

Act No. 25 of 1996

[L.S.]

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

[Assented to 16th August, 1996]

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, 1996.

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 in [subsection \(2\)](#), by inserting after the words “mark in relation to the goods”, the words “or the 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”.

Section 5 amended

4. [Section 5\(1\)](#) of the Act is amended by inserting after the word “uses”, the words, “for the same, similar or related goods or services for which the mark is registered,”.

Section 13 amended

5. [Section 13](#) of the Act is amended by deleting from the words “part of a trade mark” to the end and substituting the following:

“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.”

Section 13A Inserted

6. The Act is amended by inserting after [section 13](#), the following new section:

“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.”

Section 14 amended

7. [Section 14](#) of the Act is amended—

- (a) in [subsection \(1\)](#)—
 - (i) by deleting the words “in respect of the same goods or description of goods” and substituting the words “in respect of the same, similar or related goods or services or description of goods or services”;
 - (ii) by inserting after the word “confusion”, the words, “unless the proprietor of the earlier trade mark consents to the registration”; and
- (b) in [subsection \(3\)](#), by deleting the words “in respect of the same goods or description of goods” and substituting the words “in respect of the same, similar or related goods or services or description of goods or services.”

Section 24 repealed

8. [Section 24](#) of the Act is repealed.

Section 25 repealed and substituted

9. [Section 25](#) of the Act is repealed and the following sections are substituted:

“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.

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 Registrar 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 Registrar 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 Registrar 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 Registrar 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.”

Section 35 amended

10. [Section 35](#) of the Act is amended—

(a) in [subsection \(1\)\(a\)](#), by deleting the words “for the time being” and substituting the words “for a continuous period of three years or longer”;

(b) in [subsection \(3\)](#), by deleting from the words “due to” to the end and substituting the following:

“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”.

Section 36 repealed

11. [Section 36](#) of the Act is repealed.

Section 66A to 66r inserted

12. The Act is amended by inserting after [section 66](#), the following sections:

Unauthorized 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 sign 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 sign; 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 sign 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 sign 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 sign 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 sign 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 sign 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.

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.

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.

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.

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”.

Schedule amended

13. The Schedule to the Act is amended in [paragraph 7](#) by deleting the words “36,”.

Passed in the House of Representatives this 19th day of July, 1996.

N. COX

Acting Clerk of the House

Passed in the Senate this 5th day of August, 1996.

D. DOLLY

Acting Clerk of the Senate
