

Trade Marks Act*
(Act No. 11 of 1955, as amended up to Act No. 31 of 1997)

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An Act to make provision with respect to the law relating to Trade Marks.

Short title

1. This Act may be cited as the Trade Marks Act.

Interpretation

2.—(1) In this Act—

“assignment” means assignment by act of the parties concerned;

“associated trade marks” means trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks;

“Controller” has the same meaning assigned to it under section 2 of the Patents Act, 1996;

“Convention” means the Paris Convention for the Protection of Industrial Property made on the 20th March 1883 and any amendments and revisions thereof to which Trinidad and Tobago is a party;

“the Court” means the High Court;

“designated owner” means the person identified as the importer of the goods on the entry made in relation to the goods under the Customs Act;

“Intellectual Property Office” has the meaning assigned to it under section 2 of the Patents Act, 1996;

“Judge” means a Judge of the Court;

“limitation” means a limitation of the exclusive right to the use of a trade mark given by the registration of a person as proprietor of the trade mark, including a limitation of that right as to mode of use or as to use relating to—

(a) goods to be exported to any market outside of Trinidad and Tobago; or

(b) services for use or available for acceptance in any country outside of Trinidad and Tobago;

“mark” in relation to—

(a) goods includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof or packaging of goods or their shape provided, however, that the trade mark does not exclusively consist of the shape which results from the nature of the goods themselves, or which is necessary to obtain a technical result or which gives substantial value to the goods;

(b) services includes a device, name, signature, word, letter, numeral or any combination thereof;

“notified trade mark” means a trade mark in respect of which a notice under section 71A is in force;

“objector” means any person who has given under section 71A a notice in respect of those goods that are in force;

“prescribed” means, in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the Rules;

“provision” in relation to services, means the provision of services, whether or not for valuable consideration;

“the register” means the register of trade marks kept under this Act;

“registered trade mark” means a trade mark that is actually on the register;

“registered user” means a person who is for the time being registered as such under section 37;

“the rules” means rules made under section 51;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 50;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment;

“permitted use” means the use of a trade mark by a registered user of it in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject.

(2) A reference in this Act to the use of a trade mark shall be construed as a reference to the use of a printed or other visual representation of the trade mark and—

(a) in relation to goods, shall be construed as a reference to the use of the trade mark upon, or in physical or other relation to goods; and

(b) in relation to services, shall be construed as a reference to—

(i) the use of the trade mark, or

(ii) part of a statement about the use of the trade mark,

at or near the place where the services are available for acceptance or are performed or otherwise in relation to services.

[Amended by Acts Nos. 46 of 1979, 17 of 1994, 25 of 1996 and 31 of 1997]

The Register

Register of Trade Marks

3.—(1) There shall be kept by the Controller at his office a record called the Register of Trade Marks, in which shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations and such other matters as may be prescribed.

(2) The Register of Trade Marks shall be divided into two parts called respectively Part A and Part B.

[Amended by Act No. 31 of 1997]

Application of Act to trade marks for services

3A. The provisions of this Act with respect to trade marks relating to goods apply *mutatis mutandis* to trade marks relating to services.

[Added by Act No. 31 of 1997]

Effect of Registration and the Action for Infringement

No action for infringement of unregistered trade mark

4. No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off or the remedies in respect thereof.

[Amended by Act No. 17 of 1994]

Rights given by registration in Part A and infringement thereof

5.—(1) Subject to this section and to sections 8 and 12, the registration of a person in Part A of the Register as proprietor of a trade mark other than a certification trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses, for the same, similar or related goods or services for which the mark is registered, a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being used as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as mentioned above is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as mentioned above shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as mentioned above in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as mentioned above shall not be deemed to be infringed by the use of any such mark as mentioned above by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark;

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as mentioned above or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods;

(c) in relation to services to which the proprietor or registered user of the trade mark conforming to the permitted use has applied the trade mark, where the purpose and effect of the use of the trade mark is to indicate that those services have been performed by the proprietor or a registered user of the trade mark;

(d) in relation to services the provision of which is connected in the course of trade with the proprietor or a registered user of the trade mark, where the proprietor or registered user has at any time expressly or impliedly consented to the use of the trade mark; or

(e) in relation to services available for use with other services in relation to which the trade mark has been used without infringement of the right given by registration or might for the time being be so used, if—

(i) the use of the trade mark is reasonably necessary in order to indicate that the services are available for such use; and

(ii) neither the purpose nor the effect of the use of the trade mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the provision of those services.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as mentioned above, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

[Amended by Acts Nos. 17 of 1994 and 25 of 1996]

Rights given by registration in Part B and infringement thereof

6.—(1) Except as provided by subsection (2), the registration of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the Register, and the provisions of section 5 shall have effect in like manner in relation to a trade mark registered in Part B of the Register as they have effect in relation to a trade mark registered in Part A of the Register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as mentioned above in Part B of the Register, otherwise than by an act that is deemed to be an infringement by virtue of section 7, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

Infringement by breach of certain restrictions

7.—(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

(2) The acts to which this section applies are—

(a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;

(b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;

(c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or

registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;

(d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;

(e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

Saving for vested rights

8. Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to that person being put on the Register for that identical or nearly resembling trade mark in respect of those goods under section 14(2).

Registration to be in respect of particular goods

9. A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Controller, whose decision shall be final.

[Amended by Act No. 31 of 1997]

Registrability and Validity of Registration

Distinctiveness requisite for registration in Part A

10.—(1) In order to be registrable in Part A of the register a trade mark other than a certification trade mark must contain or consist of at least one of the following essential particulars—

(a) the name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

(d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

(e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of its section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Controller may have regard to the extent to which—

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

[Amended by Act No. 31 of 1997]

Capability of distinguishing requisite for registration in Part B

11.—(1) In order to be registrable in Part B of the Register a trade mark must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as mentioned above the Controller may have regard to the extent to which—

(a) the trade mark is inherently capable of distinguishing as mentioned above; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as mentioned above.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

[Amended by Act No. 31 of 1997]

Saving for use of name, address or description of goods

12. No registration of a trade mark shall interfere with—

(a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or

(b) the use by any person of any *bona fide* description of the character or quality of his goods.

Prohibition of registration of deceptive, etc., matter

13. It shall not be lawful to register as a trade mark or part of a trade mark—

(a) any matter the use of which would, by reason of its being likely to—

(i) deceive or cause confusion;

(ii) disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols or bring them into contempt or disrepute,

be disentitled to protection in a court of justice;

(b) subject to section 17, words that generically designate goods or services or types of goods or services to which the trade mark applies;

(c) any matter the use of which would be contrary to law or morality; or

(d) any scandalous design.

[Amended by Act No. 25 of 1996]

Protection of well-known trade marks

13A.—(1) A trade mark shall not be registered—

(a) if it is identical with, or confusingly similar to, or constitutes a translation of, a trade mark or a trade name which is well-known in Trinidad and Tobago as being already the mark of a person other than the applicant for registration and used for identical or similar goods or services; or

(b) if it is identical with, or confusingly similar to, or constitutes a translation of, a trade mark which is registered with respect to goods or services which are not similar to those with respect to which registration is applied for, provided that use of the trade mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trade mark and that the interests of the owner of the registered trade mark are likely to be damaged by such use.

(2) In determining whether a trade mark is well-known, account shall be taken of the knowledge of the trade mark, including knowledge in Trinidad and Tobago obtained as a result of the promotion of the trade mark, in the relevant sector of the public that normally deals with the relevant goods or services.

[Added by Act No. 25 of 1996]

Prohibition of registration of identical and resembling trade marks

14.—(1) Subject to subsection (2), no trade marks shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the Register in respect of the same, similar or related goods or services or description of goods or services, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion, unless the proprietor of the earlier trade mark consents to the registration.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Controller make it proper to do so, the Court or the Controller may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Controller, as the case may be, may think it right to impose.

(3) 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.

[Amended by Acts Nos. 25 of 1996 and 31 of 1997]

Registration in Part A to be conclusive as to validity after seven years

15.—(1) In all legal proceedings relating to a trade mark registered in Part A of the Register (including applications under section 46) the original registration in Part A of the Register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against section 13.

(2) Nothing in section 6(1) shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the Register, the foregoing provisions of this section relating to a trade mark registered in Part A of the Register.

Registration subject to disclaimer

16. If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character,

the Controller or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

(i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as mentioned above, to the exclusive use of which the Controller or the Court holds him not to be entitled; or

(ii) that the proprietor shall make such other disclaimer as the Controller or the Court may consider necessary for the purpose of defining his rights under the registration,

but no disclaimer on the Register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

[Amended by Act No. 31 of 1997]

Words used as name or description of an article, substance or activity

17.—(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article, substance or activity.

(2) If, however, it is proved either—

(a) that there is a well-known and established use of the word or words as the name or description of the article, substance or activity by a person or persons carrying on a trade therein, not being used in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or

(b) that the article, substance or activity was formerly manufactured under a patent (being a patent in force on, or granted after the date of, the commencement of this Act) that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article, substance or activity, the provisions of subsection (3) shall have effect.

(3) Where the facts mentioned in subsection (2)(a) or (b) are proved with respect to any word or words, then—

(a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article, substance or activity in question or of any goods of the same description, shall be deemed for the purposes of section 46 to be an entry wrongly remaining on the Register;

(b) if the trade mark contains that word or those words and other matter, the Court or the Controller, in deciding whether the trade mark shall remain on the Register, so far as regards registration in respect of the article, substance or activity in question and of any goods of the same description, may in case of a decision in favour of its remaining on the Register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article, substance or activity and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and

(c) for the purposes of any other legal proceedings relating to the trade mark—

(i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article, substance or activity in question or to any goods of the same description; or

(ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as mentioned above,

shall be deemed to have ceased on the date at which the use mentioned in subsection (2)(a) first became well-known and established, or at the expiration of the period of two years mentioned in subsection (2)(b).

(4) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 15, be deemed for the purposes of section 46 to be an entry made in the Register without sufficient cause, or an entry wrongly remaining on the Register, as the circumstances may require. However, the foregoing provisions of this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

[Amended by Acts Nos. 17 of 1994 and 31 of 1997]

Effect of limitation as to colours

18. A trade mark may be limited in whole or in part to one or more specified colours and in any such case the Controller or the Court shall have regard to the fact that it is so

limited when considering the distinctive character of the trade mark. If a trade mark is registered without limitations of colour it shall be deemed to be registered for all colours.

[Amended by Act No. 31 of 1997]

Procedure for and Duration of Registration

Application for registration

19.—(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or in Part B of the Register.

(2) Subject to this Act, the Controller may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Controller may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance the Controller shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat and the decision shall be subject to appeal to a Judge in Chambers.

(5) On an appeal under this section the Judge shall, if required, hear the applicant and the Controller, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated as mentioned above by the Controller, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Controller, other than those so stated as mentioned above by him, except by leave of the Judge hearing the appeal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(7) The Controller or a Judge as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Controller or the Judge, as the case may be, may think fit.

[Amended by Act No. 31 of 1997]

Advertisement of acceptance

20.—(1) Subject to subsection (2), where an application for registration of a trade mark is accepted, the Controller shall—

- (a) give notice in writing of the acceptance to the applicant;
 - (b) require the applicant, within sixty days from the receipt of the notification of acceptance, to pay the prescribed fee for the publication of the application; and
 - (c) upon payment of the prescribed fee, cause to be published in the prescribed manner, an advertisement which shall state the limitations and conditions upon which the application was accepted.
- (2) The Controller may cause an application to be advertised in the prescribed manner before its acceptance where—
- (a) the application is made under section 10(1)(e) or
 - (b) it appears to him to be expedient to do so by reason of exceptional circumstances.
- (3) Where an application is advertised under subsection (2), the Controller may advertise that application again in the prescribed manner upon acceptance of the application.

[Amended by Acts Nos. 17 of 1994 and 31 of 1997]

Opposition to registration

21.—(1) Any person may, within three months of the advertisement of the application, give notice in duplicate to the Controller of opposition to the registration of the trade mark. The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition. The Controller shall send the duplicate of such notice to the applicant.

(2) Within one month after the receipt of such duplicate or such further time as the Controller may allow, the applicant shall send to the Controller, in the prescribed manner, a counter statement in duplicate of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

[Amended by Act No. 31 of 1997]

Conflicting claims to registration

22.—(1) On receipt of a counter statement as mentioned in section 21(2) the Controller shall send one copy to the person or persons giving notice of opposition and shall, after hearing the parties if so required and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted. The decision of the Controller shall be subject to appeal to a Judge in Chambers.

(2) On an appeal under this section the Judge shall, if required, hear the parties and the Controller, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(3) On the hearing of an appeal under this section any party may, either in the manner prescribed or by special leave of the Judge, bring forward further material for the consideration of the Judge.

(4) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Controller, other than those so stated as mentioned above by the opponent, except by leave of the Judge. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(5) On an appeal under this section the Judge may, after hearing the Controller, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(6) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Trinidad and Tobago, the Judge or the Controller may require him to give security for costs of the proceedings relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

[Amended by Act No. 31 of 1997]

Registration

23.—(1) When an application for registration of a trade mark in Part A or in Part B of the Register has been accepted and has not been opposed and the time for notice of opposition has expired or having been opposed the opposition has been decided in favour of the applicant, the Controller shall unless the application has been accepted in error register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purpose of this Act to be the date of registration. However, the foregoing provisions of this section, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of any written law relating to international or commonwealth arrangements, have effect subject to the provisions of that written law.

(2) On the registration of a trade mark, the Controller shall issue to the applicant, on payment by him of the prescribed fee, a certificate in the prescribed form of the registration sealed with the seal of the Controller.

[Amended by Act No. 31 of 1997]

24. [Repealed by Act No. 25 of 1996]

Duration of registration

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

(2) Registration may be renewed in accordance with section 25A for further periods of ten years.

[Amended by Act No. 25 of 1996]

Renewal of registration

25A.—(1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the prescribed renewal fee.

(2) The Controller shall give due notice of such approaching expiration to the proprietor of such trade mark at least six months before the expiration of the period of registration.

(3) Subject to this section, a request for renewal shall be made, and the renewal fee shall be paid, before the expiry of the registration.

(4) Where no request is made before the expiry of the registration, a request may be made, and the fee together with the prescribed additional renewal fee may be paid, within six months of the expiration or such longer period as the Controller may permit.

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

(6) Where the registration is not renewed in accordance with this section, the Controller shall remove the trade mark from the register.

(7) Where a trade mark is removed from the register for non-payment of the renewal fee, the trade mark shall, for the purpose of an application for registration during one year next after the date of the removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Controller that there has been no *bona fide* user of the trade mark during the two years immediately preceding the removal, or that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

[Added by Act No. 25 of 1996 and amended by Act No. 31 of 1997]

Registration of parts of trade marks and of trade marks as a series

26.—(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to section 32(2) and section 44(2), have all the incidents of an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statements of the goods in relation to which they are respectively used or proposed to be used; or

(b) statements of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour,

seeks to register those trade marks, they may be registered as a series in one registration.

Assignment, Transmission and Associated Marks

Powers of and restrictions on assignment and transmission

27.—(1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered or was registered, as the case may be, or of some (but not all) of those goods.

Powers of assignment and transmission of unregistered mark

28. Section 27 has effect in the case of an unregistered trade mark used in relation to any goods as it has effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

Restrictions on assignment or transmission where exclusive rights would subsist in different persons

29.—(1) Notwithstanding anything in sections 27 and 28, a trade mark shall not be or be deemed to have been assignable or transmissible in a case in which as a result of

assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of identical trade marks or trade marks nearly resembling each other, so that, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion. However, where a trade mark is, or has been, assigned or transmitted in such a case as mentioned above, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within Trinidad and Tobago (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside Trinidad and Tobago.

(2) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Controller in the prescribed manner a statement of case setting out the circumstances, and the Controller may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (1), and a certificate so issued shall, subject to this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (1) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but as regards a certificate in favour of validity, only if application for the registration under section 34 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(3) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

*Restrictions on assignment or transmission where multiple exclusive rights
would subsist in different parts of Trinidad and Tobago*

30.—(1) Notwithstanding anything in sections 27 and 28, a trade mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in Trinidad and Tobago, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in Trinidad and Tobago. However, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him

or to a predecessor in title of his since the commencement of this Act, in any such case, the Controller, if he is satisfied that in all the circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission and an assignment or transmission, so approved shall not be deemed to be or to have been invalid under this section or under section 29; but in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 34 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(2) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

*Conditions of assignment otherwise than in connection
with the goodwill of the business*

31.—(1) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the coming into operation of this Act, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Controller may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Controller may direct.

(2) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

Associated trade marks

32.—(1) Associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Controller may at any time require that the trade marks be entered on the Register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are, by virtue of section 26(1) registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are by virtue of section 26(3), registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Controller may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the Register accordingly.

(6) Any decision of the Controller under subsection (2) or subsection (5) shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

Power of registered proprietor to assign and give receipts

33. Subject to this Act, the person for the time being entered in the Register as proprietor of a trade mark shall, subject to any rights appearing from the Register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

Registration of assignments and transmissions

34.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Controller to register his title, and the Controller shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the Register.

(2) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

(3) Except for the purposes of an appeal under this section or of an application under section 46, a document or instrument in respect of which no entry has been made in the Register in accordance with subsection (1) of this section shall not be admitted in evidence in any court in proof of the title to a trade mark unless the Court otherwise directs.

[Amended by Act No. 31 of 1997]

Use and Non-Use

*Removal from register and imposition of limitations
on ground of non-use*

35.—(1) Subject to subsection (2), a registered trade mark may be taken off the Register in respect of any of the goods in respect of which it is registered on application by

any person aggrieved to the Court or, at the option of the applicant and subject to section 61, to the Controller, on the ground either—

(a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has been in fact no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for a continuous period of three years or longer up to the date one month before the date of the application; or

(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being.

However (except where the applicant has been permitted under section 14(2) to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Controller, as the case may be, is of the opinion that he might properly be permitted so to register such a trade mark), the Court or the Controller as the case may be, may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered—

(a) the matters referred to in subsection (1)(b) are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Trinidad and Tobago (otherwise than for export from Trinidad and Tobago), or in relation to goods to be exported to a particular market outside Trinidad and Tobago; and

(b) a person has been permitted under section 14(2) to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Trinidad and Tobago) or in relation to goods to be exported to that market, or the Court, or the Controller, as the case may be, is of the opinion that he might properly be permitted so to register such a trade mark,

on application by that person to the Court or, at the option of the applicant and subject to section 61 to the Controller, the Court or the Controller, as the case may be, may impose on the registration of the first-mentioned trade mark such limitations as the Court or the Controller thinks proper for securing that registration shall cease to extend to such use as last mentioned above.

(3) An applicant shall not be entitled to rely for the purposes of subsection (1)(b), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to—

(a) special circumstances in the trade; or

(b) circumstances arising independently of the will of the trade mark owner that constitute an obstacle to the use of the trade mark, such as import restrictions on, or other Government requirements for, goods or services identified by the trade mark,

and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

[Amended by Acts Nos. 25 of 1996 and 31 of 1997]

36. [Repealed by Act No. 25 of 1996]

Registered users

37.—(1) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 35 and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant. A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Controller in the prescribed manner and must furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Controller—

(a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;

(b) stating the goods in respect of which registration is proposed;

(c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and

(d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof; and with such further documents, information or evidence as may be required under the rules or by the Controller.

[Amended by Act No. 31 of 1997]

Power of Controller to refuse application

38.—(1) The Controller shall refuse an application under section 37 if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(2) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

Registration as registered user

39.—(1) When the requirements of section 37(4) have been complied with, if the Controller, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to any conditions or restrictions which the Controller thinks proper, would not be contrary to the public interest, the Controller may register the proposed registered user as a registered user in respect of the goods subject as mentioned above.

(2) Any decision of the Controller under this section refusing registration of a person as a registered user of a trade mark shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

*Controller not to disclose information to trade rivals,
if so required*

40. The Controller shall if so required by an applicant take steps to ensure that information given for the purposes of an application under section 37 (other than matter entered in the Register) is not disclosed to rivals in trade.

[Amended by Act No. 31 of 1997]

*Power of Controller to vary or cancel
registration of registered user*

41.—(1) Without prejudice to the provisions of section 46 the registration of a person as a registered user—

(a) may be varied by the Controller as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) may be cancelled by the Controller on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or

(c) may be cancelled by the Controller on the application in writing in the prescribed manner of any person on any of the following grounds:

(i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested; or

(d) may be cancelled by the Controller in respect of any goods in relation to which the trade mark is no longer registered.

(2) Any decision of the Controller under the foregoing provisions of this section shall be subject to appeal to a Judge in Chambers.

(3) The Controller shall notify the registration of a person as a registered user to any other registered user of the trade mark, and also notify any application under subsection (1) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and shall give to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

[Amended by Act No. 31 of 1997]

No right of assignment or transmission in registered user

42. Nothing in this Act shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

Proposed use of trade mark by corporation to be constituted, etc.

43.—(1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

(a) if the Controller is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or

(b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Controller is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Controller is also satisfied that the person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) Section 35 shall have effect in relation to a trade mark registered under the power conferred by subsection (1) of this section, as if for the reference in section 35(1)(a) to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as mentioned above, then, unless the corporation has been registered as the proprietor of the trade mark in respect of those goods within a period of six months or within such further period not exceeding six months as the Controller may allow, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Controller shall amend the Register accordingly.

[Amended by Act No. 31 of 1997]

*Use of one of associated or substantially identical trade marks
equivalent to use of another*

44.—(1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Controller may, if and so far as the Court or the Controller thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of section 26(1).

[Amended by Act No. 31 of 1997]

Use of trade mark for export trade

45. The application in Trinidad and Tobago of a trade mark to goods to be exported from Trinidad and Tobago, and any other act done in Trinidad and Tobago in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Trinidad and Tobago, would constitute use of a trade mark therein, shall be deemed to

constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

Rectification and Correction of Register

General power to rectify entries in register. Schedule

46.—(1) Subject to the Schedule, the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause, or by any entry wrongly remaining on the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as it may think fit.

(2) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Controller may himself apply to the Court under this section.

(3) Any order of the Court rectifying the Register shall direct that notice of the rectification shall be served in the prescribed manner on the Controller, and the Controller shall on receipt of the notice rectify the Register accordingly.

(4) The power to rectify the Register conferred by this section shall include power to remove a registration in Part A of the Register to Part B.

[Amended by Act No. 31 of 1997]

Power to expunge or vary registration for breach of condition

47. The Court may, on application by any person aggrieved, or on application by the Controller, make such order as it may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the Register in relation thereto.

[Amended by Act No. 31 of 1997]

Correction of register

48.—(1) The Controller may on request, made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name—

(a) correct any error in the name, address or description of the registered proprietor of a trade mark;

(b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;

(c) cancel the entry of a trade mark on the Register;

(d) strike out any goods or classes of goods from those in respect of which a trade mark is registered; or

(e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Controller may, on request made by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

(3) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

[Amended by Act No. 31 of 1997]

Alteration of registered trade mark

49.—(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Controller for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Controller may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient to do so, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Controller in the prescribed manner of opposition to the application, the Controller shall, after hearing the parties if so required, decide the matter.

(3) Any decision of the Controller under this section shall be subject to appeal to a Judge in Chambers.

(4) Where leave as mentioned above is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

[Amended by Act No. 31 of 1997]

Certification Trade Marks

Certification trade marks

50.—(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the Register in respect of those goods in the name, as proprietor thereof, of that person; but a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish as mentioned above, the Controller may have regard to the extent to which—

(a) the mark is inherently adapted to distinguish as mentioned above in relation to the goods in question; and

(b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as mentioned above in relation to the goods in question.

(3) Subject to subsections (4), (5) and (6), and to sections 8 and 12, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such a manner as to render the use of the mark likely to be taken either—

(a) as being used as a trade mark; or

(b) in case in which the use is use upon goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or the goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration as mentioned above shall be subject to any conditions or limitations entered on the Register, and shall not be deemed to be infringed by the use of any such mark as mentioned above in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration as mentioned above shall not be deemed to be infringed by the use of any such mark as mentioned above by any person—

(a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as mentioned above or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor;

but paragraph (a) shall not have effect in the case of use consisting of the application of any such mark as mentioned above to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) There shall be deposited with the Controller in respect of every trade mark registered under this section regulations approved by the Controller for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Controller may require or permit to be inserted therein.

(8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Controller.

(9) The provisions of the Schedule shall have effect with respect to the registration of a mark under this section and to marks so registered.

[Amended by Act No. 31 of 1997]

Rules and Fees

Power to make rules

51.—(1) The Minister, subject to negative resolution of Parliament, may make such rules as he considers expedient—

(a) for regulating the practice under this Act, including the service of documents;

(b) for classifying goods for the purposes of registration of trade marks and for empowering the Controller to amend the Register so far as may be requisite for the purpose of adapting the entries therein to any amended or substituted classification that may be prescribed;

(c) for prohibiting the registration of any mark on the grounds of morality, public policy or other good and sufficient reason;

(d) for making or requiring duplicates of trade marks and other documents;

(e) prescribing anything (including forms) which is required to be, or may be, prescribed under this Act and any other forms which he may consider necessary for the purposes of this Act;

(f) generally for regulating the business of the Controller's Office in relation to trade marks and all things by this Act placed under the direction or control of the Controller;

(g) for the regulation of customs and border measures.

(2) Rules made under this Act shall while in force be of the same effect as if they were contained in this Act.

[Amended by Acts Nos. 45 of 1979 and 31 of 1997]

Fees

52. There shall be paid in respect of applications and other matters under this Act such fees as may be prescribed.

Powers and Duties of Controller

Hearing before exercise of Controller's discretion

53. Where any discretionary or other power is given to the Controller by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required to do so within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

[Amended by Act No. 31 of 1997]

Power of Controller to award costs

54. In all proceedings before the Controller under this Act, the Controller shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

[Amended by Act No. 31 of 1997]

Legal Proceedings and Appeals

Registration to be prima facie evidence of validity

55. In all legal proceedings related to a registered trade mark (including applications under section 46) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Certificate of validity

56. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

*Costs of Controller in proceedings before Court,
and payment of costs of Controller*

57. In all proceedings before the Court under this Act the costs of the Controller shall be in the discretion of the Court, 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.

[Amended by Act No. 31 of 1997]

Trade usage, etc., to be considered

58. In any action or proceeding relating to a trade mark or trade name the Court shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

Controller's appearance in proceedings involving rectification

59.—(1) In any legal proceeding in which the relief sought includes alteration or rectification of the Register, the Controller shall have the right to appear and be heard and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Controller in lieu of appearing and being heard, may submit to the Court a statement in writing signed by him stating the grounds of any decision given by him.

(3) The Court in dealing with any question of the rectification of the Register (including all applications under section 46) shall have power to review any decision of the Controller relating to the entry in question or the correction sought to be made.

[Amended by Act No. 31 of 1997]

Discretion of Court in appeals

60. In any appeal from a decision of the Controller to the Court or a Judge in Chambers under this Act, the Court or Judge in Chambers shall have and exercise the same discretionary powers as under this Act are conferred upon the Controller.

[Amended by Act No. 31 of 1997]

Procedure in cases of option to apply to Court or Controller

61. Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Controller—

(a) if an action concerning the trade mark in question is pending, the application must be made to the Court;

(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, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

[Amended by Act No. 31 of 1997]

Evidence

Mode of giving evidence

62.—(1) In any proceeding under this Act before the Controller the evidence shall be given by statutory declaration in the absence of directions to the contrary, but in any case in which the Controller thinks it right to do so, the Controller may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken *viva voce*, the Controller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a Judge of the High Court.

[Amended by Act No. 31 of 1997]

Evidence of entries in register

63.—(1) A printed or written copy of any entry in the Register, purporting to be certified by the Controller and sealed with the seal of the Controller, shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.

(2) Any person requiring such a certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

[Amended by Act No. 31 of 1997]

Evidence of things done by Controller

64. A certificate purporting to be under the hand of the Controller as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

[Amended by Act No. 31 of 1997]

Offences

65. [Repealed by Act No. 31 of 1997]

66. [Repealed by Act No. 31 of 1997]

Unauthorised use of trade mark, etc., in relation to goods

66A.—(1) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

(a) applies to goods or their packaging a mark identical to, or likely to be mistaken for, a registered trade mark;

(b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a mark; or

(c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(2) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

(a) applies a mark identical to, or likely to be mistaken for, a registered trade mark to material intended to be used—

(i) for labelling or packaging goods;

(ii) as a business paper in relation to goods; or

(iii) for advertising goods; or

(b) uses in the course of a business material bearing such a mark for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or

(c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(3) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

(a) makes an article specifically designed or adapted for making copies of a mark identical to, or likely to be mistaken for, a registered trade mark; or

(b) has such an article in his possession, custody or control in the course of a business, knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

(4) A person does not commit an offence under this section unless—

(a) the goods are goods in respect of which the trade mark is registered; or

(b) the trade mark has a reputation in Trinidad and Tobago and the use of the mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(5) It is a defence for a person charged with an offence under this section to show that he believed on reasonable grounds that the use of the mark in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.

(6) A person who commits an offence under this section is liable—

(a) on summary conviction, to a fine of ten thousand dollars and to imprisonment for six months;

(b) on conviction on indictment, to a fine of forty thousand dollars and to imprisonment for ten years.

[Added by Act No. 25 of 1996 and amended by Act No. 31 of 1997]

Falsification of register, etc.

66B.—(1) It is an offence for a person to make, or cause to be made, a false entry in the register, knowing or having reason to believe that it is false.

(2) It is an offence for a person—

(a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register; or

(b) to produce or tender or cause to be produced or tendered in evidence any such thing, knowing or having reason to believe that it is false.

(3) A person who commits an offence under this section is liable—

(a) on summary conviction, to a fine of twenty thousand dollars and to imprisonment for six months;

(b) on conviction on indictment, to a fine of forty thousand dollars and to imprisonment for ten years.

[Added by Act No. 25 of 1996 and amended by Act No. 31 of 1997]

Falsely representing trade mark as registered

66C.—(1) It is an offence for a person—

(a) falsely to represent that a mark is a registered trade mark; or

(b) to make a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false.

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

(a) of the word “registered”; or

(b) of 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 trade mark is in fact so registered for the goods or services in question.

[Added by Act No. 25 of 1996]

Forfeiture of counterfeit goods, etc.

66D.—(1) Where there has come into the possession of any person in connection with the investigation or prosecution of a relevant offence—

(a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark;

(b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or

(c) articles specifically designed or adapted for making copies of such a sign,

that person may apply under this section for an order for the forfeiture of the goods, material or articles.

(2) An application under this section may be made—

(a) where proceedings have been brought in any court for a relevant offence relating to some or all of the goods, material or articles, to that court;

(b) where no application for the forfeiture of the goods, material or articles has been made under paragraph (a), by way of complaint to a summary court.

(3) On an application under this section, the court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles.

(4) A court may infer for the purposes of this section that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch or otherwise.

(5) An order under this section may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of an appeal.

(6) Any person aggrieved by an order made under this section by a summary court, or by a decision of the court not to make such an order, may appeal against that order or decision to the Court of Appeal.

(7) Subject to subsection (8), where any goods, material or articles are forfeited under this section they shall be destroyed in accordance with such directions as the court may give.

(8) On making an order under this section the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall, instead of being destroyed, be released, to such person as the court may specify, on condition that that person—

(a) causes the offending sign to be erased, removed or obliterated; and

(b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

(9) For the purposes of this section, “relevant offence” means an offence under section 66A, an offence involving dishonesty or deception or such other offence as may be prescribed.

[Added by Act No. 25 of 1996]

Offences by corporations

66E.—(1) Where an offence under this Act which has been committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he, as well as the body corporate, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

[Added by Act No. 25 of 1996]

Miscellaneous

Change of form of trade connection not to be deemed to cause deception

67. The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists, shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

Jointly owned trade marks

68. Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

(a) on behalf of both or all of them; or

(b) in relation to any goods with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

Subject as mentioned above, nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

[Amended by Act No. 17 of 1994]

Trusts and equities

69.—(1) There shall not be entered in the Register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Controller.

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

[Amended by Act No. 31 of 1997]

69A. [Repealed by Act No. 31 of 1997]

Recognition of agents

70. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may under and in accordance with the rules, be done by or to an agent of that person duly authorised in the prescribed manner.

*References in written law to Patents, Designs and Trade Marks Ordinance.
Ch. 31 No. 18. 1950 Ed.*

71. Any reference in any written law to the provisions relating to trade marks (repealed by this Act) formerly contained in the Patents, Designs and Trade Marks Ordinance shall be read as referring to this Act.

Notice of objection to importation

71A.—(1) The registered owner of a registered trade mark may give to the Comptroller of Customs and Excise a notice in the prescribed form objecting to the importation after the date of the notice of goods that infringe the trade mark, and the notice shall be given together with any prescribed document.

(2) Where—

(a) the registered owner of the registered trade mark has not given a notice under subsection (1); or

(b) any notice given under subsection (1) is no longer in force,

a registered user of the trade mark having power to give a notice under subsection (1) may ask the registered owner to give such a notice in respect of the trade mark.

(3) Where the registered owner does not comply with the request within the prescribed period the registered user may give the notice to the Comptroller of Customs and Excise and the registered user shall give also to the Comptroller, together with the notice—

(a) any document prescribed for the purposes of subsection (1); and

(b) any other prescribed document.

(4) A notice given by the registered owner of a registered trade mark remains in force for two years from the day on which the notice is given unless it is revoked, before the end of that period, by notice in writing given to the Comptroller of Customs and Excise by the person who is then the registered owner of the registered trade mark.

(5) A notice given by a registered user of the registered trade mark remains in force for two years unless it is revoked, before the end of that period, by notice in writing given to the Comptroller of Customs and Excise—

(a) if the registered user has power to revoke the notice, by the registered user; or

(b) in any other case by the person who is then the registered owner of the registered trade mark.

[Added by Act No. 31 of 1997]

Comptroller of Customs and Excise

71B.—(1) This section applies to goods manufactured outside Trinidad and Tobago that—

(a) are imported into Trinidad and Tobago; and

(b) are subject to the control of the Comptroller of Customs and Excise pursuant to the Customs Act.

(2) Where goods to which this section applies—

(a) have applied to them or in relation to them a mark that, in the opinion of the Comptroller of Customs and Excise, is substantially identical with, or deceptively similar to, a notified trade mark; and

(b) are goods in respect of which the notified trade mark is registered or for similar or related goods for which the mark is registered,

the Comptroller of Customs and Excise shall seize the goods unless satisfied that there are no reasonable grounds for believing that the notified trade mark is infringed by the importation of the goods.

(3) The Comptroller of Customs and Excise may from time to time require the objector who has given notice under section 71A, to give the Comptroller security or further security within such time and in such manner, whether by way of bond, deposit of a sum of money or otherwise, as the Comptroller may specify, against all actions, proceedings, claims and demands which may be taken or made against, or cost and expenses which may be incurred by, the Comptroller in consequence of the seizure of goods to which the notice relates.

(4) The Comptroller of Customs and Excise may decide not to seize the goods if he has not been given by the objector, such security in accordance with subsection (3).

(5) Goods seized under this section shall be kept in a secure place as directed by the Comptroller of Customs and Excise.

[Added by Act No. 31 of 1997]

Notice of seizure

71C.—(1) The Comptroller of Customs and Excise shall, as soon as practicable—

(a) give (either personally or by post) to the designated owner of any seized goods a notice in writing identifying the goods and stating that they have been seized under section 71B; and

(b) give (either personally or by post) to the objector, or to each objector, a notice in the prescribed form—

(i) identifying the goods and stating that they have been seized under section 71B;

(ii) giving the full name and address of the designated owner of the goods and any information that the Comptroller of Customs and Excise has and that he believes, on reasonable grounds, to be likely to help the objector to identify the importer of the goods; and

(iii) stating that the goods will be released to the designated owner unless the objector or one of the objectors brings an action for infringement of the notified trade mark in respect of the goods, and gives to the Comptroller of Customs and Excise notice in writing of the action, within the period of ten working days after he has been given the notice or, if the

Comptroller of Customs and Excise extends that period under section 71F, within the extended period.

(2) Where the Comptroller of Customs and Excise gives notice under subsection (1), the Comptroller shall allow the designated owner and the objector sufficient opportunity to inspect the seized goods for the purposes of substantiating any claim.

[Added by Act No. 31 of 1997]

Forfeiture of goods

71D.—(1) The designated owner of any seized goods may, at any time before an objector starts an action for infringement of a notified trade mark in respect of the goods, consent to the goods being forfeited to the State by giving notice in the prescribed form to that effect to the Comptroller of Customs and Excise.

(2) Where the designated owner gives such a notice, the goods are forfeited to the State.

[Added by Act No. 31 of 1997]

Release of goods to owner—no action for infringement

71E.—(1) The Comptroller shall release the seized goods to their designated owner if within the action period, the objector has not, or none of the objectors has—

(a) brought an action for infringement of the notified trade mark in respect of the goods; and

(b) given to the Comptroller of Customs and Excise notice in writing of the action in the prescribed form.

(2) The Comptroller of Customs and Excise shall also release the seized goods to their designated owner if—

(a) before the end of the action period, the objector or each of the objectors has, by notice in the prescribed form to the Comptroller of Customs and Excise, consented to the release of the goods; and

(b) at that time—

(i) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods; or

(ii) any action brought by an objector has been withdrawn.

(3) The Comptroller of Customs and Excise may release the seized goods to their designated owner at any time before the end of the action period if—

(a) the Comptroller of Customs and Excise, having regard to information that has come to his knowledge after the goods were seized, is satisfied that there are no reasonable grounds

for believing that the notified trade mark has been infringed by the importation of the goods; and

(b) the objector has not, or none of the objectors has, brought an action for infringement of the notified trade mark in respect of the goods.

(4) In this section, “action period”, in relation to seized goods, means—

(a) if there is only one objector to the importation of the goods, the period within which the objector may bring an action for infringement of the registered trade mark in respect of goods under section 71F; or

(b) if there is more than one objector to the importation of the goods, the period beginning on the earliest day on which an objector may bring an action for infringement of the registered trade mark in respect of the goods under section 71F and ending at the end of the last day on which an objector may bring such an action under section 71F.

[Added by Act No. 31 of 1997]

Action for infringement

71F.—(1) An objector may bring an action for infringement of a notified trade mark in respect of seized goods and give notice of it in the prescribed form to the Comptroller of Customs and Excise—

(a) where paragraph (b) does not apply, within the notified period of ten working days specified in the notice given to the objector in respect of the goods under section 71C; or

(b) where—

(i) the objector has, before the end of the notified period, applied in writing to the Comptroller of Customs and Excise for an extension of the notified period; and

(ii) the Comptroller of Customs and Excise, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended the notified period for a number of working days not exceeding ten,

within that period as so extended by the Comptroller of Customs and Excise.

(2) The court hearing the action—

(a) may, on the application of a person, allow the person to be joined as a defendant to the action; and

(b) shall allow the Comptroller of Customs and Excise to appear and be heard.

(3) In addition to any relief that the court may grant apart from this section, the court may—

(a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to any conditions that the court considers fit to impose; or

(b) order that the seized goods be forfeited to the State.

(4) Where—

(a) the court decides that the trade mark was not infringed by the importation of the goods; and

(b) the designated owner of the goods, or any other defendant, satisfies the court that he has suffered loss or damage because the goods were seized,

the Court may order the objector to pay to the designated owner or other defendant compensation, in the amount determined by the court, for any part of that loss or damage that is attributable to any period beginning on or after the day on which the action was brought.

(5) Where, after three weeks from the day on which the action was brought, there is not in force at any time an order of the court preventing the goods from being released, the Comptroller of Customs and Excise shall release the goods to their designated owner.

(6) Where the court orders that the goods be released, the Comptroller shall, subject to section 71I, comply with the order.

[Added by Act No. 31 of 1997]

Action for infringement by registered user

71G. Notwithstanding section 37(3), where a registered user of a notified trade mark is an objector in relation to any seized goods, the registered user may start an action for the infringement of the trade mark in respect of the goods within the required period without first ascertaining whether the registered owner is willing to bring the action.

[Added by Act No. 31 of 1997]

Forfeited goods—how to be disposed of

71H. Where—

(a) goods are forfeited to the State under section 71D; or

(b) the court orders under section 71F that goods be forfeited to the State,

the goods are to be destroyed or otherwise disposed of as the Comptroller of Customs and Excise directs, except that in the case of counterfeit goods, the Comptroller shall not permit the re-exportation of those goods in an unaltered state other than in exceptional circumstances.

[Added by Act No. 31 of 1997]

Power of Comptroller to retain control of goods

71I. The Comptroller of Customs and Excise—

(a) shall not release, or dispose of, any seized goods; or

(b) shall not take any action in relation to the goods to give effect to any order of a court under section 71F,

if the Comptroller is required or allowed to retain control of the goods under any other law of Trinidad and Tobago,

[Added by Act No. 31 of 1997]

Insufficient security

71J. If security given under section 71B(3) by the objector who gave notice under section 71A in respect of a trade mark is not sufficient to meet the expenses incurred by the State as a result of the action taken by the Comptroller of Customs and Excise under this Act because of the notice, the amount of the difference between those expenses and the amount of security—

(a) is a debt due by the objector, or by the objectors jointly or each of them separately, to the State; and

(b) may be recovered by an action taken in a court of competent jurisdiction.

[Added by Act No. 31 of 1997]

State not liable for loss, etc., suffered because of seizure

71K. The State is not liable for any loss or damage suffered by a person—

(a) because the Comptroller of Customs and Excise seized, or failed to seize, goods under this Act; or

(b) because of the release of any seized goods.

[Added by Act No. 31 of 1997]

Power to require information

71L.—(1) Where—

(a) goods that may be seized under this Act are imported into Trinidad and Tobago; and

(b) the Comptroller of Customs and Excise relying on information received, is satisfied on reasonable grounds that the use of a trade mark applied to or in relation to those goods is fraudulent,

the Comptroller of Customs and Excise may ask the importer of the goods—

(c) to produce any document in his or her possession relating to the goods; and

(d) to give information about—

(i) the name and address of the person by whom the goods were consigned to Trinidad and Tobago; and

(ii) the name and address of the person in Trinidad and Tobago to whom the goods were consigned.

(2) Where the importer intentionally or recklessly fails to comply with the request within the prescribed period, the importer is guilty of an offence punishable, on conviction, by imprisonment for a period not exceeding six months.

[Added by Act No. 31 of 1997]

Importation for personal use

71M. Notwithstanding the provisions of sections 71A to 71L, the importation by a natural person for his own personal use of not more than five of the same items bearing a registered trade mark in respect of which a notice has been given in accordance with section 71A shall be permitted, except that the Comptroller of Customs and Excise may permit the importation of a greater number of items if he is satisfied that they are for the personal use of the natural person.

[Added by Act No. 31 of 1997]

Validity of Registrations under Previous Ordinance

Incorporation of existing register with Part A

72. The Register of Trade Marks existing at the date of the commencement of this Act shall be incorporated with and form part of Part A of the Register. Subject to sections 8, 15 and 73 of this Act the validity of the original entry of any trade mark upon the Register so incorporated shall be determined in accordance with the Ordinance in force at the date of such entry and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

*Trade mark registrable under this Act not removable
on certain grounds*

73. No trade mark which was upon the Register at the commencement of this Act and which under this Act is a registrable trade mark shall be removed from the Register on the ground that it was not registrable under the Ordinance in force at the date of registration. But nothing in this section shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Ordinance then in force.

*Nothing in this Act to invalidate registration of trade mark
previously made*

74. Nothing in this Act shall be taken to have invalidated the original registration of a trade mark that immediately before the commencement of this Act was validly in the Register of Trade Marks existing at the commencement of this Act.

Previous use of a trade mark by person becoming registered user

75. Where a person is registered as a registered user of a trade mark on an application made within one year from the commencement of this Act, section 37(2) shall have effect in relation to any previous use (whether before or after the commencement of this Act) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

International and Inter-Commonwealth Arrangements

Arrangements with Convention countries

76.—(1)(a) Any person who has applied for protection for any trade mark in a Convention country or his legal representative or assignee, is entitled to registration of his trade mark under this Act in priority to other applicants; and the registration shall take effect from the same date as the date of the application in the Convention country.

(b) This section shall not apply unless the application for protection in Trinidad and Tobago is made within six months from the date of the application in the Convention country.

(c) Nothing in this section shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Trinidad and Tobago.

(2) The trade mark shall not be invalidated by reason only of the use thereof in Trinidad and Tobago during the period specified in this section as that within which the application may be made.

(3) The application for the registration of a trade mark under this section shall be made in the same manner, and subject to the payment of the same fees, as an ordinary application under this Act.

(4) Where a person has applied for protection for any trade mark by an application which—

(a) in accordance with the terms of a treaty subsisting between any two or more Convention countries, is equivalent to an application duly made in any one of those Convention countries; or

(b) in accordance with the law of any Convention country, is equivalent to an application duly made in that Convention country,
he shall be deemed for the purposes of this section to have applied in that Convention country.

(5) In this section the expression “Convention country” means a country in the case of which there is for the time being in force an Order made by the President with a view to the fulfilment of the obligations of Trinidad and Tobago under the Convention declaring that that country is a Convention country; and with respect to any country such declaration might extend to all or to only some of the provisions of this Act, and where a declaration is in force for some (but not all) of the provisions of this Act with respect to any country that country shall be considered a Convention country for the purposes of those provisions only.

[Amended by Act No. 46 of 1979]

*Arrangements with Commonwealth countries
not being Convention countries*

77.—(1) Whenever it appears to the President that the Legislature of any Commonwealth Country not being a Convention country has made satisfactory provision for the protection in such country of trade marks registered in Trinidad and Tobago, the President may by order apply all or any of the provisions of section 76 relating to the protection of trade marks registered in a Convention country, with such variations or additions, if any, as he thinks fit, to trade marks registered in such Commonwealth Country.

(2) An order made under this section shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act.

Restraint of Use of Arms of Trinidad and Tobago

Restraint of use of national coat of arms, etc.

78.—(1) No person shall adopt in connection with any trade, business, profession or calling, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for—

(a) the Coat of Arms of Trinidad and Tobago;

(b) the flag of Trinidad and Tobago;

(c) the standard, arms or crest of the President;

(d) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received or are produced, sold or performed under presidential or governmental patronage, approval or authority.

(2) Where it is made to appear to the Court that any act has been done contrary to this section, the Court may make any such Order as the circumstances require including provision

for relief by way of injunction and the recovery of damages or profits, and may give directions with respect to the disposition of any offending wares, packages, labels and advertising material and of any dies used in connection therewith.

[Amended by Act No. 45 of 1979]

Repeal and Savings

Repeal and savings

79.—(1) The Patents, Designs and Trade Marks Ordinance is hereby repealed so far as the same relates to trade marks.

(2) Nothing in this Act shall affect any order, rule or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, or thing done, under any written law repealed by this Act; and every such order, rule, direction, approval, application or thing shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding written law of this Act.

(3) Any document referring to any written law repealed by this Act shall be construed as referring to the corresponding written law of this Act.

Schedule Certification Trade Marks

1.—(1) An application for the registration of a mark under section 50 of this Act must be made to the Controller in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of section 19(2), (4), (5), (6) and (7) of this Act shall have effect in relation to an application under the said section 50 as they have effect in relation to an application under section 19(1).

(3) In dealing under the said provisions with an application under section 50, the Controller (or Judge in Chambers, as the case may be) shall have regard to the like considerations, so far as relevant, as if the application were an application under section 19 of this Act and to any other considerations relevant to applications under section 50, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark, and also to the following matters:

(a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;

(b) whether the draft regulations are satisfactory; and

(c) whether in all circumstances the registration applied for would be to the public advantage.

(4) An applicant for the registration of a trade mark under section 50 shall transmit to the Controller draft regulations for governing the use thereof at such time before the decision of the Controller as he may require in order to enable him to consider the draft.

2. Where an application has been accepted, the Controller shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and sections 21 and 22 of this Act shall have effect in relation to the registration of the mark as if the application had been an application under section 19 of this Act.

3.—(1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor be altered by the Controller.

(2) The Controller may cause an application for an amendment of the regulations to be advertised in any case where it appears to him that it is expedient so to do, and, where he causes an application to be advertised, if within one month from the date of the advertisement any person gives notice to him of opposition to the application, he shall not decide the matter without giving the parties an opportunity to be heard.

4.—(1) The Controller may, on the application in the prescribed manner of any person aggrieved, make such order as he thinks fit for expunging or varying any entry in the Register relating to a certification trade mark, or for varying the deposited regulations, on the ground—

(a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;

(b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;

(c) that it is no longer to the public advantage that the trade mark should be registered;
or

(d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied.

(2) The Register and the deposited regulations shall be rectified in such manner as may be requisite for giving effect to an order made under sub-paragraph (1).

5. Any decision of the Controller under paragraph 3 and any order of the Controller under paragraph 4 of this Schedule shall be subject to appeal to a Judge in Chambers.

6. Notwithstanding anything in section 54 of this Act, the Controller shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

7. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, sections 5, 7, 10, 19, 20, 21 and 22 (except as expressly applied by

this Schedule), sections 29, 30, 31, 35, 37, 38, 39, 40, 41, 42, 43, 67 and any provisions the operation of which is limited by the terms thereof to registration in Part B of the Register.

[Amended by Acts Nos. 25 of 1996 and 31 of 1997]

* *Short title.*

Act No. 11 of 1955 amended by Acts Nos. 45 and 46 of 1979, 7 of 1984, 17 of 1994, 25 of 1996 and 31 of 1997.

Entry into force (of last amending Act): September 5, 1997 with the exception of its section 11 and the definitions of "Controller" and "Intellectual Property Office" which entered into force on December 1, 1997.

Source: Consolidation (approved by the national authorities) by the International Bureau of WIPO based on official texts communicated by the Trinidad and Tobago authorities.