

## **New Trinidad & Tobago Trade Marks Law Implemented 25 June 2020**

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The long-awaited Trade Marks Act, No. 8 of 2015, ('the New Act') and accompanying Trade Marks Regulations, 2020, ('the Regulations') came into effect in Trinidad and Tobago on 25 June 2020.

The Act was originally passed in June 2015, but its implementation was delayed pending the finalisation of the accompanying Regulations. The Trade Marks Act, Chap. 82:81 ('the Repealed Act') has been repealed. The new official fees and forms are available on the Intellectual Property Office website at <http://ipo.gov.tt/>.

### **What's new?**

Trade mark applications can now be filed electronically and will be published through an online Trade Marks Journal, instead of in the local newspaper. These measures eliminate the need for the payment of official publication fees. Certificates will also be issued electronically. Trinidad and Tobago is now one in only a handful of Caribbean countries to modernise in this manner. It is hoped that other Caribbean countries will follow their lead, especially in light of the COVID-19 pandemic and its restrictions, which have accentuated the need for a more efficient way of working.

Under the Repealed Act, trade marks were registered in either Part A or B of the Register, Part A being for "distinctive" marks and, Part B being for marks with a lower level of distinctiveness yet "capable of distinguishing" goods or services of one proprietor from those of another. This distinction no longer exists under the New Act. Any sign which is capable of distinguishing will be accepted under the provisions of the New Act, so long as the usual absolute and relative grounds requirements are otherwise met. Trade marks registered in Parts A or B of the Register under the Repealed Act are now simply considered registered trade marks under the New Act without the former categorisation.

To the extent that non-conventional marks, such as sounds, scents and tastes, can be represented graphically and are capable of distinguishing, they are protectable under the New Act. However, in practice, the requirement for graphical representation is a challenging standard to meet for these types of marks and, therefore, it is yet to be seen how progressive this revision will be in practice.

Under the Repealed Act, Trinidad and Tobago was operating on the basis of the 7<sup>th</sup> Edition of the Nice Classification, which classifies goods and services in Classes 1 to 42. Applications filed under the New Act must now be classified in accordance with the latest version of the Nice Classification (as updated from time to time). Currently the 11<sup>th</sup> Edition of Nice is in effect. When trade marks with goods and/or services classified under the 7<sup>th</sup> Edition of the Nice Classification are renewed, they must be reclassified into the latest Edition of Nice at the same time. It is also possible to file an amendment application in order to reclassify the goods and services covered by an existing trade mark registration into the latest edition of Nice under the New Act, where reclassification is needed, at any time.

Brand owners may see a reduced number of office actions handed down under the New Act as a result of the abolishment of the archaic requirement for the association of similar / identical trade marks owned by a single proprietor. Any entry in the Register kept under the Repealed Act indicating that an existing registered mark is associated with any other mark also ceased to have effect with the implementation of the New Act. This also means that trade marks which were previously associated can be assigned separately, if desired.

The New Act also offers: enhanced protection for “well-known” marks under Article 6*bis* of the Paris Convention; protection for collective marks (protection under the Repealed Act extended to certification marks, but not collective marks); revised rules on grounds of revocation on grounds of non-use; and new criminal sanctions and enforcement measures.

### **What's next?**

Trinidad and Tobago still intends to accede to the Madrid Protocol in accordance with Section 57 of the New Act. Further Regulations will be required in order to give effect to the provisions of the Madrid Protocol once Trinidad and Tobago becomes a contracting party. In the future, it will be possible to designate Trinidad and Tobago as part of an application for International Registration or base an International Registration on a national Trinidad and Tobago trade mark application, where the applicant has a personal connection to Trinidad and Tobago (i.e. whether as a citizen, by domicile or by way of a local industrial or commercial establishment). Once Trinidad and Tobago accedes to the Madrid Protocol, it will join a small number of Caribbean Islands to do so to date, namely, Antigua and Barbuda, Cuba, the Caribbean Netherlands (BES Islands), Curacao and St. Maarten. However, it should also be noted that the French Caribbean can be protected under an International Registration designating France too, as well as a national French trade mark registration, of course.

It will be interesting to see if Trinidad and Tobago's accession to the Madrid Protocol results in a lower number of locally filed trade mark applications by brand owners and a corresponding increase in the number of office actions issued by the Intellectual Property Office as a result, as we have seen in Antigua and Barbuda.

***For more information, please contact:***



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Sophie joined HSM IP in January 2015 after working as a Solicitor specialising in Intellectual Property litigation at King & Wood Mallesons' London office (formerly SJ Berwin LLP) since March 2010. Sophie also completed her training contract at SJ Berwin LLP during the period February 2008 to February 2010 and undertook seats in the Finance, Media (with a focus on Film Finance), Intellectual Property and Corporate departments and also at Parliament under the supervision of Jonathan Djanogly MP. Sophie's portfolio includes management, advising clients on matters of trade mark, copyright, design and patent law, drafting and reviewing assignments, licences and settlement agreements and handling all IP related disputes. Sophie works on the committee responsible for drafting new IP legislation in the Cayman Islands and is also a member of the Intellectual Property Caribbean Association (IPCA), AIPLA and MARQUES.