

CARIFORUM INTELLECTUAL PROPERTY RIGHTS & INNOVATION



Trade Marks Distinctiveness: Trinidad and Tobago

**Presented by the Controller of the Trinidad and Tobago Intellectual
Property Office, Office of the Attorney General and Ministry of Legal
Affairs**

Overview



- What is a trade mark
- Traditional trade marks
- Non traditional trade marks
- Trade marks registration process
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- New examination criteria for trade marks
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- New examination criteria for trade marks
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- Relative refusal
- Assessing distinctiveness
- Case mapping
- Well-known marks
- Protection for certification marks

Overview

- Protection for collective marks
- Facilitating accession to the Madrid Protocol
- Question and answer



What is a trade mark



- “National legislations provide express definitions of what is a trade mark. Simply stated, a trade mark is any sign which is capable of distinguishing the goods or services of one individual or entity from those of another” – Pages 3 to 4 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf



What is a trade mark



REPEALING OF TRADE MARKS ACT CHAP 82:81 AND PROCLAMATION OF TRADE MARKS ACT NO. 8 OF 2015 WITH ACCOMPANYING REGULATIONS





<http://ipo.gov.tt/ipo-news/repealing-of-trade-marks-act-chap-8281-and-proclamation-of-trade-marks-act-no-8-of-2015-with-accompanying-regulations/>

What is a trade mark



Broader Definition of a 'Trade Mark'

Old Law – TMA Chap 82:81	New Law- TMA No. 8 of 2015
<p>Under the <u>Old Law</u> a trade mark was defined as a mark used in relation to goods indicating a connection in the course of trade between the goods and the proprietor.</p> <p>https://rgd.legalaffairs.gov.tt/law/s2/alphabetical_list/lawspdfs/82.81.pdf</p>	<p>The <u>New Law</u> expands the scope of this definition, to now protect traditional, as well as non traditional marks such as sound, scent, taste and touch (<u>Section 3</u>)</p> <p></p> <p></p> <p>http://ipo.gov.tt/downloads/Trademark/Trade_Mark_Act_2015.pdf</p>

What is a trade mark



- The New Trade Marks Act provides that a Trade Mark is any sign capable of being represented graphically and which is capable of distinguishing goods and services in the course of trade.
- **Section 3 of TMA:** “Trade mark” means, except in relation to a certification trade mark, *any sign capable of being represented graphically* and which is *capable of distinguishing goods or services* dealt with or provided in the course of trade by a person, from goods or services so dealt with or provided by any other person.
- “*Sound, scent, motion, touch (tactile) and taste marks must be capable of graphical representation in order to be filed at the IPOs*” (pg. 8 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf)

What is a trade mark



- The New Trade Marks Act has amended the definition of a Trade Mark to include non traditional marks, the following can be registered as a trade mark:



1. Words
2. Symbols
3. Names
4. Letters



1. Sound
2. Scent
3. Taste
4. Touch

Traditional Trade Marks



GUCCI



Mercedes-Benz





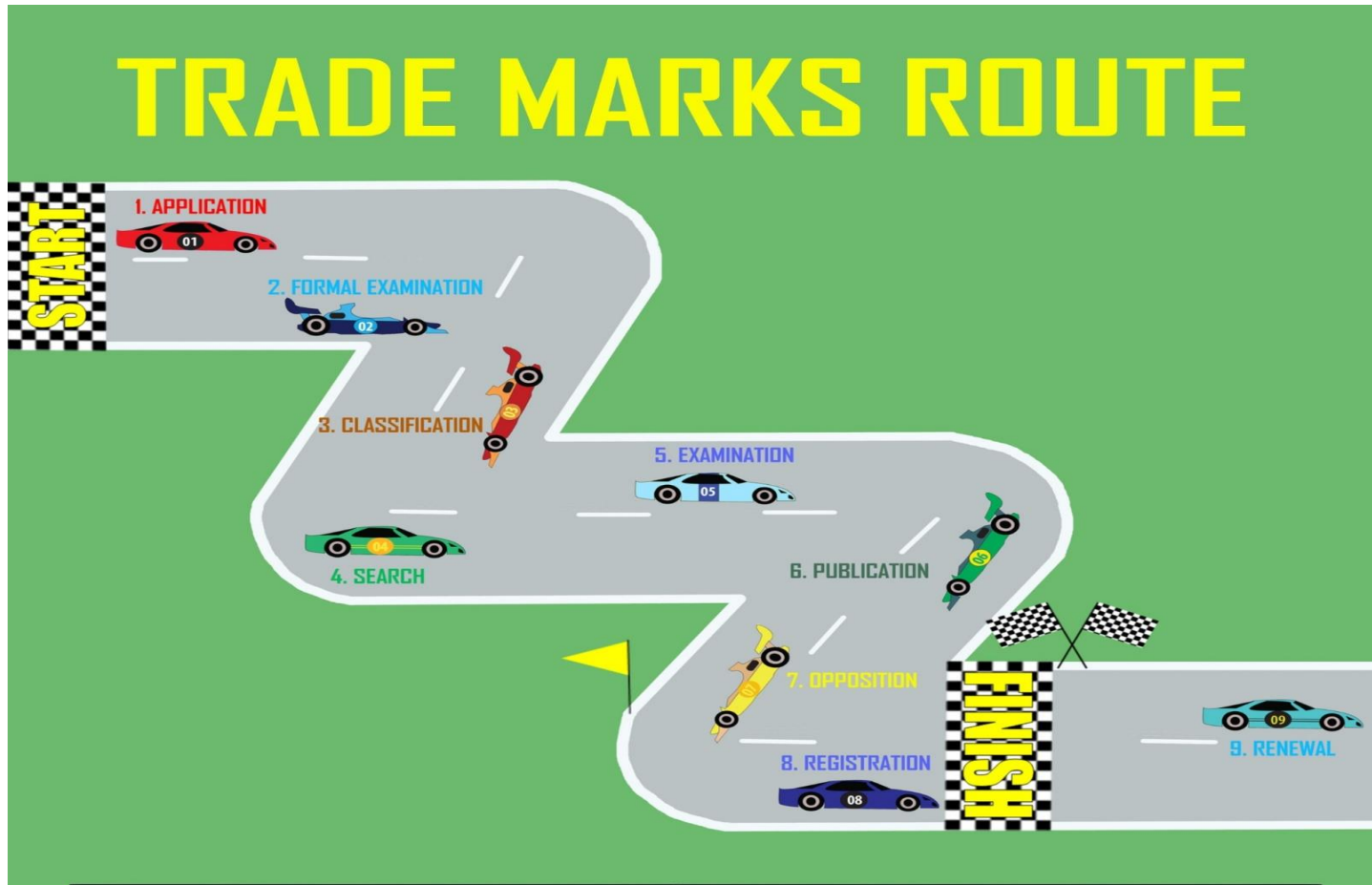
Non Traditional Trade Marks

- **SOUND** – Time Warner Entertainment- Looney Tunes Theme Song



- **SCENT** - Example of a Registered Scent in the UK - Tires with “a floral fragrance/smell reminiscent of roses”
- **TOUCH** - The distinctive texture of certain bags and luggage sold under the LOUIS VUITTON brand may be entitled to protection in some jurisdictions as a touch trade mark

Trade Marks Registration Process



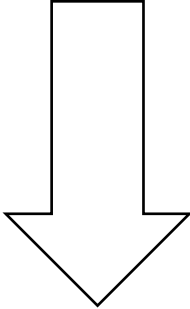
Examination Checklist



Documents Filed:	Yes	No	Date
Formalities, Nice Classification and Recent Search Report completed			
Mark overcomes absolute grounds? –s8			
Local applicant, search of Companies Registry completed?			
Is the applicant a distributor?			
Google search of mark and business (especially locals)/WIPO Global Brands Database			
Artificial intelligence search completed through global brands database (especially locals)			
Country of origin: has the mark been registered in the country of origin?			
Dictionary search completed for word marks- Oxford and Merriam Webster's			
Is there a translation of the word on file?			
Similarity with other marks – s9 Are the proprietors the same? <ul style="list-style-type: none"> • Are the goods and/or services the same/similar? • History of the similar mark noted? • Are there any missing fields in the search report? • Field test completed? • Well known marks-s9/58 • Similar pending applications • Coexistent registrations- GBD 			
Geographical name?			
Generic based on research			
Contrary to law (especially copyright), morality based on research or Scandalous mark			
Disclaimers			

New examination criteria for trade marks



OLD LAW	NEW LAW
Adapted to Distinguish (Part A) Capable of Distinguishing (Part B)	One Criteria  Capable of distinguishing

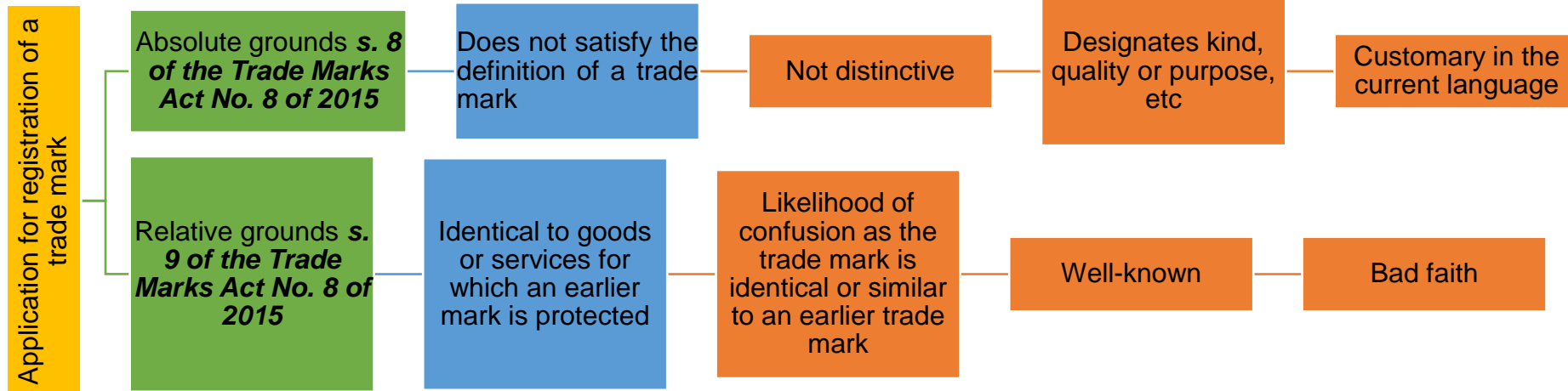
New examination criteria for trade marks



The introduction of Absolute and Relative Grounds for Refusing a Trade Mark

OLD LAW	NEW LAW
Provided for the Refusal of Trade Marks that does not satisfy certain conditions	Sets out those marks that are barred from registration according to two separate categories (Absolute and Relative grounds) (<u>Sections 8 and 9</u>)

Grounds of refusal of registration



Cross section of the grounds of refusal of registration adapted from the Trade Marks Act No. 8 of 2015 available online at http://ipo.gov.tt/downloads/Trademark/Trade_Mark_Act_2015.pdf

New examination criteria for trade marks



- “**The substantive examination** of the trade mark application **should not be conducted unless all the previous processes were conducted**, that is, formalities, Vienna Classification (if applicable), Nice Classification and the search for prior rights” (pg. 17 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf

- “**In conducting the substantive examination, the examiner should identify all the grounds for the refusal of the mark** and provide a cogent refusal that identifies the relevant sections of the law, any applicable case law and learning relative to the refusal of the mark” (pg. 17 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(1)(a) of TMA: A sign which does not satisfy the definition of a trade mark





Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(1)(b) of TMA: A trade mark which is devoid of any distinctive character



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(1)(c) of TMA: A trade mark which consists exclusively of signs or indications which to designate- **the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods** or of rendering of services, or other characteristics of goods or services





Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(1)(c) of TMA: Signs or designations which serve to designate the **kind** of goods or services

Adapted from pg. 28 of *“Intellectual Property Guides A Practical Guide to Trade Mark Law”* by Amanda Michaels Second Edition:
“Kind: An example of such a mark might be the word “Glasscan” for a glass beverage container; or a photograph of a pile of coffee beans on a jar of coffee; or a picture of a squeeze of toothpaste on a toothbrush to be registered in relation to toothpaste.”



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(1)(c) of TMA: Signs or designations which serve to designate the **quality** of goods or services



Adapted from pg. 28 of *“Intellectual Property Guides A Practical Guide to Trade Mark Law”* by Amanda Michaels Second Edition: *“An example of such a mark might be “5 star” whether for hotel services or brandy...”*

Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(1)(c) of TMA: Signs or designations which serve to designate the **quantity** of goods or services

Adapted from pgs. 28 to 29 of “*Intellectual Property Guides A Practical Guide to Trade Mark Law*” by Amanda Michaels Second Edition: “*Quantity: It is hard to think of any simple and exclusive indication of quantity which a sane trade mark proprietor might wish to register and which would be caught by this provision. However, clearly, any direct and exclusive reference to weight, length, etc., would fall under this heading.*”

Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(1)(c) of TMA: Signs or designations which serve to designate the **value** of goods or services

Adapted from pg. 29 of *“Intellectual Property Guides A Practical Guide to Trade Mark Law”* by Amanda Michaels Second Edition:
“Value: This may be hard to distinguish to distinguish from “quality” above, but would probably catch marks like “Budget” or “Kwiksave”.



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(1)(c) of TMA: Signs or designations which serve to designate the **time of production** of goods or services



Allusiveness – Baby Dry



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(1)(d) of TMA: A trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Adapted from pg. 64 of *“Intellectual Property Guides A Practical Guide to Trade Mark Law”* by Amanda Michaels Second Edition: *“Shredded Wheat” “Aspirin” “Escalator”, all of which were originally trade marks but lost their distinctiveness by becoming the generic name of the goods.”*



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(3) of TMA: A sign shall not be registered as a trade mark if it consists exclusively of— (a) the **shape which results from the nature of the goods themselves**; (b) the **shape of goods which is necessary to obtain a technical result**; or (c) the shape which gives **substantial value to the goods**



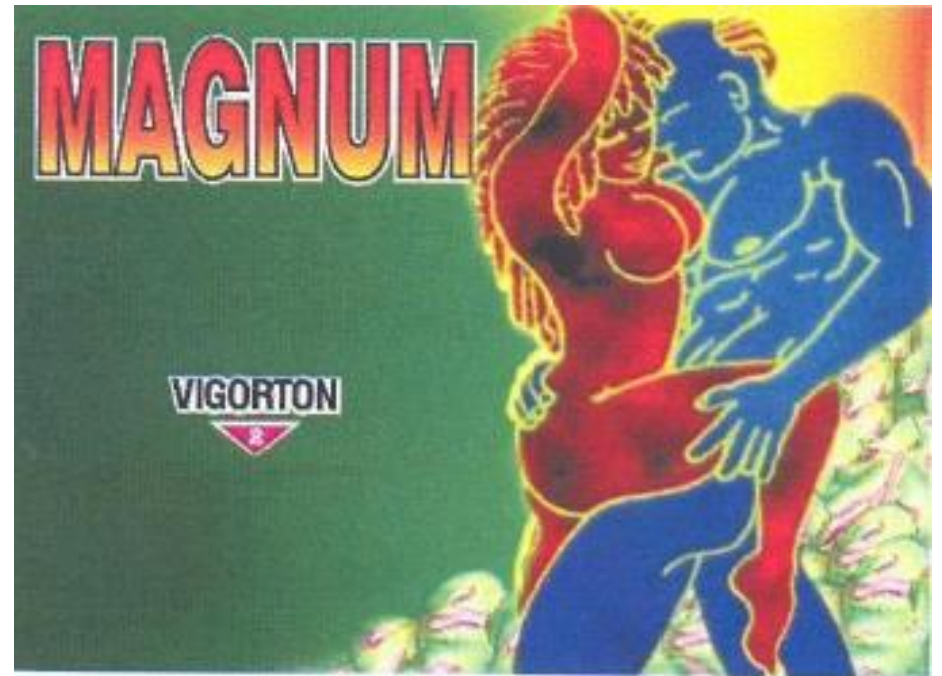
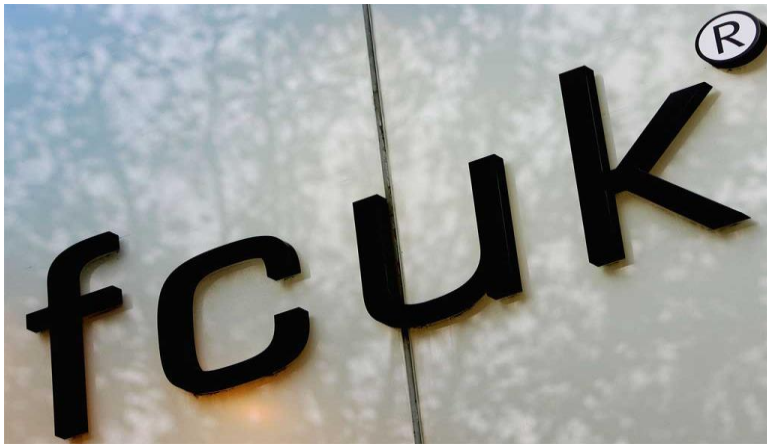
Philips v Remington (C-299/99)

Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(4) of TMA: Marks that are contrary to public policy or morality



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(4)(b) of TMA: Of such a nature as to deceive the public



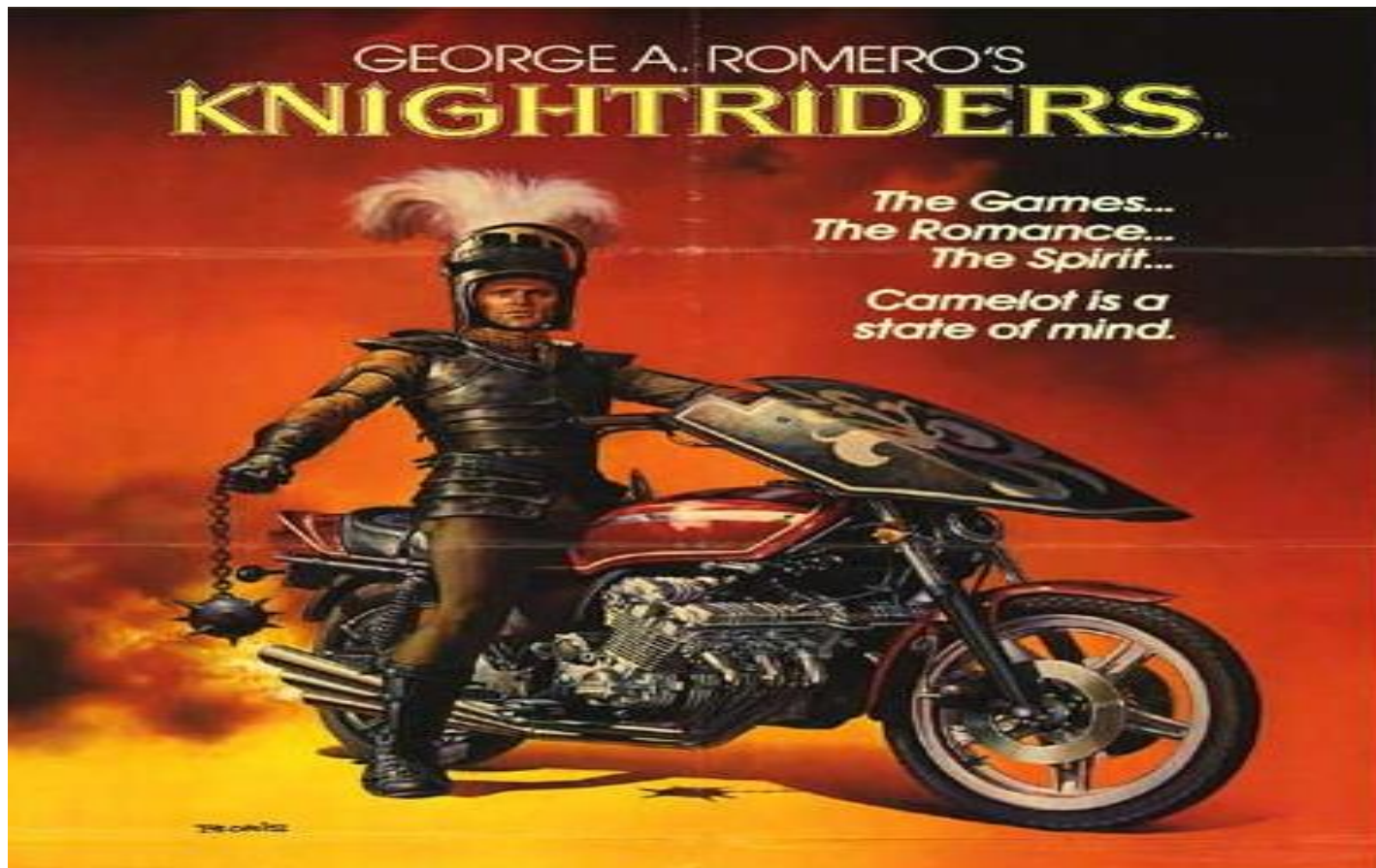
COSMOCARIBBEAN

Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015



Section 8(5) of TMA: Against law





Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

Section 8(6) of TMA: Bad faith applications

DC Comics v Cheqout [2013] FCA 478



Application for BG in the Superman Design was held as done in bad faith

<https://wipolex.wipo.int/en/text/581811>



Absolute Refusal

Section 8 of the Trade Marks Act No. 8 of 2015

DC Comics v Cheqout [2013] FCA 478: *“I am satisfied that DC Comics has established that Cheqout made the application for the Trade Mark in bad faith. This is evidenced by the use, soon after the application, of the word Superman together with the BG Shield Device, in the context of male fitness and strength. I note also that the red, white and blue colours traditionally used in conjunction with the Superman character were used by Cheqout together with the BG Shield Device. The design of the BG Shield Device closely resembles the insignia closely associated with the DC Comics character and the DC Comics registered trade marks. I am satisfied that at the date of application for the Trade Mark, Cheqout’s conduct fell short of the standards of acceptable commercial behaviour observed by reasonable and experienced persons.”*

<https://wipolex.wipo.int/en/text/581811>

Relative Refusal

Section 9 of the Trade Marks Act No. 8 of 2015



Confusingly similar



Gasec™-20 mg



Relative Refusal

Section 9 of the Trade Marks Act No. 8 of 2015

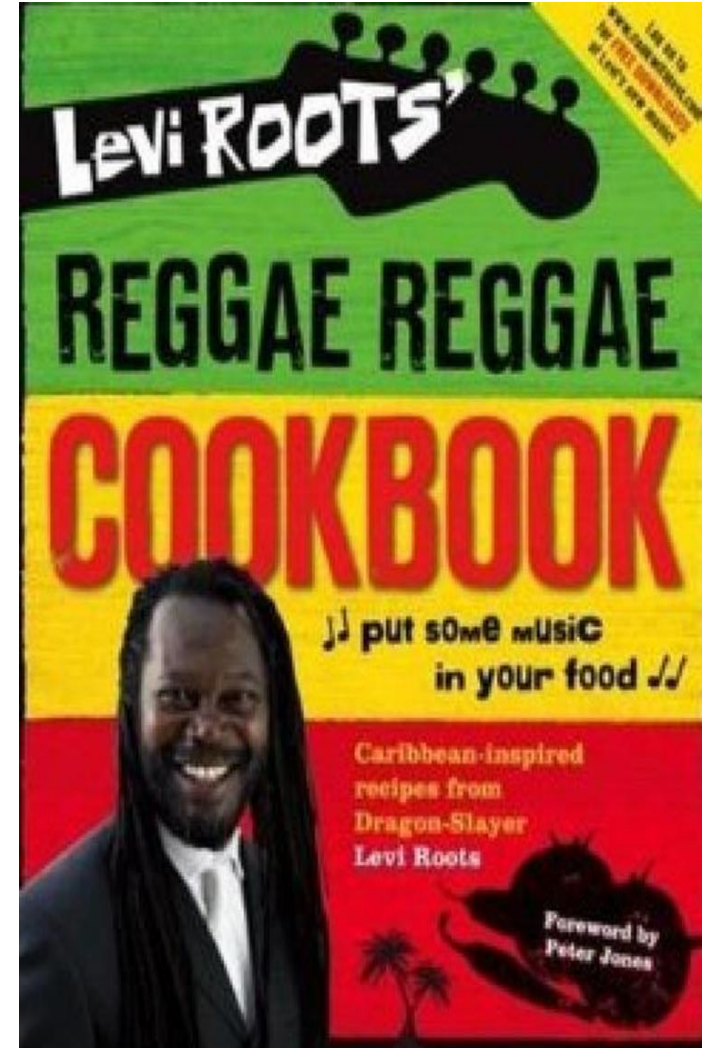


Section 9(1)(3) of the TMA – well-known marks



Relative Refusal

Section 9 of the Trade Marks Act No. 8 of 2015



Assessing distinctiveness: The propositions from Kerly's Law of Trade Marks and Trade Names 15th Ed.



FIRST	SECOND	THIRD	FOURTH	FOURTH
<ul style="list-style-type: none"> The trade mark must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings: <u>Windsurfing Philips, Linde, Henkel, etc</u> 	<ul style="list-style-type: none"> The distinctive character of a mark must be assessed by reference to (i) the goods or services in respect of which registration is applied for and (ii) the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect <u>Philips, Linde, Libertel, Henkel etc.</u> 	<ul style="list-style-type: none"> The criteria for assessment of distinctive character are the same for all categories of trade marks, but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, colours, personal names... <u>Linde, Libertel, Henkel, etc</u> 	<ul style="list-style-type: none"> (i) The market share held by goods bearing the mark, (ii) How intensive, geographically widespread and long-standing the use of the mark has been, (iii) The amount invested by the proprietor in promoting the mark; (iv) The proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor 	<ul style="list-style-type: none"> (v) Evidence from trade and professional associations (vi) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll.

Assessing distinctiveness: The propositions from Kerly's Law of Trade Marks and Trade Names 15th Ed.



FIFTH
<ul style="list-style-type: none">The identification by the relevant class of persons of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark. The expression “use of a mark as a trade mark” refers solely to use of the mark for the purposes of identification, by the relevant class of person, of the product as originating from a given undertaking: <u>Philips, Nestlé, Storck II</u>

Question of Fact

- Whether a sign possesses distinctive character, inherent or acquired, is a question of fact.

Assessment

- The assessment of inherent distinctive character depends upon the mark itself. This does not mean that the sign or mark is assessed in a vacuum: the trade of the goods or services in question provides the context.

Use

- The assessment of the distinctive character acquired through use requires an overall assessment of the way in which the mark has been used to ascertain whether the mark has become distinctive.

Additional propositions from Kerly's

Case Mapping: Common issues



Goods

- In **Re Jellinek's Application [1946] 63 RPC 59**, Romer J accepted Counsel's submission that the onus must be discharged by the applicant in respect of all goods coming within the specification applied for and not only in respect of those goods on which he is proposing to use it immediately, nor is the onus discharged by proof only that any particular method of user will not give rise to confusion; the test is: what can the applicant do (**Myall at Paragraph 10.80**).

Comparison of the marks

- In **Sabel BV v Puma AG, Rudolf Dassler Sport [1997] All ER (D) 69** The Court noted at **Paragraph 22**, "*the appreciation of the likelihood of confusion 'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.*"

Comparison of the marks continued

- The Court opined that the perception of the marks in the mind of the average consumer played a decisive role in determining registrability. The likelihood of confusion must be appreciated on a global scale, having considered all factors relevant to the circumstances of the case and a global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression which they convey, bearing in mind their distinctive and dominant components (**Sabel (supra) at Paragraph 23**).

Case Mapping: Most common issues



Comparison of the marks continued

- **Sabel (supra) at Paragraph 26** also ruled, “...the mere association which the public might make between two trademarks as a result of their analogous semantic content is not itself a sufficient ground for concluding that there is a likelihood of confusion.”

Co-existence

- **Tadeusz Ogrodnik vs. European Union Intellectual Property Office Case T 276/17 at Paragraph 79:** “.....the possibility cannot be ruled out that the coexistence of two marks on a particular market might, together with other elements, contribute to diminishing the likelihood of confusion between those marks on the part of the relevant public. The absence of a likelihood of confusion may thus be inferred from the peaceful nature of the coexistence of the marks at issue on the market concerned (judgment of 3 September 2009, **Aceites del Sur-Coosur v Koipe**, C 498/07 P, EU:C:2009:503, paragraph 82).”

Well-known

- **Hotel Cipriani v Cipriani (Grosvenor Street) [2009] R.P.C. 9 at Paragraphs 235-237,** “the learned Judge identified six criteria to be taken into account in assessing whether a mark is well-known. The list was neither exhaustive nor mandatory but provided a basic framework for the assessment: (i) the degree of knowledge or recognition of the mark in the relevant sector of the public; the relevant sector of the public for these purposes included but was not limited to consumers of the goods and services to which the mark applied, people involved in the distribution of the type of goods in question and business circles dealing with the goods or services in question;”

Case Mapping: Common issues



Well-known continued

- *(ii) the duration, extent and geographical area of any use of the mark; (iii) the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies; (iv) the duration, extent and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;*

Well-known continued

- *(v) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognised as well known by competent authorities; and (vi) the value associated with the mark”* **(Kerly’s Law of Trade Marks and Trade Names (2018) 16th ed. Paragraph 16-152).**



Well known marks

OLD LAW

Under the Old law, well known marks are protected under **Section 13A**.

In determining a well known mark, knowledge of the mark in Trinidad and Tobago must be taken into account, in the relevant sector of the public that deals with the relevant goods and services.

NEW LAW

Under the New Law, **Special Protection** is now granted for Well Known Marks. A trade mark is protected in T&T **whether or not** its proprietor carries on business or has goodwill in T&T. **(Section 3)**

This protection stems from **Article 6bis of the Paris Convention** which addresses strategies for the protection of well known marks internationally.

Protection for Collective Marks



OLD LAW	NEW LAW
Does not provide for the registration of Collective Marks.	Allows for registration and protection of Collective Marks. <u>(Part VII)</u>

Protection for Collective Marks



- Collective marks are marks that belong to an association of persons.
- *“A collective mark is a mark that distinguishes the goods or services of members of an organisation, which is the proprietor of the trade mark, from those of other organisations. A collective mark is usually owned by an association or any other entity, such as a public institution or a cooperative”*(pg. 5 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf

Protection for Certification Marks



- Certification marks certify the nature or origin of the goods or services on or in connection with which it is used.
- *“A certification mark is a mark that indicates the goods or services in connection with which it is used, are certified by the proprietor of the trade mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics”* (pg. 4 of the Caribbean Trade Marks Manual, October 17 available online at

http://ipo.gov.tt/downloads/Trademark/ctmm_oct_20_2017.pdf)



Protection for Certification Marks



OLD LAW	NEW LAW
Provides for Certification marks	Also provides for Certification Marks (<u>Sections 73 – 78</u>)

CDCTTL's Certification TM



Jamaica's Blue Mountain Coffee





Facilitating accession to the Madrid Protocol

OLD LAW

No provision under old law.

NEW LAW

Part VI of the new law, allows the Minister to make regulations to give effect to the provisions of the Madrid Protocol ([http://ipo.gov.tt/downloads/Trade mark/inter_reg_marks.pdf](http://ipo.gov.tt/downloads/Trade_mark/inter_reg_marks.pdf))

Trade Marks

Contracting Parties to the Madrid Protocol



- On **October 12, 2020**, Trinidad and Tobago deposited the instrument of accession with WIPO's Director General.
- As at **January 12, 2021**, there are 107 Contracting Parties to the Madrid Protocol covering 123 countries worldwide.
- The Madrid Protocol was implemented in Trinidad and Tobago on **January 12, 2021**.



Trade Marks

Case Study: Udazzle



- Registered in NCL 9: “Rulers (measuring instrument).”
- Registered in NCL 16: “Rulers (square and drawing).”
- Owner: U Dazzle Fashion Ltd.

Trade Marks

Case Study: Udazzle



(540) Mark



(531) International Classification of the Figurative Elements of Marks (Vienna Classification)- VCL (8)

i 01.01.04; 01.01.09; 26.11.01; 26.11.12; 26.11.14; 27.05.01; 27.05.07; 27.05.09; 27.05.10; 27.05.19.

(550) Indication relating to the nature or kind of mark

The words contained in the mark have no meaning

(i) Voluntary description of mark

The mark consists of the stylized word "Udazzle" which is an invented word. The mark has a dashed semi-circle surrounding the letters "azzle" and three four-pointed stars within the semi-circle above the letters "azzle".

(511) The International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) and the list of goods and services classified according thereto- NCL (11-2021)

09 Rulers [measuring instruments].

(821) Basic application

TT, 22.10.2015, 50578.

(822) Basic registration

TT, 16.06.2017, 50578.

(832) Designation(s) under the Madrid Protocol

CA, CN, EM, GB, RU, US.

<https://branddb.wipo.int/branddb/en/>

Question and Answer





Intellectual Property Office
Inspiring Innovation Protecting Creations



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