



21 Jul
2020

Trinidad and Tobago's Trademarks Act 2015 surprises practitioners five years later

Trinidad and Tobago - [Caribbean IP](#)

- **After waiting more than five years to be implemented, the Trademarks Act 2015 became operative on 25 June 2020**
- **The Trademarks Regulations 2020 were completed only days before the law came into effect**
- **The regulations answer some longstanding questions and usher in a more modern trademark regime**

Background

Considering that Trinidad and Tobago's Trademarks Act 2015 had been waiting more than five years to be implemented, it caught many by surprise when the country's president proclaimed that the act would become immediately operative on 25 June 2020.

Since the act's passage in 2015, mark owners and practitioners had awaited the subsidiary legislation that would effectuate the new trademark system. The Trademarks Regulations 2020 were completed on 17 June 2020, only days before the law came into effect. The new act repealed the Trademarks Act, Chap 82:81, which had been in place since 1955.

Despite the quick transition, the regulations answer some long-anticipated questions and usher in a more modern trademark regime. The act takes its inspiration from the UK Trademarks Act 1994 and will feel familiar to those accustomed to the UK law or the other Commonwealth Caribbean laws it has also influenced.

Key changes

Trinidad and Tobago now has an expanded definition of 'trademark' that includes more non-traditional marks. The new definition opens the door to all signs capable of graphical representation, including sound marks, colour marks and three-dimensional marks.

The new laws also expand the protection of well-known marks during examination, invalidity and infringement actions, including by providing additional injunctive relief options. The act also clarifies that well-known status does not require registration.

The act also contains explicit provisions regarding use on the Internet. Online use is use in Trinidad and Tobago if it has a "commercial effect" in the country. The act also sets out factors to be considered when evaluating use in the country, generally related to the connection between the internet use and actual or planned commercial activities in the country, both generally and *vis-à-vis* the mark.

While the act left the classification system to be determined by the regulations, the latter prescribe the current edition of the Nice Classification. In practice, this means that Trinidad and Tobago transitioned from the seventh edition to the 11th on 25 June 2020.

The regulations establish a new fees structure for all matters, generally increasing fees for most matters. Some previously fee-free actions (such as extensions of time) will now incur an official fee.

Also of note, the regulations reflect improved communications and technology aspects at the Intellectual Property Office. Electronic filing, electronic signatures and an online trademark journal are all provided for in the regulations

The transitional provisions provide that existing registrations, previously subdivided into a two-part registry, will roll onto the new unified registry automatically. Timely renewals will be governed under the new act, but those marks that were already in the grace period or had lapsed under the repealed act will still be governed by its terms. Pending applications will be examined under the prior act unless the applicants opt into examination under the act. Opting in is irrevocable, involves a fee, and must be done on or before 28 December 2020.

Part XI of the act establishes border enforcement measures to protect registered marks. The system establishes measures to register a trademark with the customs officials in the case of expected importation of infringing goods. The customs authority may then seize alleged infringing goods and hold them temporarily, pending an infringement action. Separate subsidiary legislation - the Trademarks (Border Enforcement Measures) Regulations 2020 - effectuates the customs procedures.

Finally, although Trinidad and Tobago has not joined the Madrid System, the act and regulations set the groundwork for accession. The act empowers the promulgation of relevant regulations should Trinidad and Tobago join the Madrid System, which is expected in the future.

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