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REGISTERING YOUR SLOGAN AS A TRADEMARK

Fanta Punch

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In today's competitive marketing environment, the use of slogans can be a powerful promotional mechanism for businesses to promote brand awareness and build goodwill. Slogans are short, pithy, memorable phrases with which customers identify. Customers are likely to remember them either because the slogan creates in their minds a positive purchasing experience to be repeated or, alternatively, a negative one to be avoided. Slogans have the capacity to make a clear distinction between a proprietor's goods or services and those of other traders.

Slogans may be suggestive or unusual! Since they do not comprise signs or symbols that directly describe a proprietor's goods or services, slogans are not typically thought of as trademarks.

Among the many famous slogans which have mass appeal are Nike's "*Just do it*" or Burger King's "*Have it your way*" or Geico's "*Even a cave man can do it*". With the aid of a technologically advanced range of advertising media – the internet, mobile networks, or television, businesses are able to use slogans uniquely to distinguish their goods and services, and to symbolize the goodwill and value in their brand that sets them apart from their competitors.

Can slogans be registered?

Provided that they have no direct reference to the character and quality of a proprietor's goods or services to which they refer, slogans can be registered. They must be distinctive and capable of distinguishing the goods and services of one proprietor from those of another. A slogan is eligible for registration if it has acquired a distinctive character, either because the slogan itself has a high degree of inherent adaptedness and is immediately distinctive, or alternatively, through use has demonstrated that it is capable of distinguishing the proprietor's goods or services.

Practical Tips

In deciding its applicability for registration as a trademark, an important factor for consideration is whether the slogan could be found to be descriptive, in addition to its advertising or promotional function.

What is considered to be descriptive will vary. To overcome the hurdle of having your application to register a slogan as a trademark refused, the slogan has to be sufficiently distinctive to identify its goods or services from those of other traders.

Some factors to consider include:

- During its developmental stage, make the slogan creative and distinctive in relation to the goods and services with which it is to be associated. The more unusual a slogan is, the easier it is to claim distinctiveness.
- Avoid commonly used phrases which could be characteristic of the goods or the quality of the goods or services.
- Avoid a situation where a possible meaning could be descriptive. An ambiguous or vague slogan might be registrable if is sufficiently non-specific and indirect.
- Having promotional or advertising value is not fatal to a slogan's registrability, but it must be capable of distinguishing the goods and services of the trademark.

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CASH IS KING— ARE YOU JUDGMENT RICH AND MONEY POOR?

Recently in the case of Universal Projects Limited the Privy Council ordered the Government of Trinidad and Tobago to pay $31 million to a local construction company. The State, of course, can satisfy the award, but what happens if the party ordered to pay is not the State, but an individual or company, whose pockets are not as deep as the Government's Treasury? How can the successful party then reduce his judgment into cash? This article provides an overview of the mechanisms for enforcing monetary judgments obtained in the local courts.

Most successful litigants discover that obtaining a judgment in their favour is only the first step in gaining redress against the party who wronged them. This is because a judgment only states that one party wronged another, and because of that wrong the party in the right should be paid. It says nothing about how the order of the court is to be executed against the other party, "*the judgment debtor",* to facilitate payment of the award. The onus thus lies on the successful party to give his paper judgment the *Midas* touch and transform it into cash.

The most popular form of recovering money against a recalcitrant judgment debtor is to obtain a court order to levy on that person's personal property. This was done recently against the Trinidad and Tobago Football Federation (TTFF) after they failed to pay over $4 million dollars as ordered by the court to thirteen football players who represented the country at the 2006 FIFA World Cup. This is usually effective in cases where the sum to be paid is relatively small, or where the threat of the levy is enough to shame the other party to pay up or have his property put out for sale. In the case of larger awards, like that against the TTFF, the auction of office equipment is unlikely to cover the amount of the award.

If the party ordered to pay the judgment owns shares in a public company or securities a charge can be placed these instruments with the court's permission. The effect of the charge is to prevent the owner of the instruments from selling or enjoying the proceeds of sale from the instrument until the judgment is paid off. One drawback of this approach is that a separate judgment is still required to sell the shares.

Sometimes the party ordered to pay the judgment are themselves owed money from other sources for instance salary or payments due under a contract. Once it can be shown that money is owed to the judgment debtor from another source, the successful party can seek a court order to have that money redirected to the successful party to cover the amount of the award.

If the judgment debtor is in receipt of income which cannot be 'garnished' the court on the application of the successful party can declare the other party bankrupt and order the liquidation of their assets. Where the judgment debtor is a company the successful party can apply to the court for the Company to be wound up and the assets sold to pay the judgment.

These are some of the more practical means of recovering money from a judgment debtor. In each case the successful party will have to invest some more time and money to recover the cash equivalent of their judgment. Unless this is done the effect of the judgment will only be to make them judgment rich and money poor.§

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REGISTERING YOUR SLOGAN AS A TRADEMARK

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- A slogan which is novel and original in how it conveys its association with the goods or services is more likely to be distinctive and registrable.
- A slogan which is suggestive and requires some level of thought, imagination or perception by the consumer in concluding the reason for the choice of mark (while not being descriptive), is more likely to be accepted for registration as a trademark.

As an advertising tool, slogans can create great impact in setting apart a business' brand from those of its competitors in ways which differ from those of trademarks. However, to garner the protection afforded by the registration of them as trademarks and to have the exclusivity of the intellectual proprietary rights, slogans must fulfil the requirements for registration and distinguish a proprietor's goods or services in such a way that is distinctive, inextricably linking in the customer's mind the reputation and goodwill of the proprietor's business with that of its goods or services.

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ELECTRONIC TRANSACTIONS: FORMING THE ELECTRONIC CONTRACT

This is the second of a three-part series on the provisions of the newly enacted Electronic Transactions Act, 2011 (the "Act"). The first article dealt with the legal recognition of electronic transactions. In this issue we address the means by which electronic contracts may be formed. Our next and final article in the series will address the basis on which electronic signatures may be used and authenticated.

Formation of electronic contracts

Portions of the Act have now been proclaimed, and therefore are in force. This includes Part III of the Act, which addresses the means by which electronic contracts may be formed and has particular implications for the common-law requirements for formation of contracts.

Under the common-law, the formation of any contract requires that there must be an offer and an acceptance of that offer. This requirement did not contemplate electronic means of communication. Under the Act, however, parties to a prospective contract are now permitted to form the contract in an electronic environment. The Act provides that offer, acceptance or any other matter material to the operation or formation of a contract may be expressed by electronic means; and the mere fact that the contract is formed electronically does not affect its validity or enforceability.

Signifying offer and acceptance electronically

The Act also allows an offer and the acceptance of an offer to be expressed electronically. One area of commerce for which this is particularly relevant in the use of "click-wrap" contracts. Such contracts are used, for instance, where internet shopping malls are accessible via a provider's website or where software is being installed by a user. They usually require that the customer must scroll through an on-screen licence agreement and can only make a purchase or install the software after the customer has reached the end of the licence and signified acceptance by such means as:

- emailing acceptance to the provider, or,
- sending credit card details; or
- clicking a particular key, confirming agreement to the licence terms.

With the introduction of this Act it is intended that acceptance of an offer (and formation of a contract) may be validly completed by touching or clicking on an appropriately designated icon or place on the computer screen, or otherwise communicating electronically in a manner that is intended to express acceptance.

In the examples of the click-wrap contract (above), sometimes the presentation of the licence agreement and retrieval of the customer's acceptance is an automated process involving no human interaction. Under the Act such an automated process is referred to as the use of an "electronic agent". The Act provides that contracts formed through the interaction between such electronic agents and a person, or as between electronic agents, are valid and enforceable.

Managing errors in automated formation of contracts

However, it is possible that where contracts are entered into through the use of electronic agents, material errors may occur. In such circumstances the electronic contract is voidable if all of the following occur, namely: there is no opportunity afforded to the user to prevent or correct the error, notification of the error is given to the person responsible for the electronic agent, no reasonable steps are taken to correct the error, and no material benefit or value is received by the person making the error. These provisions do not, however, apply to electronic auctions. An electronic data message or record shall be attributed to the person from whose action the message or record resulted, whether via an agent or electronic agent of that person.

Timing of electronic messages

The common-law has also developed rules with regard to the timing of the sending and receiving of communications. However, with regard to electronic transactions, the Act now sets out that electronic information is deemed to be sent either when it leaves the senders computer network or, if both the sender and the addressee are in the same computer network, when the electronic information becomes capable of being retrieved and processed by the person to whom it is addressed. Similarly, Electronic information is deemed to be received either when it enters the computer network designated or used by the person to whom it is addressed for receiving such information or, where that addressee has not designated or does not use a computer network for receiving such information, upon that addressee becoming aware of it. However, the parties may contract away from these provisions.

Conclusion

The common-law has been the main source of law relating to the formation of electronic contracts. However, now that Part III of the Act has been proclaimed, the Act governs the formation of electronic contracts and should settle questions with regard to the enforceability of click-wrap agreements, the use of automated contracts, and the timing of the sending and receiving of electronic messages.

The final instalment in this series will consider the use and authentication of electronic signatures.§

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PROPOSED LEGISLATIVE REFORMS TO THE PUBLIC PROCUREMENT REGIME: A REVIEW

Catherine Ramnarine

'Procurement' has almost become a dirty word in Trinidad & Tobago. Almost everyone agrees however, that reform to the existing public procurement legislation is required. There is currently a package of proposed legislative reforms to the public procurement regime before a Joint Select Committee of Parliament. In this Article, we take a brief look at some of those key reforms.

One of the main difficulties with any public procurement system is striking the right balance between the need for transparency and accountability in the spending of public funds with the need to avoid delays and other inefficiencies caused by bureaucratic red tape. It is a balance that our current procurement regime woefully fails to achieve. Ironically, depending on the procurement vehicle that is being used, one is likely to be at either of the two extreme ends of this broad spectrum.

For example, the Central Tenders Board Act, which governs the procurement processes of some state entities, is widely perceived as being overly bureaucratic and causing unnecessary delays and inefficiencies. On the other hand, there is a very strong sense that the special purpose State enterprises (which were created to avoid this perceived bureaucracy) have tended to operate without clear guidelines or controls and are thus widely regarded as lacking transparency and accountability.

The Proposed Reforms:

The legislative proposals currently under consideration are:

- The Legislative Proposal to repeal and replace the Central Tenders Board Act/The National Tenders Board Bill ("NTBB"); and
- The Legislative Proposal to provide for Public Procurement and Disposal of Public Property ("PPDPP").

This Article is not intended as an exhaustive critique of these proposals. They are still at a very early stage in the legislative process and will undoubtedly undergo several changes from their present form before (and if) they become law. We can, however, review the 'broad strokes' of the proposed legislation.

It is important to note that the proposals were developed separately by different past regimes. Each of the proposals outlines a distinct, self contained system and is not intended to operate in conjunction with the other. Indeed, there are several fundamental differences between them. While the PPDPP is based primarily on recommendations outlined in the 2005 *White Paper on the Reform of the Public Sector Procurement Regime*, the proposals outlined in the NTBB date back to the mid 1990s. Not only does the NTBB pre-date the *White Paper*, but it also pre-dates the proliferation of special purpose state companies as prominent vehicles for public procurement. It is perhaps for this reason that the NTBB appears somewhat more limited in scope than its counterpart.

The Legislative Proposal to repeal and replace the Central Tenders Board Act/The National Tenders Board Bill ("NTBB")

The principal features of the proposed reforms under the NTBB are:

- The replacement of the Central Tenders Board with a new National Tenders Board; and
- The establishment of a Parliamentary Commission to monitor the award and implementation of procurement contracts.

The abolition of the Central Tenders Board and establishment, in its stead, of a National Tenders Board appears for the most part to be a change in name only. The NTB functions in much the same way as the CTB does. Its scope remains limited to the tendering process, with no role in the design or execution stages. Moreover, it is subject to the same exceptions as the CTB, enabling the State to by-pass the Board by contracting with special purpose state companies.

At first glance, the establishment of the Parliamentary Commission appears more revolutionary, as it introduces a mechanism for the investigation of complaints relating to procurement. Unlike the Board, the Commission's role is not restricted to the tendering process. It is empowered to investigate:

- The tender procedures applied in procurement contracts;
- The award of any procurement contract; and
- The implementation of the terms of any procurement contracts.

However, while the NTBB places considerable focus on the investigative process, giving the Commission wide ranging powers to facilitate the gathering of information and evidence, the Commission's powers upon the conclusion of such an investigation are not clearly articulated. It is required to inform the Board, the principal officer of the body concerned and the Prime Minister of the results of the investigation and to make "such orders and recommendations as it considers necessary" in respect of the matter which was investigated. The NTBB does not expressly outline the penalties that the Commission can impose or the remedies, if any, that it can award to an aggrieved party. It is not clear whether the Commission would be able to impose fines, award damages or compensation or overturn contracts that were not awarded or executed properly. This is a significant drawback.

Perhaps one of the most significant drawbacks of the NTBB (in it current form) is that the authority of both the Board and the Commission is restricted to the activities of 'procurement entities' – which are narrowly defined under the NTBB as the

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PROPOSED LEGISLATIVE REFORMS TO THE PUBLIC PROCUREMENT REGIME

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Government of T&T, the Tobago House of Assembly, municipal corporations and certain specified statutory bodies. This definition excludes special purpose state companies (such UDeCOTT and Nidco) whose activities are accordingly not regulated by or impeachable under the NTBB. This creates a significant vacuum, placing the entities that, in recent times, have not only been responsible for substantial projects and asset purchases but have found themselves mired in controversy with regard to a number of procurement issues.

As noted above, the NTBB was drafted at a time there were not as many special purpose state companies, and the use of such special purpose vehicles for procurement was not as vogue - so perhaps this explains why it does not expressly treat with such entities. However, if the NTBB is to be at all successful in addressing the shortcomings of the current public procurement system its scope would need to be expanded to include all entities engaged in public procurement.

The Legislative Proposal to provide for Public Procurement and Disposal of Public Property (PPDPP)

The PPDPP, on the other hand, is much wider in scope. It applies to all state agencies including ministries and departments of government, statutory bodies and companies owned or controlled by the State – including special purpose state companies. It is not restricted to the tendering process, but applies to the whole of procurement, from the identification of the need for goods or services to the performance of the relevant contract.

The most noteworthy features of the PPDPP are:

- The abolition of the Central Tenders Board;
- The establishment of a Procurement Regulator;
- The establishment of a National Procurement Advisory Council representing civil society; and
- The introduction of National Procurement Guidelines to be developed by the Regulator and the Advisory Council.

The crux of the system proposed under the PPDPP is decentralised purchasing coupled with mandatory compliance with prescribed rules. With the abolition of the Central Tenders Board, state entities will no longer be required to go through a central agency but will instead be individually responsible for their own procurement. However, all state entities will be required to adopt and adhere to prescribed Guidelines developed by the Regulator in consultation with the Advisory Council (a body comprising representatives from various industries and non-governmental bodies) and subject to approval by Parliament. Breaches of these Guidelines will be punishable by fine and imprisonment.

Allegations of breaches of the Guidelines will be investigated by the Procurement Regulator. The PPDPP gives the Regulator wide powers of access to information relating to the procurement transaction under investigation. It also includes protection for whistle blowers. The Regulator has the power to suspend a transaction pending the outcome of his investigation. He can also employ alternative dispute resolution (ADR) and other mediation techniques. Where the Regulator finds that there was a breach of the Guidelines, the person that committed the breach is liable to a fine of $500,000.00 and to imprisonment for 7 years. This penalty applies to elected officials. On the other hand, if the Regulator finds that a complaint was frivolous or vexatious; the complainant may be ordered to pay the costs of the investigation and is liable to be sued for damages by the parties to the procurement transaction. Decisions of the Regulator can be appealed to the Court. The Regulator also has the power to conduct periodic inspections and audits.

There is no doubt that the underlying objectives of the PPDPP are laudable. Indeed, it does appear to address many of the shortcomings of the current procurement regime – widening the scope of regulatory oversight of public procurement to encompass all stages of the procurement cycle as well as the activities of special purpose state companies and introducing a mechanism for the investigation of complaints and allegations of impropriety.

However, as the old saying goes, the proof of the pudding is in the eating. So too the true effectiveness of the reforms introduced by the PPDPP will depend on the manner in which they are implemented in practice. Many of the concrete details regarding the operation of the procurement process are not actually addressed in the PPDPP, but rather, are intended to be covered in the Guidelines. The development and formulation of these Guidelines will be a critical step in the operation of the proposed system and it will be important that the membership of the Advisory Council effectively reflects and represents all relevant stakeholders. It will also be critical to ensure that the new system is supported by an effective administrative and organisational framework including appropriate staffing, infrastructure and technology. The new decentralised system will place a greater administrative burden on individual entities, which will be required to implement their own internal procurement processes instead of relying on a central agency such as the Central Tenders Board.

Critics of the proposed reforms also point to the dangers of conferring the extensive powers of the Regulator on a single individual and question whether it is actually possible to locate someone with the expertise and political and commercial independence necessary in order to properly carry out these functions. Certainly, in a society as small as ours this is a very real concern, and care will have to be taken to appoint an individual capable of inspiring public trust and confidence in the integrity of the office of Regulator and the system of public procurement. In the interim, we look forward to the report of the Joint Select Committee.§

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