modifications, apply to further proceedings thereon.

Further
procedures.

(2) For the purposes of applying regulations 29 to 38 of the Trade Marks Regulations—

- (a) a reference in those regulations to the applicant shall be treated as a reference to the holder; and
- (b) a reference in those regulations to the application shall be treated as a reference to the international registration designating Trinidad and Tobago.

Notifications of refusal.

18. (1) Except where refusal is based on an opposition, a notification of refusal shall not be given after the expiry of eighteen months from the date on which the notification of the international registration designating Trinidad and Tobago was sent to the Controller.

(2) Where there is a possibility that opposition may be filed after the expiry of the period of eighteen months, the Controller shall inform the International Bureau accordingly.

(3) A notification of refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Regulations under the Protocol.

(4) Where—

- (a) after a notification of refusal has been given under regulation 13(4), the holder makes representations within the period specified in regulation 13(5) or any extended period; or
- (b) after a notification of refusal based on opposition has been given under regulation 15(5), the holder files a counter-statement within the period specified in regulation 16(1) or any extended period,

the Controller shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(5) For the purposes of subregulation (4), a final decision shall be regarded as being made where—

- (a) the Controller or the Court, on appeal from the Controller, decides whether the refusal shall be upheld in whole or in relation to only some of the goods or services in relation to which protection in Trinidad and Tobago is requested, and any right of appeal against that decision expires or is exhausted;
- (b) the representations or counter-statement is withdrawn; or

- (c) the proceedings relating to the refusal are discontinued or abandoned.

19. (1) Where—

Protection.

- (a) after examination and publication under regulations 13 and 14—
- (i) the period of eighteen months from the date on which the notification of the request for extension of protection to Trinidad and Tobago was sent to Trinidad and Tobago has not expired, but the period for giving notification of refusal based on an opposition in accordance with regulation 15(5) expires without a notification of refusal, whether based on opposition or otherwise, having been given;
 - (ii) the period of eighteen months from the date on which the notification of the request for extension of protection to Trinidad and Tobago was sent to Trinidad and Tobago has expired, and the period for giving notice of opposition specified in regulation 15(1), including any extended period, expires without a notice of opposition having been given;
 - (iii) a notification of refusal has been given in respect of only some of the goods or services in respect of which protection in Trinidad and Tobago has been requested and the holder has made no representations within the period specified in regulation 13(5), including any extended period, or has filed no counter-statement within the period specified in regulation 16(1), including

any extended period, as the case may be, or that the holder has informed the Controller that he does not intend to make such representations or file a counter-statement; or

- (iv) a notification of refusal has been given in respect of all or some of the goods or services in respect of which protection in Trinidad and Tobago has been requested and the Controller notifies the International Bureau in accordance with regulation 18(4) that a final decision has been made that the refusal is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in Trinidad and Tobago has been requested; or

- (b) the period of eighteen months from the date on which the notification of the request for extension of protection to Trinidad and Tobago was sent to Trinidad and Tobago expires without any notification of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark in Trinidad and Tobago; and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in Trinidad and Tobago has been requested, protection shall apply only as regards the remaining goods or services.

- (2) Subject to regulation 28, for the purposes of the application by these Regulations of the provisions of the Act, a

trade mark so protected shall be treated as being registered under the Act—

- (a) where the request for extension of protection to Trinidad and Tobago is mentioned in the international application, the date of the international registration; or
- (b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

20. (1) Sections 23 and 24 of the Act shall, with the necessary modifications, apply so as to permit the protection of a protected international trade mark in Trinidad and Tobago to be revoked or declared invalid.

Revocation and
invalidity.

(2) For the purposes of applying sections 23 and 24 of the Act—

- (a) the reference in section 23(1) of the Act to the date of completion of the registration procedure shall be treated as a reference to the date the protected international trade mark in Trinidad and Tobago became protected;
- (b) the reference in section 23(2) of the Act to the form in which a trade mark was registered shall be treated as a reference to the form in which it is protected;
- (c) references in sections 23(6) and 24(9) of the Act to goods or services for which the trade mark is registered shall be treated as references to those in respect of which it is protected;
- (d) references in section 23 of the Act to the registration of a trade mark being revoked shall be treated as references to the protection of a protected international trade mark in Trinidad and Tobago being revoked; and

(e) references in section 24 of the Act to the registration of a trade mark being declared invalid shall be treated as references to the protection of a protected international trade mark in Trinidad and Tobago being declared invalid.

(3) Regulations 55 to 58 of the Trade Marks Regulations shall, with the necessary modifications, apply to the procedure upon an application for revocation or a declaration of invalidity of protection of a protected international trade mark in Trinidad and Tobago.

(4) Where the protection of a protected international trade mark in Trinidad and Tobago is revoked or declared invalid to any extent, the Controller shall notify the International Bureau and—

(a) in the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from the date of the application for revocation, or if the Controller or the Court is satisfied that the grounds for revocation existed at an earlier date, from that date;

(b) in the case of a declaration of invalidity, the trade mark shall, to that extent, be deemed never to have been a protected international trade mark in Trinidad and Tobago, but this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

Effect of
acquiescence.

21. (1) Section 25 of the Act applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a protected international trade mark in Trinidad and Tobago.

(2) For the purposes of applying section 25 of the Act—

(a) the reference in that section to a registered trade mark shall be treated as a reference to a protected international trade mark in Trinidad and Tobago; and

- (b) references in that section to registration shall be treated as references to protection of a protected international trade mark in Trinidad and Tobago.

22. Section 118 of the Act shall, with the necessary modifications, apply in relation to proceedings before the Court in which the validity of the protection of a protected international trade mark in Trinidad and Tobago is contested.

Certificate of
validity of
contested
registration.

23. (1) Part XI of the Act and the Trade Marks (Border Enforcement Measures) Regulations shall, with the necessary modifications, apply in relation to goods which are, in relation to a protected international trade mark in Trinidad and Tobago, infringing goods within the meaning of section 3 of the Act.

Importation of
infringing
goods.

(2) For the purposes of subregulation (1), references in section 3 and Part XI of the Act and in the Trade Marks (Border Enforcement Measures) Regulations to a registered trade mark shall be treated as references to a protected international trade mark in Trinidad and Tobago.

24. (1) Sections 49 to 52 and 55 of the Act shall, with the necessary modifications, apply in relation to a protected international trade mark in Trinidad and Tobago.

Offences.

(2) For the purposes of the application of sections 49 to 52 and 55 of the Act—

- (a) references in those sections to a registered trade mark shall be treated as references to a protected international trade mark in Trinidad and Tobago; and
- (b) references in those sections to goods or services for which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago.

Falsely
representing
trade mark as
protected
international
trade mark in
Trinidad and
Tobago.

25. Any person who—

- (a) falsely represents that a mark is a protected international trade mark in Trinidad and Tobago; or
- (b) makes a false representation as to the goods or services for which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago,

knowing or having reason to believe that the representation is false commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and imprisonment for ten years.

PART III

**TRANSFORMATION OF INTERNATIONAL
REGISTRATIONS INTO NATIONAL APPLICATION**

Transformation
application.

26. (1) This regulation applies where—

- (a) an international registration designating Trinidad and Tobago is cancelled at the request of the Office of Origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration;
- (b) an application (referred to in this Part as “a transformation application”) is made to the Controller, within three months from the date on which the international registration was cancelled, for registration in Trinidad and Tobago of a trade mark identical to that comprised in the international registration in respect of all or some of the goods or services in respect of which the international registration was cancelled; and
- (c) the application is made by the person who was the holder of the international registration immediately before its cancellation.

(2) A transformation application shall be filed with the Controller on Form MP 1.

(3) A trade mark registered pursuant to a transformation application shall be treated as if it were registered—

- (a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or
- (b) where the request for extension to Trinidad and Tobago was made subsequent to the international registration, on the date of recordal of that request in accordance with Article 3ter (2) of the Madrid Protocol,

and that date shall be deemed for the purposes of the Act to be the date of registration of the trade mark.

27. (1) Where the protected international trade mark in Trinidad and Tobago has become protected under regulation 19 on or before the actual date on which the transformation application is made (referred to in this regulation as the “transformation date”), the trade mark shall be registered under the Act.

Procedure for transformation application.

(2) Where the international registration designating Trinidad and Tobago has not become protected under regulation 19 by the transformation date and its particulars have been published under regulation 14, the Controller shall treat—

- (a) the publication of its particulars as the publication of the transformation application under section 14(1) of the Act; and
- (b) any opposition to its protection under regulation 15 as an opposition to its registration under section 14(2) of the Act, and regulations 26 to 38 of the Trade Marks Regulations shall apply, subject to such modifications as the Controller may determine.

(3) Where particulars of the international registration designating Trinidad and Tobago have not yet been published under regulation 14 by the transformation date and the Controller has issued a notification of refusal under regulation 13(4), the Controller shall, for the purposes of the transformation application, inform the applicant of the notification of refusal under section 13(3) of the Act.

PART IV

CONCURRENT REGISTRATIONS

Effects of international registration where trade mark is also registered under the Act.

28. (1) This regulation applies where—

- (a) a registered trade mark is also a protected international trade mark in Trinidad and Tobago;
- (b) the proprietor of the registered trade mark is the holder of the protected international trade mark in Trinidad and Tobago;
- (c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected international trade mark in Trinidad and Tobago; and
- (d) the date of registration of the registered trade mark is earlier than the date specified in regulation 19(2) in relation to the protected international trade mark in Trinidad and Tobago.

(2) For the purposes of the application by these Regulations of the provisions of the Act, the protected international trade mark in Trinidad and Tobago shall, notwithstanding regulation 19(2), be treated as being registered under the Act as of the date of registration of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered.

(3) For the purposes of determining whether the protected international trade mark in Trinidad and Tobago is an earlier trade mark, it shall be treated as having the date of

application of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered, taking account, where appropriate, of the priorities claimed in respect of the registered trade mark.

(4) Where the conditions specified in subregulation (1) are satisfied in relation to a trade mark, subregulations (2) and (3) shall—

- (a) continue to apply in respect of the relevant protected international trade mark in Trinidad and Tobago, notwithstanding that the relevant registered trade mark lapses or is cancelled; or
- (b) cease to apply if it is revoked or declared invalid.

(5) On the application of the holder of the protected international trade mark in Trinidad and Tobago on Form MP 2, the Controller shall note in the Register that the international registration replaces the registered trade mark as regards the goods or services in respect of which the registered trade mark was registered.

(6) The provisions of this regulation are without prejudice to any right or remedy conferred on any person in respect of the registered trade mark.

PART V

INTERNATIONAL APPLICATIONS ORIGINATING IN TRINIDAD AND TOBAGO

29. (1) An applicant for the registration of a trade mark, or the proprietor of a registered trade mark may, subject to the provision of this regulation, apply to the Controller for the international registration of a trade mark on the International Bureau's official forms.

Application for
international
registration.

(2) An application for international registration shall be filed in English and may be made only where the applicant for such registration is—

- (a) a citizen of Trinidad and Tobago;

- (b) a body or corporation incorporated or constituted under the laws of Trinidad and Tobago;
- (c) a person domiciled in Trinidad and Tobago; or
- (d) a person who has a real and effective industrial or commercial establishment in Trinidad and Tobago.

(3) The particulars appearing in the application shall correspond with the particulars appearing at that time in the basic application or basic registration, as the case may be.

(4) The applicant shall provide, at the request of the Controller, such evidence as may be necessary to satisfy him that the applicant is eligible to make the application in accordance with subregulation (2).

(5) If the international application complies with the requirements set out in this regulation, the Controller shall submit the international application to the International Bureau.

Notification to
the
International
Bureau.

30. (1) Where the Controller has submitted an application for international registration, he shall notify the International Bureau of the occurrence of any of the events specified in subregulation (2), and shall request the International Bureau to cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to subsist by reason of that event.

(2) The events referred to in subregulation (1) are as follows:

- (a) before the expiry of the period of five years from the date of the international registration, the Controller—
 - (i) refuses to accept the basic application as regards some or all of the goods or services covered by the international registration; or

- (ii) after accepting the application, refuses to register the trade mark as regards some or all of those goods or services, having regard to matters coming to his notice since he accepted the application, and in either case that decision becomes a final decision, whether before or after the expiry of that period of five years;
- (b) the basic application—
 - (i) is, before the expiry of the period of five years from the date of the international registration, treated as withdrawn under—
 - (A) regulation 10(6)(a), 21(5) or 24(2) of the Trade Marks Regulations;
 - (B) sections 66(4) and 67(3) of the Act; or
 - (C) sections 75(4) and 76(3) of the Act; and
 - (ii) is not reinstated under regulation 74 of the Trade Marks Regulations, whether before or after the expiry of that period of five years;
- (c) opposition proceedings begun before the expiry of the period of five years from the date of the international registration resulting in a final decision not to register the trade mark as regards some or all of the goods or services covered by the international registration;
- (d) the basic application is withdrawn, or is restricted as regards goods or services covered by the international registration, as a result of a request by the applicant made—
 - (i) before the expiry of the period of five years from the date of the international registration; or

- (ii) subsequently, when the basic application was at the time of the request subject to an appeal against refusal of registration or to opposition proceedings, begun in either case before the expiry of the period of five years;
- (e) the registration resulting from the basic application or the basic registration expires without renewal and is removed from the Register before the expiry of the period of five years from the date of the international registration, and no request for its restoration is made within the period specified in regulation 51 of the Trade Marks Regulations, or such a request is made and a final decision is made refusing the request;
- (f) a final decision is made to revoke or declare invalid the registration resulting from the basic application or the basic registration, as a result of proceedings begun before the expiry of the period of five years from the date of the international registration; and
- (g) the registration resulting from the basic application or the basic registration is cancelled as a result of a request by the proprietor made before the expiry of the period of five years from the date of the international registration, or made subsequently where, at the time of the request—
 - (i) the registration resulting from the basic application or the basic registration was subject to proceedings for revocation or invalidation; and
 - (ii) such proceedings were begun before the expiry of the period of five years from the date of the international registration.

- (3) For the purposes of this regulation—
- (a) a final decision shall be regarded as made where—
 - (i) any right of appeal against the decision expires or is exhausted; or
 - (ii) proceedings relating to an application or registration are discontinued or abandoned; and
 - (b) a reference to an application being withdrawn includes it being deemed withdrawn, abandoned, or never to have been made.

PART VI

MISCELLANEOUS

31. (1) In all legal proceedings relating to a protected international trade mark in Trinidad and Tobago, the registration of a person as the holder of a protected international trade mark in Trinidad and Tobago shall be *prima facie* evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

Evidence of certain matters relating to international registration.

- (2) Judicial notice shall be taken of the following:
- (a) the Madrid Protocol and the Regulations under the Protocol;
 - (b) a copy of an entry in the International Register issued by the International Bureau; and
 - (c) a copy of the *Gazette*.
- (3) Any document mentioned in subregulation (2)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau thereby communicated.
- (4) Evidence of any instrument issued by the International Bureau or any entry in or extract from such a document may be given in any such proceedings by production of a copy, and such document purporting to be such a copy shall be received in evidence.

(5) In this regulation, “legal proceedings” include proceedings before the Controller.

Agents.

32. Any act required or authorised by these Regulations to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark in Trinidad and Tobago, or any procedure relating to a protected international trade mark in Trinidad and Tobago, may be done by or to an agent authorised by that person.

Burden of proving use of a protected international trade mark in Trinidad and Tobago.

33. If in any civil proceedings relating to a protected international trade mark in Trinidad and Tobago, a question arises as to the use to which the trade mark has been put, it is for the holder to show what use has been made of it.

Communication of information to International Bureau.

34. Notwithstanding any written law, the Controller may communicate to the International Bureau any information which Trinidad and Tobago is required to communicate by virtue of these Regulations or pursuant to the Madrid Protocol or the Regulations under the Protocol.

Application of Trade Marks Regulations.

35. (1) Except as otherwise provided in these Regulations, the Trade Marks Regulations shall, with the necessary modifications, apply in relation to an international registration designating Trinidad and Tobago and to a protected international trade mark in Trinidad and Tobago as they apply in relation to an application for registration of a trade mark and to a registered trade mark.

(2) The provisions of the Trade Marks Regulations relating to costs and security for costs and to evidence before the Controller shall apply in relation to proceedings under these Regulations in the same manner as they apply in relation to proceedings relating to a registered trade mark or application for registration of a trade mark.

FIRST SCHEDULE

FEES

Regulation 3.

<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
1. Filing of a transformation application	26(2)	\$1,400	MP 1
2. Application for international registration through Controller		*	—
3. Request to divide an international application for registration of a trade mark made in respect of 2 or more goods or services into 2 or more separate applications, each in respect of one or more of those goods or services	7	\$350 for each additional application that the original application is divided into	—

*This fee includes any fee payable to the International Bureau for that application or request.

SECOND SCHEDULE

DESCRIPTION OF FORMS

[Regulation 4(4)].

<i>Form</i>	<i>Description of Form</i>
MP 1	Request to transform an international registration into national application(s).
MP 2	Request to replace Trinidad and Tobago national registration with international registration.