

TRADE MARKS (INTERNATIONAL REGISTRATION)  
REGULATIONS, 2020

**Arrangement of Regulations**

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LEGAL NOTICE NO. 290

REPUBLIC OF TRINIDAD AND TOBAGO

TRADE MARKS ACT, 2015

REGULATIONS

MADE BY THE MINISTER UNDER SECTION 57 OF THE TRADE MARKS ACT

TRADE MARKS (INTERNATIONAL REGISTRATION)  
REGULATIONS, 2020

PART I

PRELIMINARY

1. These Regulations may be cited as the Trade Marks (International  
Registration) Regulations, 2020. Citation

2. (1) In these Regulations—

Interpretation

“Act” means the Trade Marks Act;

Act No. 8 of  
2015

“applicant” means the natural person or legal entity in whose  
name the international application is filed;

“approved form” means a form approved by the Controller;

“electronic online system” means the electronic online system  
established under regulation 76 of the Trade Marks  
Regulations;

“Gazette” refers to the periodical Gazette referred to in Rule 32  
of the Regulations under the Protocol;

“holder” means the natural person or legal entity in whose name  
the international registration is recorded in the Interna-  
tional Register;

“international registration designating Trinidad and Tobago”  
means an international registration in which a request has  
been made, either in the relevant international application  
or subsequently, for extension of protection to Trinidad and  
Tobago under the Madrid Protocol;

“International Register” has the meaning assigned by Article 2 of  
the Madrid Protocol and Rule 1 of the Regulations under the  
Protocol;

“Office of Origin” has the meaning assigned by Article 2(2) of the  
Madrid Protocol;

“protected international trade mark in Trinidad and Tobago” has the meaning under regulation 19, and references to “protection” and “protected” shall be construed accordingly;

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

“Regulations under the Protocol” means the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as in force on February 1, 2020 as may be revised from time to time;

“Trade Marks (Border Enforcement Measures) Regulations” means the Trade Marks (Border Enforcement Measures) Regulations made under section 123 of the Act;

“Trade Marks Journal” means the journal by that name published under regulation 93 of the Trade Marks Regulations;

“Trade Marks Regulations” means the Trade Marks Regulations made under section 123 of the Act.

Fees First  
Schedule

3. (1) The fees set out in the First Schedule shall be payable to the Controller in respect of the matters set out in that Schedule.

(2) Unless otherwise provided for in these Regulations, or the Controller permits or directs otherwise, where a fee specified in the First Schedule in respect of any matter—

- (a) the fee shall be paid at the same time as the filing of the form corresponding to the matter; and
- (b) if the fee is not paid, the form shall not be treated as filed.

(3) Fees payable under these Regulations shall be paid using the mode of payment permitted or directed by the Controller.

Forms

4. (1) The Controller shall publish on the Intellectual Property Office’s website and in the Trade Marks Journal—

- (a) the approved forms referred to in these Regulations;
- (b) the Controller’s directions relating to the use of an approved form; and
- (c) any amendment or modification of any approved form or direction.

(2) An approved form may be modified on the direction of the Controller—

- (a) for use in a case other than the case for which it is intended;
- (b) for carrying out any transaction by means of the electronic online system; or
- (c) for any other purpose that the Controller considers necessary.

(3) The Controller may accept, in lieu of an approved form, any other document which is filed with the Intellectual Property Office for any purpose for which the approved form was published, if the document—

- (a) complies with every direction of the Controller relating to the use of the approved form; and
- (b) is in a format that is acceptable to the Controller.

(4) Any reference in these Regulations to a numbered form shall be construed as a reference to the current version of the approved form bearing the corresponding number which is—

- (a) described—
  - (i) in the Second Schedule; or
  - (ii) in the Second Schedule to the Trade Marks Regulations;  
and
- (b) published in the Trade Marks Journal.

Second  
Schedule

5. (1) Unless the Controller permits otherwise in a particular case, the electronic online system shall be used by a person for giving or sending to, filing with or serving on the Controller or the Intellectual Property Office any document, other than a notice or document to be served in proceedings in Court.

Electronic  
Online System

(2) The electronic online system may be used by the Controller or the Intellectual Property Office for giving or sending to, or serving on a person, any notice or other document, other than a notice or document to be served in proceedings in Court.

- (3) The Controller may issue practice directions specifying—
- (a) the manner in which a document is to be given or sent to, filed with or served on the Controller or the Intellectual Property Office under subregulation (1);
  - (b) the manner in which the Controller or the Intellectual Property Office may give, send or serve a notice or document under subregulation (2);
  - (c) the procedures and conditions for the setting-up, operation and use of the electronic online system; and
  - (d) in the event of any malfunction of the electronic online system, the manner in which a document is to be given or sent to, filed with or served on the Controller or the Intellectual Property Office under subregulation (1), or in which the Controller or the Intellectual Property Office may give, send or serve a notice or document under subregulation (2).

## (4) The Controller—

- (a) may correct any error or omission in any document or information that has occurred as a result of any malfunction of the electronic online system; and
- (b) shall maintain a record of the correction so made.

## PART II

## INTERNATIONAL REGISTRATIONS DESIGNATING TRINIDAD AND TOBAGO

Entitlement to protection

6. (1) Subject to regulations 13 to 19, an international registration designating Trinidad and Tobago shall be entitled to become protected where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration of a trade mark under the Act, including any imposed by the Trade Marks Regulations.

(2) For the purposes of subregulation (1), sections 5 and 7 of the Act and regulations 10, 15, 16, 18, 19, 20 and 21 of the Trade Marks Regulations shall be disregarded.

Request for division of international registration designating Trinidad and Tobago

7. (1) Subject to this regulation, the holder of an international registration designating Trinidad and Tobago (referred to in this regulation as a “principal registration”) for two or more goods or services (referred to in this regulation as “the subject goods or services”) may make a request to the International Bureau through the Controller, to divide the principal registration into two international registrations designating Trinidad and Tobago (referred to in this regulation as “divisional registration”), each for—

- (a) one or more classes of goods or services to which the subject goods or services belong; or
- (b) one or more of the subject goods or services.

## (2) A request made under subregulation (1) shall—

- (a) be made before the date the principal registration becomes a protected international trade mark in Trinidad and Tobago;
- (b) be made on the International Bureau’s official forms;
- (c) specify the name of the holder of the principal registration;
- (d) specify the number of the principal registration given by the International Bureau;
- (e) contain, for each divisional registration sought and each class of goods or services for which the divisional registration is sought, a specification in accordance with section 6 of the Act and regulation 19 of the Trade Marks Regulations setting out the goods or services to which that divisional registration relates; and

(f) be accompanied by the address for service in Trinidad and Tobago of the holder of the principal registration, if the address has not been furnished to the Controller under regulation 13(7) or filed with the Controller under regulation 16(1)(b).

(3) The Controller shall notify the International Bureau of a request for a division of a principal registration that is made in accordance with subregulation (2).

(4) Where the Controller is notified by the International Bureau that the principal registration has been divided into two divisional registrations, the Controller shall—

(a) record the details of each divisional registration in the Register, and for this purpose, each divisional registration shall be recorded in the Register as having the same date as the principal registration; and

(b) inform the holder of the principal registration of the details of each divisional registration by notice, in writing, sent to the address—

(i) furnished to the Controller under regulation 13(7) or filed with the Controller under regulation 16(1)(b) as the holder's address for service in Trinidad and Tobago; or

(ii) accompanying the request made under subregulation (1) as the holder's address for service in Trinidad and Tobago,

as the case may be.

(5) Upon the division of the principal registration into two divisional registrations by the International Bureau—

(a) any notice of opposition to the conferring of protection on the principal registration filed with the Controller shall—

(i) if the notice relates only to some, but not all, of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or

(ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations,

and the opposition proceedings are to continue as if the notice had been so given; and

- (b) any notice given to the Controller under section 43(3) of the Act claiming an interest in or under the principal registration shall—
- (i) if the notice relates only to some, but not all, of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or
  - (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations.

Effects of  
protected  
international  
trade mark in  
Trinidad and  
Tobago

8. (1) The proprietor of a protected international trade mark in Trinidad and Tobago has, subject to these Regulations, the same rights and remedies as are given by, or under sections 27 to 30 and 32, 33, 34 and 36 of the Act to the proprietor of a registered trade mark.

(2) Subregulation (1) is subject to the provisions relating to acts not amounting to infringement and exhaustion which are applicable to a registered trade mark by virtue of sections 29 and 30 of the Act, respectively.

- (3) For the purposes of the application of section 27 of the Act—
- (a) the rights of the proprietor shall have effect as of the date on which the protected international trade mark in Trinidad and Tobago is to be treated as registered under regulation 19 or 28; and
  - (b) a protected international trade mark in Trinidad and Tobago shall be treated as being in fact registered when it becomes protected under regulation 19.

(4) For the purposes of subregulation (1), references in sections 28 and 29 of the Act to goods or services in respect of which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago.

(5) Where the holder of an international registration designating Trinidad and Tobago, by notice, in writing, sent to the Controller—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred in Trinidad and Tobago by the international registration shall be subject to a specified territorial or other limitation,

the Controller shall enter the disclaimer or limitation in the Register and shall publish the disclaimer or limitation.



(6) Where a protected international trade mark in Trinidad and Tobago is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of section 27 of the Act are restricted accordingly.

(7) The remedy for groundless threats of infringement proceedings given by section 37 of the Act applies to a protected international trade mark in Trinidad and Tobago as it applies in relation to a registered trade mark.

(8) For the purposes of subregulation (7)—

- (a) the reference in section 37(4) of the Act to the registration of the trade mark shall be treated as a reference to the protection of a protected international trade mark in Trinidad and Tobago; and
- (b) the reference in section 37(5) of the Act to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is a protected international trade mark in Trinidad and Tobago or is the subject of an international application or international registration designating Trinidad and Tobago.

9. (1) Where a person is, by the Act or these Regulations, required to furnish the Controller with an address, the address furnished shall be as full as possible for the purpose of enabling a person to find easily the place of business of the person whose address is given.

Protected international trade mark in Trinidad and Tobago as object of property

10. (1) The following are notifiable transactions for the purposes of this regulation:

Notification of transactions

- (a) the grant of a licence under a protected international trade mark in Trinidad and Tobago; and
  - (b) the granting of any security interest, whether fixed or floating, over a protected international trade mark in Trinidad and Tobago and any right in, or under it.
- (2) On application being made to the Controller by—
- (a) a person claiming to be entitled to an interest in, or under a protected international trade mark in Trinidad and Tobago by virtue of a notifiable transaction; or
  - (b) any other person claiming to be affected by such a transaction,

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

(3) The following are relevant transactions for the purposes of this regulation:

- (a) an assignment of a protected international trade mark in Trinidad and Tobago or any right in it;
- (b) the making by personal representatives of an assent in relation to a protected international trade mark in Trinidad and Tobago or any right in, or under it; or
- (c) an order of the Court or other competent authority transferring a protected international trade mark in Trinidad and Tobago or any right in, or under it.

(4) Until—

- (a) in the case of any notifiable transaction referred to in subregulation (1)(b), an application has been made for the registration of the relevant particulars of the transaction; or
- (b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in, or under, the protected international trade mark in Trinidad and Tobago in ignorance of it.

(5) A person who becomes the proprietor of a protected international trade mark in Trinidad and Tobago by virtue of any notifiable transaction referred to in subregulation (1)(b) or relevant transaction is not entitled to damages, an account of profits or statutory damages under section 32(2) of the Act in respect of any infringement of the protected international trade mark in Trinidad and Tobago occurring after the date of the transaction and before the transaction is recorded in the International Register.

(6) For the avoidance of doubt, subregulation (4) shall not apply to any relevant transaction relating to—

- (a) a licence under a protected international trade mark in Trinidad and Tobago; or
- (b) any right in, or under the licence.

(7) In this regulation, “relevant particulars” means—

- (a) in the case of the grant of a licence under a protected international trade mark in Trinidad and Tobago—
  - (i) the name and address of the licensee;
  - (ii) where the licence is an exclusive licence, that fact;

- (iii) where the licence is limited, a description of the limitation; and
  - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;
- (b) in the case of the grant of any security interest over a protected international trade mark in Trinidad and Tobago or any right in, or under it—
- (i) the name and address of the grantee;
  - (ii) the nature of the interest, whether fixed or floating; and
  - (iii) the extent of the security and the right in, or under the trade mark secured.

11. (1) Sections 44 to 47 of the Act shall, with the necessary <sup>Licensing</sup> modifications, apply in relation to licences to use a protected international trade mark in Trinidad and Tobago as they apply in relation to licences to use a registered trade mark.

(2) The reference in section 44(2) of the Act to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which a trade mark is protected in Trinidad and Tobago.

12. (1) Subject to subregulation (2), section 11 of the Act shall <sup>Priority</sup> apply so as to confer a right of priority in relation to protection of an international registration designating Trinidad and Tobago as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Regulations under the Protocol.

13. (1) Upon receiving from the International Bureau notification <sup>Examination</sup> of an international registration designating Trinidad and Tobago, the Controller shall examine whether it satisfies the requirements of regulation 6.

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

(3) Where the mark to which the international registration relates contains or consists of a word or words in characters other than Roman or in a language other than English, the Controller may require the holder to file with the Controller a copy of a translation or, if the case requires, transliteration of each word in English, certified or verified to the satisfaction of the Controller.

(4) If it appears to the Controller that the requirements of regulation 6 are not met, or are met only in relation to some of the goods or services in respect of which protection in Trinidad and Tobago has been requested, he shall give notification of refusal to the International Bureau.

(5) The notification of refusal shall specify a period within which the holder may make representations.

(6) If the holder requires an extension of time to make representations, he shall file with the Controller his request for an extension of time in Form TM 31 of the Trade Marks Regulations before the expiry of the period in question or any extended period previously granted by the Controller.

(7) A holder making representations shall file with the Controller an address for service in Trinidad and Tobago in Form TM 1 of the Trade Marks Regulations.

(8) The request referred to in subregulation (6) and the address for service referred to in subregulation (7) may be filed using the electronic online system.

(9) A request by the holder to the Controller to change or correct an address for service shall be made in Form TM 1 of the Trade Marks Regulations.

(10) The following shall be notified to the Controller in Form TM1 of the Trade Marks Regulations:

- (a) any appointment of an agent for a matter for which no form is prescribed; and
- (b) any change of an agent for a matter.

Publication

14. Where, following examination, it appears to the Controller that the requirements of regulation 6 are met in relation to some or all of the goods or services comprised in the international registration, the Controller shall publish the particulars of the international registration in the Trade Marks Journal.

Notice of  
Opposition

15. (1) A person (referred to in these Regulations as “the opponent”) may, within three months from the date of the publication of the international registration in the Trade Marks Journal, file with the Controller a notice opposing the conferring of protection on the international registration (referred to in these Regulations as “the notice of opposition”) in Form TM 6 of the Trade Marks Regulations.

(2) The opponent shall enter an address for service in Trinidad and Tobago in the form referred to in subregulation (1).

(3) Regulations 26 and 27 of the Trade Marks Regulations shall, with the necessary modifications, apply to the filing and contents of a notice of opposition.

(4) For the purposes of applying regulation 26 of the Trade Marks Regulations—

(a) a reference in that regulation to the date of the publication of the application for registration shall be treated as a reference to the date of publication of the international registration in the Trade Marks Journal; and

(b) a reference in that regulation to the applicant shall be treated as a reference to the holder.

(5) Upon filing of a notice of opposition, the Controller shall, within five months from the date of the publication of the international registration in the Trade Marks Journal, give notification of refusal to the International Bureau stating the matters relating to the opposition.

16. (1) Within two months from the date of the Controller's Counter-notification of refusal based on opposition to the International Bureau, the <sup>Counter-</sup>statement holder shall file with the Controller—

(a) a counter-statement in Form TM 7 of the Trade Marks Regulations setting out the grounds on which he relies as supporting the international registration designating Trinidad and Tobago, and the facts alleged in the notice of opposition which he admits, if any (referred to in these Regulations as “a counter-statement”); and

(b) an address for service in Trinidad and Tobago in Form TM 1 of the Trade Marks Regulations.

(2) The holder shall forthwith serve on the opponent a copy of both documents.

(3) A request for an extension of time to file a counter-statement shall be made to the Controller, in writing, within two months from the date of the Controller's notification of refusal based on opposition to the International Bureau.

(4) The total extension of time for which the Controller may allow to file a counter-statement shall not exceed four months from the date of the Controller's notification of refusal based on opposition to the International Bureau.

(5) For the avoidance of doubt, if the holder fails to comply with subregulation (1) or (3) in relation to any class of goods or services in respect of which protection is opposed, the Controller shall be entitled to treat the holder's request for protection in Trinidad and Tobago in respect of those goods or services as withdrawn, and the refusal shall subsist in respect of those goods or services.

Further  
procedures

17. (1) Upon the filing of a notice of opposition under regulation 15 and a counter-statement under regulation 16, regulations 29 to 38 of the Trade Marks Regulations shall, with the necessary modifications, apply to further proceedings thereon.

(2) For the purposes of applying regulations 29 to 38 of the Trade Marks Regulations—

- (a) a reference in those regulations to the applicant shall be treated as a reference to the holder; and
- (b) a reference in those regulations to the application shall be treated as a reference to the international registration designating Trinidad and Tobago.

Notifications  
of refusal

18. (1) Except where refusal is based on an opposition, a notification of refusal shall not be given after the expiry of eighteen months from the date on which the notification of the international registration designating Trinidad and Tobago was sent to the Controller.

(2) Where there is a possibility that opposition may be filed after the expiry of the period of eighteen months, the Controller shall inform the International Bureau accordingly.

(3) A notification of refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Regulations under the Protocol.

(4) Where—

- (a) after a notification of refusal has been given under regulation 13(4), the holder makes representations within the period specified in regulation 13(5) or any extended period; or
- (b) after a notification of refusal based on opposition has been given under regulation 15(5), the holder files a counter-statement within the period specified in regulation 16(1) or any extended period,

the Controller shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(5) For the purposes of subregulation (4), a final decision shall be regarded as being made where—

- (a) the Controller or the Court, on appeal from the Controller, decides whether the refusal shall be upheld in whole or in relation to only some of the goods or services in relation to which protection in Trinidad and Tobago is requested, and any right of appeal against that decision expires or is exhausted;

- (b) the representations or counter-statement is withdrawn;  
or
- (c) the proceedings relating to the refusal are discontinued  
or abandoned.

19. (1) Where—

Protection

- (a) after examination and publication under regulations 13  
and 14—
  - (i) the period of eighteen months from the date on which  
the notification of the request for extension of protection  
to Trinidad and Tobago was sent to Trinidad and Tobago  
has not expired, but the period for giving notification of  
refusal based on an opposition in accordance with  
regulation 15(5) expires without a notification of refusal,  
whether based on opposition or otherwise, having been  
given;
  - (ii) the period of eighteen months from the date on which  
the notification of the request for extension of protection  
to Trinidad and Tobago was sent to Trinidad and  
Tobago has expired, and the period for giving notice of  
opposition specified in regulation 15(1), including any  
extended period, expires without a notice of opposition  
having been given;
  - (iii) a notification of refusal has been given in respect of  
only some of the goods or services in respect of which  
protection in Trinidad and Tobago has been requested  
and the holder has made no representations within the  
period specified in regulation 13(5), including any  
extended period, or has filed no counter-statement  
within the period specified in regulation 16(1), including  
any extended period, as the case may be, or that the  
holder has informed the Controller that he does not  
intend to make such representations or file a counter-  
statement; or
  - (iv) a notification of refusal has been given in respect of all  
or some of the goods or services in respect of which  
protection in Trinidad and Tobago has been requested  
and the Controller notifies the International Bureau in  
accordance with regulation 18(4) that a final decision  
has been made that the refusal is withdrawn, or is  
withdrawn in respect of some of the goods or services in  
respect of which protection in Trinidad and Tobago has  
been requested; or

- (b) the period of eighteen months from the date on which the notification of the request for extension of protection to Trinidad and Tobago was sent to Trinidad and Tobago expires without any notification of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark in Trinidad and Tobago; and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in Trinidad and Tobago has been requested, protection shall apply only as regards the remaining goods or services.

(2) Subject to regulation 28, for the purposes of the application by these Regulations of the provisions of the Act, a trade mark so protected shall be treated as being registered under the Act—

- (a) where the request for extension of protection to Trinidad and Tobago is mentioned in the international application, the date of the international registration; or
- (b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

Revocation  
and invalidity

20. (1) Sections 23 and 24 of the Act shall, with the necessary modifications, apply so as to permit the protection of a protected international trade mark in Trinidad and Tobago to be revoked or declared invalid.

(2) For the purposes of applying sections 23 and 24 of the Act—

- (a) the reference in section 23(1) of the Act to the date of completion of the registration procedure shall be treated as a reference to the date the protected international trade mark in Trinidad and Tobago became protected;
- (b) the reference in section 23(2) of the Act to the form in which a trade mark was registered shall be treated as a reference to the form in which it is protected;
- (c) references in sections 23(6) and 24(9) of the Act to goods or services for which the trade mark is registered shall be treated as references to those in respect of which it is protected;
- (d) references in section 23 of the Act to the registration of a trade mark being revoked shall be treated as references to the protection of a protected international trade mark in Trinidad and Tobago being revoked; and



(e) references in section 24 of the Act to the registration of a trade mark being declared invalid shall be treated as references to the protection of a protected international trade mark in Trinidad and Tobago being declared invalid.

(3) Regulations 55 to 58 of the Trade Marks Regulations shall, with the necessary modifications, apply to the procedure upon an application for revocation or a declaration of invalidity of protection of a protected international trade mark in Trinidad and Tobago.

(4) Where the protection of a protected international trade mark in Trinidad and Tobago is revoked or declared invalid to any extent, the Controller shall notify the International Bureau and—

(a) in the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from the date of the application for revocation, or if the Controller or the Court is satisfied that the grounds for revocation existed at an earlier date, from that date;

(b) in the case of a declaration of invalidity, the trade mark shall, to that extent, be deemed never to have been a protected international trade mark in Trinidad and Tobago, but this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

21. (1) Section 25 of the Act applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a protected international trade mark in Trinidad and Tobago. <sup>Effect of acquiescence</sup>

(2) For the purposes of applying section 25 of the Act—

(a) the reference in that section to a registered trade mark shall be treated as a reference to a protected international trade mark in Trinidad and Tobago; and

(b) references in that section to registration shall be treated as references to protection of a protected international trade mark in Trinidad and Tobago.

22. Section 118 of the Act shall, with the necessary modifications, apply in relation to proceedings before the Court in which the validity of the protection of a protected international trade mark in Trinidad and Tobago is contested. <sup>Certificate of validity of contested registration</sup>

23. (1) Part XI of the Act and the Trade Marks (Border Enforcement Measures) Regulations shall, with the necessary modifications, apply in relation to goods which are, in relation to a protected international trade mark in Trinidad and Tobago, infringing goods within the meaning of section 3 of the Act. <sup>Importation of infringing goods</sup>

(2) For the purposes of subregulation (1), references in section 3 and Part XI of the Act and in the Trade Marks (Border Enforcement Measures) Regulations to a registered trade mark shall be treated as references to a protected international trade mark in Trinidad and Tobago.

Offences 24. (1) Sections 49 to 52 and 55 of the Act shall, with the necessary modifications, apply in relation to a protected international trade mark in Trinidad and Tobago.

(2) For the purposes of the application of sections 49 to 52 and 55 of the Act—

(a) references in those sections to a registered trade mark shall be treated as references to a protected international trade mark in Trinidad and Tobago; and

(b) references in those sections to goods or services for which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago.

Falsely representing trade mark as a protected international trade mark in Trinidad and Tobago

25. Any person who—

(a) falsely represents that a mark is a protected international trade mark in Trinidad and Tobago; or

(b) makes a false representation as to the goods or services for which a protected international trade mark in Trinidad and Tobago confers protection in Trinidad and Tobago,

knowing or having reason to believe that the representation is false commits an offence and is liable on conviction on indictment to a fine of two hundred and fifty thousand dollars and imprisonment for ten years.

### PART III

#### TRANSFORMATION OF INTERNATIONAL REGISTRATIONS INTO NATIONAL APPLICATION

Transformation application 26. (1) This regulation applies where—

(a) an international registration designating Trinidad and Tobago is cancelled at the request of the Office of Origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration;

- (b) an application (referred to in this Part as “a transformation application”) is made to the Controller, within three months from the date on which the international registration was cancelled, for registration in Trinidad and Tobago of a trade mark identical to that comprised in the international registration in respect of all or some of the goods or services in respect of which the international registration was cancelled; and
- (c) the application is made by the person who was the holder of the international registration immediately before its cancellation.

(2) A transformation application shall be filed with the Controller on Form MP 1.

(3) A trade mark registered pursuant to a transformation application shall be treated as if it were registered—

- (a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or
- (b) where the request for extension to Trinidad and Tobago was made subsequent to the international registration, on the date of recordal of that request in accordance with Article 3ter (2) of the Madrid Protocol,

and that date shall be deemed for the purposes of the Act to be the date of registration of the trade mark.

27. (1) Where the protected international trade mark in Trinidad and Tobago has become protected under regulation 19 on or before the actual date on which the transformation application is made (referred to in this regulation as the “transformation date”), the trade mark shall be registered under the Act.

(2) Where the international registration designating Trinidad and Tobago has not become protected under regulation 19 by the transformation date and its particulars have been published under regulation 14, the Controller shall treat—

- (a) the publication of its particulars as the publication of the transformation application under section 14(1) of the Act; and
- (b) any opposition to its protection under regulation 15 as an opposition to its registration under section 14(2) of the Act, and regulations 26 to 38 of the Trade Marks Regulations shall apply, subject to such modifications as the Controller may determine.

(3) Where particulars of the international registration designating Trinidad and Tobago have not yet been published under regulation 14 by the transformation date and the Controller has issued a notification of refusal under regulation 13(4), the Controller shall, for the purposes of the transformation application, inform the applicant of the notification of refusal under section 13(3) of the Act.

#### PART IV

##### CONCURRENT REGISTRATIONS

Effects of international registration where trade mark is also registered under the Act

28. (1) This regulation applies where—

- (a) a registered trade mark is also a protected international trade mark in Trinidad and Tobago;
- (b) the proprietor of the registered trade mark is the holder of the protected international trade mark in Trinidad and Tobago;
- (c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected international trade mark in Trinidad and Tobago; and
- (d) the date of registration of the registered trade mark is earlier than the date specified in regulation 19(2) in relation to the protected international trade mark in Trinidad and Tobago.

(2) For the purposes of the application by these Regulations of the provisions of the Act, the protected international trade mark in Trinidad and Tobago shall, notwithstanding regulation 19(2), be treated as being registered under the Act as of the date of registration of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered.

(3) For the purposes of determining whether the protected international trade mark in Trinidad and Tobago is an earlier trade mark, it shall be treated as having the date of application of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered, taking account, where appropriate, of the priorities claimed in respect of the registered trade mark.

(4) Where the conditions specified in subregulation (1) are satisfied in relation to a trade mark, subregulations (2) and (3) shall—

- (a) continue to apply in respect of the relevant protected international trade mark in Trinidad and Tobago, notwithstanding that the relevant registered trade mark lapses or is cancelled; or
- (b) cease to apply if it is revoked or declared invalid.

(5) On the application of the holder of the protected international trade mark in Trinidad and Tobago on Form MP 2, the Controller shall note in the Register that the international registration replaces the registered trade mark as regards the goods or services in respect of which the registered trade mark was registered.

(6) The provisions of this regulation are without prejudice to any right or remedy conferred on any person in respect of the registered trade mark.

## PART V

### INTERNATIONAL APPLICATIONS ORIGINATING IN TRINIDAD AND TOBAGO

29. (1) An applicant for the registration of a trade mark, or the proprietor of a registered trade mark may, subject to the provision of this regulation, apply to the Controller for the international registration of a trade mark on the International Bureau's official forms.

(2) An application for international registration shall be filed in English and may be made only where the applicant for such registration is—

- (a) a citizen of Trinidad and Tobago;
- (b) a body or corporation incorporated or constituted under the laws of Trinidad and Tobago;
- (c) a person domiciled in Trinidad and Tobago; or
- (d) a person who has a real and effective industrial or commercial establishment in Trinidad and Tobago.

(3) The particulars appearing in the application shall correspond with the particulars appearing at that time in the basic application or basic registration, as the case may be.

(4) The applicant shall provide, at the request of the Controller, such evidence as may be necessary to satisfy him that the applicant is eligible to make the application in accordance with subregulation (2).

(5) If the international application complies with the requirements set out in this regulation, the Controller shall submit the international application to the International Bureau.

30. (1) Where the Controller has submitted an application for international registration, he shall notify the International Bureau of the occurrence of any of the events specified in subregulation (2), and shall request the International Bureau to cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to subsist by reason of that event.

- (2) The events referred to in subregulation (1) are as follows:
- (a) before the expiry of the period of five years from the date of the international registration, the Controller—
    - (i) refuses to accept the basic application as regards some or all of the goods or services covered by the international registration; or
    - (ii) after accepting the application, refuses to register the trade mark as regards some or all of those goods or services, having regard to matters coming to his notice since he accepted the application,

and in either case that decision becomes a final decision, whether before or after the expiry of that period of five years;

- (b) the basic application—
  - (i) is, before the expiry of the period of five years from the date of the international registration, treated as withdrawn under—
    - (A) regulation 10(6)(a), 21(5) or 24(2) of the Trade Marks Regulations;
    - (B) sections 66(4) and 67(3) of the Act; or
    - (C) sections 75(4) and 76(3) of the Act; and
  - (ii) is not reinstated under regulation 74 of the Trade Marks Regulations, whether before or after the expiry of that period of five years;
- (c) opposition proceedings begun before the expiry of the period of five years from the date of the international registration resulting in a final decision not to register the trade mark as regards some or all of the goods or services covered by the international registration;
- (d) the basic application is withdrawn, or is restricted as regards goods or services covered by the international registration, as a result of a request by the applicant made—
  - (i) before the expiry of the period of five years from the date of the international registration; or
  - (ii) subsequently, when the basic application was at the time of the request subject to an appeal against refusal of registration or to opposition proceedings, begun in either case before the expiry of the period of five years;

- (e) the registration resulting from the basic application or the basic registration expires without renewal and is removed from the Register before the expiry of the period of five years from the date of the international registration, and no request for its restoration is made within the period specified in regulation 51 of the Trade Marks Regulations, or such a request is made and a final decision is made refusing the request;
  - (f) a final decision is made to revoke or declare invalid the registration resulting from the basic application or the basic registration, as a result of proceedings begun before the expiry of the period of five years from the date of the international registration; and
  - (g) the registration resulting from the basic application or the basic registration is cancelled as a result of a request by the proprietor made before the expiry of the period of five years from the date of the international registration, or made subsequently where, at the time of the request—
    - (i) the registration resulting from the basic application or the basic registration was subject to proceedings for revocation or invalidation; and
    - (ii) such proceedings were begun before the expiry of the period of five years from the date of the international registration.
- (3) For the purposes of this regulation—
- (a) a final decision shall be regarded as made where—
    - (i) any right of appeal against the decision expires or is exhausted; or
    - (ii) proceedings relating to an application or registration are discontinued or abandoned; and
  - (b) a reference to an application being withdrawn includes it being deemed withdrawn, abandoned, or never to have been made.

## PART VI

### MISCELLANEOUS

31. (1) In all legal proceedings relating to a protected international trade mark in Trinidad and Tobago, the registration of a person as the holder of a protected international trade mark in Trinidad and Tobago shall be *prima facie* evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

Evidence of  
certain  
matters  
relating to  
international  
registration

(2) Judicial notice shall be taken of the following:

- (a) the Madrid Protocol and the Regulations under the Protocol;
- (b) a copy of an entry in the International Register issued by the International Bureau; and
- (c) a copy of the Gazette.

(3) Any document mentioned in subregulation (2)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau thereby communicated.

(4) Evidence of any instrument issued by the International Bureau or any entry in or extract from such a document may be given in any such proceedings by production of a copy, and such document purporting to be such a copy shall be received in evidence.

(5) In this regulation, “legal proceedings” include proceedings before the Controller.

Agents

32. Any act required or authorised by these Regulations to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark in Trinidad and Tobago, or any procedure relating to a protected international trade mark in Trinidad and Tobago, may be done by or to an agent authorised by that person.

Burden of proving use of protected international trade mark in Trinidad and Tobago

33. If in any civil proceedings relating to a protected international trade mark in Trinidad and Tobago, a question arises as to the use to which the trade mark has been put, it is for the holder to show what use has been made of it.

Communication of information to International Bureau

34. Notwithstanding any written law, the Controller may communicate to the International Bureau any information which Trinidad and Tobago is required to communicate by virtue of these Regulations or pursuant to the Madrid Protocol or the Regulations under the Protocol.

Application of Trade Marks Regulations

35. (1) Except as otherwise provided in these Regulations, the Trade Marks Regulations shall, with the necessary modifications, apply in relation to an international registration designating Trinidad and Tobago and to a protected international trade mark in Trinidad and Tobago as they apply in relation to an application for registration of a trade mark and to a registered trade mark.

(2) The provisions of the Trade Marks Regulations relating to costs and security for costs and to evidence before the Controller shall apply in relation to proceedings under these Regulations in the same manner as they apply in relation to proceedings relating to a registered trade mark or application for registration of a trade mark.



## FIRST SCHEDULE

(Regulation 3)

## FEES

<i>Matter</i>	<i>Corresponding regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
1. Filing of a transformation application	26(2)	\$1,400	MP 1
2. Application for international registration through Controller		*	—
3. Request to divide an international application for registration of a trade mark made in respect of 2 or more goods or services into 2 or more separate applications, each in respect of one or more of those goods or services	7	\$350 for each additional application that the original application is divided into	—

\*This fee includes any fee payable to the International Bureau for that application or request.

**SECOND SCHEDULE**

[Regulation 4 (4)]

**DESCRIPTIONS OF FORMS**

<i>Form</i>	<i>Description of Form</i>
MP 1	Request to transform an international registration into national application(s)
MP 2	Request to replace Trinidad and Tobago national registration with international registration

Dated this 7th day of August, 2020.

F. AL-RAWI  
*Attorney General and  
Minister of Legal Affairs*