

TRINIDAD AND TOBAGO: Trademark Law Now in Effect

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Trinidad and Tobago replaced its trademark legislation and regulations on June 25, 2020. The Trade Marks Act, 2015 (Act), came into effect immediately upon a presidential proclamation made that day.

While the Act was passed more than five years before (see the June 15, 2015 *INTA Bulletin*), the related regulations—the Trade Marks Regulations, 2020—were presented in Parliament on the same day that the new laws went into effect.

Despite the rapid transition, the Act and Regulations bring long-awaited changes to the country's trademark system. As in several other Commonwealth countries, the Act is highly influenced by the United Kingdom's Trade Marks Act, 1994. Local practitioners had to wait five years for the implementation. It was anticipated that the Act would allow for greater registration of nontraditional marks, expand protection of well-known marks, allow for collective marks, and increase enforcement options at the border.

The arrival of the Regulations answers many of the remaining questions concerning the Act's implementation. For example, the Act indicated trademarks must be classified according to the "prescribed system." The Regulations clarify that the current version of the Nice Classification system (11th Edition) will be used, rather than the 42-class 7th Edition of Nice in use until the Act came into effect.

As the Singapore Treaty also came into force earlier this year, the Regulations outline the use of technological improvements to the trademark system in Trinidad and Tobago, including electronic filing, electronic signatures, and an online trademark journal.

For current mark owners and applicants, the Act and Regulations provide transitional provisions for pre-existing rights. Existing registrations will automatically be registered under the Act. The prior division of the registry into Parts A and B (a division based on whether a mark was distinctive or simply capable of distinguishing) has been eliminated. Upon renewal, reclassification of marks previously registered under the local classification (pre-1994) to comply with the Nice Classification (11th Edition) will be required.

Pending applications remain pending and will be examined under the prior Act's provisions unless the applicant opts for examination under the Act. To do so, applicants must opt out by December 28, 2020, and before advertisement of the mark. Registrations that were past due when the Act commenced will be governed by the prior act, but those coming due on or after June 25, 2020, will be controlled by the Act.

Finally, the Act sets the groundwork for Trinidad and Tobago to join the Madrid System. It empowers the creation of relevant regulations to effectuate the Madrid Protocol as well as other international agreements. However, currently, the Regulations address Madrid only in a cursory manner. Amendments to the Regulations can most likely be expected should Trinidad and Tobago join the Madrid System.

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