



THE MADRID PROTOCOL

A route to global branding

REBECCA SANTANA DAVIES
Legal Specialist
12-11-2021



CARIFORUM



IPR IN THE GLOBAL ECONOMY

Three international systems that facilitate IPR protection at the international level

- The Madrid Protocol trademarks
- The Hague Agreement industrial designs
- The Lisbon Agreement appellations of origin and geographical indications

A SYSTEM AVAILABLE TO NATIONALS OF ITS MEMBERS

The Madrid system can only be used by persons who have

- an **attachment to a Contracting Party**
 - nationality, or
 - domicile, or
 - industrial or commercial establishment
- **and**
- a **basic mark in that Contracting Party**
 - a TM application or a TM registration at the relevant Office

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

- A brand protection system in full expansion ... currently available to nationals of 107 members (covering 123 Countries) around the world, including Antigua and Barbuda (March 17, 2000)
- A business competitiveness tool ... of special interest to export industries
- A trademark protection route increasingly used by all types of companies ... and particularly attractive for SMEs

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

The European Union acceded to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks on 01/07/2004.

The EUIPO as Office of Origin
The EUIPO as Designated Office

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

Tasks of the EUIPO as Designated Office:

- first **republishation** in the EUTM Bulletin;
- examination of **formalities**, including examination of limited lists for the EU designation, of the clarity and precision of the terms in the specification of goods and services, and of seniority claims;
- examination of **absolute grounds**;
- examination of **oppositions**;
- processing of communications from WIPO concerning **changes** to the IRs;
- second republication in the EUTM Bulletin (upon conclusion of all procedures)
- issue of grants of protection or final decisions.

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

In principle, the IR holder does **not need to appoint a representative** before the EUIPO.

Holders outside the European Economic Area (EEA) are, however, required to be represented:

- (a) further to a provisional refusal,
- (b) for filing seniority claims directly before the EUIPO, or
- (c) further to an objection to a seniority claim

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

The formalities examination carried out by the EUIPO on IRs is limited to

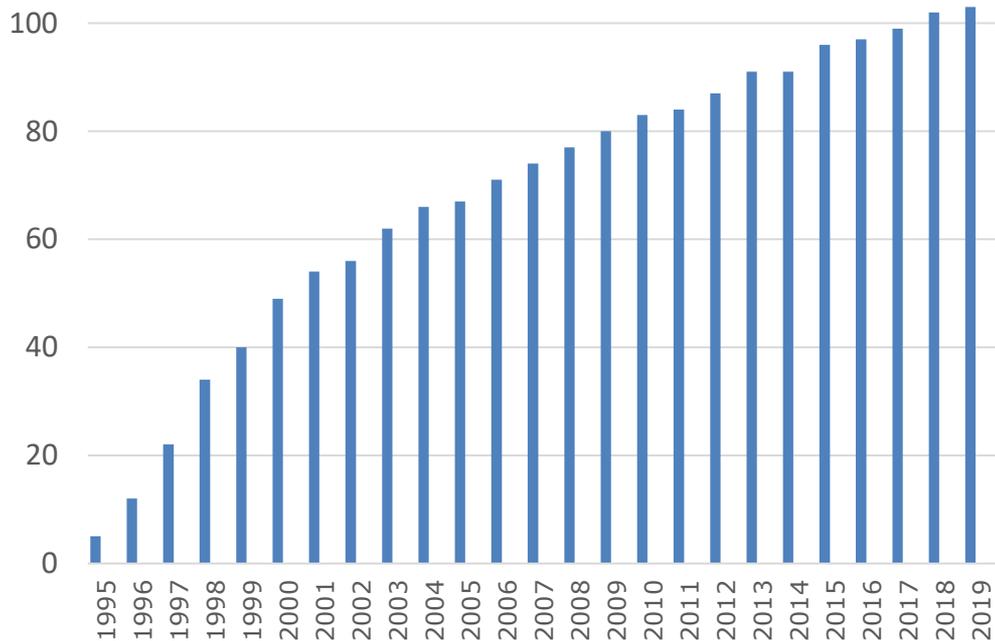
- whether a **second language** has been indicated,
- whether the application is for a collective or a certification mark (which must include the submission of the regulations governing the use of the mark),
- whether the limited lists for the EU designation fall within the scope of the IR's main list,
- whether there are any seniority claims and
- whether the list of goods and/or services meets the requirements of clarity and precision

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

The Absolute ground examination carried out by the EUIPO on IRs:

- If the mark is NOT eligible for protection, it will send a Provisional refusal of protection giving **2 months** to submit observations.
- If the holder fails to overcome the objections or convince the examiner that they are unfounded, or fails to respond to the objection, the refusal will be confirmed.
- If after re-examining, the objection is waived, the Office issues an interim status of the mark to the WIPO

THE MADRID PROTOCOL – A SYSTEM IN FULL EXPANSION (Dec 1995 – Jan 2020)



107 Members

105 States

+ 2 intergovernmental
organizations

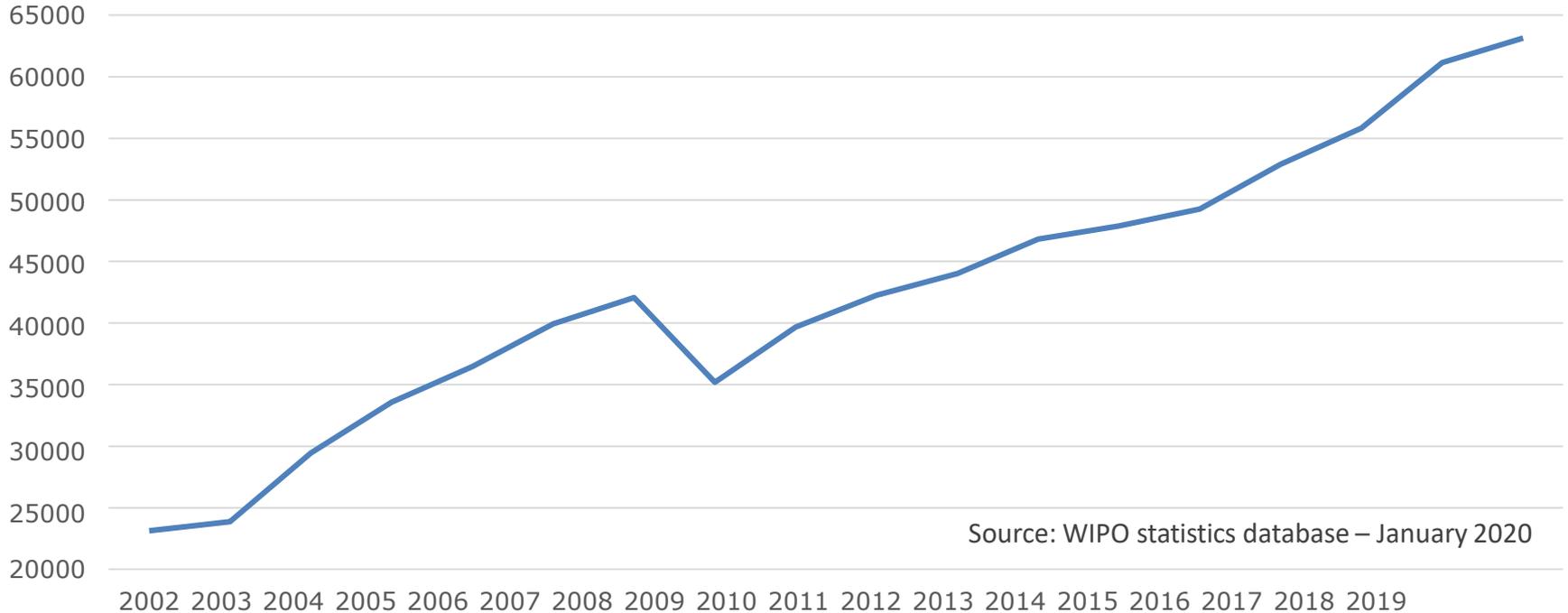
- European Union (27 States)
- OAPI (17 States)

MADRID GEOGRAPHICAL COVERAGE 107 Members = 123 countries (by January 2020)



> 80% of world trade

THE MADRID PROTOCOL : A GROWING NUMBER OF APPLICATIONS (2002-2019)



THE MADRID PROTOCOL – MAIN OBJECTIVES

- Facilitate brand protection abroad, in export markets ...
- ... and lower the costs that entrepreneurs have to pay to obtain and maintain such protection

As a result, the Protocol helps entrepreneurs to

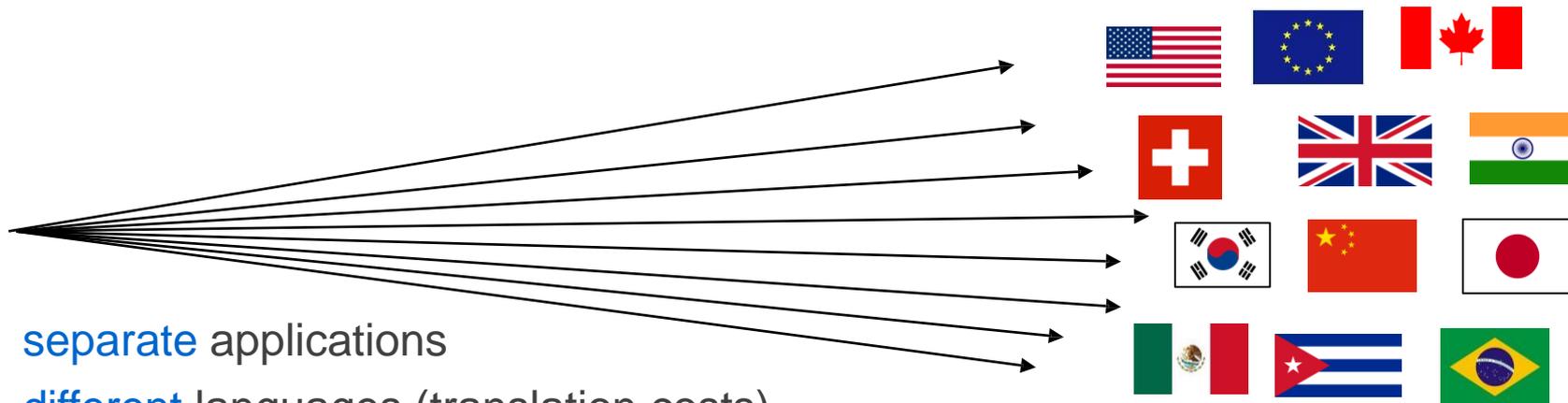
- export branded products/services
- add value to their exports
- improve their international competitiveness

HOW DOES THE PROTOCOL ACHIEVE THOSE OBJECTIVES?

By offering a **simple, expedite** and **cost-effective** set of procedures for entrepreneurs to

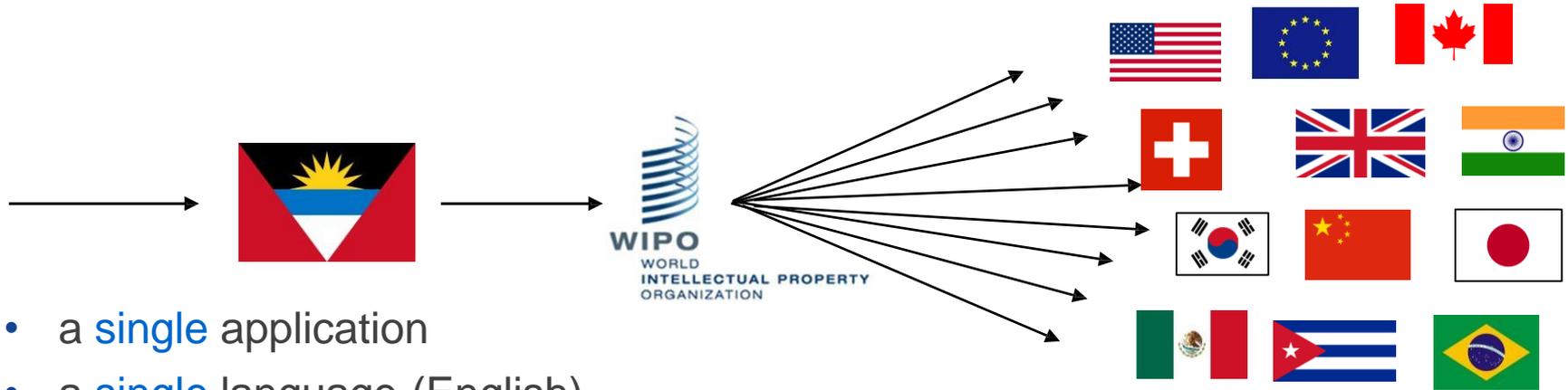
- apply for the legal protection of their brands in export markets
= **central filing of trade mark applications**
- manage their trade mark rights valid in various countries
= **central management of trade mark registrations**

TRADITIONAL FILING vs MADRID CENTRAL FILING

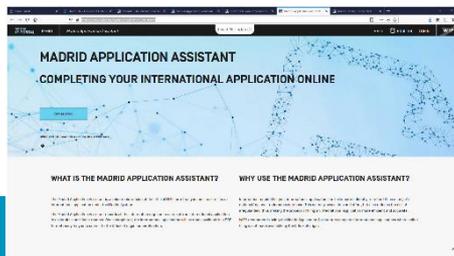


- **separate** applications
- **different** languages (translation costs)
- fees paid in **different** local currencies (currency exchange costs)
- local representatives **usually required** (additional costs involved)
- **different** procedures from the start with **different timeframes**

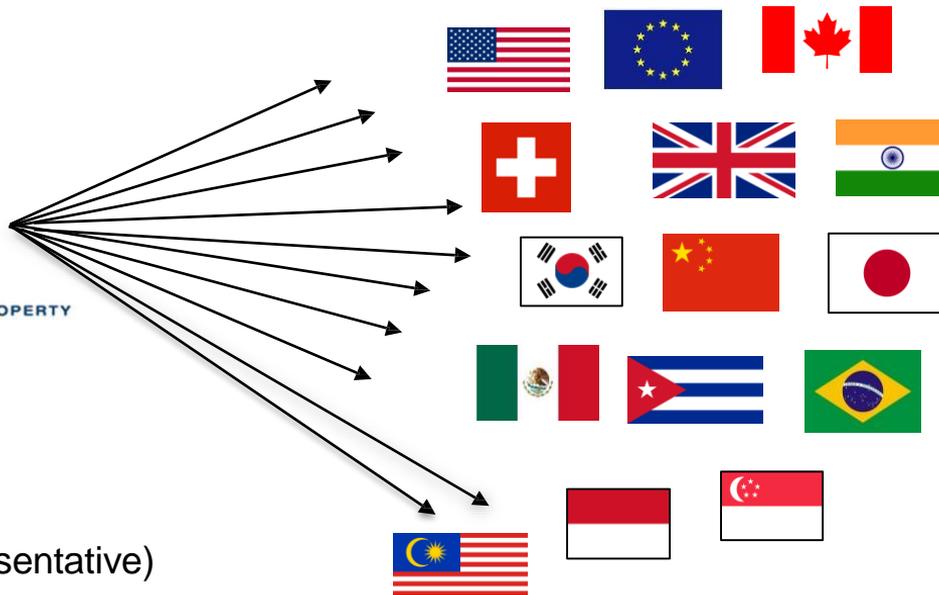
TRADITIONAL FILING vs MADRID CENTRAL FILING



- a **single** application
- a **single** language (English)
- fees paid in a **single** currency (CHF)
- local representative **only required in limited cases**
- a **single** international procedure and **strict deadlines** for DCPs



MADRID CENTRAL MANAGEMENT



- **renewal** (every 10 years)
- **subsequent designations**
- **modifications**
 - changes in name or address (holder/representative)
 - assignments (change in ownership)

THE MADRID SYSTEM LEGAL FRAMEWORK

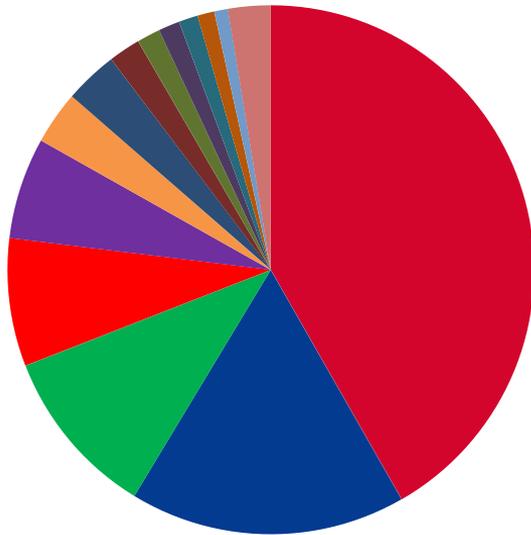
Each Designated Contracting Party decides ...

- whether it corresponds or not to confer trademark protection to a given IR under the Madrid Protocol, and
- in accordance with its own substantive trademark law provisions

DCPs may refuse protection within

- 12 months or
- 18 months or
- 18+ months in case of opposition

MADRID UNION MEMBERS – AN ATTRACTIVE MARKET FOR CARIBBEAN EXPORTS



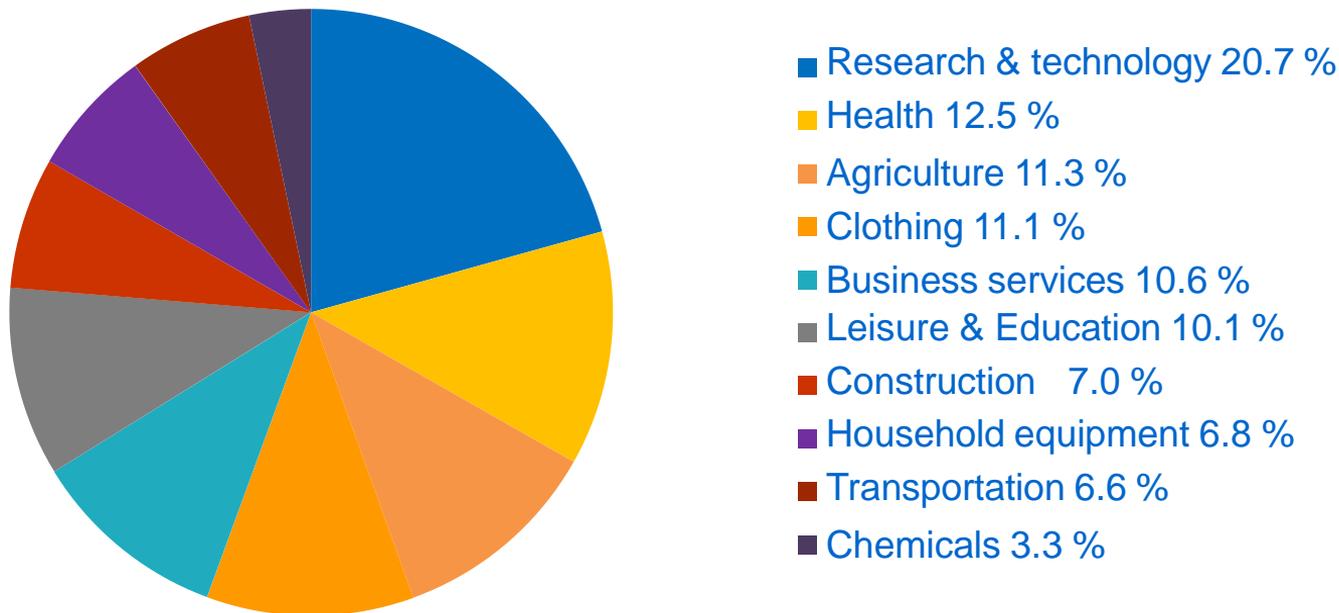
More than 80% of Caribbean exports of goods and services go to Madrid Union Members ...

... including the US, European Union, Canada and Switzerland, but also the UK, India, China, Mexico, Japan, Brazil, etc.

Becoming a Party to the Madrid Protocol offers to Caribbean nationals the possibility to obtain easier trademark protection in those markets

■ US ■ EU ■ CARIFORUM ■ CA ■ CH ■ IN ■ CL ■ UK ■ KR ■ CN ■ MX ■ JP ■ BR ■ other

MADRID PROTOCOL : USERS FROM A VARIETY OF INDUSTRY SECTORS (2018)



Source: Madrid Yearly Review 2019 - WIPO publication No. 940E/19

**Are there many Caribbean companies wishing
to protect their marks abroad?**

CARIBBEAN TRADEMARKS

TRADEMARK FILINGS ABROAD 2018 (equivalent count)

COUNTRY	TOTAL	DIRECT FILINGS	MADRID FILINGS	COUNTRY	TOTAL	DIRECT FILINGS	MADRID FILINGS
Bahamas	2165	2165		Saint Lucia	172	172	
Barbados	1622	1622		Antigua and Barbuda	162	159	3
Cuba	1085	761	324	Suriname	73	73	
Belize	949	949		Haiti	59	59	
Dominican Republic	762	762		Dominica	42	42	
St Kitts and Nevis	660	660		St Vincent & the Grenadines	18	18	
Jamaica	208	208		Guyana	10	10	
Trinidad and Tobago	206	206		Grenada	8	8	

Source: WIPO statistics database – January 2020

ANTIGUA AND BARBUDA – 3 ACTIVE REGISTRATIONS = 60 NATIONAL MARKS



KAI COLLECTIVE

ARISE COLLECTIVE

Eyewear, spectacles, corrective lenses, eye care products ...

349 MADRID REGISTRATIONS BY HOLDERS FROM OTHER CARIBBEAN COUNTRIES



esquire group



CLYDESDALE ESTATE COFFEE

EL DORADO

CORPAG

Source: WIPO Madrid Monitor – January 2020

THEY HAD TO FILE THROUGH ANOTHER COUNTRY (A MADRID UNION MEMBER)



THANK YOU



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.caripi-hub.com