

**Patents Act, 1996*****No. 21 of 1996, as amended by Act No. 18 of 2000**

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An Act to make provision in respect of future patents and applications for patents; for the protection of inventions, to give effect to certain international conventions on patents and for connected purposes.

Part I Preliminary

Short title and commencement

1.—(1) This Act may be cited as the Patents Act, 1996.

(2) This Act shall come into operation on such date as the President may appoint by Proclamation and different dates may be appointed for different Parts or sections of this Act.

Interpretation

2. In this Act—

“appointed day” in any Part or section of this Act, means the day appointed under section 1(2) for the coming into operation of that Part or section;

“Controller” means the Controller of the Intellectual Property Office appointed under section 3(2) and any reference to the Controller shall be construed as including a reference to any officer discharging the functions of the Controller;

“Court” means the High Court;

“date of filing” means—



(a) in relation to an application for a patent made under this Act, the date which is the date of filing that application under section 19; and

(b) in relation to any other application, the date which, under the law of the country where the application was made or in accordance with the terms of a treaty or convention to which that country is a party, is to be treated as the date of filing the application or is equivalent to the date of filing an application in that country (regardless of the outcome of the application) by virtue of section 20;

“Examiner” means any person or body appointed or designated as such by the Minister under section 5;

“exclusive licence” means a licence from the proprietor of or applicant for a patent which confers on the licensee, or on the licensee and persons authorized by him, to the exclusion of all other persons (including the proprietor or the applicant), any right in respect of the invention to which the patent or application relates and “exclusive licensee” and “nonexclusive licence” shall be construed accordingly;

“formal requirements” means those requirements designated as such by rules made for the purposes of section 23;

“Intellectual Property Office” means the Intellectual Property Office referred to in section 3(1);

“international application for a patent” means an application made under the Patent Cooperation Treaty;

“International Bureau” means the secretariat of the World Intellectual Property Organization established by the convention signed at Stockholm on the 14th day of July, 1967;

“invention” means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;

“inventor” means the actual deviser of an invention and “joint inventor” shall be construed accordingly;

“Minister” means the Minister to whom is assigned responsibility for patents;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property signed in Paris on the 20th day of March, 1883 as amended from time to time and as in force in Trinidad and Tobago;

“patent” means the title granted to protect an invention and unless the context otherwise requires includes, subject to Part XV, a utility certificate;

“patent application” means an application under this Act for a patent and unless the context otherwise requires includes, subject to Part XV, a utility certificate application;



“Patent Cooperation Treaty” means the treaty of that name signed at Washington on the 19th day of June, 1970;

“patented invention” means an invention for which a patent is granted and “patented process” shall be construed accordingly;

“patented product” means a product which is a patented invention or, in relation to a patented process, a product obtained directly by means of the process or to which the process has been applied;

“periodical” includes the *Gazette*, daily newspapers circulating in Trinidad and Tobago or other publication issued by the Intellectual Property Office;

“prescribed” means, in the case of proceedings before the Court, prescribed by rules of Court, and, in any other case, prescribed by rules made under this Act;

“priority date” means the date determined as such under section 20;

“published” means made available to the public and a document shall be taken to be published if a reproduction thereof can be inspected as of right by members of the public whether on payment of a fee or not;

“register” means the register of patents referred to in section 34;

“right” in relation to any patent application or patent includes an interest in the patent application or patent and, without prejudice to the foregoing, any reference in this Act to a right in a patent includes a reference to a share in the patent;

“utility certificate”, unless the context otherwise requires, means a utility certificate under Part XV.

Part II

Intellectual Property Office

Intellectual Property Office; Controller and his staff

3.—(1) There shall be an office to be known as the Intellectual Property Office.

(2) There shall be a Controller in charge of the Intellectual Property Office who shall have the responsibility for the administration of all laws relating to intellectual property, and who shall exercise the powers and perform the functions conferred by and under this Act, and by and under any law.

(3) There shall be appointed such number of Deputy or Assistant Controllers and other officers as are considered necessary.

(4) The offices of the Controller, Deputy Controller and Assistant Controller are prescribed as public offices for the purposes of section 111(4) of the Constitution.



(5) The Controller shall have a seal of such device as may be approved by the Minister and impressions of such seal shall be judicially noticed and admitted in evidence.

(6) The Minister may issue to the Controller directions in writing, not inconsistent with the provisions of this Act, concerning the exercise and performance of his powers and functions in relation to any matter which appears to the Minister to concern the development of intellectual property and other matters connected therewith and the Controller shall give effect to any such direction.

(7) Subject to the provisions of this Act, the officers appointed under subsection (3) shall discharge under the superintendence and direction of the Controller such functions under this Act as he may from time to time by general or special order in writing direct them to discharge.

Part III **Patents**

Administration of patents; Information Services

4.—(1) For the purposes of this Act, the Controller shall be responsible for the grant and administration of patents and utility certificates, for the provision of patent information services, and for the promotion of inventiveness among citizens of Trinidad and Tobago.

(2) The patent information services referred to in subsection (1) shall consist of the making available, in the manner prescribed for use by the public, and on payment of the prescribed fees, if any, of patent and relevant non-patent literature, including all domestic patent documents and such foreign patent documents as are available.

Appointment of Examiners

5. The Minister may appoint or designate such Examiners as may be necessary for exercising the powers conferred and performing the functions required by or under this Act.

Restrictions on officers of Intellectual Property Office

6.—(1) No patent application may be filed by, no patent may be granted to, and no rights relating to patents may be held by officers and other employees of the Intellectual Property Office.

(2) No officer or other employee of the Intellectual Property Office shall, during his period of employment or thereafter, communicate information obtained as such officer or employee to a person not entitled to the information or make other use of such information for personal gain.

(3) An officer or other employee of the Intellectual Property Office who contravenes subsection (2) shall be liable on summary conviction to a fine of fifteen thousand dollars and to imprisonment for six months.



Exercise of discretionary power by Controller

7. Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to any party in proceedings before him without giving that party an opportunity of being heard as regards such exercise.

Part IV
Patentability of Inventions

Patentable inventions

8. Subject to section 12, a patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say—

- (a) the invention is new;
- (b) it involves an inventive step;
- (c) it is capable of industrial application,

and references in this Act to a patentable invention shall be construed accordingly.

Novelty

9.—(1) An invention shall be taken to be new if it does not form part of the state of the art.

(2) The state of the art in the case of an invention to which an application for a patent or a patent relates shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in Trinidad and Tobago or elsewhere) by written or oral description, by use or in any other way.

(3) For the purposes of this section, the disclosure of matter constituting an invention under subsection (2) shall not be taken into consideration if such disclosure occurred not more than one year immediately preceding the date of filing the patent application and the disclosure was due to or in consequence of—

- (a) acts committed by the applicant or his predecessor in title; or
- (b) an abuse committed by a third party with regard to the applicant or his predecessor in title.

(4) In the case of an invention consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body, the fact that the substance or composition forms part of the state of the art shall not prevent the invention from being taken to be new if the use of the substance or composition in any such method does not form part of the state of the art.



Inventive step

10. An invention shall be taken to involve an inventive step if, having regard to the state of the art within the meaning of section 9(2), it is not obvious to a person having ordinary skill in the art.

Industrial application

11. An invention shall be taken to be capable of industrial application if it can be made or used in any kind of industry including agriculture, fishery and handicraft.

Exclusions from patentability

12.—(1) It is hereby declared that the following are excluded from patentability that is to say, anything which consists of—

- (a) a discovery, scientific theory or mathematical method;
- (b) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business;
- (d) diagnostic, therapeutic and surgical methods for the treatment of humans or animals;
- (e) the presentation of information.

(2) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public order or morality, or which is prejudicial to human, animal or plant life or health, or to the environment, provided that such refusal is not based solely on the ground that the commercial exploitation is prohibited by a law in force in Trinidad and Tobago.

Part V

Right to Apply for and Obtain a Patent

Right to apply for patent

13. Any person may make an application for a patent either alone or jointly with another.

Right to patent

14.—(1) A patent for an invention may be granted—

- (a) primarily to the inventor or joint inventors;



(b) to the successor or successors in title of any person or persons mentioned in paragraph (a),

and to no other person.

(2) Subject to section 15, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (1) to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

(3) Where two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date shall have the right to the patent as long as the said application is not withdrawn, abandoned or rejected.

Invention made by an employee or pursuant to a commission

15.—(1) In the absence of any provisions to the contrary in any contract of employment or for the execution of work, the right to a patent for an invention made in the performance of such contract of employment or in the execution of such work shall, notwithstanding section 14, be deemed to accrue to the employer, or the person who commissioned the work, as the case may be.

(2) Where an invention referred to in subsection (1) acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract of employment or for the execution of work, as the case may be, the inventor shall be entitled to equitable remuneration which may be fixed by the Court in the absence of agreement between the parties.

(3) Where an employee whose contract of employment does not require him to engage in any inventive activity makes, in the field of activities of his employer, an invention using data or means placed at his disposal by his employer, the right to the patent for such invention shall be deemed to accrue to the employer, in the absence of any provision to the contrary in the contract of employment, provided that the employee shall be entitled to equitable remuneration which, in the absence of agreement between the parties, may be fixed by the Court taking into account his emoluments, the economic value of the invention and any benefit derived from it by the employer.

(4) For the avoidance of doubt, it is hereby declared that when an invention is made by an employee whose contract of employment does not require him to engage in inventive activity, or in a field of activity different to that of his employer and without using information or means put at his disposal by the employer, the right to the patent for such invention shall accrue to the employee.

(5) The rights conferred on the inventor under subsections (1), (2), (3) and (4) shall not be restricted by contract.

(6) This section shall not apply to an invention made before the appointed day.



Judicial assignment of patent application or patent

16.—(1) Where the essential elements of the invention claimed in a patent application or patent have been unlawfully derived from an invention for which the right to the patent belongs to another person, such other person may apply to the Court for an order that the said patent application or patent be assigned to him.

(2) The Court upon receipt of such application may make such order as it sees fit.

(3) No application for the assignment of a patent under subsection (1) shall be entertained by the Court after the expiry of five years from the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him, that he was not entitled to the patent.

Mention of inventor

17.—(1) The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention unless in a written declaration addressed to the Controller he indicates or in the case of joint inventors, they indicate a wish not to be named.

(2) Any promise or undertaking by the inventor made to any person to the effect that he will make such a declaration shall be void.

Part VI
Applications for Patent

Making of application

18.—(1) Every application for a patent shall be made in the prescribed form, and shall be filed at the Intellectual Property Office in the prescribed manner under this Act. Such an application shall be accompanied by the prescribed filing fee.

(2) Every application for a patent shall contain—

(a) a request for the grant of a patent;

(b) a specification containing a description of the invention, a claim or claims and any drawings referred to in the description or any claim;

(c) an abstract;

(d) where the applicant's ordinary residence or principal place of business is outside of Trinidad and Tobago, an address within Trinidad and Tobago for service; and

(e) where the applicant is not the sole inventor or the applicants are not the joint inventors, a statement justifying his or their right to be granted the patent.



(3) The specification of an application shall disclose the invention in a manner which is clear and complete enough for the invention to be performed by a person skilled in the art, and shall, in particular, indicate at least one mode known to the applicant for carrying out the invention.

(4) The claim or claims shall—

(a) define the matter for which the applicant seeks protection;

(b) be clear and concise;

(c) be supported by the description; and

(d) relate to one invention or to a group of inventions which are so linked as to form a single general inventive concept.

(5) The purpose of the abstract is to give technical information and, upon publication, it shall not form part of the state of the art by virtue of section 9(2), and the Controller may determine whether the abstract adequately fulfills its purpose and, if it does not, may reframe it so that it does.

(6) Without prejudice to the provisions of subsections (3) and (4), rules may be made prescribing the circumstances in which the specification of an application which requires for its performance the use of a micro-organism is to be treated for the purposes of this Act as complying with subsection (3).

Date of filing application

19.—(1) The date of filing an application for a patent shall, subject to the provisions of this section, be the earliest date on which the following conditions are satisfied in relation to the application, that is to say—

(a) the documents filed contain an indication that a patent is sought in pursuance of the application;

(b) those documents identify the applicant or applicants for the patent;

(c) those documents contain a description of the invention for which a patent is sought whether or not the description complies with the other provisions of this Act and the relevant rules.

(2) If the Controller finds that the application does not comply with subsection (1) he shall invite the applicant to file the required correction, and shall accord as the filing date the date of receipt of the required correction, but if no correction is made, the application shall be treated as if it had not been filed.

(3) Where the application refers to drawings which in fact are not included in the application, the Controller shall invite the applicant to furnish the missing drawings, and if the applicant complies, the Controller shall accord as the filing date the date of receipt of the missing drawings. If the applicant does not comply, the Controller shall accord as the filing



date the date of receipt of the application and shall treat any reference to the said drawings as nonexistent.

(4)(a) The applicant may, up to the time when the application is in order for grant, divide the application into two or more applications (“divisional applications”), provided that each divisional application shall not go beyond the disclosure in the initial application;

(b) Each divisional application shall be entitled to the filing date and, where applicable, the priority date of the initial application.

(5) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under section 18(4)(d) shall not be a ground for the invalidation of the patent.

Priority date

20.—(1) A patent application may contain a declaration claiming priority of one or more earlier applications filed by the applicant or his predecessor in title in a country that is a party to the Paris Convention.

(2) Where the application contains a declaration under subsection (1), the Controller may require that the applicant furnish within the prescribed time a copy of the earlier application certified as correct by the office with which it was filed, or where the earlier application is an international application filed under the Patent Cooperation Treaty, by the office with which the international application was filed, and if the earlier application is not in English, a translation thereof in English verified by the translator that the translation is to the best of his knowledge complete and faithful.

(3) The effect of the declaration referred to in subsection (1) shall be as provided in the Convention referred to therein.

(4) Where any of the requirements of this section or any rules pertaining thereto have not been complied with, the declaration referred to in subsection (1) shall be deemed to be invalid.

Information on corresponding foreign applications

21.—(1) The applicant shall, at the request of the Controller, furnish the Controller with the date and number of any other application for a patent or other title of protection made in an industrial or intellectual property office of any other country, or within a regional industrial or intellectual property office (hereafter in this section referred to as a “foreign application”), relating to the same or essentially the same invention as that claimed in the application filed with the Controller.

(2) The applicant shall upon request furnish the Controller with the following documents relating to one of the foreign applications referred to in subsection (1):



(a) a copy of any communication received by the applicant concerning the result of any search or examination carried out in respect of the foreign application;

(b) copy of the patent or other title of protection granted on the basis of the foreign application;

(c) a copy of any final decision rejecting the foreign application or refusing the patent requested in the foreign application;

(d) a copy of any final decision invalidating the patent or other title of protection granted on the basis of the foreign application referred to in subsection (2).

(3) Documents furnished pursuant to subsections (1) and (2)—

(a) shall, if not in English, be accompanied by a translation thereof in English verified by the translator that the translation is to the best of his knowledge complete and faithful; and

(b) may be used only for facilitating the evaluation of the novelty and inventive step of the invention for which the patent application is made.

(4) The applicant for a patent may submit comments on any documents furnished by him under subsections (1) and (2).

Disclosure of matter, etc., between earlier and later applications

22. Where an application is made for a patent under section 19 and a declaration is made in accordance with section 20(2) in or in connection with that application specifying an earlier application, the first-mentioned application and any patent granted in pursuance thereof shall not be invalidated by reason only of the fact that any subject matter disclosed in the earlier application was made available to the public at any time after the date of filing of the said earlier application.

Examination as to form

23.—(1) Where an application for a patent has a date of filing and is not withdrawn, upon the payment by the applicant of the prescribed fee, the Controller shall conduct a formalities examination.

(2) On such formalities examination the Controller shall determine whether the application complies with the provisions of this Act and rules made thereunder relating to such examination.

(3) If the Controller determines that all the formal requirements have not been complied with, he shall give the applicant an opportunity to make observations on the report and to amend the application within a specified period so as to comply with those requirements and if the applicant fails to do so the Controller may refuse the application.

(4) If the Controller refuses the application under subsection (3), he shall inform the applicant in writing of his decision and the reason therefor.



Search and substantive examination

24.—(1) Where the Controller is of the opinion that the application complies with the requirements of section 23 he shall, upon payment by the applicant of the prescribed fee, cause the application to be examined as to whether there has been compliance with the requirements of sections 8 to 12 and 18(3) and (4) and the rules relating thereto.

(2) For the purposes of the examination under this section the Controller may transmit the application to a duly authorized authority with which an arrangement to that effect has been made.

Refusal or grant of patent

25.—(1) If the Controller determines that any of the requirements of this Act or the rules made thereunder are not complied with, he shall so inform the applicant and shall give him an opportunity within a specified period to make observations on the determination and, subject to section 26(2), to amend the application so as to comply with those requirements, and if the applicant fails either to satisfy the Controller that the said requirements are complied with, or to amend the application so as to comply with them, the Controller shall, subject to section 7, refuse the application.

(2) If the Controller determines that the application, whether as originally filed or as amended in pursuance of section 23, this section, or section 26, complies with the requirements of this Act and the relevant rules made thereunder, he shall notify the applicant of that fact and on payment within the prescribed period of the fee prescribed for the grant, grant him a patent, and if the said fee is not so paid, the application shall be deemed to be withdrawn.

(3) Where two or more patent applications for the same invention, having the same date of filing or the same date of priority, are filed by the same applicant or his successor-in-title, the Controller may on that ground refuse to grant a patent in pursuance of more than one of the applications.

(4) If the Controller refuses the application under subsection (1) or (3), he shall inform the applicant in writing of his decision and of the reasons for his decision.

(5) The patent shall be deemed to be granted on the date the Controller publishes under section 28(1) a notice of the grant of the patent.

*Amendment of application, time limit for grant,
changes in patent*

26.—(1) At any time before a patent is granted under this Act, the applicant may, in accordance with the prescribed conditions and subject to subsection (2), amend the application of his own volition.



(2) No amendment of an application shall be allowed under section 23(3) or 25(1) or this section if such amendment extends the matter disclosed in the application as filed.

(3) The Controller shall, whenever possible, reach a final decision on the application not later than two years after the commencement of the examination referred to in section 24.

(4) The Controller shall, upon request of the owner of the patent, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred thereby, provided that the change would not result in the disclosure contained in the patent going beyond the disclosure contained in the initial application on the basis of which the patent was granted.

Withdrawal of application

27. At any time before a patent is granted under this Act, the applicant may in the prescribed manner, withdraw his application and any such withdrawal may not be revoked.

Notification of grant and publication of specification

28.—(1) The Controller shall as soon as practicable after a patent has been granted under section 25(2) publish a notice of the grant in a periodical.

(2) At the same time as the publication under subsection (1) of the notice of a grant, the Controller shall publish in the prescribed manner particulars of the patent and also such matters and information as appeared to him to be useful or important.

(3) The Controller shall, as soon as practicable after he publishes a notice under subsection (1), issue to the proprietor of the patent a certificate, in the prescribed form, that the patent has been granted to him, and a copy of the patent.

Part VII Provisions as to Patents after Grant

Term of patent

29. A patent granted under this Act shall take effect on the date on which notice of its grant is published in a periodical and, subject to this Act, shall continue in force until the end of the period of twenty years beginning with the date of filing of the application for the patent.

Annual fees

30.—(1) In order to maintain the patent or patent application, an annual maintenance fee shall be paid in advance to the Controller for each year, starting one year after the date of filing the application for grant of the patent. A period of grace of six months shall be allowed for the late payment of the annual maintenance fee on payment of the prescribed surcharge. If



an annual maintenance fee is not paid in accordance with this subsection, the patent application shall be deemed to have been withdrawn or the patent shall lapse.

(2) If a patent ceases to have effect under subsection (1), the lapse of the patent shall be entered in the register and published in a periodical.

Surrender of patent or of claim

31.—(1) The proprietor of a patent may at any time by notice given to the Controller in the prescribed manner offer to surrender his patent or one or more claims contained in his patent.

(2) Where an offer is made under this section, the Controller shall advertise the offer in the prescribed manner and any person interested may, within the prescribed period commencing on the date of the publication of the advertisement, give notice to the Controller of his opposition to the proposed surrender.

(3) Where notice of opposition is duly given under this section the Controller shall notify the proprietor of the patent and determine the question.

(4) If the Controller is satisfied that the patent or any claim or claims contained in the patent may properly be surrendered, he may accept the offer, and record his acceptance in the register, and shall, as soon as practicable, publish notice of his acceptance in a periodical.

(5) As from the date when notice of acceptance is published in a periodical under subsection (4), the patent or claim or claims shall cease to have effect, but no action for infringement shall lie in respect of any act done before that date and no right to compensation shall accrue for any use of the patented invention before that date for purposes of State.

(6) Where a patent has been granted to two or more persons, a notice in accordance with subsection (1) shall be signed by each of these persons.

Part VIII

Property in Patent Applications and Patents

Nature of and transactions in patents

32.—(1) Any patent or application for a patent is personal property (without being a thing in action), and any patent or any such application and rights in or under it may be transferred, created or granted in accordance with subsections (2) to (6).

(2) Subject to section 33(3), any patent or any such application, or any right in it, may be assigned or mortgaged.

(3) Any patent or any such application or right shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representatives.



(4) Subject to section 33(3), a licence may be granted under any patent or any such application for working the invention which is the subject of the patent or the application, and—

(a) to the extent that the licence so provides, a sub-licence may be granted under any such licence and any such licence or sub-licence may be assigned or mortgaged; and

(b) any such licence or sub-licence shall vest by operation of law in the same way as any other personal property and may be vested by an assent of personal representative.

(5) Any of the following transactions, that is to say—

(a) any assignment or mortgage of a patent or any such application, or any right in a patent or any such application;

(b) any assent relating to any patent or any such application or right,

shall be void unless it is in writing and is signed by or on behalf of the parties to the transaction (or, in the case of an assent or other transaction by a personal representative, by or on behalf of the personal representative) or in the case of a body corporate is so signed or is under the seal of that body.

(6) An assignment of a patent or any such application or a share in it, and an exclusive licence granted under any patent or any such application, may confer on the assignee or licensee the right of the assignor or licensor to bring proceedings by virtue of section 50 for a previous infringement.

Co-ownership of patents and applications for patents

33.—(1) Where a patent is granted to two or more persons, each of them shall, subject to any agreement to the contrary, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of this section, where two or more persons are proprietors of a patent, then, subject to any agreement for the time being in force, each of those persons shall be separately entitled, by himself or his agents, in respect of the invention concerned, for his own benefit and without accounting to the other or others—

(a) to do any act which would, apart from this subsection, amount to an infringement of the patent concerned and any such act shall not amount to an infringement of that patent; or

(b) to bring civil proceedings for infringement of the patent pursuant to section 50.

(3) Subject to any agreement for the time being in force, where two or more persons are proprietors of a patent, one of them shall not, without the consent of the other or others, grant a licence under the patent or assign or mortgage a share in the patent.

(4) Subject to the provisions of this section, where two or more persons are proprietors of a patent, anyone else may supply one of those persons with the means, relating to an essential element of the invention, for putting the invention into effect, and the supply of those means by virtue of this subsection shall not amount to an infringement of the patent.



(5) Where a patented product is disposed of by any of two or more proprietors to any person, that person and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

(6) Nothing in subsection (1) or (2) shall affect the mutual rights or obligations of trustees or of the personal representatives of a deceased person, or their rights or obligations as such.

(7) The foregoing provisions of this section shall have effect in relation to an application for a patent which is filed as they have effect in relation to a patent and—

(a) references to a patent and a patent being granted shall accordingly include references respectively to any such application and to the application being filed; and

(b) the reference in subsection (5) to a patented product shall be construed accordingly.

Part IX **Register of Patents, Evidence of Register, Documents, etc.**

Register of patents

34.—(1) There shall be kept and maintained by the Controller at the Intellectual Property Office a register of patents in which there shall be entered particulars of patents in force, of assignments and transmissions of patents and of licences under patents and notice of all matters which are required by or under this Act to be entered in the register and of such other matters affecting the validity of proprietorship of patent as may be prescribed by rules.

(2) Without prejudice to subsection (1) or any other provision of this Act, rules may make provisions with respect to the following matters including provisions imposing requirements as to any of those matters:

(a) the registration of patents and of applications for patents;

(b) the registration of transactions, instruments or events affecting rights in or under patents and applications;

(c) the furnishing to the Controller of any prescribed documents or description of documents in connection with any matter which is required to be registered;

(d) the correction of errors in the register and in any documents filed at the Intellectual Property Office in connection with registration;

(e) the publication and advertisement of anything done under this Act or rules in relation to the register.

(3) Notwithstanding anything in subsection (2)(b), no notice of any trust, whether express, implied or constructive, shall be entered in the register and the Controller shall not be affected by any such notice.



(4) The register need not be kept in documentary form.

(5) Save as otherwise provided by rules, the public shall have a right to inspect the register at the Intellectual Property Office at all convenient times.

(6) Any person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain such a copy or extract on payment of a fee prescribed in relation to certified copies and extracts, and rules may provide that any person who applies for an uncertified copy or extract shall be entitled to such a copy or extract on payment of a fee prescribed in relation to uncertified copies and extracts.

(7) Applications under subsection (6) or rules made by virtue of that subsection shall be made in such manner as may be prescribed.

(8) In relation to any portion of the register kept otherwise than in documentary form—

(a) the right of inspection conferred by subsection (5) is, save as otherwise provided by rules, a right to inspect the material on the register; and

(b) the right to a copy or extract conferred by subsection (6) or by rules is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

Effect of registration, etc., on rights in patents

35.—(1) Any person who claims to have acquired the property in a patent or application for a patent by virtue of any transaction, instrument or event to which this section applies shall be entitled as against any other person who claims to have acquired that property by virtue of an earlier transaction, instrument or event to which this section applies if, at the time of the later transaction, instrument or event—

(a) the earlier transaction, instrument or event was not registered, or

(b) in the case of any application, notice of the earlier transaction, instrument or event had not been given to the Controller, and

(c) in any case, the person claiming under the later transaction, instrument or event, did not know of the earlier transaction, instrument or event.

(2) Subsection (1) shall apply equally to the case where any person claims to have acquired any right in or under a patent or application for a patent, by virtue of a transaction, instrument or event to which this section applies, and that right is incompatible with any such right acquired by virtue of an earlier transaction, instrument or event to which this section applies.

(3) This section applies to the following transactions, instruments and events—

(a) the assignment of a patent or application for a patent, or a right in it;

(b) the mortgage of a patent or application or the granting of security over it;



(c) the grant, assignment of a licence or sublicense, or mortgage of a licence or sublicense, under a patent or application;

(d) the death of the proprietor or one of the proprietors of any such patent or application or of any person having a right in or under a patent or application and the vesting by an assent of the personal representative of a patent, application or any such right; and

(e) any order or directions of a court or other competent authority—

(i) transferring a patent or application or any right in or under it to any person; or

(ii) that an application should proceed in the name of any person,

and in either case the event by virtue of which the court or authority had power to make any such order or give any such directions.

(4) Where an application for the registration of a transaction, instrument or event has been made, but the transaction, instrument or event has not been registered, then, for the purposes of subsection (1)(a), registration of the application shall be treated as registration of the transaction, instrument or event.

Information about and inspection of patent applications and patents

36.—(1) The Controller shall, on a request being made to him in the prescribed manner and on payment of the prescribed fee, if any, give the person making the request such information as may be prescribed.

(2) Subject to subsection (4), until a patent is granted documents or information constituting or relating to the application shall not, without the written consent of the applicant, be published or communicated to any person by the Controller.

(3) Where a patent application has been withdrawn in accordance with section 27, documents or information constituting or relating to the application shall not, without the written consent of the applicant, be published or communicated to any person by the Controller.

(4) Subsection (2) shall not prevent the Controller from publishing or communicating to others any prescribed bibliographic information about an unpublished patent application.

Correction of errors

37.—(1) The Controller may, in accordance with the provisions of this section, correct any linguistic error, error of transcription, clerical error or mistake in any specification of a patent, any application for a patent, or any document filed in pursuance of such an application, or any error in the register.

(2) A correction may be made in pursuance of this section either upon a request made in the prescribed manner and accompanied by the prescribed fee, or without such a request.



(3) Where the Controller proposes, or a request is made, to make a correction referred to in subsection (1), he shall before determining the matter give notice of the proposal to the proprietor of or applicant for the patent, as the case may be, and to any person, other than the person by whom the request is made, who appears to him to be concerned.

Rectification of register

38.—(1) The Court may, on the application of a person aggrieved, order the register to be rectified by the making, or the variation or deletion of any entry in it.

(2) In proceedings under this section the Court may determine any question which it may be necessary or expedient to decide in connection with the rectification of the register.

(3) Rules of Court may provide for the notification of any application under this section to the Controller and for his appearance on the application and for giving effect to any order of the Court on the application.

Evidence of register, documents, etc.

39.—(1) The register shall be *prima facie* evidence of anything required or authorized by this Act or rules to be registered and shall be admissible and sufficient evidence of any such thing.

(2) A certificate purporting to be signed by the Controller and certifying that any entry which he is authorized by this Act or rules to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be *prima facie* evidence, and shall be admissible and sufficient evidence, of the matters so certified.

(3) Each of the following, that is to say:

(a) a copy of an entry in the register or an extract from the register which is supplied under section 34(6);

(b) a copy of any document kept in the Intellectual Property Office, or an extract from any such document, any specification of patent drawings or other matter which has been published under section 28(2),

which purports to be a certified copy or a certified extract shall be admitted in evidence without further proof and without production of the original, and such evidence shall be sufficient evidence of the matter therein stated.

(4) In this Part “certified copy” and “certified extract” means a copy and extract certified by the Controller and sealed with the seal of the Intellectual Property Office.



Part X Rights of Owner of Patent

Rights of owner of patent

40.—(1) Subject to the other provisions of this Part, the owner of a patent shall have the following exclusive rights in relation to the patent:

- (a) to exploit the patented invention;
- (b) to assign or transmit the patent;
- (c) to conclude licence contracts.

(2) The owner of the patent shall have the right, subject to sections 43, 46 and 58, to take action against any person exploiting the patented invention in Trinidad and Tobago without his agreement.

(3) For the purposes of this Part, “to exploit” or “exploiting” a patented invention means any of the following acts in relation to the patent:

- (a) when the patent has been granted in respect of a product—
 - (i) making, importing, offering for sale, selling or using the product;
 - (ii) stocking such product for the purposes of offering for sale, selling or using;
- (b) when the patent has been granted in respect of a process—
 - (i) using the process;
 - (ii) doing any of the acts referred to in paragraph (a), in respect of a product obtained directly by means of the process.

Prevention of indirect use of invention

41.—(1) While in force a patent shall confer on its proprietor the right to prevent all persons not having his consent from supplying or offering to supply in Trinidad and Tobago a person (other than a person entitled to engage in commercial working of the patented invention) with means relating to an essential element of that invention, for putting it into effect therein, provided that that person knows, or it is obvious to a reasonable person in the circumstances that those means are suitable for putting, and are intended to put that invention into effect.

(2) Subsection (1) shall not apply when the means referred to therein are staple commercial products, except when the person induces the person supplied to commit acts which the proprietor of the patent is entitled to prevent by virtue of section 40.



(3) Persons performing acts referred to in paragraphs (a), (b), or (c) of section 42 shall not be considered to be persons entitled to engage in commercial working of the invention for the purposes of subsection (1).

Limitation of effect of patent

42. The rights conferred by a patent shall not extend to—

(a) acts done privately and for non-commercial purposes;

(b) acts done for experimental purposes relating to the subject matter of the relevant patented invention;

(c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared; and

(d) the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, the territory or territorial waters of Trinidad and Tobago.

Exhaustion of rights

43. The rights conferred by a patent shall not extend to acts in respect of articles which have been put on the market in Trinidad and Tobago by the owner of the patent or with his consent.

Extent of protection

44. The extent of the protection conferred by a patent shall be determined by the terms of the claim; and, the description and drawings shall be used to interpret the claims.

Part XI

Voluntary and Non-voluntary Licences

Voluntary licences

45.—(1) Subject to section 33, a proprietor of a patent application or patent may grant a licence in respect of the relevant invention.

(2) A licence contract shall be in writing and may, on payment of the prescribed fee, be recorded in the register and the relevant notice published in a periodical as prescribed by the rules. Until such contract has been so recorded, the licence shall have no effect against third parties, unless otherwise decided by the Court.

(3) In the absence of any provision to the contrary in the terms of a licence contract, a licensee may not extend to another person the authorization conferred on him by the proprietor in accordance with subsection (1), nor may he assign or mortgage his licence.



(4) In the absence of any provision to the contrary in the terms of a licence contract, the proprietor may continue to enjoy the rights conferred on him by sections 40 and 41.

(5) To the extent that the licence has been granted as an exclusive licence, the proprietor may not grant a licence in respect of the invention to a third person and may not himself do any of the acts referred to in sections 40 and 41.

(6) If before the expiration of the licence contract, any of the following events occur with respect to any patent application or patent, the subject of that contract:

- (a) the patent application is withdrawn or is deemed to be withdrawn;
- (b) the patent application is treated as if it had not been filed;
- (c) the grant of a patent is refused; or
- (d) the patent is revoked,

the licensee shall, from the date of the event, be no longer bound to make any payment directly relating to that patent application or patent.

(7) In any of the cases referred to in subsection (6), the licensee shall have the right to repayment of the payments already made and directly relating to the patent application or patent in question, provided he has not, or practically has not, benefitted, from the licence.

Non-voluntary licences

46.—(1) At any time after the expiration of three years from the date of grant of a patent under this Act or four years from the date of the filing, whichever is later, any person interested may apply to the Court for the grant of a licence under the patent on any of the following grounds, namely that a market for the patented invention is not being supplied, or is not being supplied on reasonable terms in Trinidad and Tobago.

(2) Subject to subsections (4), (5), (6) and (7), if the Court is satisfied that either of the grounds referred to in subsection (1) is established, the Court may make an order for the grant of the licence in accordance with the application on such terms as the Court thinks fit.

(3) A licence granted under this section—

(a) is not exclusive;

(b) shall not be assigned otherwise than in connection with the goodwill of the business in which the patented invention is used; and

(c) is limited to the supply of the patented invention predominantly in Trinidad and Tobago.

(4) Where the Court is satisfied that the grounds on which any licence granted under this section have ceased to exist, it may, on the application of any interested party, terminate such licence.



(5) Any person to whom a licence is granted under this section shall pay such remuneration to the patentee as may be agreed, or as may be determined by a method agreed upon between that person and the patentee, or in default of agreement, as the Court may, taking into account the economic value of the licence, determine on the application of either party.

(6) Before a licence is granted under subsection (1), the Court must be satisfied that the person applying for the licence has made efforts to obtain a licence from the patentee on reasonable commercial terms and conditions within a reasonable time, but has failed to do so.

(7) A licence shall not be granted under this section in respect of a patent relating to semiconductor technology except for public non-commercial use or to remedy a practice determined after judicial or administrative process to be anti-competitive.

Exercise of powers on applications under section 46

47. The powers of the Court on an application under section 46 shall be exercised with a view to securing that the inventor or other person beneficially entitled to a patent shall receive reasonable remuneration having regard to the economic value of the licence.

Use of patented invention for services of the State

48.—(1) Where the public interest so requires, or where the Minister decides that the manner of exploitation by the owner of a patent or his licensee is anti-competitive, then subject to subsection (2) the Minister may authorize a State agency or any person in writing, to make use, exercise or vend the patented invention for the services of the State subject to the payment of adequate compensation to the owner thereof, taking into account the economic value of the exploitation, and anything done by virtue of this subsection shall not amount to an infringement of the patent.

(2) Before issuing his authorization under subsection (1), the Minister shall hear the owner of the patent and any other interested party who may wish to be heard.

(3) Subsection (2) does not apply in the case of a national emergency.

(4) The Minister may upon the request of any of the parties vary the terms of the authorization.

(5)(a) Upon the request of the owner of the patent, the Minister shall terminate the authorization if he is satisfied that the circumstances which led to his decision have ceased to exist and are unlikely to recur, or that the State agency or person authorized by him has failed to comply with the terms of the authorization;

(b) Notwithstanding paragraph (a), the Minister shall not terminate the authorization if he is satisfied that the need for adequate protection of the legitimate interests of the State agency or the person authorized by him justifies maintaining the decision.



(6) An authorization granted to a person other than a State agency shall be subject to the conditions prescribed by subsection (3) of section 46.

(7)(a) Before an authorization is granted under subsection (1), the Minister must be satisfied that the proposed user has made efforts to obtain a licence from the patentee on reasonable commercial terms and conditions within a reasonable time, but has failed to do so;

(b) Paragraph (a) shall not apply in cases of national emergency or other circumstances of extreme urgency, provided however, that in such cases the owner of the patent shall be notified of the Minister's decision as soon as is reasonably practicable.

(8) Any decision of the Minister under subsections (1), (4) or (5) may be subject to judicial review.

Part XII Infringement

Infringement

49. Subject to the provisions of sections 42, 43, 44, 46 and 48 the performance of any of the acts referred to in sections 40 and 41, in relation to a patent while it is in force, without the authorization of the proprietor of the patent, shall constitute an infringement.

Action for infringement

50.—(1) Subject to the provisions of this Part, civil proceedings may be brought in the Court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the Court) in those proceedings a claim may be made—

(a) for an injunction restraining the defendant from any apprehended act of infringement;

(b) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised;

(c) for damages in respect of the infringement;

(d) for an account of the profits derived by him from the infringement;

(e) for a declaration that the patent is valid and has been infringed by him.

(2) The Court shall not, in respect of the same infringement, both award the proprietor of a patent damages and order that he shall be given an account of the profits.



Restrictions on recovery of damages for infringement

51.—(1) In proceedings for infringement of a patent damages shall not be awarded, and no order shall be made for an account of profits, against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable grounds for supposing that the patent existed; and a person shall not be taken to have been so aware or to have had reasonable grounds for so supposing by reason only of the application to a product of the word “patent” or “patented”, or any word or words expressing or implying that a patent has been obtained for the product, unless the number of the patent accompanied the word or words in question.

(2) Where an amendment of the specification of a patent has been allowed under any of the provisions of this Act, no damages shall be awarded in proceedings for an infringement of the patent committed before the decision to allow the amendment unless the Court is satisfied that the specification of the patent as published was framed in good faith and with reasonable skill and knowledge.

Relief for infringement of partially valid patent

52.—(1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the Court may, subject to subsection (2), grant relief in respect of that part of the patent which is found to be valid and infringed.

(2) Where in any such proceedings it is found that a patent is only partially valid, the Court shall not grant relief by way of damages, costs or expenses, except where the plaintiff proves that the specification for the patent was framed in good faith and with reasonable skill and knowledge and in that event the Court may grant relief in respect of that part of the patent which is valid and infringed, subject to the discretion of the Court as to costs or expenses and as to the date from which damages should be reckoned.

(3) As a condition of relief under this section the Court may direct that the specification of the patent shall be amended to its satisfaction upon an application made for that purpose under section 63, and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.

Certificate of contested validity of patent

53.—(1) If in any proceedings before the Court the validity of a patent to any extent is contested and that patent is found by the Court to be wholly or partially valid, the Court may certify the finding and the fact that the validity of the patent was so contested.

(2) Where a certificate is granted under this section, then, if in any subsequent proceedings before the Court for infringement of the patent concerned or for revocation of the patent a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the Court otherwise



directs, be entitled to his costs or expenses as between attorney-at-law and client (other than the costs of expenses of any appeal in the subsequent proceedings).

Proceedings for infringement by exclusive licensee

54.—(1) Subject to the provisions of this section, the holder of an exclusive licence under a patent shall have the same right as the proprietor of the patent to bring proceedings in respect of any infringement of the patent committed after the date of the licence; and references to the proprietor of the patent in this Act relating to infringement shall be construed accordingly.

(2) In awarding damages or granting any other relief in any such proceedings the Court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such as a result of the infringement, or, as the case may be, the profits derived from the infringement, so far as it constitutes an infringement of the rights of the exclusive licensee as such.

(3) In any proceedings taken by an exclusive licensee by virtue of this section, the proprietor of the patent shall be made a party to the proceedings, but if made a defendant shall not be liable for any costs or expenses unless he enters an appearance and takes part in the proceedings.

Effect of non-registration on infringement proceedings

55. Where by virtue of a transaction, instrument or event to which section 35 applies a person becomes the proprietor or one of the proprietors or an exclusive licensee of a patent and the patent is subsequently infringed, the Court shall not award him damages or order that he be given an account of the profits in respect of such a subsequent infringement occurring before the transaction, instrument or event is registered unless—

(a) the transaction, instrument or event is registered within the period of six months beginning with its date; or

(b) the Court is satisfied that it was not practicable to register the transaction, instrument or event before the end of that period and that it was registered as soon as was practicable thereafter.

Remedy for groundless threats of infringement proceedings

56.—(1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in Court against the person making the threat, claiming any relief mentioned in subsection (3).



(2) In any such proceedings the plaintiff shall, if he proves that the threats were so made and satisfies the Court that he is a person aggrieved by them, be entitled to the relief claimed unless—

(a) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and

(b) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is—

(a) a declaration to the effect that the threats are unjustifiable;

(b) an injunction against the continuance of the threats; and

(c) damages in respect of any loss which the plaintiff has sustained by the threats.

(4) Proceedings may not be brought under this section for a threat to bring proceedings for an infringement alleged to consist of making or importing a product for disposal or of using a process.

(5) It is hereby declared that a mere notification of the existence of a patent does not constitute a threat of proceedings within the meaning of this section.

Power of Court to make declaration as to non-infringement

57.—(1) Without prejudice to the Court's jurisdiction to make a declaration apart from this section, a declaration that an act (that is to say, the use by any person of any process, or the making or use or sale by any person of any product) does not, or a proposed act would not, constitute an infringement of a patent, may be made by the Court in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown—

(a) that that person has applied in writing to the proprietor for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and

(b) that the proprietor has refused or failed within a reasonable time to give any such acknowledgement.

(2) No declaration under subsection (1) shall be made if the act in question is already the subject matter of an infringement proceeding.

Right to continue use begun before date of filing or priority

58.—(1) Where a patent is granted for an invention, a person who before the date of filing of the patent application or, if priority was claimed, before the date of priority, does in good faith in Trinidad and Tobago an act which would constitute an infringement of the



patent if it were then in force, or makes in good faith effective and serious preparation to do such an act, shall have the rights specified in subsection (2).

(2) Any such person shall have the right—

(a) to continue to do or, as the case may be, to do that act himself; and

(b) if the act was done or preparations had been made to do it in the course of a business—

(i) to assign the right under paragraph (a);

(ii) to transmit the right under paragraph (a) to his heirs on his death or, in the case of a body corporate on its dissolution, to any person who acquires that part of the business in the course of which the act was done or preparations had been made to do it; or

(iii) to authorize the act to be done by any partners of his for the time being in that business,

and the doing of that act by virtue of this subsection shall not amount to an infringement of the patent concerned.

(3) The rights specified in subsection (2) shall not include the right to grant a licence to any person to do an act referred to in subsection (1).

(4) Where a product which is the subject of a patent is disposed of by any person to another in exercise of a right conferred by subsection (2), that other and any person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole proprietor of the patent.

Part XIII Revocation of Patent

Application for revocation of patent

59.—(1) Subject to the provisions of this section and section 60, any person may apply to the Court for revocation of a patent.

(2) An application for the revocation of a patent on the ground mentioned in section 60(e) may be made only by a person found by the Court pursuant to section 16 to be entitled to be granted that patent or to be granted a patent for part of the matter covered by the patent, or, in case more than one person is found to be so entitled, by all those persons.

(3) An application under this section may be filed even if the patent has lapsed.

Grounds for revocation

60. An application for revocation of a patent may be made only on any of the following grounds, that is to say:



- (a) the subject matter of the patent is not patentable under Part IV;
- (b) the specification of the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject matter of the patent extends beyond the content of the patent application as filed or, if the patent was granted on a divisional application, it extends beyond the content of the relevant earlier application as filed;
- (d) the protection conferred by the patent has been extended by an amendment which should not have been allowed;
- (e) the patent was granted to a person who was not entitled thereto under section 14 or section 15, as the case may be.

Examination of application for revocation

61.—(1) If on an application for revocation of a patent the Court considers that the grounds for revocation mentioned in section 60 prejudice the maintenance of the patent, the Court may by order unconditionally revoke the patent.

(2) If on an application for revocation of a patent the Court considers that the grounds for revocation mentioned in section 60 affect the patent only partially, the Court may make an order for the revocation of the patent unless within a time specified by the Court the relevant specification is amended to the satisfaction of the Court.

(3) If required by the Court the proprietor of the patent shall furnish to the Court such information as may be required in regard to foreign applications filed for protection of the invention or documents filed with any other national or regional industrial property office or in connection with any proceedings relating to an application, a patent or other title of protection for the same or essentially the same invention.

Part XIV
Putting Validity in Issue

Circumstances in which validity of patent may be put in issue

62.—(1) Subject to the following provisions of this section, the validity of a patent may be put in issue before the Court only:

- (a) by way of defence in proceedings for infringement under sections 50 or 54;
- (b) in proceedings under sections 48, 56, 57 or 59.

(2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.



(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 59 or otherwise) are the grounds on which the patent may be revoked under that section.

(4) No determination shall be made in any proceedings mentioned in subsection (1) on the validity of a patent which any person puts in issue on the ground specified in section 60(e) unless—

(a) it has been determined, either in entitlement proceedings commenced by that person or in the proceedings in which the validity of the patent is in issue, that the patent should have been granted to him and not some other person; and

(b) except it has been so determined in entitlement proceedings, the proceedings in which the validity of the patent is in issue are commenced before the end of the period of two years beginning with the date of the grant of the patent or it is shown that any person registered as a proprietor of the patent knew at the time of the grant or of the transfer of the patent to him that he was not entitled to the patent.

(5) Where the validity of a patent is put in issue by way of defence, the Court shall if it thinks just to do so, give the defendant an opportunity to comply with the condition in subsection (4)(a).

(6) In subsection (4) “entitlement proceedings”, in relation to a patent, means proceedings to determine the question whether a patent was granted to a person not entitled to it.

Amendment of patent in infringement or revocation proceedings

63.—(1) Subject to subsection (5), in any proceedings before the Court in which the validity of a patent is put in issue the Court may, allow the proprietor of the patent to amend the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the Court thinks fit.

(2) A person may give notice to the Court of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the Court shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

(3) An amendment of a specification of a patent under this section shall have effect and be deemed always to have had effect from the grant of the patent.

(4) Where an application for an order under this section is made to the Court, the applicant shall notify the Controller who shall be entitled to appear and be heard and shall appear if so directed by the Court.

(5) No such amendment shall be allowed if it discloses matter which extends beyond that disclosed in the specification of the granted patent or extends the scope of the protection conferred by the patent.



Part XV Utility Certificates

Provisions applicable to utility certificates

64.—(1) The provisions in this Act relating to patents or to patent applications shall, unless otherwise provided under this Part, be applicable to utility certificates or to utility certificate applications, as the case may be.

(2) Sections 8, 10, 24, 29, 30(1) and 60(a) shall not apply to utility certificates nor to utility certificate applications.

Protection by utility certificate

65.—(1) A utility certificate may be granted only for an invention which is new and is capable of industrial application.

(2) An invention for which a utility certificate is requested shall not be considered new if it differs from earlier inventions only in minor respects or in details which are immaterial to the function or application of the invention.

Term of utility certificate

66. A utility certificate granted under this Act shall take effect on the date on which notice of its grant is published in a periodical and, subject to this Act, shall continue in force until the end of a period of ten years beginning on the date on which the utility certificate application or, where relevant, the patent application was filed.

Grounds for revocation

67. An application for revocation of a utility certificate may be made only on the grounds—

(a) that the subject matter of the utility certificate may not be protected by a utility certificate under Part IV and this Part; and

(b) mentioned in sections 60(b), (c), (d) or (e).

Conversion of application

68.—(1) At any time before a patent is granted or before the refusal of a patent application is notified under this Act, an applicant for a patent may, in accordance with the prescribed conditions, request that his application be treated as a utility certificate application.

(2) In the same circumstances mentioned in subsection (1), an applicant for a utility certificate may, in accordance with the prescribed conditions and upon payment of the prescribed fee, request that his application be treated as a patent application.



(3) The Controller shall refuse a request under subsection (1) or (2) if the patent application or the utility certificate application has already been the subject of a request under either of those subsections.

Registration of utility certificates

69. Particulars of utility certificates granted and notice of all matters which are required by or under this Act or rules to be registered, shall be registered in a special part of the register of patents by the Controller.

Part XVI
International Arrangements

Notification as to convention countries

70. The Minister may, with a view to the fulfillment of a treaty or international convention or arrangement, by order declare that any country specified in the Order is a convention country for the purposes of section 20.

Implementation of Patent Cooperation Treaty

71.—(1) The Patent Cooperation Treaty (in this section referred to as “the Treaty”) and any regulations made thereunder shall be given full effect.

(2) Where the provisions of this Act conflict with those of the Treaty, the provisions of the Treaty shall prevail.

(3) Where this Act does not provide for any matter provided for by the Treaty, the provisions of the Treaty shall apply.

(4) The Intellectual Property Office shall act as a receiving office, designated office and elected office as provided for in the Treaty.

(5) The processing and examination of an international application for a patent designating Trinidad and Tobago shall not commence before the expiration of the time limit prescribed in Articles 22 and 39 of the Treaty, except that such processing and examination may commence if the applicant files an express request at the Intellectual Property Office within that time limit.

(6) The Controller shall not grant or refuse to grant a patent on an international application before the expiration of the time limit prescribed in Rule 52 as provided for in Article 28 or in Rule 78 as provided for in Article 41 as the case may be, except with the consent of the applicant in writing.

(7) Where an international application for a patent which purports to designate Trinidad and Tobago is refused an international filing date under the Treaty because—

(a) it is declared considered withdrawn; or



(b) the International Bureau has made a finding under Article 12(3) of the Treaty; or

(c) the receiving office has declared that the designation of Trinidad and Tobago is considered withdrawn,

and the Controller determines that such refusal was caused by an error or omission in the Intellectual Property Office or any other institution having functions under the Treaty, he may direct that the application shall be treated as an application under this Act.

Judicial notice of certain treaties and instruments thereunder

72.—(1) Judicial notice shall be taken of the Paris Convention, the Budapest Treaty, the Patent Cooperation Treaty and of any bulletin, journal or gazette published under such Convention or Treaty.

(2) Any document mentioned in any such bulletin, journal or gazette shall be admissible as evidence of any instrument or other act thereby communicated, or of any institution established by or having functions under any Convention or Treaty mentioned in subsection (1).

Part XVII
Offences

Falsification of register, etc.

73. If a person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy or reproduction of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be liable—

(a) on summary conviction, to a fine of twenty thousand dollars;

(b) on conviction on indictment, to a fine of forty thousand dollars and to imprisonment for ten years.

Unauthorized claim of patent rights

74.—(1) If a person falsely represents that anything disposed of by him for value is a patented product or process he shall, subject to the following provisions of this section, be liable on summary conviction to a fine of ten thousand dollars.

(2) For the purposes of subsection (1) a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the word “patent” or “patented” or anything expressing or implying that the article is a patented product, shall be taken to represent that the article is a patented product.

(3) Subsection (1) does not apply where the representation is made in respect of a product after the patent for that product or, as the case may be, the process in question has



expired or been revoked and before the end of a period which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(4) In proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of the offence.

Unauthorized claim that patent has been applied for

75.—(1) If a person represents that a patent has been applied for in respect of any article disposed of for value by him, and—

- (a) no such application has been made; or
- (b) any such application has been refused or withdrawn,

he shall, subject to the following provisions of this section, be liable on summary conviction to a fine of ten thousand dollars.

(2) Subsection (1)(b) does not apply where the representation is made (or continues to be made) before the expiry of a period which commences with the refusal or withdrawal and which is reasonably sufficient to enable the accused to take steps to ensure that the representation is not made (or does not continue to be made).

(3) For the purposes of subsection (1) a person who for value disposes of an article having stamped, engraved or impressed on it or otherwise applied to it the words “patent applied for” or “patent pending” or anything expressing or implying that a patent has been applied for in respect of the article, shall be taken to represent that a patent has been applied for in respect of the article.

(4) In any proceedings for an offence under this section it shall be a defence for the accused to prove that he used due diligence to prevent the commission of such an offence.

Misuse of title “Intellectual Property Office”

76. If any person uses on his place of business, or on any document issued by him, or otherwise, the words “Intellectual Property Office” or any other words suggesting that his place of business is, or is officially connected with, the Intellectual Property Office, he shall be liable on summary conviction to a fine of fifteen thousand dollars.

Offences by corporations

77.—(1) Where an offence under this Act which has been committed by a body corporate 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 who was 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.



(2) Where the affairs of a body corporate are managed by its members, subsection (1) shall apply in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

Time limit for prosecution

78. No prosecution for an offence under this Act shall be commenced after the expiration of five years after the commission of the offence or one year after the discovery thereof, whichever date last occurs.

Part XVIII
Representation

Representation

79.—(1) A person who is an Attorney-at-law shall be entitled to represent any party in any matter or proceedings before the Controller under this Act, provided—

(a) that the name of such a person is on the Roll of Attorneys-at-law kept under section 13 of the Legal Profession Act, 1986; and

(b) that he resides and has a place of business in Trinidad and Tobago.

(2) Where an applicant's ordinary residence or principal place of business is outside of Trinidad and Tobago he shall be represented by an Attorney-at-law resident and practising in Trinidad and Tobago.

Part XIX
Legal Proceedings

Appeal against order of Controller

80.—(1) An appeal to the Court shall lie from any order or decision of the Controller under this Act or the rules made thereunder except any of the following decisions, that is to say:

(a) a decision falling within section 19(5);

(b) a decision under rules which is excepted by rules from the right of appeal conferred by this section.

(2) In any such appeal or other proceedings before the Court, the Controller shall be entitled to appear or be represented and shall appear if so directed by the Court.

(3) In any appeal or other proceedings under this Act, the Court may exercise any power which could have been exercised by the Controller in the proceedings from which the appeal is brought.



(4) Save as otherwise provided in this Act, an appeal under this section shall be made within three months from the date of the order or decision, as the case may be, of the Controller or within such further time as the Court may allow in accordance with the Rules of Court.

(5) Rules of Court shall make provision for the appointment of scientific advisers to assist the Court in proceedings under this Act, for regulating the functions of such advisers and for payment of such remuneration to them as the Court may determine from time to time.

Right of appeal from order and decision of Court

81.—(1) An appeal to the Court of Appeal from an order or decision made by the Court in proceedings under this Act shall lie on any of the following grounds, but no other—

(a) that the Court had no jurisdiction in the matter, but it shall not be competent for the Court of Appeal to entertain such ground of appeal, unless objection to the jurisdiction of the Court has been formally taken at some time during the progress of the matter before the making of the order or decision;

(b) that the Court has exceeded its jurisdiction in the matter;

(c) that the order or decision of the Court has been obtained by fraud;

(d) that any finding or decision of the Court in any matter is erroneous in point of law;
or

(e) that some other specific illegality not mentioned above, and substantially affecting the merits of the matter, has been committed in the course of the proceedings.

(2) On the hearing of an appeal in any matter under subsection (1), the Court of Appeal shall have power—

(a) if it appears to the Court of Appeal that a new hearing should be held, to set aside the order or decision appealed against and order that a new hearing be held; or

(b) to order a new hearing on any question without interfering with the finding or decision upon any other question,

and the Court of Appeal may make such final or other order as the circumstances of the matter may require.

(3) The Court of Appeal may in any matter brought on appeal before it dismiss the appeal if it considers that no substantial miscarriage of justice has actually occurred notwithstanding that it is of the opinion that any point raised in the appeal might have been decided in favour of the appellant.



Burden of proof in certain cases

82.—(1) If the invention for which a patent is granted is a process for obtaining a new product, the same product produced by a person other than the proprietor of the patent or a licensee of his shall, unless the contrary is proved, be taken in any proceedings to have been obtained by that process.

(2) In considering whether a party has discharged the burden imposed upon him by this section, the Court shall not require him to disclose any manufacturing or commercial secrets if it appears to the Court that it would be unreasonable to do so.

Extension of privilege for certain communications with Attorneys-at-law relating to patent proceedings

83. For the removal of doubt, it is hereby declared that the privilege from disclosure conferred by law in legal proceedings in respect of communications made with an Attorney-at-law or a person acting on his behalf, or in relation to information obtained or supplied for submission to an Attorney-at-law or a person acting on his behalf, for the purpose of any pending or contemplated proceedings before the Court, extends to such communications so made for the purpose of any pending or contemplated proceedings before the Controller under this Act or the Patent Cooperation Treaty.

Costs and security for costs

84.—(1) The Controller may, in proceedings before him under this Act, by order award to any party such costs as he may consider reasonable, and direct how and by whom they are to be paid.

(2) If any party by whom notice of any opposition is given under this Act or by whom application is made to the Controller for the grant of a licence under a patent or for the revocation of a patent, neither resides nor carries on business in Trinidad and Tobago, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given, may treat the opposition or the application, as the case may be, as abandoned.

(3) Any order made under subsection (1) for the payment of costs may be enforced as if it were a money judgment passed by a Petty Civil Court if within the pecuniary jurisdiction of that Court, or, failing that, by the Court.

Part XX
General and Miscellaneous

Immunity as regards official acts

85. Neither the Minister nor any employee of the State—



(a) shall be taken to warrant the validity of any patent granted under this Act or any treaty or international convention to which Trinidad and Tobago is a party; or

(b) shall incur any liability by reason of or in connection with any examination or investigation required or authorized by this Act or any such treaty or convention, or any report or other proceedings consequent on any such examination or investigation.

Service by post

86. Any notice required or authorized to be given by or under this Act and any application or other document so authorized or required to be made or filed, may be given, made or filed by post or in any other prescribed manner.

Controller's annual report

87.—(1) The Controller shall, before the 1st June every year, make an annual report to the Minister with respect to the operation of this Act and the discharge of his functions thereunder which shall be laid before Parliament.

(2) Every such report shall include an audited account of all fees and other monies received and paid by him under this Act during the previous year.

Saving in respect of rights to sell forfeited articles

88. Nothing in this Act affects the right of the State or any person in the employment of the State to dispose of or use articles forfeited under the laws relating to customs and excise.

Act binding on State

89. This Act is binding on the State.

Rules

90. The Minister may, subject to a negative resolution of Parliament make such rules as he thinks expedient for regulating the business of the Intellectual Property Office in relation to patents and applications for patents (including international applications for patents) and for regulating all matters placed by this Act under the direction or control of the Controller.

Repeal and transitional provisions, Chap. 82:83

91.—(1) Subject to the provisions of this section, Part I of the Patents and Designs Act (hereinafter referred to as “the former Act”) is repealed, and section 2 and Part IV thereof insofar as they relate to patents shall not apply.

(2) Where, upon the commencement of this Act, an application made under the former Act is pending, such an application shall, notwithstanding the provisions of subsection (1) be dealt with under the former Act but the grant shall thereafter be subject to this Act.



(3) The Controller shall, on and after the appointed day—

(a) perform all the functions of and exercise all the powers conferred on the Registrar General in relation to patents under the former Act; and

(b) be the custodian of the Register of patents kept under the former Act and of the patents granted under that Act together with the certificates of registration and other relevant records.

(4) A patent granted under the former Act before the appointed day shall remain in force for twenty years from the date of the application.

(5) Nothing in this Act applies to or affects—

(a) any proceedings for revocation or infringement of a patent, commenced before the coming into operation of this Act;

(b) any existing licence, or any application for a licence made before the commencement of this Act.

* *Short title.*

Entry into force (of amending Act): June 15, 2000.

Source: Communication from the authorities of Trinidad and Tobago.

Note: Consolidation by the International Bureau of WIPO.