

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Trinidad and Tobago

Introductory Remarks

As a former British colony, Trinidad and Tobago inherited its legal system from the United Kingdom. Consequently, Trinidad and Tobago has a "Common Law" legal system as opposed to a civil law legal system.

The system for the enforcement of all rights in general is provided through a combination of legislation and the Common Law. Intellectual property rights in Trinidad and Tobago are private rights and consequently the onus of enforcing those rights lies with the right holder.

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.

The Supreme Court of Judicature (comprised of the High Court of Justice and the Court of Appeal) with a final appeal to the Judicial Committee of the Privy Council.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Which persons have standing to assert IPRs?

The proprietor of the intellectual property right or a licensee may assert his right in the intellectual property right through civil proceedings. In the case of trademarks, patents, industrial designs and layout-designs of integrated circuits, the registered proprietor of the right or the "registered licensee" may assert that right. In the case of copyright, neighbouring rights and protection of secret information, the proprietor of the intellectual property right may assert the right. There is no system of registration of the latter category of intellectual property rights.

In relation to enforcement of copyright and neighbouring rights, proceedings may be brought by anyone claiming to be the owner either as a result of creation, of subsequent operation of the law, or by virtue of assignment or other transmission of the right(s). Such enforcement proceedings can also be brought (except against the owner) by an exclusive licensee.

¹ Document IP/C/5.

In the case of trademarks, patents, industrial designs and integrated circuits, and plant breeders' rights, the proprietor of the intellectual property right must be recorded on the Register. In the case of geographical indications, any interested person and any interested group of producers or consumers may institute proceedings in the court to prevent any unlawful act.

Unregistered trademarks are enforced by a "passing off" action under Common Law in which the plaintiff must show that the defendant has misappropriated some part of the plaintiff's "goodwill".

How may they be represented?

Before the Supreme Court, a natural person may appear in person, but a corporate entity must be represented by an Attorney-at-Law entitled to practise in Trinidad and Tobago.

Are there any requirements for mandatory personal appearances before a court by the right holder?

There are no such requirements.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence that lies within its control?

The courts have the authority to order the production of documents in court by virtue of The Rules of Court. In Trinidad and Tobago, a party to litigation has an obligation (either automatically or upon order of the court) to give "discovery" of such documents which it may have in its custody, possession or power which relate to the issues in the litigation proceedings. This involves first producing a list of such documents and then the opposing party has the power to inspect and take copies of those documents, save where legal or professional privilege is properly claimed, for example in relation to communications relating to legal advice or the preparation of witness statements. Any breach of this discovery obligation leaves the defaulting party at risk of having his statement of claim or defence struck out.

There is also the power of the court to make orders at the start of proceedings for the protection of evidence in those proceedings if there is a legitimate fear of such evidence being destroyed. See answer to question 10, on Anton Piller Orders.

4. What means exist to identify and protect confidential information brought forward as evidence?

There are no statutory directives given to the court regarding confidentiality and it is entirely in the court's discretion as to how they will deal with confidential information brought forward as evidence. The onus lies on the party claiming confidentiality of information to apply to the court for directions as to confidentiality. If in the exercise of its discretion, the court determined that the confidentiality of that information needed protecting, it would order terms and conditions for its protection.

The courts in Trinidad and Tobago normally hold the substantive trial of litigation in a court open to members of the public (including journalists). However, some of the preliminary proceedings may be held "in chambers", that is in a court closed to the public. The court also has the power to sit "in camera", that is in closed session, where it is satisfied that it is necessary to do so to protect legitimate secret information.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use;

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Injunctions

Under their general jurisdiction and under the provisions of the various intellectual property laws, the courts may grant relief for infringement in the form of an interlocutory (that is interim) or permanent injunction and, at the option of the plaintiff, either damages or an account of profits. Under their general jurisdiction the courts have the powers to order an unsuccessful party to pay the costs of the successful party.

The courts apply the rule that they may grant an interlocutory injunction if the court is satisfied that there is a serious issue to be tried, if the risk of damage to the plaintiff if the injunction is not granted will not be compensated by an order for damages, provided that the plaintiff gives an undertaking to compensate the defendant if the injunction is later found by the court to be unjustified. A permanent injunction may be granted where the plaintiff establishes infringement.

Damages, recovery of profits and expenses, including attorney's fees

Under their general jurisdiction and under the provisions of the various intellectual property laws, the courts have wide powers to award damages for infringement, or if the plaintiff prefers, an account of profits. Under the Copyright Act, the plaintiff can be awarded damages in the case of innocent infringement but the quantum of damages will take into account the fact that the infringement was innocent. Damages usually include the recovery of commercial losses associated with the infringement and an award of damages would normally be accompanied by an order for payment of legal costs incurred by the successful party in the case.

As to the expenses and attorney's fees, it is the practice in Trinidad and Tobago to order that costs be taxed if not otherwise agreed. Under such order the successful party will normally recover a sum corresponding to the reasonable sums which were reasonably expended in the litigation (including court costs and attorney's fees). If these cannot be agreed between the parties, such costs are assessed by the Registrar. However, as a party will normally spend more money on a case than the Registrar will consider reasonable, and as the Registrar will disallow all claimed costs for which there are not sufficient evidence of how the costs have been incurred and of receipts for expenditure, a successful party will, in actuality, probably recover only two-thirds of its actual costs. Where the court considers that litigation (or a single issue in it) was brought unreasonably, it can make an order for the costs thereof to be assessed on an "indemnity basis". Under this basis the party's costs are assessed as its total costs other than those which were unreasonably incurred.

Destruction or other disposal of infringing goods and materials/implements for their production

The courts have an inherent jurisdiction to order defendants to deliver up infringing goods and copies as well as materials/implements for their production. Provisions of the Copyright Act and the Trade Marks Act allow for the seizure of infringing goods or copies, and, in the case of the Copyright Act, the equipment used for making them, and delivery of the goods, copies or equipment to the right owner, the exclusive licensee or the performer, or their destruction. There is also a provision for disposal of forfeited goods or copies by the Customs authority. The Trademarks Act

makes it an offence to manufacture or possess a die, etc., for use in the commission of a trademark offence.

The Trade Marks Act provides for the court to direct the disposal of counterfeit goods which have been seized by the Customs authorities. Under the Copyright Act, if the court directs that copies are forfeited to the State, the copies must be disposed of as prescribed by regulations.

For patent infringement, a court has statutory power to make an order for the infringer "to deliver up or destroy any patented product in relation to which the patent has been infringed or any article in which that product is inextricably comprised".

For infringement of a registered trademark, the court may order the offending sign to be erased, removed or obliterated from infringing goods, material or articles in the possession, custody or control of the infringer; or for such goods, materials or articles to be delivered up to the trademark proprietor, and the court can then order their destruction.

For infringement of copyright or neighbouring rights, the court may (as a part of its inherent powers) similarly order delivery up of infringing works in the custody of the defendant. In addition, orders for delivery up and subsequent destruction of infringing goods are also available as part of the criminal procedure for copyright infringement (see answer to question 24 below).

The court likewise has inherent powers to make orders for delivery up, or destruction, of articles coming into existence for the purposes of "passing off" or as a result of knowingly acting in breach of confidence.

Any other remedies

As an alternative to an award of damages, the owner of copyright or neighbouring rights, a patent or a new plant variety, upon a finding of infringement of his rights, may elect to seek, instead of damages, an "account of profits". This requires the court to assess the profits which the infringer has made as a result of his infringing acts and to pay these over to the right holder.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods of services found to be infringing and of their channels of distribution?

It is within the inherent powers of the courts of Trinidad and Tobago to make such orders, even (in an appropriate case) prior to a finding of infringement. The courts will routinely order an infringer to provide information which identifies those who have supplied to him infringing articles, and also those who have supplied particular means by which these have been made, provided in this latter case that such means were supplied with knowledge, or a reasonable belief, that such would be used in infringing acts.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Describe provisions relating to the indemnification of defendants wrongfully enjoined

An interlocutory injunction will only be ordered by a court on the basis of the plaintiff giving to the court an undertaking that, if the defendant is subsequently found to have been wrongfully enjoined, the plaintiff will pay damages therefor to the defendant. The court can require security for such an undertaking to be given, by way of a deposit of money in the court's funds or by providing a

guarantee from a bank or other reliable source of funds, and will normally do so in the case of a plaintiff resident outside the jurisdiction.

To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

The judges in the courts of Trinidad and Tobago are under the common law immune from litigation in the event that their decisions may subsequently be overturned, either by an appellate court, or by a court in another case reaching a different conclusion.

The Controller is generally immune from liability resulting from the performance of his statutory duties.

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

Describe provisions governing the length and cost of proceedings

There are no such provisions in the laws of Trinidad and Tobago. The Rules of Court stipulate periods for dealing with various pre-trial matters, which periods can usually be extended by agreement between the parties, without application to the court. However, at any stage, a party may apply to the court for a specific order that the litigation against the defaulting party be dismissed or for an order requiring the opposing party to take some step within a defined period, failing which the litigation should automatically be determined against that party.

Before the substantive trial takes place, there will be many and varied pre-trial procedures which the parties may be required or choose to employ. There is first a formal exchange of pleadings which sets out the allegations made against a party and the defences which the opposing party proposes to raise against these. These pleadings do not set out to enumerate the detailed facts which will have to be established if the allegations are to succeed at the eventual trial. A party may at this time make admissions which reduces the issues in contention and there then follows the discovery of documents which relate to the determination of those live issues, for which see answer to question 3 above. When these pre-trial procedures are judged to be complete, the case may be "set down" for trial.

Provide any available data on the actual duration of proceedings and their cost

There is no useful data available since the duration and cost of proceedings for enforcement of intellectual property rights depend on the complexity of the particular case and whether (and if so at what stage) settlement is reached before the trial of the substantive issues.

(b) Administrative procedures and remedies

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

Trinidad and Tobago's intellectual property right legislation does not have provisions for administrative procedures that deal with infringement. Administrative determinations are related to registration rather than infringement.

Provisional Measures

(a) *Judicial measures*

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

Under the Common Law system the court has the following powers:

- The High Court has power to adjudicate upon enforcement of intellectual property rights and can take provisional measures before full trial on the merits of a case, including the grant of interim or preliminary injunctions called interlocutory injunctions.
- The court may also grant relief of the type known as Anton Piller order after the case in which this relief was first made. Under this order, the defendant is required to admit to its premises, as named in the order, persons named in the order and supervised by an independent attorney to search for and take into custody any document and things of the type specified in the order in order to preserve such as evidence for a trial. The defendant is also usually enjoined from activity likely to be an infringement of the stated intellectual property right and is required to make an affidavit disclosing the source of the articles which have already left the premises.
- The courts can also grant what is called a Mareva injunction, again after the case in which it was first made. This is an order for the blocking of bank account, and other assets of the defendant pending review of these by the court.
- A further provisional measure, rarely applied, is the issue of the writ *ne exeat regno*. Under this, a party is forbidden to leave the country until further order of the court. As with the Mareva injunction, this writ will normally only be used when it is feared that a defendant will leave the jurisdiction of the court before damages awarded by the court have been paid.
- Yet a further provisional measure, is an application to the court for an interim award of damages. To obtain this, the plaintiff must show to the court that it is likely that at full trial the court will award substantial damages and that, pending the assessment of these at trial, it is just that there should be an interim payment. The court may make it a condition of such payment that the defendant will take steps to preserve the sum for reparation (with interest) should the court at trial award the plaintiff no damages, or a lesser sum than the interim payment.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

In cases of exceptional urgency, the High Court will order an injunction on an *ex parte* basis, that is *inaudita altera parte*. However, this will only be done when the court is of the opinion that an immediate injunction is necessary because otherwise the plaintiff is likely to suffer extreme and irreparable harm. *Ex parte* injunctions are granted to the plaintiff for a matter of days only, the plaintiff must then return to the court at a time when the defendant can also be present and then seek a renewal of the injunction on the grounds set out in the answer to question 10 above. Some of the other types of provisional relief such as Anton Piller and Mareva orders are normally made on an *ex parte* basis in order to surprise the defendant and thereby prevent it from taking steps to evade the relief ultimately to be awarded by the court.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

Usually the plaintiff is required to institute the action by filing a writ of summons before applying for provisional measures. In cases of extreme urgency, an *ex parte* injunction may be granted, upon an undertaking by an intended plaintiff to file the writ of summons at the earliest possible opportunity. Indeed an *ex parte* injunction may issue, upon the mere production to the Judge of the infringing item, upon Counsel's undertaking to put the supporting evidence of infringement on oath, at the earliest possible opportunity.

Strict guidelines will be given by the Judge granting *ex parte* injunction for the "return hearing" when the defendant will be afforded an opportunity to be heard. On the return hearing the general principles governing interlocutory injunctions will be applied and also key measures in affording protection to the defendant against damages that he may incur in the event that the provisional measure is proved to be unjustified. These could include undertakings by the plaintiff supported by bond to secure the payment of damages or less commonly by a payment of money into court.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

Describe provisions governing the length and cost of proceedings

Under the laws of Trinidad and Tobago there are no provisions which govern the length or costs of proceedings for provisional measures. Provided that a request for provisional measures is made promptly, the court will then stipulate a timetable for further procedure and a hearing date will be fixed.

As provisional relief is usually requested because of the threat of imminent damage to the interests of the plaintiff, the court will expedite the timetable in an appropriate way according to the perceived need for immediate relief. The appeal courts will likewise act with great expedition when it is perceived that this is necessary in the public interest.

The normal rules with respect to costs explained in the answer to question 5 above also apply to applications for provisional measures. However, the usual order for costs awarded in respect of applications for provisional relief is that these only take effect at the end of the substantive trial, though the court can make an order for "costs to be taxed and paid forthwith".

Provide any available data on the actual duration of proceedings and their cost

Refer to the previous answer.

(b) *Administrative measures*

14. Reply to the above questions in relation to any administrative provisional measures.

There are no provisions in the laws of Trinidad and Tobago whereby provisional relief can be given by an administrative body, save as regards "border measures" discussed in the answers to questions 15-19 below.

Special Requirements Related to Border Measures

15. **Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis imports*). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51)

Under the inherent jurisdiction of the High Court, under Common Law, procedures exist that enable a right holder who has valid grounds for suspecting that the importation of goods infringe any intellectual property right (i.e. rights in respect of copyright and related rights, trademarks, geographical indications, industrial designs, patents and layout-designs of integrated circuits) to apply to the Court for an order for the suspension by the Customs authorities of the release into free circulation of such goods. The existing judicial procedures cover the evidence required to be furnished, security or equivalent assurance, notice to all interested persons, duration of suspension, indemnification of the importer and of the owner of the goods (and all other persons entitled to indemnification) and right of inspection and information.

In addition to the procedures mentioned and referred to above, and in the answers to questions 5 and 10, the procedures set out below exist in Trinidad and Tobago.

Section 48 of the Copyright Act 1997 allows the Trinidad and Tobago Customs and Excise to seize imported copies of published copyright material if a notice of objection to importation of the copies has been given to the Comptroller of Customs and Excise. The material that must be subject of such copies is published works or sound recordings. Three copies imported for personal use only by a natural person are exempt from seizure.

Section 71 of the Trade Marks Act allows the Trinidad and Tobago Customs and Excise to seize infringing trademark goods imported into Trinidad and Tobago in respect of which a notice of objection has been filed with the Comptroller of Customs and Excise under section 71(A) by the registered owner of a registered trademark. Importation by a natural person for his personal use of not more than five of the same items bearing a registered mark in respect of which notice has been given shall be permitted, except that the Comptroller has a discretion to permit importation of a greater number of items if satisfied that they are for the personal use of that natural person. Where the infringing goods have applied to them or in relation to them a mark that in the opinion of the comptroller is substantively identical with or deceptively similar to the notified trademark and are goods in respect of which the notified trademark is registered or for similar or related goods, the Comptroller shall seize the goods unless he is satisfied that there are no reasonable grounds for believing that there is an infringement.

Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

The Copyright Act allows for the interdiction of such goods where their importation is prohibited by the copyright owner. See the answer given to question 15 above. As to the import of goods put on the market in another country, the Patents Act and Industrial Designs Act provide expressly for national exhaustion. The Trade Marks Act and the Layout-Designs Act do not contain an express provision on the level of exhaustion.

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?

Under section 71 of the Trade Marks Act and section 48 of the Copyright Act, the competent authority to suspend the release of the goods is the Comptroller of Customs and Excise.

To initiate the seizure of copies or counterfeit goods, the copyright owner, exclusive licensee or the trademark owner, or authorised user must provide a written notice of objection to importation to the Comptroller of Customs together with any prescribed documents. A notice remains in force for two years from the day on which the notice is given. The Comptroller may not seize copies or goods unless the copyright owner, exclusive licensee or the trademark owner or authorised user provides a security to cover the expense that may be incurred by the Comptroller.

Under the Trade Marks Act, the Comptroller may seize infringing goods which are manufactured outside Trinidad and Tobago and imported into Trinidad and Tobago and which are subject to the control of the Customs and Excise under the Customs Act. Similarly, under the Copyright Act, the Comptroller may seize copies if a written notice of objection has been given to the Comptroller, and if the copies are imported into Trinidad and Tobago for trade or some other purpose which will prejudicially affect the owner of copyright or neighbouring rights. If goods have a trademark that, in the opinion of the Comptroller, is identical with, or deceptively similar to, a notified trademark and are goods in a class for which the trademark is registered the Comptroller must seize the goods unless satisfied that there are no reasonable grounds for believing that infringement has occurred.

Once goods or copies have been seized, the Comptroller must give notice of the seizure, to the objector and the importer or owner, which notice identifies the copies or goods.

Under the Trade Marks Act, the notice must also state that the goods or copies will be released to the designated owner or importer unless the objector brings an action for infringement, and gives to the Comptroller notice in writing of the action, within ten (10) working days after the notice, or, if the Comptroller extends that period, within the extended period.

Under section 71(L) of the Trade Marks Act, if goods are seized and the Comptroller is satisfied that the use of a trademark is fraudulent, the Comptroller may ask the importer of the goods, or an agent of the importer, to produce any document relating to the goods, and give information about the name and address of the person by whom the goods were consigned to Trinidad and Tobago, and the name and address of the person in Trinidad and Tobago to whom the goods were consigned. Failure to comply with the request is an offence punishable, on conviction, by imprisonment for a period not exceeding six months.

If an infringement action has not been started within the required time the Comptroller must release the seized copies or goods to their importer or designated owner. Under the Trade Marks Act and the Copyright (Customs) Regulations 2000, the Comptroller shall release the seized goods to their designated owner at any time before the end of the action period, if new information has come to hand after the seizure which demonstrates that there are no reasonable grounds for believing that the notified trademark or pirated copies were infringed and no action for infringement has been brought by the objector. Under the Copyright Act, the Comptroller may permit the objector and the designated owner sufficient opportunity to inspect and remove a sample of the seized copies. Under the Trade Marks Act the Comptroller may permit the objector and the designated owner sufficient opportunity to inspect the seized goods for the purposes of substantiating any claim.

In deciding the infringement case, the court may order that the seized copies or goods be released to their importer or designated owner subject to conditions (if any) that the court considers fit to impose, or it may order that the seized goods be forfeited to the State. Under the Trade Marks Act, if the court decides that there was no infringement and the designated owner, or defendant to the infringement action, suffers loss or damage, the objector may be ordered to pay compensation.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost

The Trade Marks Act makes provision for border measures as outlined above, but there are no regulations to implement these provisions. The relevant regulations under the Copyright Act only came into force on 14 February 2000 and so there has been insufficient time to provide data.

However, as mentioned above, under the Common Law system, judicial measures may be applied in border situations and in this regard the answer to question 8 above, is applicable.

How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

Once the person who has given the notice to the Comptroller has received the notice of suspension of release of goods, he must bring an action for infringement in relation to the seized copies or goods, and give notice of it to the Comptroller within ten working days of the notice from the Comptroller, unless an extension has been obtained. The extension cannot exceed ten working days. The copyright owner must bring an action for infringement within the time specified in the notice or the time limited for bringing an action for infringement whichever is earlier.

Under the Trade Marks Act if, three weeks after the action was brought, there is no order of the court preventing the release of the seized copies or goods, then they must be released by the Comptroller. If an infringement action is commenced, the court may order the release of the seized copies or goods at any time it sees fit.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?

Are competent authorities required to act upon their own initiative and, if so, in what circumstances?

There is no provision requiring *ex officio* action by Customs authorities. All actions must be initiated by the copyright owner or exclusive licensee or by the owner (or in some circumstances an authorised user of a trademark) of the industrial property right. Under the Copyright Act, copies may only be seized if the copyright/neighbouring rights owner or exclusive licensee gives a notice of objection to the importation of the copies. Under the Trade Marks Act, the Comptroller may only seize goods if the goods bear a mark identical or similar to a trademark in relation to which a notice of objection has been given.

Are there any special provisions applicable to *ex officio* action?

No, there are no such provisions.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

The Customs authority is not empowered to order remedies for infringement. They can seize infringing copies of counterfeit goods and dispose of those copies or goods if they are forfeited by the importer (Copyright Act) or by a decision of the court. All remedies are decided by the courts.

Criminal Procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

The Magistrates' Court, in respect of summary offences, the Criminal Assizes, in respect of indictable offences and (on appeal) the Court of Appeal have jurisdiction over criminal acts of infringement and final appeal lies to the Judicial Committee of the Privy Council.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

An offence of trademark infringement is committed under section 66A of the Trade Marks Act. The detailed provisions of this enactment can be summarised as applying when there has been unauthorised use of a registered trademark (or of a mark likely to be mistaken for such a mark) by way of application of such mark to goods or to their packaging, or by the sale, possession, custody or control of such goods, or where such mark, or where a person has possession, custody or control of such goods, or where such mark is applied to labeling or packaging of goods, or used in a business paper or in advertising in relation to goods, provided in each case that the action has been taken "with a view to gain for himself or another, or with intent to cause loss to another" and, anyway, without the consent of the proprietor.

These offences are also extended to possession, custody or control of material for use in labeling, packaging or advertising goods bearing such a mark, and to the making, possession, custody or control of articles specifically designed or adapted for making copies of such mark, provided in each such case that the activity has been "in the course of business".

However, no offence is committed under these summarised provisions unless the goods in question are goods for which the mark is registered or unless the trademark has such a reputation in Trinidad and Tobago that its unauthorised use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark, and also where the defendant is able to show that he believed on reasonable grounds that his actions did not involve a (civil) infringement of the trademark registration.

An offence of infringement of copyright or neighbouring rights is committed under the provisions of section 41 of the Copyright Act 1997. Under this provision, an infringement of any right protected under the Act for profit-making purposes committed by a defendant who "knows or has reason to believe" that he is infringing is an offence.

Under section 22(3) of the Industrial Designs Act the performance, intentionally, of any act under section 9(2) including making, selling, importing for commercial purposes, constitutes an offence.

Under section 5(1) of the Layout-Designs (Topographies) of Integrated Circuits Act, the performance, knowingly, of any act under section 6, making, reproducing, importing, selling or otherwise distributing for commercial purposes, constitutes an offence.

There are criminal proceedings prescribed under section 38 of the Protection of New Plant Varieties Act for wilful non-compliance or misuse of variety denomination.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

The Trinidad and Tobago Police are responsible for investigating suspected offences under any legislation creating criminal offences. This will include intellectual property legislation, whether or not complaints have been received. The decision on whether to prosecute for a suspected offence is a matter for the Director of Public Prosecutions. In practice, most police action results from complaints and information received. This does not preclude a private prosecution for these offences (see the answer to question 23 below).

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Yes, a prosecution can be brought by any person or body having a sufficient personal or public reason for seeking enforcement of the criminal law. However, a *fiat* to prosecute must be obtained from the Director of Public Prosecutions.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

COPYRIGHT: under section 41 of the Copyright Act, the penalty for infringement for profit-making purposes by a person knowing or having reason to believe that he is committing an infringement, in summary conviction is a fine of TT\$100,000 and to ten years imprisonment. The Magistrate can increase the penalty to TT\$200,000 for a new act of infringement within five years of a previous conviction for infringement.

Where there has been no decision on such remedies in civil proceedings, the Magistrate has the authority to order the impounding of suspected copies of works on sound recordings, as well as the packaging of the implements that could be used for the making of, and the documents, accounts or business papers referring to such copies; to order the forfeiture and seizure of all copies of works or sound recordings manufactured, reproduced, distributed, sold or otherwise used, intended for use or possessed with intent to use in contravention of the rights of the owner and all plates, moulds, masters, tapes, film negatives or other articles by means of which such copies of works or sound recordings may be reproduced and all electronic, mechanical or other devices for manufacturing, reproducing or assembling such copies of works or sound recordings; to order the destruction or other reasonable disposition of infringing copies and their packaging outside the channels of commerce; where there is danger that implements may be used to commit or continue to commit acts of infringements, to order their destruction or reasonable disposition outside the channels of commerce.

Where an offence under section 41 committed by a body corporate is proved to have been committed with the consent or connivance or attributable to neglect on the part of any director, manager, secretary or person purporting to act in any such capacity, he as well as the body corporate is guilty and liable to the above penalties.

TRADEMARKS: under section 66(A)(1) of the Trade Marks Act it is an offence for a person to apply to goods or their packaging a mark identical to, or likely to be mistaken for, a registered trademark, sell or let for hire, offer or expose for sale or hire or distribute goods which bear or the packaging of which bears such a mark, has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything by himself or another which would be an offence as mentioned above.

Under subsection (2) it is an offence for a person to, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor to apply a mark identical to, or likely to be mistaken for, a registered trademark, for labeling or packaging goods, advertising goods or as a business paper in relation to goods; or uses in the course of business material bearing such a mark for labeling or packaging goods, as a business paper in relation to goods, or for advertising goods; or has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another which would be an offence mentioned above.

Subsection (3) makes it an offence for a person who, with a view to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor to make an article specifically designed or adapted for making copies of a mark identical to, or likely to be mistaken for, a registered trademark; or has such an article in his possession, custody or control in the course of business; knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labeling or packaging goods, as a business paper in relation to goods, or for advertising goods.

The court has power to forfeit counterfeit goods on the application of a person under the section. On such forfeiture, the court can order the destruction of any such goods; or cause the offending sign to be erased or obliterated and make an order for costs.

Where an offence under this Act is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, a director, manager, secretary or other similar officer of the body corporate or any person purporting to act in any such capacity, he as well as the body corporate, shall be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

PATENTS: there is no provision for infringement of patents to be treated as criminal offence.

INDUSTRIAL DESIGNS: section 23(3) of the Industrial Designs Act provides that it is an offence for any person to intentionally perform an act which constitutes an infringement under the Act. The penalty on summary conviction is a fine of TT\$10,000 and five years imprisonment.

INTEGRATED CIRCUITS: section 15 provides that it is an offence for any person to knowingly perform any of the acts listed in section 6, such as reproduction, importation, sale or distribution for commercial purposes of the protected layout-design. Penalty on summary conviction is a fine of TT\$10,000 and imprisonment for 5 years. The court has power to order the seizure, forfeiture and destruction of the layout-designs, integrated circuits or articles concerned and of any materials or implements, the predominant use of which has been in the commission of the offence.

GEOGRAPHICAL INDICATIONS: section 7 provides that any person who knowingly and with intent to deceive, performs any of the acts referred to in section 3, such as the use of any means in the designation or presentation of a good in question originates in a geographical area other than the true place of origin, commits an offence. Any use constituting an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention, and use of a geographical indication identifying wines or spirits for wines or spirits not originating in the place indicated, are also offences. The penalty on summary conviction is a fine of TT\$8,000 or three years imprisonment.

NEW PLANT VARIETIES: section 38 provides that any person who wilfully offers for sale or markets propagating material of a variety protected in Trinidad and Tobago without using the registered variety denomination commits an offence. Wilful misuse of the registered variety denomination is also an offence. The penalty on summary conviction is a fine of TT\$10,000.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

There are no provisions governing the length and cost of proceedings. See the answer to question 8 above.
