



Trade Marks Oppositions and Hearings: Practices in Trinidad and Tobago

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TTIPO

OUTLINE

- ❖ **Introduction**
- ❖ **Opposition Procedure**
- ❖ **Adjudication**
- ❖ **Inter Partes Hearing**
- ❖ **Role of the Hearing Officer**
- ❖ **Judgment**





What is a Trade Mark?

“...any sign capable of being represented graphically and which is capable of distinguishing goods or services...” (**s3 Trade Marks Act, No. 8 of 2015**)

When does an Opposition arise?

- When the Trade Mark application has been examined, the mark is either accepted or refused.
- If accepted it is then published in the online journal where the mark is now available for the public to inspect.



WHO MAY OPPOSE?



- Any person may file an Opposition.
 - ❖ **Trade Mark owner**
 - ❖ **Private Individual**
- A person may within the prescribed time from the date of the publication of the application, give notice to the Controller of opposition to the registration— **s14(2) of TMA**
- Other Oppositions- Applications to alter a registered Trade Mark- **Reg. 54 TMA**

OPPOSITION FILES

- An Opposition file, numbered sequentially in a series prefixed “OPP”, should be opened.



- The Opposition number should be entered prominently on the minute sheet of the Application being Opposed, and the file for the Application should be kept with the Opposition file.



OPPOSITION FILES

- All formal notices, correspondence and evidence relating to the Opposition should be filed in the Opposition file and also entered on IPAS.

SPECIMEN OF CHECKLIST

Trade mark Application No:				FILED IN TIME		EXTENSION OF TIME		
Opponent:		Agent:						
Applicant:		Agent:						
Documents Filed:	Yes	No	Date	Yes	No	Yes	No	Date
Publication Date:								
Notice of opposition (including statement of grounds): Form TM#6 (within 3 months of publication date Rule 26 & 27 TMR) Paid for (\$1400.00): Yes or No Date Paid:			Filing Date: Notification Date:					
<u>Counter-statement</u> by Applicant Form TM#7 (to be filed within 2 months of the receipt of the Notice of opposition) Rule 28 TMR Paid for (\$700.00): Yes or No Date Paid: No fees for extension of time request (EOT)			Filing Date: Notification Date:					Filing Date: Notification Date: Consent: Yes <input type="checkbox"/> No <input type="checkbox"/> Date
Evidence in support of opposition (to be filed within 2 months of the receipt of the Counter-statement) Rule 29 TMR Request for extension of time to file statutory declaration under r. 29 TM 32			Filing Date: Notification Date:					Filing Date: Notification Date: Consent: Yes <input type="checkbox"/> No <input type="checkbox"/> Date
Where the Opponent has not filed any evidence, his opposition will be considered withdrawn unless the Controller determines otherwise (Rule 29(3) of the TMR).								



<p>Evidence in support of application (to be filed within 4 months of receipt of opponent's Statutory Declaration) Rule 30 TMR</p> <ul style="list-style-type: none">• If the applicant does not comply, he shall be treated as having withdrawn his application (r. 30(2))• Request for extension of time: MUST be made within 2 months of receipt of the opponent's statutory declaration <p>Request for extension of time to file statutory declaration under r. 29 TM 32</p>			Filing Date: Notification Date:					Filing Date: Notification Date: Consent: Yes <input type="checkbox"/> No <input type="checkbox"/> Date
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<p>Evidence in Reply by opponent (to be filed within 2 months of receipt Applicant's Statutory Declaration) Rule 31 TMR</p> <ul style="list-style-type: none"> • (Rule 31(3) TMR) Request for extension of time: MUST be made within 2 months of receipt of the applicant's statutory declaration • Extension of time shall NOT exceed 6 months from the first request <ul style="list-style-type: none"> ○ Made on TM 32 			<p>Filing Date:</p> <p>Notification Date:</p>					<p>Filing Date:</p> <p>Notification Date:</p> <p>Consent:</p> <p>Yes <input type="checkbox"/></p> <p>No <input type="checkbox"/></p> <p>Date</p>
<p>Further Evidence Filed with leave of Controller (Rule 32 TMR) NO PAYMENT REQUIRED</p>								

Hearing **Rule 35 TMR**

- Written submissions and bundle of authorities must be filed at least one month before hearing date.
- Entry of appearance on TM 8
 - Failure to appear although TM 8 was filed: the Controller may proceed with hearing/ deliver decision/ dismiss proceedings.
- No appearance: Controller may dismiss proceedings.
- The Controller may set aside a decision rendered following the non-appearance of a party.
- Restoring proceedings or setting aside decision:
 - Rule 35(8) TMR- *an application to restore any proceedings or to set aside any decision under sub-regulation (6) or (7) shall be made within seven days after the proceedings have been dismissed or after the*

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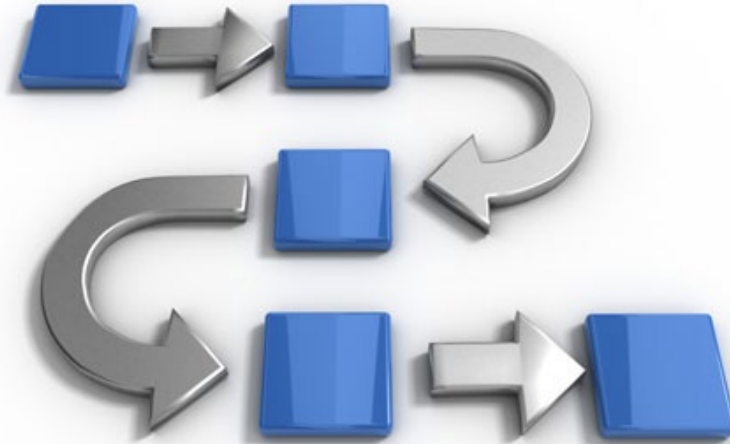


<i>hearing, as the case may be</i>								
Extension of time Rule 37TMR: <i>“Where any extension of time is granted to any party, the Controller may, if he thinks fit, without giving the party a hearing, grant a reasonable extension of time to the other party in which to take any subsequent step”</i>								

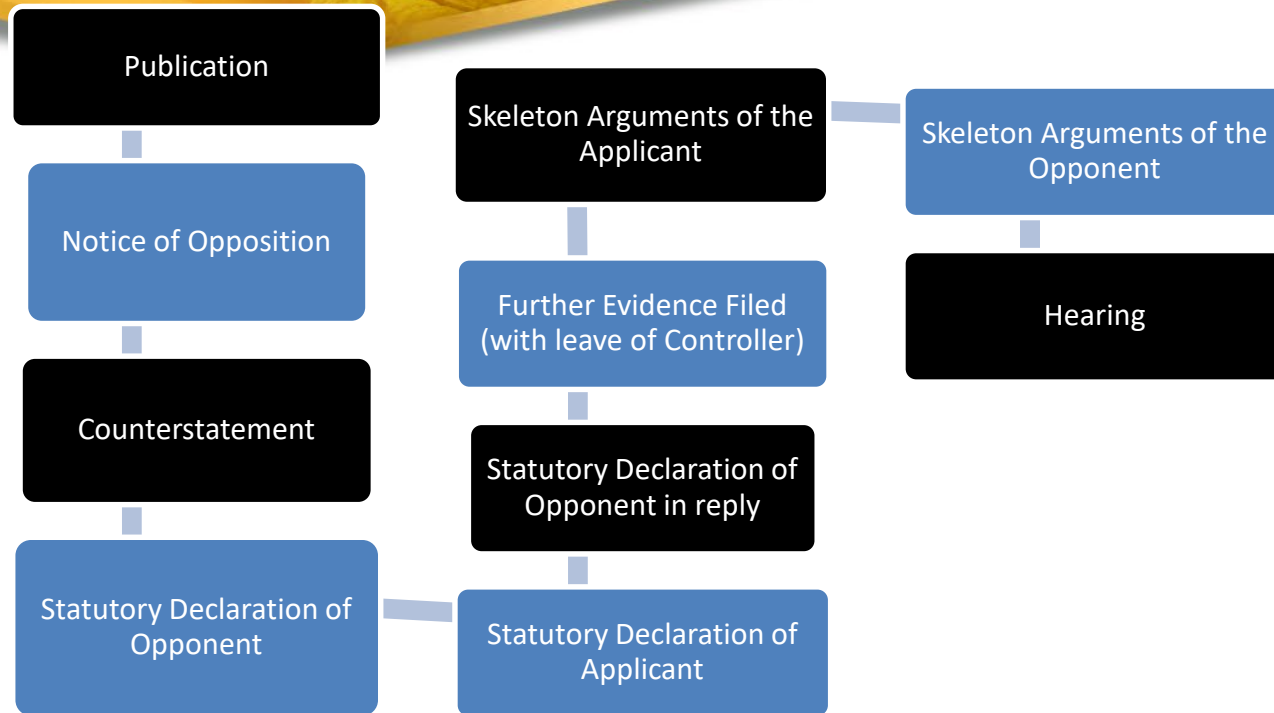
SCALE OF COSTS

TOPIC	ACT NO. 8 OF 2015 AND TMR
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
Drawing and filing counter-statement	\$ 1,500
Preparing and filing evidence for opposition and revocation, invalidation or rectification proceedings	\$2,500-\$4,000 per statutory declaration
INTERLOCUTORY PROCEEDINGS	
Preparing for all interlocutory proceedings	\$2,500-\$4,000
Attending all interlocutory proceedings	\$2,500-\$4,000
FULL HEARINGS	
Preparing for hearing	\$1,000-\$3,000
Attendance at hearing	\$2,500-\$4,000
General and travelling expenses of witness required to attend the hearing-	\$1,000-\$2,000 per day
(a) Where the witness is an expert witness	\$500-\$1,000 per day
(b) Where the witness is not an expert witness	

OPPOSITION PROCEDURE



PROCEDURE



NOTICE OF OPPOSITION

Regulation 26 of TMR

- ❖ A Notice of Opposition can be filed within 3 months from the date of publication (no Extensions of Time (EoT) can be granted).
- ❖ Notice of Opposition is filed on Trade Mark Form No 6.
- ❖ A fee of TTD \$1400 must be paid.
- ❖ The Notice of Opposition must include:
 - ✓ The grounds on which the Opposition is based under the **TMA** such as:
 - Section 8(1)(b) – mark is devoid of any distinctive character
 - Section 9 – relative grounds for refusal of registration

**IMPORTANT
NOTICE**

COUNTERSTATEMENT



Rule 28 TMR

- Within 2 months of receiving the Notice of Opposition, the Applicant (party who applied for the mark) has to file a Counterstatement on TM No. 7.
- If no Counterstatement is filed within the time, the Application is deemed to have been abandoned.
- However, parties can file for an extension of time.

FILING OF EVIDENCE

- ❖ Opponent must file Statutory Declaration supporting the opposition- **Rule 29 of TMR**
 - ✓ Must be filed within **2 months** of the receipt of Counterstatement
 - ✓ If not filed, opposition deemed withdrawn (EoT permissible)
- ❖ Applicant must file Statutory Declaration- **Rule 30 of TMR**
 - ✓ Must be filed within **4 months** of the receipt of Opponent's Statutory Declaration
 - ✓ If not filed, application deemed withdrawn (EoT permissible)
- ❖ Opponent to file Statutory Declaration strictly in reply to the Applicant's Declaration- **Rule 31 of TMR**
 - ✓ Must be filed within **2 months** of the receipt of Applicant's Statutory Declaration

EVIDENCE



Order of presenting evidence:





ADR Services

- MOU between the TTIPO and World Intellectual Property Organization's Arbitration and Mediation Center
 - Mediation is encouraged especially prior to Skeleton Arguments being filed

<http://ipo.gov.tt/ipo-news/alternative-dispute-resolution/>

WIPO | ADR
Arbitration
and Mediation
Center



SKELETON ARGUMENTS

- ❖ The filing of Skeleton Arguments are required prior to hearing
- ❖ Skeleton Arguments can include:
 - ✓ Case law
 - ✓ Points of law

- ❖ Skeleton Arguments should **not** include:
 - ✗ Fresh Evidence
 - However, the Controller retains the discretion to permit the filing of further evidence at any time.- **Rule 32 of TMR**

ADJUDICATION

- ❖ Parties have the option of either written submissions or an oral hearing- **Regulation 35(3) TMR.**
 - ❖ All parties must agree in writing for the option via written submissions
 - ❖ All Opposition parties prefer the approach of written submissions at the TTIPO
- ❖ The Burden of Proof is on the Applicant.
- ❖ Oral Hearing
 - ✓ TTIPO consults with the parties to determine a day/time for the hearing.
 - ✓ **Form TM8** shall be filed for the opposition hearing- **Regulation 35(3) TMR.**
 - ✓ Parties must file confirming their attendance on TM No. 7 within **7 days** of notice from the TTIPO.



Interim Proceedings- EoT

- ❖ Where a party requires an extension of time to file a required document, they should first seek the consent of the other party. If consent is not granted it goes to Interim Proceedings
- ❖ 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– *Rule 37 of TMR*



ROLE OF THE HEARING OFFICER

- ❖ Hearing Officer can be the Controller, Deputy Controller, Legal Officer II (where appointed)
- ❖ The role of the Hearing Officer is to listen carefully to the submissions on Preliminary Matters and Substantive Matters and guide parties to the issues at hand
- ❖ Evidence presented during the hearing is not admitted unless directed by the Controller





Judgment

- ❖ Judgment is issued within a 3 month period. At the end of the Hearing, the Hearing Officer will set a date as to when the Judgment will be provided.
- ❖ If parties ask for costs in written submissions, the Hearing Officer can award costs according to the scale provided in the *Third Schedule of the Trade Marks Regulations.*
- ❖ Judgment can be appealed to the High Court based on an error of fact or application of the law.

Examples of Judgments

TRINIDAD TOBAGO

TRADE MARKS ACT, CHAPTER 82:81

IN THE MATTER OF the Trade Mark Application No. 42712 “ZIG-ZAG AND DEVICE” in Class 34 in the name of Republic Technologies (NA) LLC, a company organized and existing under the laws of the State of Delaware, whose trade or business address is at 2301 Ravine Way, Glenview, Illinois 60025, United States of America and Opposition thereto by North Atlantic Operating Company Inc., a company organized and existing under the laws of Delaware.

DECISION

FACTS:

1. Trade Mark Application No. 42712 “ZIG-ZAG AND DEVICE” was applied for on 8th September, 2010 in Class 34 in respect of “*Tobacco; smoking tobacco; cigarettes; smoker's articles (not of precious metal) including cigarette papers in booklets or in tubes, automatic rolling boxes, rollers, tube filing machines, filter tips, metal boxes (not in precious metals) for cigarettes, cigars, tobacco and cigarette papers in booklets*”. The application was accepted and subsequently published in the Newsday newspaper on 20th March, 2013.
2. Counsel representing Republic Technologies (NA) LLC (Applicant)- Olive Ramchand (Fitzwilliam Stone Furness-Smith & Morgan)
3. Counsel representing North Atlantic Operating Company Inc. (Opponent)- Ariane Ramnath (J.D. Sellier & Co.)
4. A Notice of Opposition was filed on 6th September, 2013 by the Opponent on the grounds that pursuant to **Section 13(a)(i)** of the **Trade Marks Act, Chap 82:81**, Trade Mark Application No. 42712: “ZIG-ZAG AND DEVICE”

Opposition and Rectification Matters

Number of Opposition Matters presently before the TTIPO	12
Number of Rectification Matters presently before the TTIPO	1
Number of Opposition Matters received in 2022	2
Number of Rectification Matters received in 2022	2

THIRD SCHEDULE 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



<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



IMPORTANT POINTS TO NOTE

- **PROPER AND EFFICIENT RECORD KEEPING**
Use of IPAS, DIARY and CHECKLIST
- **DOUBLE OPPOSITION**
ZUCARITAS v ZUCOSOS
- **MUTIPLE OPPOSITIONS TO ONE MARK**
TARGET
- **POSSIBILITY OF A 'WIN-WIN' JUDGMENT**
BULLSEYE

Role of the IP Library

- In 2017 the IPO was granted depository library status by WIPO. As such, WIPO will provide the IPO with annual publications including: books, magazines, CDs, and reports in various topics.

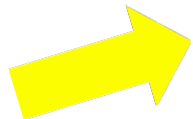
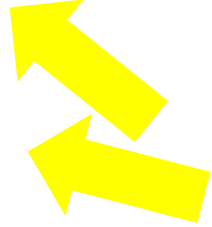


<http://ipo.gov.tt/ip-library/library-information/>



*Thank
you*





Ipo Trinbago

Address: 3rd Floor, Capital Plaza, 11-13
Frederick Street, Port of Spain.

Email: info@ipo.gov.tt/Phone: 226-4IPO(4476)

[www.ipo.gov.tt/kavish.seetahal@ipo.gov.tt/](http://www.ipo.gov.tt/kavish.seetahal@ipo.gov.tt)
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