

THE TRADE MARKS REGULATIONS, 2020

Explanatory Memorandum

The Trade Marks Regulations, 2020 which is subject to the negative resolution of Parliament seeks to provide for the effective regulation of matters under the Trade Marks Act, No. 8 of 2015 (“the Act”) which was assented to on the 12th of June 2015. These Regulations seek to modernize the current trade mark legislation to meet international norms and practices in accordance with international treaties and conventions. The Trade Marks Regulations, 2020 is in tandem with the Singapore Treaty on the Law of Trademarks, for which Trinidad and Tobago deposited the instrument of accession on October 4, 2019. The Singapore Treaty on the Law of Trademarks in particular, brings harmonization of administrative trade mark registration procedures especially in the field of communication technologies. As such, the Trade Marks Regulations, 2020 seeks to establish the electronic online system to facilitate, *inter alia*, the electronic filing of trade marks. The Trade Marks Regulations, 2020 seeks to provide users with more efficient, cost-effective operations and convenient delivery of services as it pertains to trade mark matters.

Part I: (Preliminary) contains regulations 1 to 11. It includes provisions regarding the citation of the Regulations, various definitions, the method for the filing of documents and the relevant forms.

Regulation 5 allows the Controller to approve and publish the forms to be used for any purpose relating to the registration of a trade mark or any other proceedings before the Controller under the Act, the Controller’s directions relating to the use of any form, and any amendment or modification of any such form or direction.

Regulation 8 provides for the various means regarding the service of documents by the Intellectual Property Office to respective parties, the serving of documents on the Intellectual Property Office by any party, and the service of documents between parties.

Part II (Registration of Trade Marks) contains regulations 12 to 39.

Division 1 (Registrability of Trade Marks) includes provisions regarding the protection of the National Emblems of Trinidad and Tobago and other protected emblems.

Regulation 12 permits the Controller to refuse trade marks containing any representation of the President.

Regulation 13 allows the Controller to refuse the registration of trade mark applications containing the representation of the National Emblems, and the words “Trinidad and Tobago Government” without the requisite authority or consent. Regulation 13 also allows the Controller to refuse the registration trade mark applications containing the words “Red Cross” or “Geneva Cross” and any representation of the Red Cross or Geneva Cross, without the requisite authority or consent.

Regulation 14 allows the Controller to refuse the registration of a trade mark containing armorial bearings, state emblems, insignia, official signs, orders of chivalry, decorations, flags or devices of any state, without the requisite consent.

Division 2 (Application for Registration) includes provisions regarding the requirements for applications for the registration of trade marks, the division of applications, priority claims, specification of classes, translations and transliterations, and deficiencies in applications.

Regulation 16 provides for the manner of representation of trade marks in the application form ensuring that applicants provide a clear indication as to the nature of the mark. Regulation 16 also permits the Controller the power to request the applicant to provide further information regarding the representation. The Act, grants the registration of non-conventional marks including sounds, scents and touch pursuant to the definition of a trade mark in section 2 of the Act which specifies that trade marks are any sign capable of being represented graphically. As such, these Regulations will ensure that all trade mark applications, including applications for non-conventional trade marks, meet the requirements of the Office.

Division 3 (Amendment of Application) provides for the amendment to trade mark applications.

Division 4 (Examination of Application for Registration) provides for the Examination Report by the Trade Mark Examiners at the Office and the responses by applicants.

Division 5 (Publication) provides for the publication of applications once accepted by the Office.

Regulation 25 provides for publication through the Trade Marks Journal which will be an online Journal created and published by the Office on the Office's website.

Division 6 (Opposition to Registration) includes provisions regarding the Opposition procedures to oppose the registration of a trade mark once published.

Regulation 26 and 27 provides for the Notice of Opposition and its contents respectively.

Regulation 28 provides for the filing of the Counter-statement.

Regulation 29 provides for the filing of Evidence in support of the opposition.

Regulation 30 provides for the filing of Evidence in support of the application.

Regulation 31 provides for the filing of Evidence in reply by the opponent.

Regulation 32 provides for the filing of any further Evidence.

Regulation 33 provides for the filing of Exhibits.

Regulation 34 provides for the filing of the Original Exhibits.

Regulation 35 provides for the Opposition Hearing before the Controller.

Regulation 36 provides for the Controller's decision in opposition proceedings.

Regulation 37 addresses Extensions of Time in Opposition proceedings.

Division 7 (Registration) provides for the Certificates of Registration issued by the Controller for trade marks that attain registration.

Part III (Register) contains regulations 40 to 46. It includes provisions regarding particulars to be entered in the Register, disclaimers and limitations, removal of matters from the Register, and Certificates of Validity.

Regulation 40 provides for the various particulars to be entered in the Register in respect of each registered trade mark.

Regulation 41 provides for the procedure for the filing of disclaimers or limitations.

Regulation 44 provides for the procedure for the removal of any matter from the Register by the Controller.

Regulation 45 provides for the entry of Certificates of Validity in the Register, where Court has certified, in accordance with section 118 of the Act, No. 8 of 2015, that a registered trade mark has been validly registered.

Part IV (Renewal of Registration of Trade Mark) contains regulations 47 to 51 and includes provisions regarding the Renewal of Registration of a trade mark.

Regulation 47 provides for the procedure regarding the renewal of a trade mark.

Regulation 48 provides for the issuance of a Notice of Renewal by the Controller six (6) months before the date of expiry of the registration of a trade mark.

Regulation 50 permits the Controller to remove a trade mark from the Register for non-renewal or failure to comply with the requirements for renewal.

Regulation 51 provides the procedure for a party to apply for restoration of a trade mark that was removed from the Register.

Part V (Registrable Transactions) contains regulations 52 and 53 and includes provisions pertaining to the process regarding registrable transactions.

Regulation 52 provides for the prescribed particulars of a transaction to be entered in the Register.

Regulation 53 provides the procedure for an application to register particulars of a transaction or to give notice of a transaction to the Controller.

Part VI (Alteration of Registered Trade Mark) contains regulation 54. It includes provisions regarding the alteration of registered trade marks.

Part VII (Revocation, Invalidation, Rectification and Cancellation) contains regulations 55 to 59. It includes provisions regarding the revocation, invalidation, rectification, and cancellation of trade marks.

Regulation 55 provides for the procedure for parties to apply for the revocation, invalidation, and rectification of trade marks.

Regulation 56 provides for the filing of Counter-statement in the said proceedings.

Regulation 57 provides for further procedures in the said proceedings.

Regulation 58 provides for intervention by third parties in the proceedings.

Regulation 59 provides for the procedure for the proprietor to apply for the cancellation of their trade mark from the Register.

Part VIII (Collective Marks and Certification Marks) contains regulations 60 to 64. It includes provisions regarding collective and certification marks.

Regulation 60 provides for the application process regarding collective and certification marks.

Regulation 61 provides for the filing of rules in relation to collective and certification marks.

Regulation 62 provides for the opposition procedure regarding the registration of collective and certification marks.

Regulation 63 provides for the amendment of the rules governing the use of a registered collective mark or certification mark.

Regulation 64 provides for the opposition procedures to the amendment of rules of a registered collective mark or certification mark.

Part IX (Evidence and Procedure) contains regulations 65 to 69. It includes provisions regarding the filing of evidence and other procedures in relation to hearings before the Controller.

Regulation 65 provides for the right of affected parties to be heard.

Regulation 66 provides for the Controller to hear any dispute relating to any matter under the Act or the Regulations.

Regulation 67 provides for the manner in which evidence is filed before the Controller in relation to any matter under the Act or the Regulations.

Part X (Costs) contains regulations 70 and 71. It includes provisions regarding costs.

Part XI (Extension of Time and Reinstatement of Applications, Rights and Other Matters) contains regulations 72 to 75. It includes provisions regarding extensions of time, reinstatement of applications, reinstatement of rights and other matters.

Regulation 72 provides for the procedure regarding extensions of time.

Regulation 74 provides for the procedure regarding the reinstatement of a trade mark application and the reinstatement procedure for any rights that have been abrogated under any proceedings pursuant to the Act or the Regulations.

Part XII (Electronic Online System) contains regulations 76 to 83. It includes provisions regarding the creation of the Electronic Online System.

Regulation 76 provides for the establishment of the Electronic Online System.

Regulation 77 provides for the registration of account holders with the Controller.

Regulation 78 provides for the assignment of an identification name and authentication code to account holders.

Regulation 79 provides for the obligation of account holders to inform the Controller of any change in their particulars which were furnished in the application for the registration as an account holder.

Regulation 81 provides for account holders to only use the electronic online system in accordance with the Regulations and any practice directions issued by the Controller.

Regulation 82 provides for the cancellation of an account and any identification name or authentication code of an account holder by the Controller under the Electronic Online System.

Part XIII (Hours of Business and Excluded Days) contains regulations 84 and 85. It includes provisions regarding the hours of business, excluded days and the extension of periods of time should there be a disruption in normal operations.

Part XIV (Miscellaneous) contains regulations 86 to 93. It includes provisions regarding General Certificates, appeals, irregularities, correction of clerical errors, applications to the Court, Orders of the Court and Trade Marks Journal.

Regulation 86 provides for the issuance of General Certificates by the Controller.

Regulation 89 provides for the appeal of the Controller's decisions to the High Court of Justice.

Regulation 90 provides for the correction of irregularities and clerical errors.

Regulation 93 provides for the Trade Marks Journal which is an electronic journal.

Part XV (Transitional Provisions) contains regulations 94 and 95.

Regulation 94 deals with pending applications for registration under the revoked Trade Marks Act and the opposition proceedings regarding same.

Regulation 95 is a savings clause with regard to time periods prescribed by the revoked Trade Marks Rules.

The First Schedule provides for the fees regarding all matters under the Regulations.

The Second Schedule provides for the Description of the Forms used under the Regulations.

The Third Schedule provides for the Scale of Costs in relation to all proceedings under the Act and the Regulations.

TRADE MARKS REGULATIONS, 2020

Arrangement of Regulations

Regulations

PART I

PRELIMINARY

1. Citation
2. Interpretation
3. Fees
4. Filing of documents
5. Forms
6. Size of documents
7. Signature on documents
8. Service of documents
9. Furnishing of address
10. Address for service
11. Agents

PART II

REGISTRATION OF TRADE MARKS

Division 1—Registrability of Trade Marks

12. Representation of President
13. Trinidad and Tobago National Emblems, etc.
14. Registration of mark consisting of armorial bearings, etc.

Division 2—Application for Registration

15. Application for registration
16. Representation of trade marks
17. Division of application for registration
18. Claim to priority
19. Specification
20. Translation and transliteration
21. Deficiencies in application

Division 3—Amendment of Application

22. Amendment of application
23. Amendment of application after publication

Division 4—Examination of Application for Registration

24. Examination report and applicant's response

Division 5—Publication

25. Publication of application

Division 6—Opposition to Registration

26. Notice of opposition
27. Contents of notice of opposition
28. Counter-statement
29. Evidence in support of opposition
30. Evidence in support of application
31. Evidence in reply by opponent
32. Further evidence
33. Exhibits
34. Original exhibits
35. Opposition hearing
36. Controller's decision in opposition proceedings
37. Extension of time in opposition proceedings
38. Costs in uncontested oppositions

Division 7—Registration

39. Certificate of registration

PART III

REGISTER

40. Entry in Register of particulars of registered trade mark
41. Registration subject to disclaimer or limitation
42. Application to change name or address in Register
43. Death of applicant before registration
44. Removal of matter from Register
45. Certificate of validity
46. Extract from Register

PART IV

RENEWAL OF REGISTRATION OF TRADE MARK

47. Renewal of registration
48. Notice of renewal
49. Notice of non-compliance
50. Removal of trade mark from Register
51. Restoration of registration

PART V

REGISTRABLE TRANSACTIONS

52. Entry in Register of particulars of registrable transactions
53. Application to register or give notice of transaction

PART VI

ALTERATION OF REGISTERED TRADE MARK

54. Application to alter registered trade mark

PART VII

REVOCATION, INVALIDATION, RECTIFICATION AND CANCELLATION

55. Application for revocation, declaration of invalidity and rectification
56. Counter-statement
57. Further procedure
58. Intervention by third parties
59. Application to cancel registered trade mark or registration in relation to certain goods or services

PART VIII

COLLECTIVE MARKS AND CERTIFICATION MARKS

60. Application of Regulations to collective marks and certification marks
61. Filing of rules
62. Opposition to registration
63. Amendment of rules
64. Opposition to amendment of rules

PART IX

EVIDENCE AND PROCEDURE

- 65. Right of affected party to be heard
- 66. Hearing before Controller to be in public
- 67. Evidence in proceedings before Controller
- 68. Statutory declarations
- 69. Notice of seal of officer taking declaration

PART X

COSTS

- 70. Application for costs
- 71. Scale of costs

PART XI

EXTENSION OF TIME AND REINSTATEMENT OF APPLICATIONS, RIGHTS
AND OTHER MATTERS

- 72. Request for extension of time
- 73. Where non-compliance with time caused by act of person employed
in the Intellectual Property Office
- 74. Reinstatement of application, right or other matter
- 75. Change of commencement date of period for filing evidence

PART XII

ELECTRONIC ONLINE SYSTEMS

- 76. Establishment of electronic online system
- 77. Registration as account holder
- 78. Identification name and authentication code
- 79. Obligation to inform Controller of change of particulars
- 80. Security measures
- 81. Duty of person using electronic online system
- 82. Cancellation of registration as account holder
- 83. Documents to be signed, made on oath or attested

PART XIII

HOURS OF BUSINESS AND EXCLUDED DAYS

- 84. Hours of business and excluded days
- 85. Extension of period where interruption in postal service or
operations

PART XIV

MISCELLANEOUS

86. General certificates by Controller
87. Case management conference
88. Production of documents, information or evidence
89. Irregularities and correction of clerical errors
90. Appeal
91. Application to Court
92. Order of Court
93. Trade Marks Journal

PART XV

TRANSITIONAL PROVISIONS

94. Pending applications for registration
95. Savings
96. Commencement

FIRST SCHEDULE—FEES

SECOND SCHEDULE—DESCRIPTION OF FORMS

THIRD SCHEDULE—SCALE OF COSTS

LEGAL NOTICE NO. 137

REPUBLIC OF TRINIDAD AND TOBAGO

TRADE MARKS ACT, 2015

REGULATIONS

MADE BY THE MINISTER UNDER SECTION 123 OF THE TRADE MARKS ACT,
IN ACCORDANCE WITH SECTION 43 OF THE INTERPRETATION ACT,
CHAP. 3:01 AND SUBJECT TO NEGATIVE RESOLUTION OF PARLIAMENT

THE TRADE MARKS REGULATIONS, 2020

PART I

PRELIMINARY

1. These Regulations may be cited as the Trade Marks Regulations, Citation
2020.

2. (1) In these Regulations—

Interpretation

“account holder” means a person registered as an account holder
by the Controller under regulation 77;

“Act” means the Trade Marks Act;

Act No. 8 of
2015

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

“authentication code” means an identification or identifying code,
password or any other authentication method or procedure
that may be assigned to or approved for an account holder by
the Controller;

“Controller” means the Controller of the Intellectual Property
Office as referred to under section 3(2) of the Patents Act; Chap. 82:76

“electronic online system” means the electronic online system
established under regulation 76;

“folio” means one hundred words, with each figure being counted
as one word;

“former Act” means the Trade Marks Act repealed by section 141
of the Act; Chap. 82:81

“identification name” means an identification name assigned to
an account holder by the Controller under regulation 78;

“Intellectual Property Office” means the Intellectual Property
Office established under section 3(1) of the Patents Act;

“specification” means the specification of goods or services in respect of which—

(a) a trade mark; or

(b) a transaction in relation to a registered trade mark or an application for the registration of a trade mark,

is registered or proposed to be registered;

“National Emblems” has the meaning assigned under the National Emblems of Trinidad and Tobago (Regulation) Act;

Chap. 19:04

“Trade Marks (International Registration) Regulations” means the Trade Marks (International Registration) Regulations made under section 57 of the Act;

“Trade Marks Journal” means the journal by that name published under regulation 93.

(2) Unless the context otherwise requires, the word “month”, wherever it occurs in any decision, direction or other document issued by the Controller, means calendar month.

(3) Any period of time fixed by these Regulations or by any decision, direction or other document for the doing of any act shall be reckoned in accordance with subregulations (4), (5) and (6).

(4) Where the act is required to be done within a specified period from or after a specified date, the specified period begins immediately after that date.

(5) Where the act is required to be done within or not less than a specified period before a specified date, the period ends immediately before that date.

(6) Where the act is required to be done within a specified number of clear days before or after a specified date, at least that number of days shall intervene between the day on which the act is done and that date.

Fees First
Schedule

3. (1) The fees specified in the First Schedule are payable to the Controller in respect of the matters specified in that Schedule.

(2) Any fee in the First Schedule shall be paid at the same time as the filing of the matter in question.

Filing of
documents

4. (1) The Controller may refuse to accept or process any document filed at the Intellectual Property Office that fails to comply with the Act or these Regulations.

(2) A document filed at the Intellectual Property Office shall—

- (a) be in English; or
- (b) where the document is not in English, be accompanied by an English translation of the document.

(3) A document filed at the Intellectual Property Office which is not filed using the electronic online system shall—

- (a) be filed using durable paper; and
- (b) be in writing that is legible and permanent.

(4) Where the Controller refuses to accept any document that does not comply with subregulation (2) or (3), the Controller shall give the applicant a notice stating the manner in which the document does not comply with subregulation (2) or (3), as the case may be.

(5) Where any document filed at the Intellectual Property Office is a copy, the Controller may—

- (a) decide whether to accept or process the document; and
- (b) require the original to be filed with the Intellectual Property Office within one month.

(6) The Controller may require the filing of a hard copy of a document filed using the electronic online system.

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

- (a) the approved forms to be used for any purpose relating to the registration of a trade mark or any other proceedings before the Controller under the Act;
- (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 regulation 4(2) and 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—

Second
Schedule

- (a) described in the Second Schedule; and
- (b) published in the Trade Marks Journal.

Size of
documents

6. Subject to any directions that may be given by the Controller, all forms, notices and other documents required or authorized by the Act or these Regulations to be given or sent to, filed with or served on the Controller, other than by means of the electronic online system, shall be given, sent, filed or served using letter size paper.

Signature of
documents

7. (1) A document to be signed for or on behalf of a partnership shall be signed by—

- (a) any partner or associate or secretary or senior officer stating that he signs on behalf of the partnership; or
- (b) any other person who satisfies the Controller that he is authorised to sign the document on behalf of the partnership.

(2) A document to be signed for or on behalf of a body corporate shall be signed by a director or secretary or other senior officer of the body corporate, or by any other person who satisfies the Controller that he is authorised to sign the document on behalf of the body corporate.

(3) A document to be signed by or on behalf of an unincorporated body or association of persons may be signed by any person who appears to the Controller to be authorised to sign.

(4) For the purposes of this regulation, “document” means a document to be given or sent to, filed with or served on the Controller in respect of any matter under the Act or these Regulations.

Service of
documents

8. (1) Where the Act or these Regulations authorise or require any document to be given or sent to, filed with or served on the Controller or Intellectual Property Office, the giving, sending, filing or service may be effected on the Controller or Intellectual Property Office by—

- (a) personal delivery;
- (b) facsimile transmission, where the original of the document transmitted is filed with the Controller within one month of the transmission; or

(c) electronic communication, by sending an electronic communication of the document using the electronic online system.

(2) Where the Act or these Regulations authorise or require any document to be given or sent to or served on any party other than the Controller or Intellectual Property Office, the giving, sending or service may be effected on that party by—

- (a) sending the document by personal delivery;
- (b) facsimile transmission, where the original of the document transmitted shall be sent or served within one month of the transmission; or
- (c) electronic communication.

(3) Where the Act or these Regulations authorise or require any notice or other document to be given or sent to or served on any party by the Controller or Intellectual Property Office, the Controller or Intellectual Property Office may effect the giving, sending or service on the party—

- (a) by sending the notice or other document by personal delivery;
- (b) by sending the notice or other document by facsimile transmission where the original of the document so transmitted is sent to or served by the Controller within one month of such transmission; or
- (c) by electronic communication, by sending an electronic communication of the notice or other document using the electronic online system.

(4) Where any person has attempted to send any document by facsimile transmission under subregulation (1), the date of transmission of an application for registration transmitted by facsimile transmission shall be the date of application, where the original of the application is received by the Controller within one month.

(5) Notwithstanding the availability of an address for service filed in accordance with regulation 10, where any notice or other document to be given, sent or served by the Controller or Intellectual Property Office, is sent to a person by electronic communication using the electronic online system under subregulation (3)(c), it shall be taken to have been duly given, sent to or served on the person.

(6) Service of any notice or other document under the Act or these Regulations on a person by electronic communication using the electronic online system may be effected only if the person is registered as an account holder in accordance with regulation 77.

(7) This regulation shall not apply to notices and documents to be served in proceedings in court.

(8) For the purpose of this regulation, “personal delivery” includes delivery by hand or by post.

Furnishing of
address

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.

(2) The Controller may require the address to include the name of the street, the number of the block of building, the number of the premises or name of premises, if any, and the postal code.

Address for
service

10. (1) For the purposes of any proceedings before the Controller, an address for service in Trinidad and Tobago shall be filed in accordance with subregulation (2) or (5) by or on behalf of—

- (a) an applicant for registration of a trade mark;
- (b) a person opposing an application for registration of a trade mark;
- (c) an applicant applying to the Controller under section 23 of the Act for the revocation of registration of a trade mark, under section 24 of the Act for a declaration of invalidity of the registration of a trade mark, or under section 85 of the Act for the rectification of the Register;
- (d) every person granted leave to intervene under regulation 58;
- (e) every proprietor of a registered trade mark which is the subject of an application to the Controller for the revocation of the registration of the mark, a declaration of invalidation of the registration, or the rectification of the Register; and
- (f) every other party to any proceedings before the Controller.

(2) Where a form is required to be filed under these Regulations for any matter in relation to the proceedings, being a form, which requires the furnishing of an address for service, the address for service shall be filed on that form.

(3) The filing of an address for service in accordance with subregulation (2) shall be effective only for the matter for which the form is filed.

(4) Notwithstanding subregulation (3)—

- (a) where the address for service is filed on Form TM 2 or TM 12, the filing of the address for service shall be effective for the purposes of all proceedings in respect of the trade mark in relation to which that form is filed;
- (b) where the address for service is filed on Form TM 6, TM17 or TM 18, the filing of the address for service shall be effective for the purposes of the proceedings in relation to which that form is filed; and
- (c) where the address for service is filed on Form TM 9 or TM 13, the filing of the address for service shall be effective for the purposes of all renewal applications or proceedings in respect of the trade mark in relation to which that form is filed.

(5) In a case where subregulation (2) or (4) does not apply, the address for service shall be filed on Form TM 1.

(6) Where an address for service is not filed as required by subregulation (1), the Controller may send to the person concerned notice to file an address for service within two months from the date of the notice and if that person fails to do so—

- (a) in the case of an applicant referred to in sub-regulation (1)(a) or (c), the application shall be treated as withdrawn;
- (b) in the case of a person referred to in subregulation (1)(b) or (d), he shall be deemed to have withdrawn from the proceedings in question; and
- (c) in the case of the proprietor referred to in sub-regulation (1)(e) or a party referred to in subregulation (1)(f), he shall not be permitted to take part in the proceedings in question.

(7) An application requesting the Controller to alter an address for service shall be made on Form TM 1.

(8) Anything sent to, or served on, a person at his address for service shall be taken to have been duly sent to, or served on, the person.

(9) Subject to any filing to the contrary under subregulation (1) or (7) or regulation 42, the Controller—

- (a) may treat the address for service of an applicant for registration of a trade mark as that of the proprietor upon registration of that trade mark; and
- (b) may treat the trade or business address in Trinidad and Tobago of a person as his address for service.

Agents

11. (1) The Controller, in dealing with any matter under the Act or these Regulations in respect of which a person has been authorised to act as an agent on behalf of another, may require the personal signature of either the agent or his senior officer.

(2) The Controller may, by notice in writing sent to an agent, require the agent to produce evidence of his authority.

(3) Where a person who has become a party to any proceedings before the Controller appoints an agent for the first time or substitutes one agent for another, the newly appointed agent shall file with the Controller in Form TM 1 his name together with an address for service in Trinidad and Tobago.

(4) Regulations 10(2) to (5) and (7) shall, with the necessary modifications, apply in relation to the filing by an agent of his name and address for service under subregulation (3).

(5) Where there is a change in the name or address for service of an agent or both and the agent remains the same legal entity after such change, the agent may file one Form TM 1 in respect of such change in name or address for service or both for all the matters under the Act for which the agent has been appointed.

(6) Any act required or authorised by the Act in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may not be done by or to the newly appointed agent referred to in subregulation (3) until he has complied with that subregulation or, in the case of a change in the name or address for service of the agent or both, until he has filed Form TM 1 in respect of such change.

PART II

REGISTRATION OF TRADE MARKS

Division 1—Registrability of Trade Marks

Representation
of President

12. The Controller shall refuse to register a trade mark which consists of or contains any representation of the President or any colourable imitation thereof.

Trinidad and
Tobago
National
Emblems, etc.

13. The Controller shall refuse to register a trade mark which consists of or contains—

- (a) any representation of the National Emblems, or of any crest, armorial bearing, insignia, or device so nearly resembling any of the foregoing as to be likely to be mistaken for them;

- (b) the words “Trinidad and Tobago Government”, or any word, letter or device if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had the Trinidad and Tobago Government’s patronage or authorisation, whether or not such be the case; or
- (c) the words “Red Cross” or “Geneva Cross”, any representation of the Red Cross or Geneva Cross, any representation of the Swiss Federal cross in white on a red background or silver on a red background, or any representation similar to any of the foregoing,

unless it appears to the Controller that consent to its registration and use of the person or authority entitled to give consent has been obtained.

14. (1) Where a representation of the name, initials, abbreviation of the name, armorial bearings, state emblems, insignia, official signs, orders of chivalry, decorations, flags or devices of any state, settlement, city, borough, town, place, society, body corporate, government body, statutory board, institution or person appears on a trade mark which is the subject of an application for registration, the Controller, before proceeding to register the mark, may require the applicant to furnish the Controller with the consent to the registration and use of the matter in question of such official or other person as appears to the Controller to be entitled to give consent.

(2) The Controller shall refuse to register the mark if no such consent is furnished within the time specified by the Controller.

Division 2—Application for Registration

15. An application for the registration of a trade mark shall be made on Form TM 2 (referred to in this Part as “the application form”) and shall contain a clear indication of the nature of the mark.

16. (1) The applicant shall provide a clear and durable representation of the mark in the space provided for that purpose in the application form.

(2) Where the representation exceeds the space in size, the representation shall be provided on a separate sheet of paper to be annexed to the application form.

(3) Where an application is for the registration of a series of trade marks, a representation of each trade mark in the series shall be provided in the application form.

(4) Where the Controller reasonably believes that the representation provided by the applicant does not sufficiently show the particulars of the mark or does not allow all features of the mark to be properly examined, the Controller may, by notice in writing, require the applicant to provide, within such time as the Controller may specify in the notice, any or all of the following:

- (a) another representation of the mark consisting of a single view of the mark or of several different views of the mark;
- (b) a description of the mark expressed in words;
- (c) such other information as the Controller may require.

(5) The Controller may at any time, if dissatisfied with any representation of a trade mark, require another representation satisfactory to him to be filed before proceeding with the application, and the applicant shall substitute the representation by filing with the Controller Form TM 16.

Division of
application for
registration

17. (1) Subject to the provisions of this regulation, an application for registration of a trade mark (referred to in this regulation as the original application) may, at the request of the applicant made on Form TM 4 at any time after the date of the original application but before the registration of the trade mark, be divided into two or more separate applications for registration of the trade mark.

(2) Where the original application is made in respect of two or more goods or services, a request under subregulation (1) may be made to divide the original application into two or more separate applications, each in respect of—

- (a) one or more classes of those goods or services, being classes of goods or services to which the original application relates;
or
- (b) one or more of those goods or services included in one or more of the classes of goods or services to which the original application relates.

(3) Where the applicant makes a request under subregulation (1), the request shall contain, for each separate application and each class of goods or services in respect of which that separate application is made, a specification in accordance with regulation 19 setting out the goods or services to which that separate application relates.

(4) Upon the division of the original application into two or more separate applications—

- (a) each separate application shall have the same date as the original application;

- (b) any notice of opposition to the registration of any trade mark which is a subject of the original application shall—
- (i) if the notice relates only to some, but not all, of the goods or services in respect of which the original application is made, be treated as having been given in relation only to each separate application made in respect of any of the goods or services to which the notice relates; or
 - (ii) subject to subparagraph (i), be treated as having been given in relation to all of the separate applications, and the opposition proceedings shall continue as if the notice had been so given; and
- (c) any notice given to the Controller under section 43(3) of the Act shall—
- (i) if the notice relates only to some (but not all) of the goods or services in respect of which the original application is made, be treated as having been given in relation only to each separate application made in respect of any of the goods or services to which the notice relates; or
 - (ii) subject to subparagraph (i), be treated as having been given in relation to all of the separate applications.

18. (1) Where a right of priority is claimed by reason of an application^{Claim to} for the registration of a trade mark filed in a Convention country under^{priority} section 11 of the Act or in another country or territory in respect of which provision corresponding to that set out in section 11 of the Act is made under section 12 of the Act (referred to in this regulation as “the priority application”), particulars of that claim shall be included in the application form at the time of filing the application form.

- (2) The particulars referred to in subregulation (1) are—
- (a) the country or territory in which—
 - (i) the priority application; or
 - (ii) where there is more than one priority application, each priority application, was filed;
 - (b) the date on which—
 - (i) the priority application; or
 - (ii) where there is more than one priority application, each priority application, was filed;

- (c) where the right of priority is claimed in respect of one or more, but not all of the goods or services for which registration was sought in the priority application, the goods or services in respect of which the right of priority is claimed; and
- (d) where the right of priority is claimed through more than one priority application, the goods or services in respect of which the right of priority is claimed through each priority application.

(3) The Controller may require the applicant, who claims priority in accordance with regulation 18(1) and (2) to furnish the certified copy of the application for the priority of which is claimed within three months from the filing date of the present application verifying to the satisfaction of the Controller—

- (a) the date of filing of the priority application;
- (b) the country or territory, or the registering or competent authority;
- (c) the representation of the mark; and
- (d) the goods and services covered by the priority application.

(4) Where the certified copy referred to in subregulation (3) is not in the English language, there shall be annexed to the certified copy a translation in English of the contents of the certified copy certified or verified to the satisfaction of the Controller.

Specification 19. (1) Goods and services shall be classified for the purposes of the registration of trade marks in accordance with the International Classification as in force on the date of the application for registration of the trade mark.

(2) Every application shall contain, for each class of goods or services to which the application relates—

- (a) the class number as set out in the International Classification as in force on the date of that application; and
- (b) a specification of those goods or services which—
 - (i) is appropriate to that class;
 - (ii) is described in such a manner as to indicate clearly the nature of those goods or services; and
 - (iii) complies with any other requirement of the Controller.

(3) An application may be made in respect of more than one class of goods or services as set out in the International Classification as in force on the date of that application, and in such a case, the specification shall set out the classes in consecutive numerical order and list under each class the goods or services to which the application relates.

20. (1) Where a trade mark contains or consists of a word or words in characters other than Roman, or in a language other than English, there shall, unless the Controller otherwise directs, be endorsed on the application form—^{Translation and transliteration}

- (a) a translation and, if the case requires, a transliteration, in English, of each word and of the words taken together as a whole to the satisfaction of the Controller; and
- (b) the language to which each word belongs.

(2) The Controller may, at any time, require a copy of the translation or transliteration, certified or verified to the satisfaction of the Controller, to be filed with the Controller.

21. (1) Where an application for registration of a trade mark does not satisfy any requirement under section 5(2) or (3) of the Act, the Controller shall send the applicant a notice requiring the applicant to remedy the deficiency.^{Deficiencies in application}

(2) Where the Controller has sent the applicant a notice under subregulation (1), the applicant shall remedy all deficiencies set out in the notice within six months from the date of the notice or the application shall be treated as withdrawn.

(3) In accordance with section 5(4) of the Act, an application for registration of a trade mark shall not be treated as made unless—

- (a) all the requirements under section 5(2) of the Act have been satisfied; and
- (b) all the fees payable under section 5(3) of the Act—
 - (i) have been paid; or
 - (ii) are treated by the Controller as paid.

(4) Subject to subregulation (1), where an application for registration does not comply with regulation 15(1) or 19(2)(a), the Controller shall send the applicant a notice requiring the applicant to remedy the deficiency.

(5) If the applicant fails to remedy all deficiencies set out in the notice under subregulation (4) within six months from the date of the notice, the application shall be treated as withdrawn.

Division 3—Amendment of Application

Amendment of application 22. (1) An application to amend an application for registration shall be made on—

- (a) Form TM 14, if it is made to correct or change the name or other particulars of the applicant, and the change does not affect the representation of the trade mark;
- (b) Form TM 15, if paragraph (a) does not apply and the amendment, or any of the amendments, pertains to—
 - (i) the class number or specification of any goods or services to which the application for registration relates; or
 - (ii) the particulars of any claim to a right of priority included in the application for registration; or
- (c) Form TM 16, if subparagraphs (a) and (b) do not apply.

(2) Before acting on an application to amend an application for registration, the Controller may require the applicant to furnish such proof as the Controller thinks fit.

Amendment of application after publication 23. (1) Where an application is made for an amendment of an application for registration which has been published, and the amendment affects the representation of the trade mark or the goods or services covered by the application for registration, the amendment or a statement of the effect of the amendment shall also be published.

(2) Any person who wishes to oppose the amendment shall, within three months from the date of publication of the amendment or statement referred to in subregulation (1), file with the Controller a notice of opposition to the amendment in Form TM 6.

(3) The notice of opposition shall contain a statement of the grounds upon which the person opposes the amendment, including, where relevant, how the amendment would be contrary to section 15(3) of the Act.

(4) Regulations 26 and 28 to 38 shall apply with the necessary modifications to any proceedings arising from the notice of opposition.

(5) For the purposes of the application of the regulations referred to in subregulation (4)—

- (a) any reference to the application for registration shall be read as a reference to the application for amendment referred to in subregulation (1);

- (b) any reference to the date of publication of the application for registration shall be read as a reference to the date of publication of the amendment or statement referred to in subregulation (1);
- (c) any reference to the notice of opposition shall be read as a reference to the notice of opposition referred to in sub-regulations (2) and (3); and
- (d) any reference to the opponent shall be read as a reference to the person referred to in subregulations (2) and (3).

Division 4—Examination of Application for Registration

24. (1) If, in the course of an examination of an application for registration, it appears to the Controller that the requirements for registration are not met or that additional information or evidence is required to meet those requirements, the Controller shall give a written notice of this to the applicant.

(2) If, within three months from the date of the written notice of the Controller, the applicant fails to—

- (a) make representations in writing;
- (b) apply to the Controller for a hearing;
- (c) apply to amend the application; or
- (d) furnish the additional or any other information or evidence,

the application shall be treated as withdrawn.

(3) If the applicant requests a hearing to make representations, the Controller shall give notice to the applicant of a date on which he will hear the applicant's arguments.

(4) For the purposes of the hearing, the applicant shall file with the Controller his written submissions and bundle of authorities at least fourteen days before the date of the hearing.

(5) The decision of the Controller, in respect of the representations of the applicant given either during the hearing or in writing, shall be communicated to the applicant in writing or in such other manner as the Controller thinks fit.

(6) Where the applicant wishes to appeal against the decision of the Controller—

- (a) the applicant shall, within one month from the date of the decision, by filing Form TM 3 with the Controller, request the Controller to state the Controller's grounds of decision; and

(b) the Controller shall, within two months from the date of the request, send the grounds of decision to the applicant.

(7) The date on which the Controller's grounds of decision are sent to the applicant shall be deemed to be the date of the Controller's decision for the purpose of an appeal to the High Court.

Division 5—Publication

Publication of applicaiton 25. (1) An application which has been accepted for registration shall be published in the Trade Marks Journal at such times and in such manner as the Controller may direct.

(2) In the case of an application with which the Controller proceeds only after the applicant has lodged the written consent to the proposed registration of the proprietor of, or the applicant for the registration of, another trade mark, the words "By Consent" and the number of that other mark shall appear in the publication.

(3) In the case of an application for the registration of a series of trade marks, the Controller may, if he thinks fit, publish, together with the publication of the application, a statement of the manner in which the several trade marks differ from one another.

Division 6—Opposition to Registration

Notice of opposition 26. A person (referred to in this Division as "the opponent") may, within three months from the date of publication of the application for registration, file with the Controller a notice opposing the registration in Form TM 6 (referred to in this Division as a "notice of opposition") and shall forthwith serve a copy of the notice of opposition on the applicant.

Contents of notice of opposition 27. The notice of opposition shall contain a statement of the grounds upon which the opponent opposes the registration.

Counter-statement 28. (1) Within two months from the date of receipt of the copy of the notice of opposition from the opponent, the applicant shall file with the Controller a counter-statement in Form TM 7 and shall forthwith serve a copy of the counter-statement on the opponent (referred to in this Division as "the counter-statement") setting out—

- (a) the grounds on which he relies as supporting his application; and
- (b) the facts alleged in the notice of opposition which he admits, if any.

(2) If the applicant does not comply with subregulation (1), he shall be deemed to have withdrawn his application, unless he obtains an extension of time.

(3) A request for an extension of time to file the counter-statement shall be made by the applicant to the Controller, in writing, within two months from the date of receipt of the notice of opposition from the opponent.

(4) The total extension of time which the Controller may allow to file the counter-statement shall not exceed four months from the date of receipt by the applicant of the notice of opposition.

29. (1) Within two months from the date of receipt of the counter-statement from the applicant, the opponent shall file with the Controller a statutory declaration setting out the evidence he wishes to adduce in support of his opposition. ^{Evidence in support of opposition}

(2) When the opponent files his statutory declaration with the Controller, the opponent shall forthwith send to the applicant a copy of the statutory declaration.

(3) If the opponent fails to comply with subregulation (1) or (2), he shall be treated as having withdrawn his opposition, unless he obtains an extension of time.

(4) Subject to subregulation (5), a request by the opponent for an extension of time to file his statutory declaration shall be made to the Controller, in writing, within two months from the date of receipt of the counter-statement from the applicant.

(5) A request by the opponent for a further extension of time to file the statutory declaration shall be made to the Controller by filing Form TM 32 before the expiry of the last extended period allowed by the Controller under this Regulation.

30. (1) Within four months from the date of receipt by the applicant of the copy of the opponent's statutory declaration referred to in regulation 29, the applicant shall file with the Controller a statutory declaration setting out the evidence he wishes to adduce in support of his application and shall forthwith send a copy of the statutory declaration to the opponent. ^{Evidence in support of application}

(2) If the applicant fails to comply with subregulation (1), he shall be treated as having withdrawn his application, unless he obtains an extension of time.

(3) Subject to subregulation (4), a request by the applicant for an extension of time to file his statutory declaration shall be made to the Controller, in writing, within two months from the date of receipt by the applicant of the copy of the opponent's statutory declaration referred to in regulation 29.

(4) A request by the applicant for a further extension of time to file his statutory declaration shall be made to the Controller by filing Form TM 32 before the expiry of the last extended period allowed by the Controller under this regulation.

Evidence in
reply by
opponent

31. (1) Within two months from the date of receipt by the opponent of the copy of the applicant's statutory declaration referred to in regulation 30, the opponent shall file with the Controller a statutory declaration setting out his evidence in reply and shall forthwith send a copy of the statutory declaration to the applicant.

(2) The opponent's statutory declaration under subregulation (1) shall be confined to matters strictly in reply to the applicant's statutory declaration referred to in regulation 30.

(3) Subject to subregulation (4), a request by the opponent for an extension of time to file his statutory declaration setting out his evidence in reply shall be made to the Controller, in writing, within two months from the date of receipt by the opponent of the copy of the applicant's statutory declaration referred to in Regulation 30.

(4) The extension of time which the Controller may allow to file the opponent's statutory declaration pursuant to a request under sub-regulation (3) shall not exceed six months in the first request from the date of receipt by the opponent of the copy of the applicant's statutory declaration by filing Form TM 32.

Further
evidence

32. No further evidence may be filed by either party except that, in any proceedings before the Controller, the Controller may at any time, if he thinks fit, give leave to either party to file further evidence upon such terms as to costs or otherwise as the Controller may think fit.

Exhibits

33. (1) Where there are exhibits to any evidence filed in an opposition, the party who is relying on the exhibits in support of his case shall, at the request of the other party, send a copy of each exhibit to that other party.

(2) If such copy or other original cannot conveniently be furnished, the original shall be filed with the Controller in order that they may be open to inspection.

34. The original exhibits to any evidence filed in an opposition shall be^{Original} produced at the opposition hearing unless the Controller otherwise^{exhibits} directs.

35. (1) Upon completion of the filing of evidence by the parties, the^{Opposition} Controller shall—^{hearing}

- (a) give notice to the parties of a date on which he will hear arguments on the case; or
- (b) if the parties agree, dispense with the hearing and proceed with the determination of the matter based on written submissions filed with the Controller.

(2) The parties shall file with the Controller their written submissions and bundles of authorities—

- (a) at least one month before the date of hearing; or
- (b) at such time that the Controller directs, if the parties agree to dispense with the hearing in accordance with subregulation (1)(b);

and shall forthwith exchange with one another their respective written submissions and bundles of authorities.

(3) Any party who intends to appear at the hearing shall file with the Controller Form TM 8 no later than seven days before the hearing.

(4) Any party who does not file with the Controller Form TM 8 seven days before the hearing may be treated as not desiring to be heard, and the Controller may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or make such other order as he thinks fit.

(5) If, after filing with the Controller Form TM 8, a party does not appear at the hearing, the Controller may proceed with the hearing in the absence of that party, or may, without proceeding with the hearing, give his decision or make such other order as he thinks fit.

(6) Any decision made by the Controller pursuant to a hearing in which any party does not appear may, on the application of the party that did not appear, be set aside by the Controller on such terms as he thinks fit.

(7) An application under this regulation to set aside any decision under subregulation (6) shall be made within seven days after the proceedings have been dismissed or after the hearing, as the case may be.

Controller's decision in opposition proceedings 36. (1) The Controller shall, within three months from the date of the hearing inform the parties of his decision and the grounds for the decision.

(2) If the parties agree to dispense with the hearing in accordance with regulation 35(1)(b), the Controller shall, within three months from the filing of the written submissions, inform the parties of his decision and the grounds for the decision.

Extension of time in opposition proceedings 37. Where any extension of time is granted to any party, the Controller may, if he thinks fit, without giving the party a hearing, grant a reasonable extension of time to the other party in which to take any subsequent step.

Costs in uncontested oppositions 38. Where an opposition is uncontested by the applicant, the Controller, in deciding whether costs should be awarded to the opponent, shall consider whether proceedings may have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was filed.

Division 7—Registration

Certificate of registration 39. Upon the registration of a trade mark, the Controller shall issue to the applicant a certificate of registration.

PART III

REGISTER

Entry in Register of particulars of registered trade mark 40. (1) There shall be entered in the Register in respect of each registered trade mark the following particulars:

- (a) the date of the filing of the application for registration;
- (b) the actual date of registration, that is, the date of the entry in the Register;
- (c) the priority date, if any, accorded pursuant to a claim to a right to priority under section 11 or 12 of the Act;
- (d) the name and address of the proprietor;
- (e) the address for service;
- (f) any disclaimer or limitation of rights notified to the Controller under regulation 41;
- (g) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the Controller has been notified on Form TM 30;
- (h) the goods or services in respect of which the trade mark is registered;

- (i) where the trade mark is a collective mark or certification mark, that fact;
 - (j) where the trade mark is registered with the consent of the proprietor of an earlier trade mark or other earlier right, that fact; and
 - (k) where the trade mark is registered pursuant to a transformation application, the number of the corresponding international registration and—
 - (i) the date of that international registration in accordance with the Madrid Protocol; or
 - (ii) where the request for extension of protection to Trinidad and Tobago was made subsequent to that international registration, the date of recordal of that request in accordance with the Madrid Protocol.
- (2) In this regulation—

“corresponding international registration”, in relation to a transformation application, means the international registration referred to in the Trade Marks (International Registration) Regulations;

“international registration” means the registration of a trade mark in the International Register;

“International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau of the World Intellectual Property Organization;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June, 1989, as revised or amended from time to time;

“transformation application” means an application referred to in regulation 26(1)(b) of the Trade Marks (International Registration) Regulations.

41. Where the applicant for registration of a trade mark or the proprietor of a registered trade mark by Form TM 22—

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

the Controller shall make the appropriate entry in the Register and publish the disclaimer or limitation.

Application to
change name
or address in
Register

42. (1) An application by—

- (a) the proprietor of a registered trade mark;
- (b) a licensee of a registered trade mark; or
- (c) any person having an interest in or charge on a registered trade mark registered under regulation 53,

to change his name or address appearing in the Register shall be filed with the Controller on Form TM 14.

(2) The Controller may at any time, on a request filed on Form TM 1 by any person who has filed an address for service under regulation 10 or 11, change that address in the Register.

Death of
applicant
before
registration

43. If an applicant for the registration of a trade mark dies after the date of his application and before the date the trade mark is entered in the Register, the Controller—

(a) after the expiration of the time referred to in regulation 26 to file a notice of opposition; or

(b) after the determination of any opposition to the registration, may, on being satisfied that the applicant is dead, enter in the Register, in place of the name of the deceased applicant, the name, address and other particulars of the person owning the trade mark, on such ownership being proved to the satisfaction of the Controller.

Removal of
matter from
Register

44. (1) Before removing from the Register any matter which appears to the Controller to have ceased to have effect, the Controller—

(a) may, if he considers it appropriate, publish in the Trade Marks Journal, his intention to remove that matter; and

(b) shall send notice of his intention to any person who appears to him to be likely to be affected by the removal.

(2) Within three months from the date on which his intention to remove the matter is published under subregulation (1)(a), any person may file with the Controller a notice of opposition to the removal in Form TM 6.

(3) Within three months from the date on which notice of his intention to remove the matter is sent to any person under subregulation (1)(b), that person may file with the Controller a notice of opposition to the removal in Form TM 6.

(4) If the Controller is satisfied after considering any opposition to the removal that the matter has not ceased to have effect, he shall not remove it.

(5) Where there has been no response to the Controller's publication or notice, he may remove the matter.

(6) If the Controller is satisfied after considering any opposition to the removal that the entry or any part thereof has ceased to have effect, he shall remove the entry or that part of the entry, as the case may be.

45. (1) Where the Court has certified, in accordance with section 118 of the Act, that a registered trade mark has been validly registered, the proprietor of the registered trade mark may request the Controller on Form TM 23 to add to the entry in the Register a note that a certificate of validity has been granted in the course of the proceedings named in the form.

(2) A copy of the certificate shall be sent with the request, and the Controller shall so note in the Register and publish the note in the Trade Marks Journal.

46. Any person may request from the Controller a certified copy of or an extract from, or an uncertified copy of or an extract from, any entry in the Register.

PART IV

RENEWAL OF REGISTRATION OF TRADE MARK

47. (1) Subject to subregulation (2), an application for the renewal of registration of a trade mark shall be made no later than six months after the date of expiry of the registration.

(2) Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of the application for its registration, an application for the renewal of its registration shall be made no later than six months after the actual date of its registration.

(3) An application for the renewal of registration of a trade mark shall—

- (a) if made on or before the date of expiry of the registration, be in Form TM 9; or
- (b) if made within six months after the date of expiry of the registration, be in Form TM 13 and be accompanied by the additional late payment fee specified in the First Schedule.

(4) Notwithstanding subregulation (3)(b), where—

- (a) a trade mark is registered—
 - (i) within six months before; or
 - (ii) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration; and

(b) an application for the renewal of its registration is made not later than six months after the actual date of its registration, the application for the renewal of its registration shall be in Form TM 9.

Notice of
renewal

48. (1) Subject to subregulations (2) and (3), the Controller shall, no more than six months before the date of expiry of the registration of a trade mark, send a notice in writing to the proprietor and to the proprietor's agent, notifying them of the date of expiry of the registration.

(2) Subject to subregulation (3), where a trade mark is registered—

(a) within six months before; or

(b) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration, the Controller shall, within one month after the actual date of its registration, send a notice in writing to the proprietor—

(i) where an application for the renewal of registration of the trade mark has previously been made in accordance with regulation 47, at the address for service as indicated in the application; or

(ii) in any other case, at the proprietor's address for service,

notifying him of the date of expiry of its registration.

(3) The Controller need not send any notice referred to in subregulation (1) or (2) if an application for the renewal of registration of the trade mark has been made in accordance with regulation 47.

Notice of non-
compliance

49. (1) If, in the course of an examination of an application for renewal of registration, it appears to the Controller that the application is not in order, the Controller shall give written notice of this to the applicant.

(2) If the applicant fails to—

(a) respond in writing to the Controller on the notice; or

(b) comply with any requisition of the Controller set out in the notice,

within the time specified in the notice, the Controller may treat the application as having been withdrawn.

(3) If the applicant wishes to have an extension of time to do any act referred to in subregulation (2)(a) or (b), he shall file with the Controller a request for an extension of time in Form TM 31 before the expiry of the time specified in the notice or any extended period previously allowed by the Controller.

50. The Controller may remove a trade mark from the Register if— Removal of trade mark from Register
- (a) no application for the renewal of registration of the trade mark is filed in accordance with regulation 47; or
 - (b) where an application for the renewal of registration of the trade mark is filed in accordance with regulation 47, the applicant for the renewal of registration—
 - (i) fails to comply with any direction of the Controller relating to the renewal; or
 - (ii) notifies the Controller that he wishes to withdraw or abandon the application.

51. (1) An application for restoration of a trade mark which has been Restoration of registration removed from the Register under regulation 50 shall be filed with the Controller on Form TM 11 within six months from the date of the removal of the trade mark from the Register.

(2) The application for restoration filed on Form TM 11 shall contain a statement of the reasons for the failure to renew the registration.

(3) The Controller may, in any case, require the applicant for restoration to furnish such additional evidence or information, by statutory declaration or otherwise, as he thinks fit, within such time as the Controller may specify.

(4) The Controller may restore the trade mark to the Register and renew its registration if he is satisfied that it is just to do so, and upon such conditions as he may think fit to impose.

PART V

REGISTRABLE TRANSACTIONS

52. (1) The prescribed particulars of a transaction to which section 41 Entry in Register of particulars of registrable transactions of the Act applies to be entered in the Register are—
- (a) in the case of an assignment of a registered trade mark or any right in it—
 - (i) the name and address of the subsequent proprietor;
 - (ii) the date of the assignment; and
 - (iii) where the assignment is in respect of any right in the trade mark, a description of the right assigned;
 - (b) in the case of the grant of a licence under a registered trade mark—
 - (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;
- (c) in the case of the grant of any security interest over a registered trade mark 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;
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it—
 - (i) the name and address of the person in whom the trade mark or any right in or under it vests by virtue of an assent; and
 - (ii) the date of the assent; and
- (e) in the case of an order of the Court or other competent authority transferring a registered trade mark or any right in or under it—
 - (i) the name and address of the transferee;
 - (ii) the date of the order; and
 - (iii) where the transfer is in respect of a right in the trade mark, a description of the right transferred.

(2) In each of the cases mentioned in subregulation (1), there shall be entered in the Register the date on which the entry is made.

Application to register or give notice of transaction

53. (1) An application to register particulars of a transaction to which section 41 of the Act applies shall be made, and a notice to be given to the Controller of particulars of a transaction to which section 43 of the Act applies shall be—

- (a) in the case of any assignment or transaction, other than a transaction referred to in paragraphs (b) to (f), on Form TM 12;
- (b) in the case of the grant of a licence, on Form TM 24;
- (c) in the case of an amendment to a licence, on Form TM 25;
- (d) in the case of a termination of a licence, on Form TM 26;
- (e) in the case of the grant, amendment or termination of any security interest, on Form TM 30; and

(f) in the case of the making by personal representatives of an assent in relation to, or of an order of the Court or other competent authority transferring, a registered trade mark, an application for registration of a trade mark, or any right in or under a registered trade mark or an application for registration of a trade mark, on Form TM 10.

(2) Where an application under subregulation (1) is filed other than by means of the electronic online system, the application shall be—

- (a) signed by or on behalf of all the parties to the assignment or transaction, in the case of an assignment or transaction referred to in subregulation (1)(a);
- (b) signed by or on behalf of the personal representative, in the case of the making by a personal representative of an assent referred to in subregulation (1)(f);
- (c) accompanied by any documentary evidence which, in the Controller's view, is sufficient to establish the transaction, in the case of an order of the Court or other competent authority referred to in subregulation (1)(f); and
- (d) signed by or on behalf of the grantor of the licence or security interest, in any other case.

(3) Where an application under subregulation (1) is filed by means of the electronic online system, the application shall be authorised by all relevant parties and be validated by such means as the Controller considers fit.

(4) Where an application under subregulation (1) is not signed in accordance with subregulation (2)(a), (b) or (d), or not authorised and validated in accordance with subregulation (3), the application shall be accompanied—

- (a) in the case of an assignment, of a registered trade mark or an application for registration of a trade mark, referred to in subregulation (1)(a), at the option of the applicant, by—
 - (i) a certified copy of the contract of assignment;
 - (ii) a certified extract of the contract of assignment, being an extract, which shows the change in the ownership of the registered trade mark or application for registration;
 - (iii) a certificate of transfer of the registered trade mark or application for registration in such form as the Controller may require, being a certificate signed by all parties to the assignment;

- (iv) a transfer document relating to the registered trade mark or application for registration in such form as the Controller may require, being a document signed by all parties to the assignment; or
 - (v) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the assignment;
- (b) in the case of a grant of a licence, under a registered trade mark or an application for registration of a trade mark, referred to in subregulation (1)(b), at the option of the applicant, by—
 - (i) a certified extract of the licence contract, being an extract which shows the parties to the contract and the rights which are licensed under the contract;
 - (ii) a statement of the licence containing such information as the Controller may require, being a statement signed by both the person granting the licence and the licensee; or
 - (iii) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the grant of the licence;
- (c) in the case of an amendment to, or a termination of, a licence, under a registered trade mark or an application for registration of a trade mark referred to in subregulation (1)(c) or (d), at the option of the applicant, by—
 - (i) a statement of the amendment or termination of the licence, as the case may be, containing such information as the Controller may require, being a statement signed by both the person granting the licence and the licensee; or
 - (ii) a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the amendment or termination of the licence, as the case may be; or
- (d) in any other case, by a certified copy of any documentary evidence which in the Controller's view is sufficient to establish the transaction.

(5) Where an application under subregulation (1) is filed by means of the electronic online system, the document referred to in subregulation (4)(a) (i), (ii), (iii), (iv) or (v) shall be filed within such time as the Controller may specify.

(6) The Controller shall refuse to accept an application under subregulation (1) if subregulation (2), (3), (4) or (5) is not complied with and in such event, the Controller may require a fresh application to be made.

(7) The Controller may require the applicant to furnish such other document, instrument and information in support of the application as the Controller thinks fit, within such time as the Controller may specify.

(8) If the applicant wishes to have an extension of time to comply with the requirement referred to in subregulation (7), he shall file with the Controller a request for an extension of time in Form TM 31 before the expiry of the time specified by the Controller or any extended period previously allowed by the Controller.

(9) Where the transaction is effected by an instrument chargeable with duty, the application shall be subject to the Controller being satisfied that the instrument has been duly stamped.

PART VI

ALTERATION OF REGISTERED TRADE MARK

54. (1) The proprietor of a registered trade mark may apply to the Controller on Form TM 16 for such alteration of his mark as is permitted under section 21 of the Act. Application to alter registered trade mark

(2) The proprietor shall provide to the Controller such evidence in respect of the application as the Controller may require.

(3) Where the Controller proposes to allow such alteration, he shall publish the mark as altered in the Trade Marks Journal.

(4) Any person claiming to be affected by the alteration may, within three months from the date of the publication of the alteration, file with the Controller a notice of opposition to the alteration in Form TM 6.

(5) The notice of opposition shall contain a statement of the grounds upon which the person opposes the alteration, including, where relevant, how the alteration would be contrary to section 21(2) of the Act.

(6) Regulations 26 and 28 to 38 shall apply, with the necessary modifications, to any proceedings arising from the notice of opposition.

(7) For the purposes of the application of the regulations referred to in subregulation (6)—

- (a) any reference to the applicant shall be read as a reference to the proprietor;
- (b) any reference to the application for registration shall be read as a reference to the application for alteration referred to in subregulation (1);
- (c) any reference to the date of publication of the application for registration shall be read as a reference to the date of publication of the alteration;
- (d) any reference to the notice of opposition shall be read as a reference to the notice of opposition referred to in subregulation (4); and
- (e) any reference to the opponent shall be read as a reference to the person referred to in subregulation (4).

PART VII

REVOCATION, INVALIDATION, RECTIFICATION AND CANCELLATION

Application for
revocation,
declaration of
invalidity and
rectification

55. (1) An application to the Controller for—

- (a) the revocation of the registration of a trade mark under section 23 of the Act; or
- (b) a declaration of invalidity of the registration of a trade mark under section 24 of the Act, shall be made on Form TM 17.

(2) An application to the Controller for the rectification of an error or omission in the Register under section 85 of the Act shall be made—

- (a) in the case of an application by the proprietor of a registered trade mark to amend any information in the Register relating to that trade mark, on—
 - (i) Form TM 14, if the amendment pertains to the name or other particulars of the proprietor;
 - (ii) Form TM 15, if subparagraph (i) does not apply and the amendment, or any of the amendments, pertains to—
 - (A) the class number or specification of any goods or services; or
 - (B) the particulars of any claim to a right of priority; or
 - (iii) Form TM 16, if subparagraphs (i) and (ii) do not apply; or

(b) in the case of an application by any other person to amend any information in the Register relating to that trade mark, on Form TM 17.

(3) The application shall be accompanied by a statement of the grounds on which the application is made.

(4) The applicant shall, if he is not the proprietor of the registered trade mark, serve a copy of the application and statement on the proprietor or the agent on record forthwith as he files these documents with the Controller.

56. (1) Within two months from the date of receipt of the copies of the application and statement from the applicant, the proprietor may file with the Controller a counter-statement in Form TM 7 setting out—

(a) the grounds on which he relies as supporting his registration; and

(b) the facts alleged in the application which he admits, if any.

(2) The proprietor or the agent on record shall serve on the applicant a copy of the counter-statement forthwith as he files the counter-statement with the Controller.

(3) In the case of an application for revocation of the registration of a trade mark on the ground referred to in section 23(1)(a) or (b) of the Act, the proprietor shall file, together with the counter-statement, evidence of the use by him of the trade mark, and shall also serve this on the applicant forthwith.

(4) A request for an extension of time to file the counter-statement shall be made by the proprietor to the Controller in writing within two months from the date of receipt of the copies of the application and statement.

(5) The total extension of time which the Controller may allow to file the counter-statement shall not exceed four months from the date of receipt by the proprietor of the copies of the application and statement.

(6) In the case of an application for revocation on the ground referred to in section 23(1)(a) or (b) of the Act, the application shall be granted where no counter-statement has been filed within the time allowed.

Further
procedure

57. (1) Upon an application being made under regulation 55 and a counter-statement being filed under regulation 56, regulations 29 to 38 shall apply, with the necessary modifications, to further proceedings thereon except that, in the case of an application for revocation on the ground of non-use under section 23(1)(a) or (b) of the Act, the application shall be granted where no evidence of use has been filed under regulation 56(3).

- (2) For the purposes of the application of regulations 29 to 38—
- (a) references in those regulations to the applicant shall be treated as references to the proprietor;
 - (b) references in those regulations to the application shall be treated as references to the proprietor's registration;
 - (c) references in those regulations to the opponent shall be treated as references to the applicant for revocation or a declaration of invalidity of the registration; and
 - (d) the reference in regulation 30(2) to the withdrawal of the application shall be treated as a reference to the admission by the proprietor to the facts alleged by the applicant in his application for revocation or a declaration of invalidity of the registration.

Intervention
by third
parties

58. (1) Any person, other than the registered proprietor, claiming to have an interest in a registered trade mark which is the subject of an application under regulation 55 may apply to the Controller on Form TM 18 for leave to intervene.

(2) The Controller may, after hearing the parties concerned if he so required, refuse leave to intervene, or grant leave to intervene upon such terms, including any undertaking as to costs, as he thinks fit.

(3) Any person granted leave to intervene shall, subject to the terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings in question.

Application to
cancel
registered
trade mark or
registration in
relation to
certain goods
or services

59. (1) The proprietor may cancel his registered trade mark by filing with the Controller—

- (a) a notice in Form TM 20 if the cancellation relates to all the goods or services in respect of which the trade mark is registered; or
- (b) a notice in Form TM 21 if the cancellation does not relate to all the goods or services in respect of which the trade mark is registered.

(2) A notice under subregulation (1) shall have no effect unless the proprietor in that notice—

- (a) gives the name and address of every other person having a right in the mark, if any; and
- (b) certifies that each such person—
 - (i) has been given not less than three months' notice of the proprietor's intention to cancel the mark; or
 - (ii) is not affected by the cancellation or if affected, consents to the cancellation.

(3) The Controller, if satisfied that the notice complies with subregulation (2) and is otherwise regular, shall make the appropriate entry in the Register.

PART VIII

COLLECTIVE MARKS AND CERTIFICATION MARKS

60. (1) Except as provided in this Part, the provisions of these Regulations shall apply in relation to collective marks and certification marks as they apply in relation to ordinary trade marks.

Application of Regulations to collective marks and certification marks

(2) In case of doubt in applying the provisions of these Regulations, any party may apply to the Controller for directions.

(3) The address of the applicant for the registration of a collective mark or certification mark shall be deemed to be the trade or business address of the applicant for the purposes of regulation 10(9)(b).

61. Within nine months from the date of the application for the registration of a collective mark or certification mark, the applicant shall file with the Controller in duplicate—

Filing of rules

- (a) Form TM 5; and
- (b) a copy of the rules governing the use of the mark.

62. (1) Any person may, within three months from the date of the publication of an application for registration of a collective mark or certification mark, give written notice to the Controller in Form TM 6 opposing the registration.

Opposition to registration

(2) Regulations 26 to 38 shall apply, with the necessary modifications, to the proceedings for opposition.

(3) In case of doubt, any party may apply to the Controller for directions.

Amendment of rules 63. (1) An application for the amendment of the rules governing the use of a registered collective mark or certification mark shall be filed with the Controller on Form TM 19.

(2) The application shall be accompanied by a copy of the amended rules with the amendments shown in red, and both shall be filed in duplicate.

(3) Where it appears expedient to the Controller that the amended rules should be made available to the public, the Controller may publish a notice indicating where copies of the amended rules may be inspected.

Opposition to amendment of rules 64. (1) Any person may, within three months from the date of the publication of the notice referred to in regulation 63(3), file with the Controller—

- (a) a notice of opposition to the amendment to the rules in Form TM 6; and
- (b) a statement indicating why the amended rules do not comply with the requirements under the Act.

(2) The person filing the notice and statement under subregulation (1) shall forthwith, serve copies of the notice and statement on the proprietor.

(3) Regulations 26 and 28 to 38 shall, with the necessary modifications, apply to the proceedings in relation to collective marks or certification marks as they apply to an opposition to an application for registration of a trade mark.

(4) For the purposes of the application of the regulations referred to in subregulation (3)—

- (a) references in those regulations to the applicant shall be treated as references to the applicant for the amendment of the rules;
- (b) references in those regulations to the date of the publication of the application for registration shall be treated as references to the date of the publication of the notice referred to in regulation 63(3);
- (c) references in those regulations to the notice of opposition shall be treated as references to the notice and statement referred to in subregulation (1); and
- (d) references in those regulations to the opponent shall be treated as references to the person who filed the notice and statement referred to in subregulation (1).

PART IX

EVIDENCE AND PROCEDURE

65. (1) Without prejudice to any of the provisions of the Act or these Regulations requiring the Controller to hear any party to proceedings under the Act or these Regulations, or to give such party an opportunity to be heard, the Controller shall, before exercising any power given to the Controller by the Act or these Regulations adversely to any party, give that party an opportunity to be heard.

(2) The Controller shall give that party at least ten days' notice of the date on which he may be heard.

(3) The Controller shall notify that party of his decision made in the exercise of his power.

66. The hearing before the Controller of any dispute between two or more parties relating to any matter under the Act or these Regulations shall be in public unless the Controller, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

67. (1) In any proceedings before the Controller under the Act or these Regulations, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Regulations or directed by the Controller.

(2) Any such statutory declaration may, in the case of an appeal to the Court, be used before the Court in lieu of evidence by affidavit, and if so used, shall have all the incidents and consequences of evidence by affidavit.

(3) The Controller may, in any particular case, take oral evidence in lieu of, or in addition to a statutory declaration and shall, unless the Controller otherwise directs, allow any witness to be cross-examined on his statutory declaration or oral evidence.

68. Any statutory declaration filed under the Act or these Regulations or used in any proceedings under the Act or these Regulations, shall be made and subscribed as follows:

- (a) in Trinidad and Tobago, before any Justice of the Peace, or any Commissioner of Affidavits or other officer authorised by law to administer an oath for the purpose of any legal proceedings;

- (b) in any other part of the Commonwealth, before any court, judge, justice of the peace, notary public or any officer authorised by law to administer an oath for the purpose of any legal proceedings; and
- (c) elsewhere, before a consulate, vice-consulate, or other person exercising the functions of a Trinidad and Tobago consular officer, or before a notary public, judge or magistrate.

Notice of seal
of officer
taking
declaration

69. Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by regulation 68 to take a declaration, may be admitted by the Controller without proof of the genuineness of the seal or signature or of the official character of the person or his authority to take the declaration.

PART X

COSTS

Application for
costs

70. (1) For the purposes of section 86 of the Act, a party to proceedings before the Controller who desires to obtain costs shall apply to the Controller for an award of costs in relation to the proceedings—

- (a) during the proceedings; or
- (b) within one month from—
 - (i) the day on which the Controller makes a decision in the proceedings that ends those proceedings; or
 - (ii) the date of the Controller's notice to the party that the proceedings have been withdrawn, discontinued or dismissed, as the case may be.

(2) Before awarding costs in respect of the proceedings, the Controller shall give each party to the proceedings an opportunity to be heard in relation to the award of costs.

Scale of costs
Third
Schedule

71. The provisions in the Third Schedule shall apply in relation to scale of costs.

PART XI

EXTENSION OF TIME AND REINSTATEMENT OF APPLICATIONS, RIGHTS AND OTHER MATTERS

Request for
extension of
time

72. (1) Any period of time—

- (a) prescribed by these Regulations; or
- (b) specified by the Controller for doing any act or taking any proceedings,

may, at the request of the person or party concerned, be extended by the Controller by such period and upon such terms as the Controller considers fit.

(2) The Controller may, upon receiving the request for extension of time, require particulars from the person or party concerned as to the nature of the request for extension of time.

(3) The Controller may refuse to grant the extension if the person requesting the extension fails to show a good and sufficient reason for the extension.

(4) Subregulations (1) to (3) shall not apply to the following matters:

- (a) the remedying of a deficiency under regulation 21;
- (b) the filing of a notice of opposition to an amendment of an application which has been published under regulation 23(2);
- (c) the doing of any act referred to in regulation 24(2)(a), (b), (c) or (d);
- (d) the filing of a notice of opposition under regulation 26;
- (e) the filing of a counter-statement under regulation 28;
- (f) the filing of any statutory declaration under regulation 29, 30 or 31;
- (g) the filing of a notice of opposition to the removal of any matter from the Register under regulation 44(2);
- (h) the doing of any act referred to in regulation 49(2)(a) or (b);
- (i) the filing of an application for the restoration of a registration under regulation 51(1);
- (j) the compliance with a requirement referred to in regulation 51(4);
- (k) the compliance with a requirement referred to in regulation 53(7);
- (l) the filing of a notice opposing the alteration of a registered trade mark under regulation 54(4);
- (m) the filing of a counter-statement to a notice referred to in paragraph (l);
- (n) the filing of a counter-statement to an application for revocation or declaration of invalidity of the registration of a trade mark, or rectification of the Register under regulation 56;
- (o) the filing of a notice opposing the registration of a collective mark or certification mark under regulation 62;
- (p) the filing of a counter-statement to a notice referred to in paragraph (o);

- (q) the filing of a notice of opposition to an amendment to rules governing the use of a registered collective or certification mark under regulation 63(1);
- (r) the filing of a counter-statement to a notice referred to in paragraph (q);
- (s) the filing of an application under regulation 74(2) for the reinstatement of an application treated as withdrawn;
- (t) the filing of a notice of opposition in respect of a pending application for registration referred to in regulation 94; and
- (u) the filing of a counter-statement to a notice referred to in paragraph (t).

Where non-compliance with time caused by act of person employed in the Intellectual Property Office

73. (1) Where, by reason of an act or omission of any person employed in the Intellectual Property Office, an act or step in relation to an application for the registration of a trade mark or any other proceedings before the Controller, required to be done or taken within a period of time, has not been so done or taken, the Controller may, notwithstanding the provisions of these Regulations, extend the period for doing the act or taking the step by such period as the Controller considers fit.

(2) Notwithstanding the provisions of these Regulations, the period of time for doing an act or taking a step under subregulation (1) may be extended although the period has expired.

Reinstatement of application, right or other matter

74. (1) Any person whose—

- (a) application is treated as withdrawn; or
- (b) right has been abrogated, or matter has ceased to be in force or to exist,

by reason that he has failed to comply with any procedural requirement in any proceedings or other matter before the Controller within the time limit under the Act or specified by the Controller for complying with that requirement, may request for the reinstatement of the application, right or matter, as the case may be, in accordance with subregulations (2), (3) and (4).

(2) A request for the reinstatement of any application, right or matter referred to in subregulation (1)—

- (a) shall be made on Form TM 27 and filed with the Controller within six months from the date the application was treated as withdrawn, the right was abrogated, or the thing ceased to be in force or to exist, as the case may be;
- (b) shall not be made unless, and shall state that—
 - (i) the omission which led to the application being treated as withdrawn was unintentional; or

- (ii) the failure to comply with a time limit which led to—
 - (A) the right being abrogated; or
 - (B) the matter ceasing to be in force or to exist, was unintentional; and
 - (c) where the omission, or the failure to comply with a time limit, relates to the filing of any document or matter, shall be accompanied by that document or matter not filed or not filed on time, as the case may be.
- (3) Subject to subregulation (4), where a request is filed under subregulation (2), the Controller shall allow the reinstatement unless there is a good and sufficient reason to refuse the request.
- (4) The Controller shall not allow the reinstatement unless the requirements of subregulation (2) are satisfied.
- (5) Subregulations (1) to (4) do not allow the reinstatement of—
- (a) any claim to a right of priority under section 11 of the Act or regulation 18(1); or
 - (b) any application which is treated as withdrawn, any right which has been abrogated or anything which has ceased to be in force or to exist by reason of—
 - (i) any acquiescence by a proprietor of an earlier trade mark or other earlier right under section 25 of the Act, or under section 25 of the Act read with the Trade Marks (International Registration) Regulations;
 - (ii) a failure to comply with the time limit for—
 - (A) any act under section 14 of the Act or Division 6 of Part II of these Regulations, or under the Trade Marks (International Registration) Regulations or regulations 29 to 38 of these Regulations read with the Trade Marks (International Registration) Regulations, in any opposition proceedings;
 - (B) any act under section 23 of the Act or Part VII of these Regulations, or under section 23 of the Act and regulations 55 to 58 of these Regulations read with the Trade Marks (International Registration) Regulations, in any proceedings for the revocation of the registration of a trade mark;

- (C) any act under section 24 of the Act or Part VII of these Regulations, or under section 24 of the Act and regulations 55 to 58 of these Regulations read with the Trade Marks (International Registration) Regulations, in any proceedings for a declaration of invalidity of the registration of a trade mark;
 - (D) any act under section 85 of the Act or Part VII of these Regulations in any proceedings for the rectification of an error or omission in the Register, being proceedings commenced by any person other than the proprietor of a registered trade mark in respect of any information in the Register relating to that trade mark;
 - (E) the filing of a request under subregulation (2); or
 - (F) the filing of Form TM 3 under regulation 24 (6)(a); or
- (iii) a failure to pay the fee for the renewal of registration of a trade mark under regulation 47(3) or 51.

Change of commencement date of period for filing evidence

75. Where the period within which any party to any proceedings before the Controller may file evidence under these Regulations is to commence upon the expiry of any period in which any other party may file evidence and that other party notifies the Controller that he does not wish to file any, or any further evidence, the Controller may direct that the period within which the first-mentioned party may file evidence shall begin on such date as may be specified in the direction, and the Controller shall notify all parties to the dispute of that date.

PART XII

ELECTRONIC ONLINE SYSTEM

Establishment of electronic online system

76. (1) There shall be established an electronic online system for the purposes of these Regulations.

- (2) The Controller may—
- (a) accept the filing of documents;
 - (b) obtain information in any form; and
 - (c) issue any document or approval;

by means of electronic records or in electronic form.

(3) Where the Controller decides to perform any of the functions under the Act or these Regulations by means of electronic records or in electronic form, the Controller may specify—

- (a) the manner and format in which such electronic records shall be filed, created, retained, issued or provided;
- (b) such control processes and procedures, as may be appropriate to ensure adequate integrity, security and confidentiality of electronic records or payments; or
- (c) any other required attributes for electronic records or payments that are currently specified for corresponding paper documents.

(4) The Controller may permit a person to have on-line access to the electronic database or databases for the purpose of examining any information, form, or document that the person is authorised to access under the Act or any other enactment.

(5) Any information, forms, or documents that are required to be signed by a person for filing with the Controller under the Act may be filed with the Controller if signed by electronic signature approved by the Controller, or by an electronically transmitted or reproduced signature.

(6) The electronic online system may be used—

- (a) for carrying out any of the transactions as directed by the Controller;
- (b) by any person for giving, sending to, filing with, or serving on the Controller or Intellectual Property Office any document, other than—
 - (i) a form that is not used for carrying out any of the transactions referred to in subparagraph (a); or
 - (ii) a notice or document to be served in proceedings in court; and
- (c) by the Controller or Intellectual Property Office for giving, sending to, or serving on, any person any notice or other document, other than a notice or document to be served in proceedings in court.

77. (1) Any person who desires to make use of the electronic online system—

- (a) to carry out any transaction as directed by the Controller referred to in regulation 76(6)(a); or

Registration
as account
holder

- (b) for giving, sending to, filing with, or serving on the Controller or Intellectual Property Office any document referred to in regulation 76(6)(b),

shall, in accordance with the procedures set out in practice directions issued by the Controller, apply to the Controller to be registered as an account holder.

(2) The Controller may register a person as an account holder on such terms and with such restrictions pertaining to the use of the electronic online system as the Controller thinks fit.

Identification name and authentication code 78. (1) Upon registration of a person as an account holder, the person shall be assigned such number of identification names and authentication codes as the Controller may determine.

(2) The Controller may cancel the identification name and authentication code assigned to an account holder if, to the knowledge of the Controller, the authority of the account holder as agent has been revoked or terminated.

Obligation to inform Controller of change of particulars 79. An account holder shall, in accordance with such procedure as may be laid down in practice directions issued by the Controller, inform the Controller of any change in the particulars furnished in his application for registration as an account holder under regulation 77.

Security measures 80. (1) An account holder shall ensure the confidentiality and security of each identification name and authentication code assigned to him and shall not—

- (a) divulge the identification name and authentication code to any other person who has no authority to use the identification name and authentication code; or
- (b) permit any other person who has not been so authorised to use the identification name and authentication code.

(2) When using the electronic online system, an account holder shall not circumvent any security or authentication mechanism in the system.

Duty of person using electronic online system 81. A person shall only use the electronic online system in accordance with these Regulations and any practice directions issued by the Controller.

Cancellation of registration as account holder 82. The Controller may cancel—

(a) the registration of an account holder; and

(b) any identification name and authentication code issued to the account holder,
if the Controller is satisfied that the account holder has contravened regulation 80 or 81 or any term or restriction imposed by the Controller.

83. (1) Where any document to be given, sent, filed or served using the electronic online system—

- (a)* is to be signed or made on oath or by affirmation, it shall be signed, made on oath or affirmed in the usual way on the original paper document; or
- (b)* is to be attested, it shall be attested in the usual way in which the original paper document is attested.

Documents to be signed, made on oath or attested

(2) The giving, sending, filing or service of a document using the electronic online system shall be effected by sending a true and complete electronic image of the original paper document.

PART XIII

HOURS OF BUSINESS AND EXCLUDED DAYS

84. (1) Subject to subregulations (4) and (7), any business done under the Act or these Regulations—

- (a)* on any day after the hours of business of the Intellectual Property Office for that class of business; or
- (b)* on any day which is an excluded day for that class of business,

Hours of business and excluded days

shall be taken to have been done on the next following day which is not an excluded day for that class of business.

(2) Where the time for doing any business under the Act or these Regulations expires on an excluded day for the doing of that class of business, that time shall be extended to the next following day which is not an excluded day for the doing of that class of business.

(3) For the avoidance of doubt, where the time for—

- (a)* carrying out any transaction referred to in regulation 76(6)(a);
- (b)* giving, sending to, filing with or serving on the Controller or Intellectual Property Office any document referred to in regulation 76(6)(b); or

- (c) giving, sending to or serving on any person by the Controller or Intellectual Property Office any notice or other document referred to in regulation 76(6)(c),

expires on an excluded day, that time shall be extended to the next following day which is not an excluded day, notwithstanding the availability of the electronic online system.

- (4) Where a document—

- (a) is transmitted to the Intellectual Property Office by means of the electronic online system; and
- (b) is received, by the server of that system set up to receive such transmissions, at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Intellectual Property Office any document by means of that system,

that document shall be treated as sent to or filed with, and received by, the Intellectual Property Office at that time and on that day.

(5) For the purposes of subregulation (4), the document shall be treated as sent to or filed with, and received by, the Intellectual Property Office if and only if the last byte of the transmission containing the document is received by the server referred to in that subregulation.

(6) Any person who sends or files a document by means of the electronic online system may produce a record of transmission issued through that system as evidence of—

- (a) the sending or filing of that document; and
- (b) the date and time when the sending or filing took place.

(7) Subject to subregulation (4) of regulation 8, where a document referred to in that subregulation—

- (a) is transmitted to the Controller or Intellectual Property Office by means of facsimile transmission; and
- (b) is received—
 - (i) by any facsimile machine designated by the Intellectual Property Office for the receipt of such transmissions; and
 - (ii) at any time before midnight on any day which is not an excluded day for the business of sending to or filing with the Intellectual Property Office that document by means of facsimile transmission,

that document shall be treated as sent to or filed with, and received by, the Intellectual Property Office at that time and on that day.

- (8) For the purposes of subregulation (5)—
- (a) a document shall be treated as sent to or filed with, and received by, the Intellectual Property Office if and only if all sheets comprising the complete document are received by the facsimile machine referred to in that subregulation; and
 - (b) the date and time of receipt of the document, as recorded by the facsimile machine referred to in that subregulation, shall, until the contrary is proved, be treated as the date and time when the document was sent to or filed with, and received by, the Intellectual Property Office.

(9) In the Act and these Regulations, “excluded day”, in relation to any specific class of business, means any day on which the Intellectual Property Office shall be taken to be closed for the purposes of the transaction by the public of that class of business.

85. (1) Where, on any day, there is an interruption in—

- (a) the postal service of Trinidad and Tobago;
- (b) the operation of the Intellectual Property Office; or
- (c) the operation of the electronic online system,

Extension of
period where
interruption in
postal service
or operations

the Controller may issue a practice direction to declare that day as one on which there has been an interruption and, where any period of time specified in the Act or these Regulations for the giving, sending, filing or serving of any notice, application or other document expires on a day so declared, the period shall be extended to the first day next following, not being an excluded day, which is not so declared.

(2) If in any case the Controller is satisfied that the failure to give, send, file or serve any notice, application or other document within the period specified in the Act or these Regulations was wholly or mainly attributable to a failure of or delay in the postal service of Trinidad and Tobago or the electronic online system, the Controller may, if he thinks fit and upon such terms as he may direct, extend the period so that it ends on the day of the receipt by the addressee of the notice, application or other document or, if the day of such receipt is an excluded day, on the first following day which is not an excluded day.

(3) The Controller shall give notice of an extension referred to in subregulation (2) to all parties to the matter.

PART XIV

MISCELLANEOUS

86. (1) Any person who desires to obtain a certificate referred to in section 119 of the Act in relation to any entry, matter or thing which the Controller is authorised to make or do under the Act or these Regulations may file with the Controller Form TM 28.

General
certificates by
Controller

(2) Before giving the certificate, the Controller may require the person to furnish evidence to show that he has an interest in the entry, matter or thing.

Case management conference

87. Notwithstanding anything in these Regulations, at any stage of any application to, or proceedings before, the Controller, the Controller may direct the applicant or parties to attend a case management conference in order that the Controller may make such order or give such direction as he thinks fit for the just, expeditious and economical disposal of the matter.

Production of documents, information or evidence

88. Notwithstanding anything in these Regulations, at any stage of any application to or proceedings before the Controller, the Controller may direct the applicant or any party to produce or file, within such period as the Controller may specify, any document, information or evidence which the Controller may reasonably require.

Irregularities and correction of clerical error

89. (1) Any irregularity in procedure which, in the opinion of the Controller, is not detrimental to the interests of any person or party may be corrected on such terms as the Controller may direct.

(2) Any correction of clerical errors shall be made on Form TM 16 and accompanied by the fee specified in the First Schedule.

Appeal

90. The following decisions of the Controller are subject to appeal to the Court:

(a) a decision referred to in regulation 36; and

(b) a decision in opposition proceedings under regulation 44, 54, 62 or 64.

Application to Court

91. A person who makes an application to the Court under the Act shall, as soon as practicable, file a copy of the application with the Controller.

Order of Court

92. (1) Where an order is made by the Court in any matter under the Act, the person or persons in whose favour the order is made shall, as soon as practicable, file a copy of the order with the Controller.

(2) If the order is to rectify or alter the Register, the person in whose favour the order is made or, if there is more than one, such one of them, as the Controller may direct, shall file with the Controller Form TM 29.

(3) The Controller shall rectify or alter the Register in accordance with such order.

93. (1) The Controller shall publish an electronic journal, to be called ^{Trade Marks} the Trade Marks Journal, which shall contain—^{Journal}

- (a) all matters that are required to be published in that Journal under these Regulations;
- (b) the Practice Directions issued by the Controller under the Act or these Regulations; and
- (c) such other information as the Controller thinks fit.

(2) The Trade Marks Journal shall be published weekly, unless the Controller otherwise directs.

PART XV

TRANSITIONAL PROVISIONS

94. (1) Where an application for registration of a trade mark made ^{Pending} under the former Act, is advertised on or after the coming into effect of ^{applications} these Regulations, the period within which a notice of opposition to the ^{for} registration may be filed shall not exceed four months from the date of advertisement, and such period shall not be extended.

(2) The period within which a counter-statement to the notice of opposition referred to in subregulation (1) may be filed shall not exceed four months from the date of the Controller's letter forwarding the copy of the notice of opposition, and such period shall not be extended.

95. Except as provided by regulation 94, where—

^{Savings}

- (a) immediately before the coming into effect of these Regulations, or any time or period prescribed by the revoked Trade Marks Rules, which were made under the former Act, has effect in relation to any act or proceeding and has not expired; and
- (b) the corresponding time or period prescribed by these Regulations would have expired or would expire earlier, the time or period prescribed by the revoked Trade Mark Rules, and not by these Regulations, shall apply to that act or proceeding, and such time or period may be extended by the Controller by such period and upon such terms as the Controller considers fit.

PART XVI

COMMENCEMENT

96. These Regulations come into force on such day as the Trade Marks ^{Commence-} Act is proclaimed.^{ment}

FIRST SCHEDULE

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
1. Filing of address for service, or request to substitute or alter address for service on record	10(5),10(7), 11(3), 11(5), 42(2)	\$50.00 in respect of each trade mark number	1
2. Application to register a trade mark, collective mark or certification mark	15(1)	\$1400 for first class \$ 150 for each additional class	2
3. Application to amend an application for registration of a trade mark, or by a proprietor of a registered trade mark to rectify an error or omission in the Register relating to that trade mark, or correct a clerical error			
(a) where the application is made in relation only to any matter other than the name or other particulars of the applicant or proprietor, the class number or specification of any goods or services, or the particulars of any claim to a right of priority or to correct a clerical error	16(5), 22(1)(c),54(1), 55(2)(a)(iii), 89(2)	\$150 in respect of each trade mark number	16
(b) where the application is made —	22(1)(b), 55 (2)(a)(ii)	\$150	15

FIRST SCHEDULE—CONTINUED

		FEES		(Regulation 3)
<i>Matter</i>	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>	
(i) in relation only to the class number or specification of any goods or services, or the particulars of any claim to a right of priority; or				
(ii) in relation to the class number or specification of any goods or services, or the particulars of any claim to a right of priority, and in relation to any matter other than the name or other particulars of the applicant or proprietor				
4. Application to change name or other particulars of person in an application for registration or in Register	22(1)(a), 42(1), 55(2)(a)(i)	\$400 (for the first mark) \$150 for each additional mark	14	
5. Request to the Controller to state grounds of decision relating to an application to register a trade mark	24(6)(a)	\$700 in respect of each trade mark number	3	

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		<i>Fee</i>	(Regulation 3)
	<i>Corresponding Regulation(s)</i>			<i>Corresponding Form(s)</i>
6. Filing of notice of opposition to —	23(2), 44(2), 44(3), 54(4), 64(1)(a)	26, 62(1),	\$1400	6
(a) an amendment of an application for registration of a trade mark which has been published, where the amendment affects the representation of the trade mark or the goods or services covered by the application for registration				
(b) the registration of a trade mark, collective mark or certification mark				
(c) the removal of any matter from the Register				
(d) the alteration of a registered trade mark				
(e) an application to amend the rules governing the use of a registered collective mark or certification mark				

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
7. Filing of a counter-statement to —	28(1), 56(1)	\$700	7
(a) a notice of opposition to the registration of a trade mark, collective mark or certification mark			
(b) an application to alter a registered trade mark			
(c) an application for revocation or a declaration of invalidity of a registration, or for rectification of Register			
(d) an application to amend the rules governing the use of a registered collective mark or certification mark			
8. Filing of notice of attendance at hearing	35(3),	\$350	8
9. Request to enter in the Register and to publish a note of a certificate of validity made under section 118 of the Act	45(1)	\$150 in respect of each trade mark number	23

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
10. Application for renewal of registration of a trade mark	47(3)(a), 47(4)	\$1400	9
11. Late application for renewal of registration of a trade mark	47(3)(b)	\$2100 (comprising \$1400 for renewal fee and \$700 for late renewal fee)	13
12. Application to restore a trade mark to the Register	51(1)	\$2100 (comprising \$1400 for renewal fee and \$700 for late renewal fee)	11
13. Application to register a change of ownership	53(1)(a)	\$350 in respect of each trade mark number	12
14. Application to register the grant of a licence	53(1)(b)	\$350 in respect of each trade mark number	24
15. Application to register an amendment of a licence	53(1)(c)	\$350 in respect of each trade mark number	25
16. Application to register the termination of a licence	53(1)(d)	\$350 in respect of each trade mark number	26
17. Application to register the grant, amendment or termination of any security interest	53(1)(e)	\$350 in respect of each trade mark number	30
18. Application to register the making of an assent, or an order	53 (1)(f)	\$350 in respect of each trade	10

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
of the Court or other competent authority		mark number	
19. Application for the revocation, or a declaration of invalidity, of the registration of a trade mark, or by any person other than the proprietor of a registered trade mark for the rectification of an error or omission in the Register relating to that trade mark	55(1), 55(2)(b)	\$350	17
20. Application for leave to intervene in proceedings	58(1)	\$350 in respect of each trade mark number	18
21. Application for cancellation of a trade mark-			
(a) where the cancellation relates to all the goods or services in respect of which the trade mark is registered	59(1)(a)	\$350 in respect of each trade mark number	20
(b) where the cancellation relates to some of the goods or services in respect of which the trade mark is registered	59(1)(b)	\$350 in respect of each trade mark number	21
22. Filing of rules relating to a collective mark or certification mark	61(a)	\$350 in respect of each trade mark number	5

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
23. Filing of amended rules relating to a collective mark or certification mark	63(1)	\$350 in respect of each trade mark number	19
24. Issue of a certificate under section 119 of the Act	86(1)	\$350 in respect of each trade mark number	28
25. Filing of a copy of an order of the Court for alteration or rectification of the Register	92(2)	\$350	29
26. Request to make any entry in the Register, or to rectify any entry therein, for which no fee is expressly provided	—	\$100	29
27. Inspection of —	—	\$50	—
(a) any notice of opposition;			
(b) any application for revocation or for a declaration of invalidity of a registration or for rectification of the Register;			
(c) any counter-statement, or any decision, given in relation to any opposition proceedings; or			

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
(d) any counter-statement, or any decision, given in relation to any application for revocation or for a declaration of invalidity of a registration or for the rectification of the Register			
28. Inspection of Register	—	\$50	—
29. For certifying office copies, manuscripts or printed matter	—	\$10 per page \$100 for certification	—
30. Request to enter a disclaimer or limitation in the Register	41	\$50 in respect of each trade mark number	22
31. Request for extension of time under Regulations 49(3) and 53(8)	49(3), 53(8)	1 st Extension-\$100 2 nd Extension-\$200 Other - \$300	31
32. Request for an extension of time to file statutory declaration under Regulations 29(5) or 30(4)	29(5), 30(4)	\$150	32
33. Request for reinstatement of application, right or matter	74(2)(a)	\$350 in respect of each trade mark number	27
34. Request to divide	17(1)	\$350 for each	4

FIRST SCHEDULE—CONTINUED

<i>Matter</i>	FEES		(Regulation 3)
	<i>Corresponding Regulation(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
an application for registration of a trade mark made in respect of 2 or more goods or services (referred to in this item as the original application) into 2 or more separate applications, each in respect of one or more of those goods or services		additional application that the original application is divided into	

SECOND SCHEDULE

(Regulation 5)

DESCRIPTION OF FORMS

<i>Forms</i>	<i>Description of Form</i>
TM 1	Request to appoint or change an agent or to enter or change an address for service
TM 2	Application to register a trade mark, collective mark or certification mark
TM 3	Request for grounds of decision
TM 4	Request to divide an application for registration
TM 5	Filing of rules governing the use of a collective mark or certification mark
TM 6	Notice of opposition
TM 7	Counter-statement
TM 8	Notice to the Controller of attendance at hearing
TM 9	Application for renewal of registration
TM 10	Assent by personal representatives or order of the court or other competent authority

SECOND SCHEDULE—CONTINUED

(Regulation 5)

<i>Forms</i>	<i>Description of Form</i>
TM 11	Application for restoration and renewal of registration removed from the Register
TM 12	Application to register a change of ownership
TM 13	Late application for renewal of registration
TM 14	Request to change the name, or other particulars of applicant for registration, proprietor or other interested person
TM 15	Application to amend the specification, class number or the priority claim of a trade mark application or registration
TM 16	Application to amend a trade mark application, registration (excluding change of name/address/address for service and amendments pertaining to the specification, class number or the priority claim), or correct a clerical error
TM 17	(1) Application for revocation or declaration of invalidity of registration of trade mark or protection of a protected international trade mark in Trinidad and Tobago; or (2) Rectification of the Register by persons other than the proprietor of the trade mark
TM 18	Application to intervene in proceedings
TM 19	Application to amend the rules governing the use of a collective mark or certification mark
TM 20	Notice to cancel a registration
TM 21	Notice of partial cancellation of the specification of goods or services for which the mark is registered
TM 22	Request by registered proprietor of trade mark for entry of disclaimer or limitation in the Register
TM 23	Request by registered proprietor for entry on the Register of a note of a certificate of validity by the court under section 118 of the Act
TM 24	Application to register a licensee
TM 25	Application to amend a licence
TM 26	Application to terminate a licence

SECOND SCHEDULE—CONTINUED

(Regulation 5)

<i>Forms</i>	<i>Description of Form</i>
TM 27	Request for reinstatement
TM 28	Request for Controller's general certificate
TM 29	Notice of order of court for alteration or rectification of Register
TM 30	Application to register the grant, amendment or termination of security interest or memorandum relating to a trade mark
TM 31	Request for extension of time
TM 32	Request for extension of time to file statutory declaration

THIRD SCHEDULE

(Regulation 71)

SCALE OF COSTS

<i>Item</i>	<i>Matter</i>	<i>Amount</i>
INSTITUTION OF PROCEEDINGS		
1.	Drawing and filing notice of opposition, application for revocation of registration of a trade mark, application for declaration of invalidity of registration of a trade mark, or application for rectification of an entry in the Register, all including a statement of grounds	\$ 1,500
2.	Drawing and filing counter-statement	\$ 1,500
3.	Preparing and filing evidence for opposition and revocation, invalidation or rectification proceedings	\$2,500-\$4,000 per statutory declaration
INTERLOCUTORY PROCEEDINGS		
4.	Preparing for all interlocutory proceedings	\$2,500-\$4,000
5.	Attending all interlocutory proceedings	\$2,500-\$4,000

THIRD SCHEDULE—CONTINUED

(Regulation 71)

<i>Item</i>	<i>Matter</i>	<i>Amount</i>
FULL HEARINGS		
6.	Preparing for hearing	\$1,000-\$3,000
7.	Attendance at hearing	\$2,500-\$4,000
8.	General and travelling expenses of witness required to attend the hearing —	
	(a) where the witness is an expert witness	\$1,000-\$2,000 per day
	(b) where the witness is not an expert witness	\$500-\$1,000 per day

Dated this 17th day of June, 2020.

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