

Geographical Indications Act, 1996 * (No. 20 of 1996, as amended by Act No. 18 of 2000)

An Act to provide for the protection of geographical indications and related matters.

Part I Preliminary

Short title and commencement

- 1.—(1) This Act may be cited as the Geographical Indications Act, 1996.
(2) This Act shall come into force on a date to be fixed by the President by Proclamation.

Interpretation

2. In this Act—

“Controller” means the Controller of the Intellectual Property Office appointed under section 3 of the Patents Act and any reference to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller;

“Court” means the High Court;

“geographical indication” means an indication which identifies a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

“good” means any natural or agricultural product or any product of handicraft or industry;

“Minister” means the Minister to whom responsibility for legal affairs has been assigned;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“producer” means—

- (i) any producer of agricultural products or any other person exploiting natural products;
- (ii) any manufacturer of products of handicraft, or industry; and
- (iii) any trader dealing in the said products;

“Register” means the Register of Geographical Indications.

Part II Protection of Geographical Indications

Civil proceedings

3. Any interested person and any interested group of producers or consumers may institute proceedings in the Court to prevent, in respect of geographical indication—

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

(b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention; or

(c) use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or

the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like, and in proceedings under this section, the Court may, in addition to issuing an injunction, award damages and grant any other remedy or relief as it may deem fit.

Availability of protection regardless of registration; presumption

4. Protection under this Act shall be available—

(a) regardless of whether a geographical indication has been registered; however, registration of a geographical indication under Part III of this Act shall, in any proceedings under this Act, raise a presumption that such indication is a geographical indication within the meaning of section 2; and

(b) against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Homonymous geographical indications for wines

5. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to paragraph (b) of section 4. The Controller, in cases of permitted concurrent use of such indications, shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

Exclusion from protection

6. The following shall not be protected as geographical indications—

(a) indications which do not correspond to the definition in section 2;

(b) indications which are contrary to public order or morality;

(c) geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

Offences

7. Any person who knowingly and with intent to deceive performs any of the acts referred to in section 3 is guilty of an offence and is liable on summary conviction to a fine of eight thousand dollars and to imprisonment for three years.

Part III Registration of Geographical Indications

Application for registration; right to file application; representation

8.—(1) An application for the registration of a geographical indication shall be filed with the Controller.

(2) The following shall have the right to file an application:

(a) persons carrying on an activity as a producer in the geographical area specified in the application, with respect to the goods specified in the application, as well as groups of such persons;

(b) groups of consumers; and

(c) any competent authority.

(3) Where an applicant's ordinary residence or principal place of business is outside Trinidad and Tobago, he shall be represented by an attorney-at-law resident and practising in Trinidad and Tobago.

Contents of application

9. An application for the registration of a geographical indication shall specify—
- (a) the name, address and nationality of the natural person or legal entity filing the application, and the capacity in which the applicant is applying for registration;
 - (b) the geographical indication for which registration is sought;
 - (c) the geographical areas to which the geographical indication applies;
 - (d) the goods for which the geographical indication applies;
 - (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used,
- and shall be subject to the payment of the prescribed fee.

Examination; opposition; registration

10.—(1) The Controller shall examine the application to ascertain whether it complies with the requirements of sections 6(b), 8 and 9 and the Regulations pertaining thereto.

(2)(a) Where the Controller finds that the conditions referred to in subsection (1) hereof are fulfilled, he shall cause the application, as accepted, to be published in the prescribed manner.

(b) Any interested person or competent authority may, within the prescribed period and in the prescribed manner, give notice to the Controller of opposition to the registration of the geographical indication on the grounds that one or more of the requirements of sections 6, 8 and 9 are not fulfilled.

(c) The Controller shall send a copy of such a notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Controller a counter-statement of the grounds on which he relies for his application; if he does not do so, he shall be deemed to have abandoned the application.

(d) If the applicant sends a counter-statement, the Controller shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered.

(3) Where the Controller finds that the conditions referred to in subsection (1) are fulfilled, and either—

(a) the registration of the geographical indication has not been opposed within the prescribed time limit; or

(b) the registration of the geographical indication has been opposed and the opposition has been decided in the applicant's favour, he shall register the geographical indication, publish a reference to the registration and issue to the applicant a certificate of registration. Otherwise, he shall refuse the application.

Right of use

11. Only producers carrying on their activity in the geographical area specified in the Register shall have the right to use a registered geographical indication, in the

course of trade, with respect to the products specified in the Register, provided that such products possess the quality, reputation or other characteristic specified in the Register.

Cancellation and rectification of registration; publication

12.—(1) Any interested person or any competent authority may apply to the Court for—

- (a) the cancellation of the registration of a geographical indication on the ground that it does not qualify for protection as such having regard to section 6; or
- (b) the rectification of the registration of an appellation of origin on the ground that the geographical area specified in the registration does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory.

(2) In any proceedings under this section, notice of the request for cancellation or rectification—

- (a) shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and
- (b) shall, by a publication in the prescribed manner, be given to all persons having the right to use the geographical indication under section 11.

(3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Court in the said notice and publication, apply to join in the proceedings.

(4) The Registrar of the Court shall notify the Controller of the decision of the Court or the decision on any appeal therefrom and the Controller shall record it and publish a reference thereto as soon as possible.

Register; publication

13.—(1)(a) The Controller shall maintain a Register in which he shall record all matters required by this Act to be recorded.

(b) The Register may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the Regulations.

(2) The Controller shall publish in the prescribed manner all the publications provided for in this Act.

Correction of errors; extension of time

14.—(1) The Controller may, subject to Regulations made under this Act, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Controller or in any matter recorded pursuant to this Act or the Regulations.

(2) If the Controller is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the Regulations, upon notice to parties concerned and upon such terms as he may direct. Notwithstanding that the time for doing the Act or taking the proceeding has expired, the Controller may grant an extension of time.

Exercise of discretionary powers

15. The Controller shall, before exercising any discretionary power vested in him by this Act adversely to any party to a proceeding before him give that party an opportunity to be heard.

Competence of Court; appeals

16.—(1) The Court shall have jurisdiction in cases of dispute relating to the application of this Act and in matters which under this Act are to be referred to the Court.

(2) Any decision taken by the Controller under this Act may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within two months of the date of the decision.

Part IV Special Provisions Concerning Marks; Exceptions

Misleading marks

17. The Controller shall, on his own motion or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in Trinidad and Tobago is of such a nature as to mislead the public as to the true place of origin.

Marks conflicting with a geographical indication for wines and spirits

18. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or of a trademark for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Controller on his own motion or at the request of an interested party, with respect to such wines or spirits not having this origin.

Exceptions regarding prior users

19.—(1) Nothing in this Act shall prevent continued and similar use in Trinidad and Tobago of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by any national or domiciliary of Trinidad and Tobago who has used that geographical indication in a continuous manner with regard to the same or related goods or services in Trinidad and Tobago either—

- (a) for at least ten years preceding April 15, 1994; or
- (b) in good faith preceding that date.

(2) Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either—

- (a) before the date of entry into force of this Act; or
- (b) before the geographical indication is protected in its country of origin, this Act shall not prejudice the registrability of or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

(3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in Trinidad and Tobago or in respect of a geographical indication of any other country with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in Trinidad and Tobago as of January 1, 1995.

(4) Any request for relief made under Part II of this Act in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in Trinidad and Tobago or after the date of registration of the trademark in Trinidad and Tobago, provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in Trinidad and Tobago and provided that the geographical indication is not used or registered in bad faith

(5) This Act shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

Part V Regulations

Regulations

20. The Minister may make Regulations prescribing all matters that are required or permitted by this Act to be prescribed, or are necessary or convenient to be prescribed for giving effect to the purposes of this Act.

* *Short title. Entry into force* (of amending Act): June 15, 2000. Source: Communication from the authorities of Trinidad and Tobago. Note: Consolidation by the International Bureau of WIPO.