

## Act No. 31 of 1997

[L.S.]

An Act to amend the Trade Marks Act, Chap. 82:81

*[Assented to 5th September, 1997]*

### Enactment

ENACTED by the Parliament of Trinidad and Tobago as follows:—

### Short title

1. This Act may be cited as the Trade Marks (Amendment) Act, 1997.

### Interpretation Chap. 82:81

2. In this Act, “the Act” means the Trade Marks Act.

### Section 2 amended

3. [Section 2](#) of the Act is amended—

(a) in [subsection \(1\)](#)—

- (i) in the definition of mark in [paragraph \(a\)](#) by inserting after the word “thereof” the words “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”;
- (ii) by inserting in the appropriate alphabetical sequence the following definitions:  
“ “Controller” has the same meaning assigned to it under [section 2](#) of the Patents Act, 1996;

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“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;

### Chap. 78:01

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

“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;”;

(iii) by deleting the definition of “Registrar”;

(b) by repealing [subsection \(2\)](#) and substituting the following subsection:

“ (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.”.

## Section 3A inserted

4. The Act is amended by inserting after [section 3](#) the following section:

### “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.”.

## Section 51 amended

5. [Section 51\(1\)](#) of the Act is amended—

(a) in [paragraph \(f\)](#) by deleting the full stop and substituting a semicolon;

(b) by inserting after [paragraph \(f\)](#) the following paragraph:

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

## Sections 65 and 66 repealed

6. [Sections 65](#) and [66](#) of the Act are repealed.

## Section 66A amended

7. [Section 66A](#) of the Act is amended by substituting for the word “sign” wherever it occurs the word “mark”.

## Section 66B amended

8. **Section 66B** of the Act is amended by substituting for the word “sign” wherever it occurs the word “mark”.

## Section 69A repealed

9. [Section 69A](#) of the Act is repealed.

## Sections 71A-71L inserted

10. The Act is amended by inserting after [section 71](#) the following sections:

### “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.

### 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.

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- (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.

## 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.

## **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.

## **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](#).

## 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.

## 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.

## **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.

## **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.

## **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.

## **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.

## **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.”

## 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.

## “Controller” substituted for “Registrar”

11. The Act is amended by deleting the words “Registrar” and “Registrar General” wherever they occur and substituting the word “Controller”.

## Commencement

12. [Section 11](#) and the definitions of “Controller” and “Intellectual Property Office” provided for by [section 3\(a\)\(ii\)](#) shall come into force on the date of the proclamation of the Patents Act, 1996.

## Act No. 21 of 1966

Passed in the House of Representatives this 11th day of April, 1997.

**J. SAMPSON**

*Clerk of the House*

Passed in the Senate this 10th day of June, 1997.

**N. COX**



