



IPR IN THE GLOBAL ECONOMY INTERNATIONAL SYSTEMS: MADRID, HAGUE, LISBON

ERNESTO RUBIO | BRIDGETOWN | 28-01-2020



CARIFORUM



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

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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

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

- A brand protection system in full expansion ... today available to nationals of 122 States
- A business competitiveness tool ... of special interest to export industries
- A balanced and flexible legal instrument ... respectful of the sovereignty of each of its Members
- A trademark protection route increasingly used by all types of companies ... and particularly attractive for SMEs

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

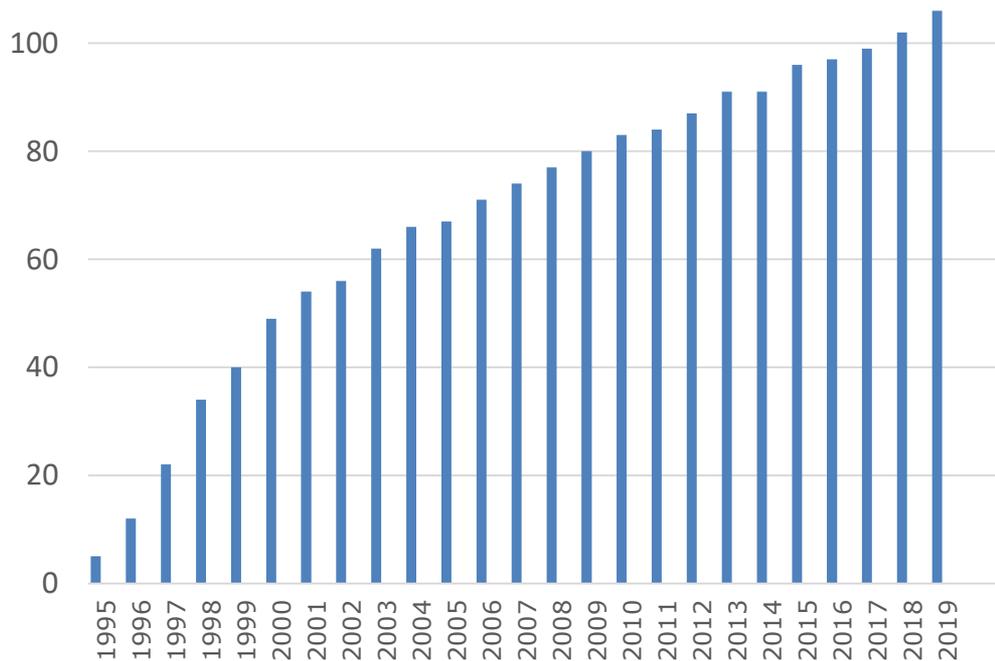
A brand protection system in full expansion
today available to nationals of 122 States

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 SYSTEM IN FULL EXPANSION (Dec 1995 – Jan 2020)



106 Members
(Contracting Parties)

104 States
+ 2 intergovernmental
organizations

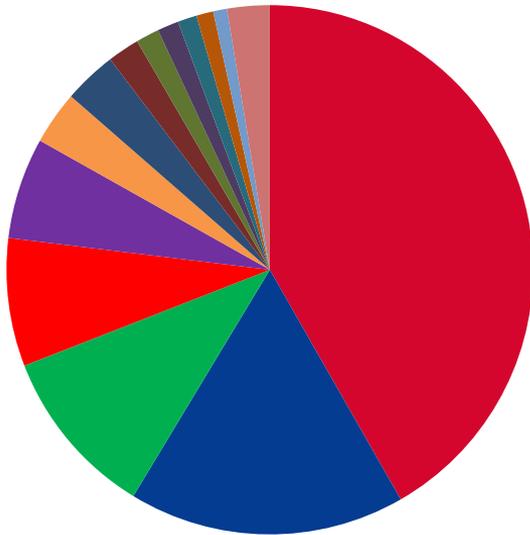
- European Union (27 States)
- OAPI (17 States)

MADRID GEOGRAPHICAL COVERAGE 106 Members = 122 countries (by January 2020)



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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, ROK, 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

THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

A business competitiveness tool
of special interest to export industries

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

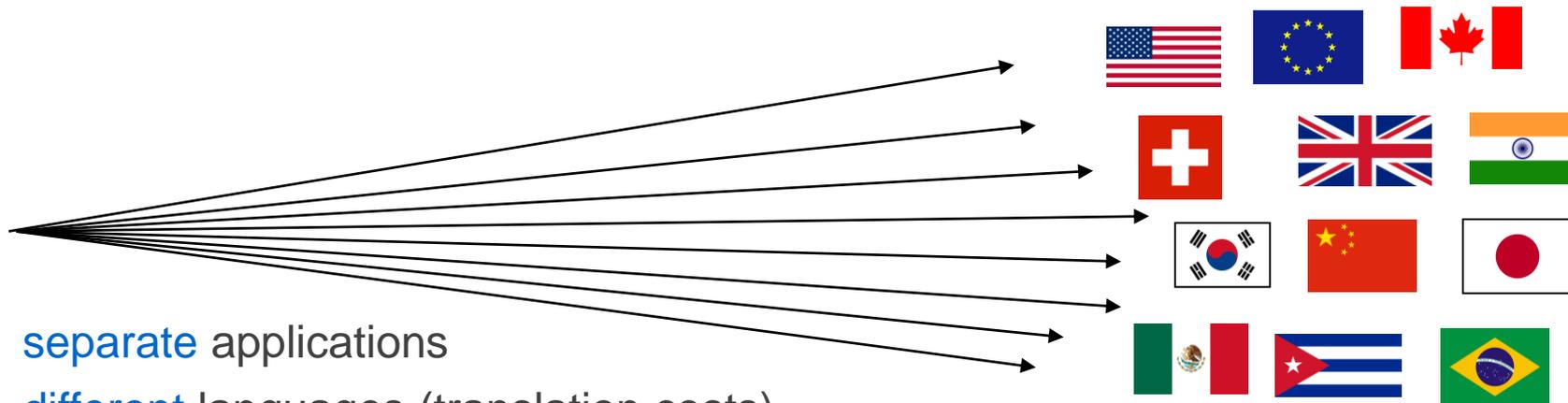
- export branded products/services
- add value to their exports
- improve their international competitiveness

HOW DOES THE PROTOCOL ACHIEVE THOSE OBJECTIVES?

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

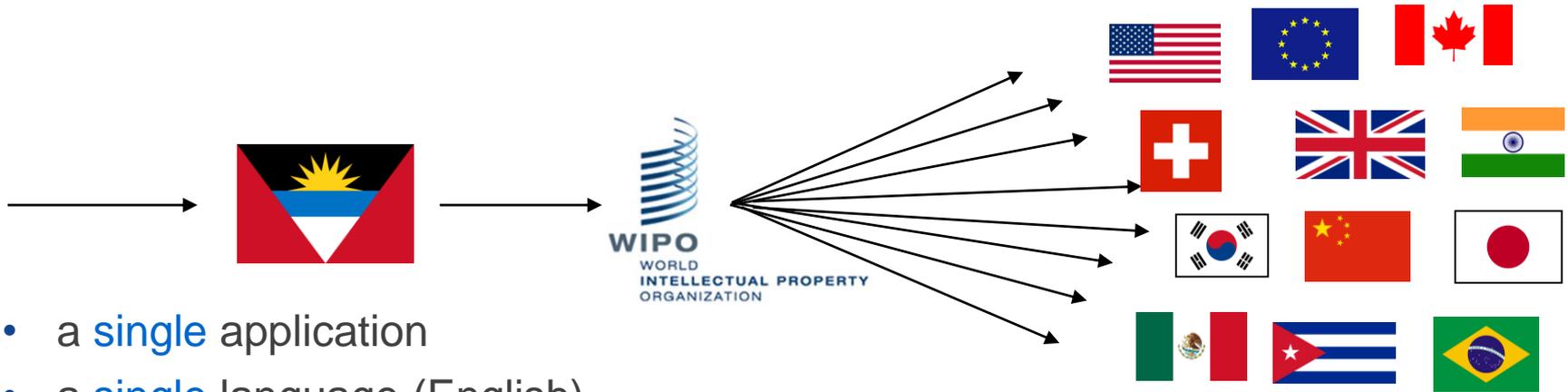
- apply for the legal protection of their brands in export markets
= **central filing of trade mark applications**
- manage their trade mark rights valid in various countries
= **central management of trade mark registrations**

TRADITIONAL FILING vs MADRID CENTRAL FILING



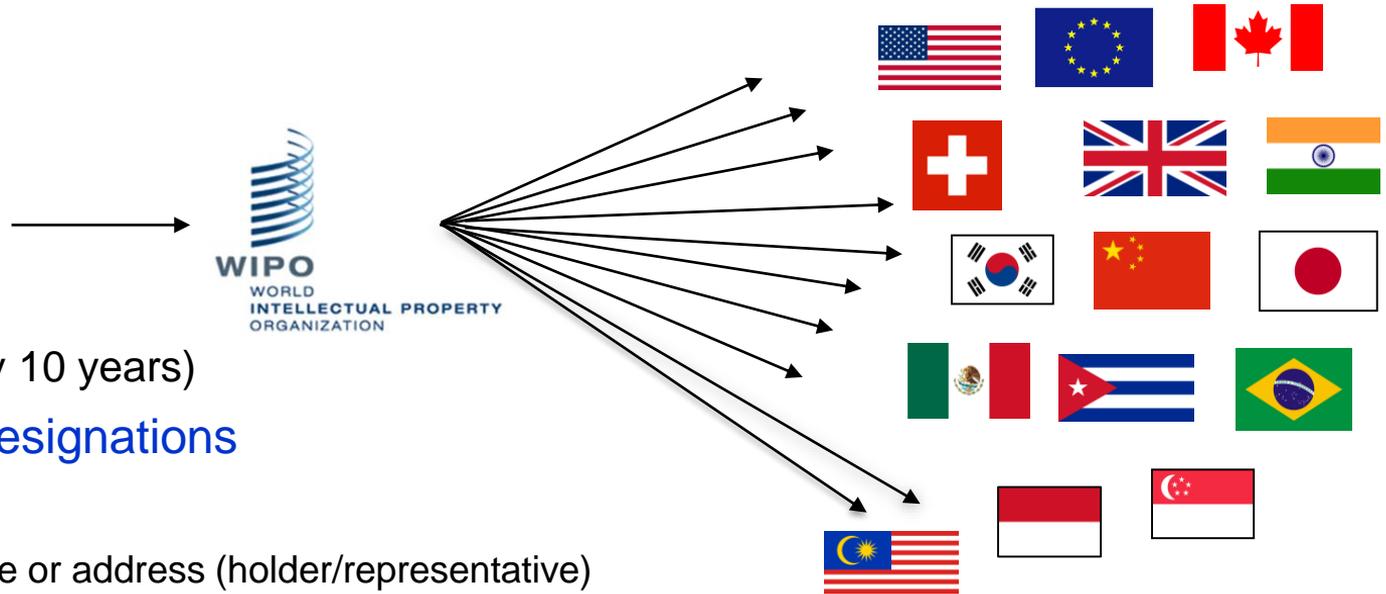
- **separate** applications
- **different** languages (translation costs)
- fees paid in **different** local currencies (currency exchange costs)
- local representatives **usually required** (additional costs involved)
- **different** procedures from the start with **different timeframes**

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 PROTOCOL : A ROUTE TO GLOBAL BRANDING

A balanced and flexible legal instrument
respectful of the sovereignty of each of its Members

THE MADRID SYSTEM LEGAL FRAMEWORK

- [Madrid Protocol 1989](#) – Diplomatic Conference
- [Common Regulations](#) – Madrid Union Assembly (Feb 1, 2019)
- [Administrative Instructions](#) – International Bureau (Feb 1, 2019)
- [Laws and Regulations of each Madrid Union Member](#)

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

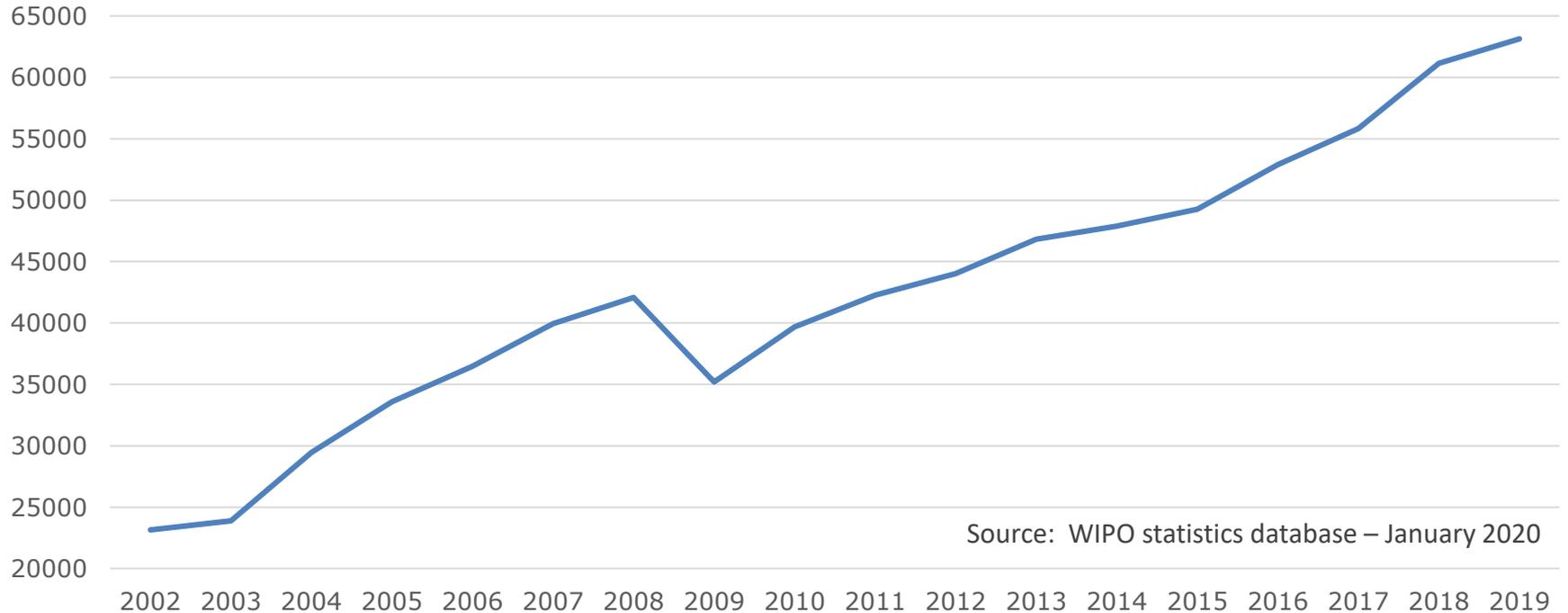
DCPs may refuse protection within

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

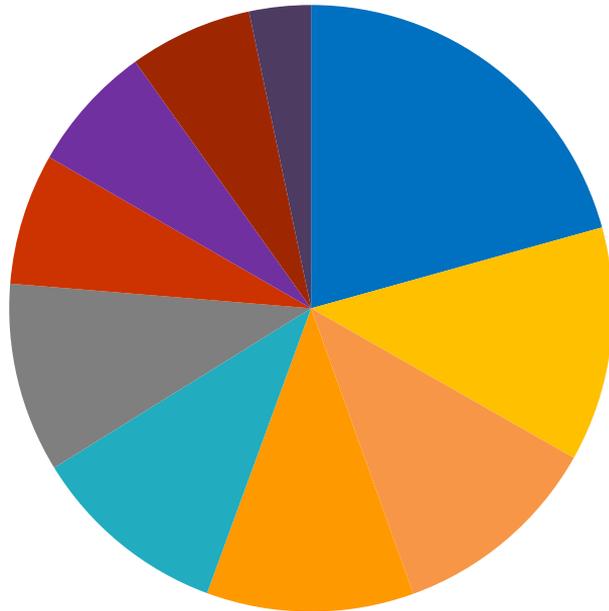
THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

A trademark protection route increasingly used by
all types of companies ...
and particularly attractive for SMEs

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



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



- Research & technology 20.7 %
- Health 12.5 %
- Agriculture 11.3 %
- Clothing 11.1 %
- Business services 10.6 %
- Leisure & Education 10.1 %
- Construction 7.0 %
- Household equipment 6.8 %
- Transportation 6.6 %
- Chemicals 3.3 %

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

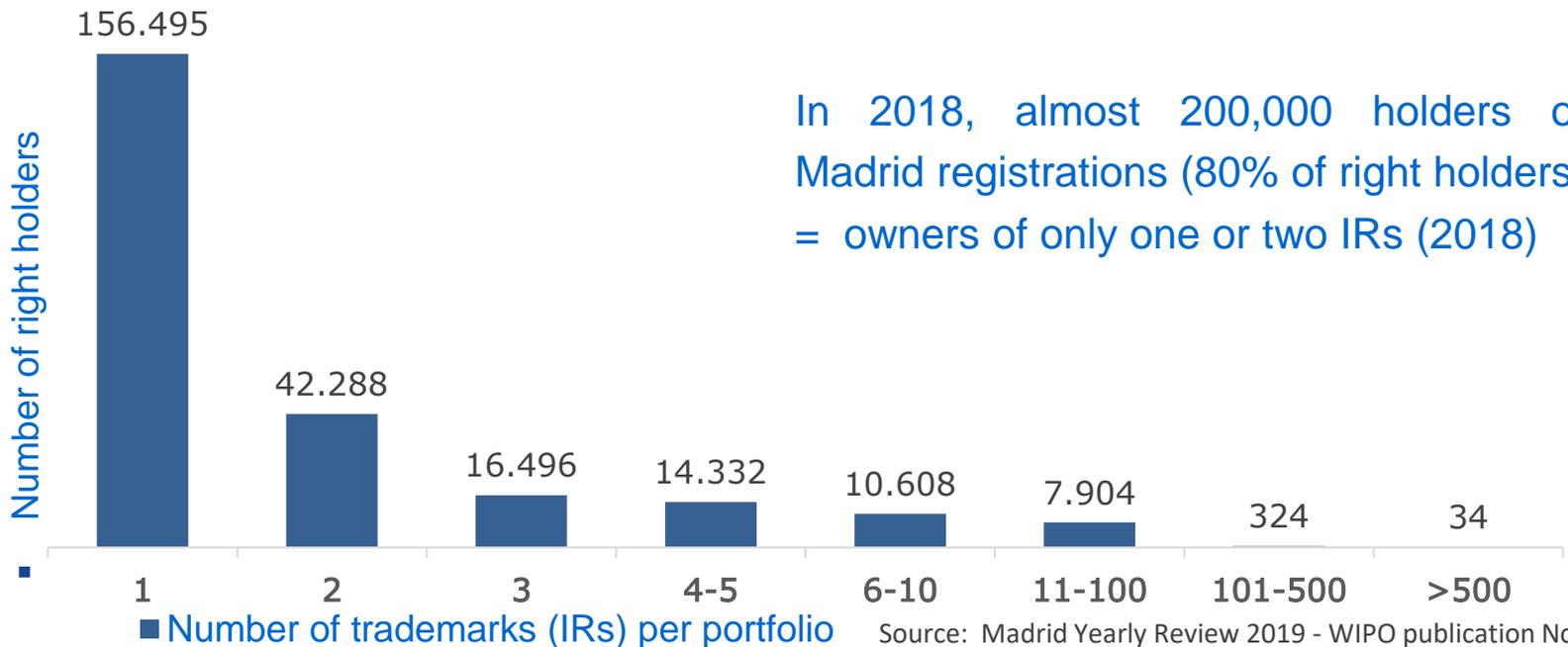
MADRID PROTOCOL : A COST EFFECTIVE PROTECTION SYSTEM (2018 PROFILE)

61,142 international applications

Average n° of designations	6.8
Average number of classes	2-3
Average fee paid per registration	CHF 3,186
50% of registrations paid	CHF 2,225 or less

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

MADRID PROTOCOL : PARTICULARLY USEFUL FOR SMEs



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

THE HAGUE SYSTEM : AN ATTRACTIVE ROUTE TO PROTECT DESIGNS GLOBALLY

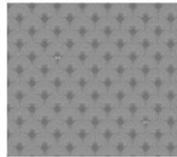
Industrial Designs



DM/103819



DM/103348



DM/103232



DM/103030



DM/103609

THE HAGUE SYSTEM

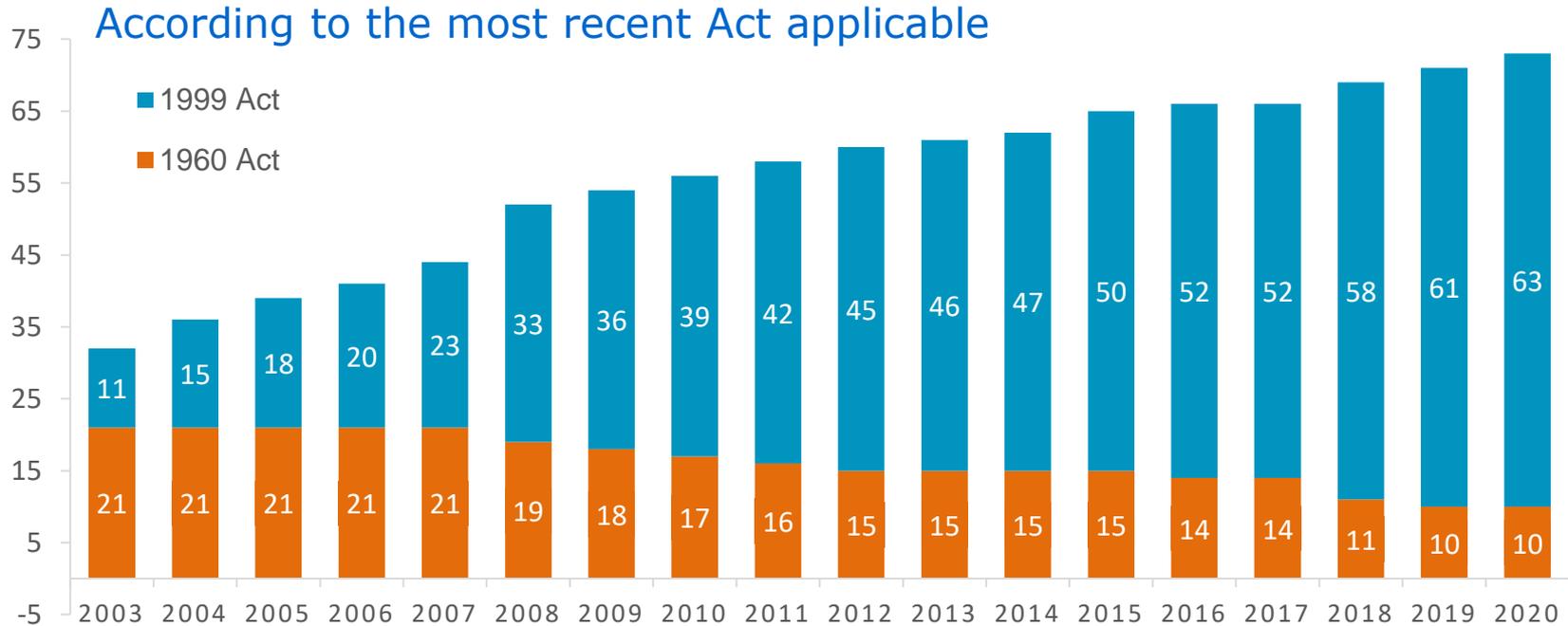
The Hague System

- aims at facilitating the protection of industrial design rights in up to **73 Contracting Parties** (States and IGOs) ...
- ... through **a single international application** that results in ...
- ... **a single international registration** with individual effects in each Contracting Party designated therein

Two autonomous and independent treaties:

- Hague Act of the Hague Agreement (**1960 Act**) – **34 Members**
- Geneva Act of the Hague Agreement (**1999 Act**) – **63 Members**

THE HAGUE SYSTEM EXPANSION SINCE 2003



HAGUE AGREEMENT MEMBERSHIP IN EARLY 2020

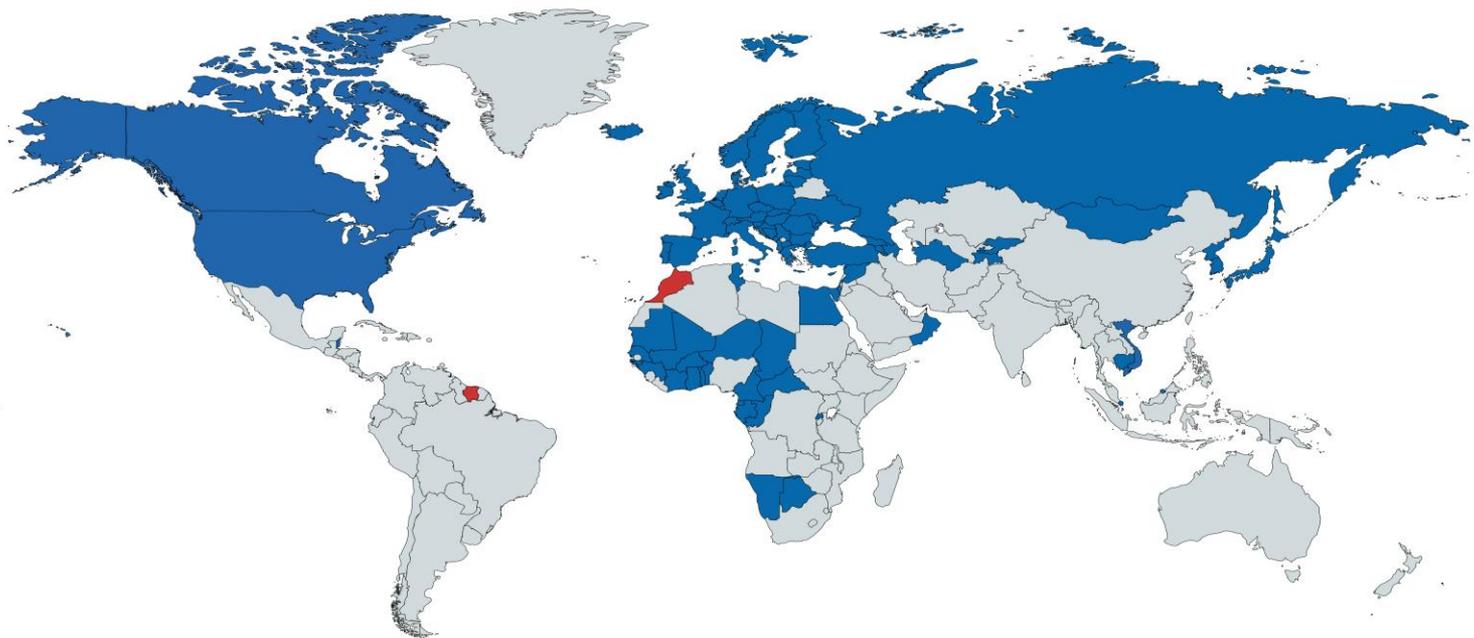
Grouped according to the most recent Act applicable

Geneva Act (1999 Act): [African Intellectual Property Organization](#), Albania, Armenia, Azerbaijan, Belgium, [Belize](#), Bosnia and Herzegovina, Botswana, Brunei Darussalam, Bulgaria, Cambodia, Canada, Croatia, DPRK, Denmark, Egypt, Estonia, [European Union](#), Finland, France, Georgia, Germany, Ghana, Hungary, Iceland, Israel, Japan, Kyrgyzstan, Latvia, Liechtenstein, Lithuania, Luxembourg, Monaco, Mongolia, Montenegro, Namibia, Netherlands, North Macedonia, Norway, Oman, Poland, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Samoa, San Marino, Sao Tome and Principe, Serbia, Singapore, Slovenia, Spain, Switzerland, Syrian Arab Republic, Tajikistan, Tunisia, Turkey, Turkmenistan, Ukraine, United Kingdom, United States of America, Vietnam
(63 Contracting Parties)

Hague Act (1960 Act): Benin, Côte d'Ivoire, Gabon, Greece, Italy, Mali, [Morocco](#), Niger, Senegal, Suriname (10 Member States)

HAGUE SYSTEM COVERAGE

73 Members = 90 countries (by Jan 2020)



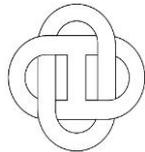
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HAGUE SYSTEM : AN ATTRACTIVE ROUTE TO PROTECT DESIGNS GLOBALLY

How does the Hague System work ?



DM/083330



DM/081718



DM/083137



DM/089858

WHO IS ENTITLED TO USE THE HAGUE SYSTEM ?

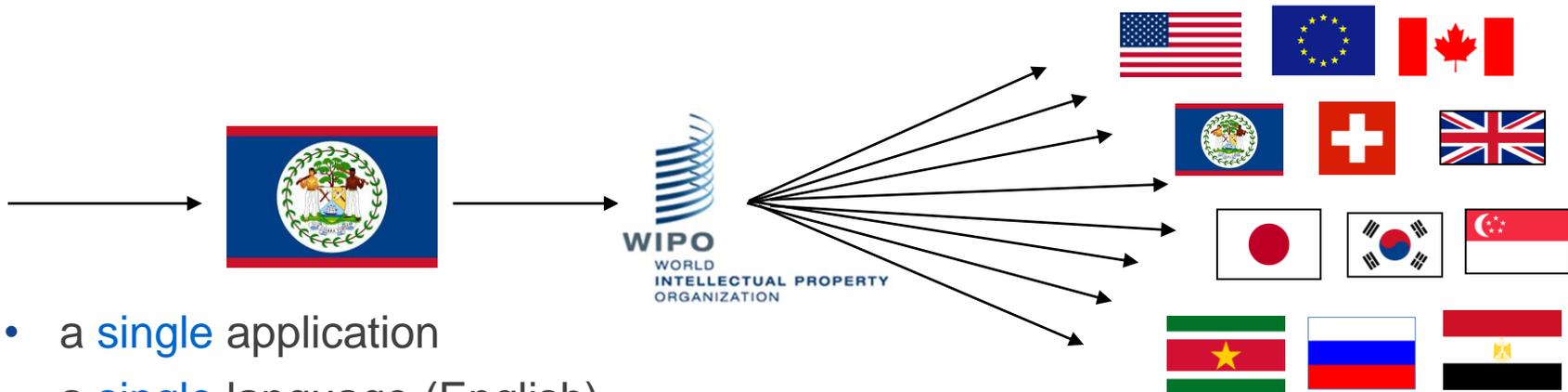
The Hague System can be used by anyone who has

- an attachment to a Contracting Party
 - industrial or commercial establishment, or
 - nationality, or
 - domicile, or
 - habitual residence

Unlike Madrid

- the applicant does not need to have a “basic design” in that Contracting Party
- moreover, the applicant may designate its own Contracting Party for protection

TRADITIONAL FILING vs HAGUE 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** at DCPs

HAGUE SYSTEM – INTERNATIONAL APPLICATION, FILING, FEES

- **Application**
 - up to 100 designs + their reproductions or specimens
 - products (in one Locarno class)
 - identity of the creator (required by some DCPs)
- **Filing at WIPO** - can be done electronically - **E-filing** interface
- **Fees (CHF)** (example)
 - one IA, one design, one reproduction, designating BZ, SR, **EM**, GB, CH (for protection in 31 countries)
 - basic fee **397**, publication fee **17**, designation fees **253**

Total **667 CHF**

- if CA (**300**) & US (**908**) are also designated

1,875 CHF

HAGUE SYSTEM : PUBLICATION AND EFFECTS OF THE REGISTRATION

- Publication**
- 6 months after registration, unless the applicant has requested:
 - immediate publication – within one week, or
 - deferred publication – up to 30 months after filing or priority date

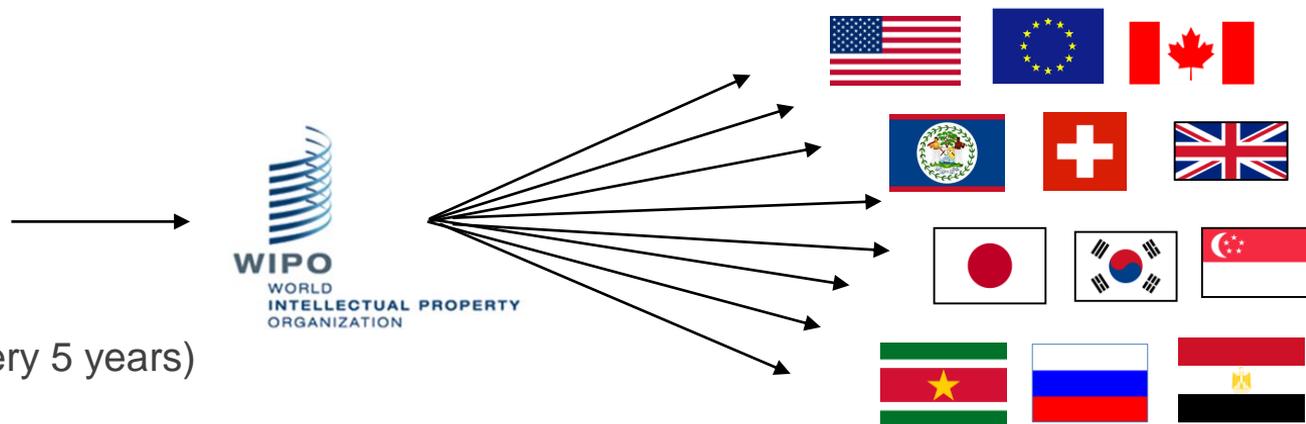
IR Effects

The same effects as a national or regional registration of 5 years duration, renewable (every 5 years) in all DCPs that have not refused protection within strict time limits (6 months or 12 months from publication)

Duration of protection – under Geneva Act minimum 15 years

up to 15 years (28 Members), 20 years (2 Members), 25 years (32 Members), or 50 years (1 Member)

HAGUE CENTRAL MANAGEMENT



- **renewal** (every 5 years)
- **modifications**
 - changes in name or address (holder/representative)
 - assignments (change in ownership)

Appellations of origin and geographical indications

THE LISBON SYSTEM

Two autonomous and independent treaties:

- Lisbon Agreement (1958) revised in Stockholm (1967)
- Geneva Act of the Lisbon Agreement (2015)

The Lisbon System

- is today a useful branding instrument ...
- ... aimed at facilitating international protection of appellations of origin (AO) in 30 countries ...
- ... very soon to also allow international protection of both AO and geographical indications (GI) in even more countries.

LISBON AGREEMENT 1958

Lisbon Agreement 1958 (rev. 1967)

deals only with **appellations of origin (AO)**

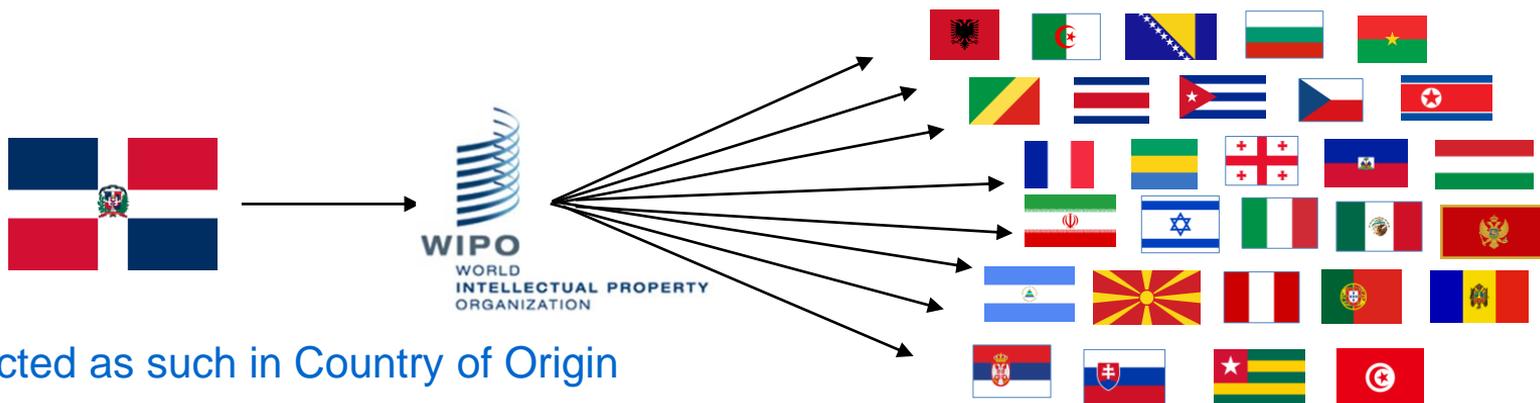
AO = a special type of geographical indication (GI)

- the **geographical denomination** of a country, region or locality
- serves to **designate a product originating therein**,
- the **quality or characteristics** of which are **due** exclusively or essentially to the **geographical environment**, including natural and human factors

strong qualitative connection between product and place of origin

- natural factors (soil and climate) and
- human factors (e.g., method of production or manufacture)

LISBON AGREEMENT – REGISTRATION PROCEDURE



- AO protected as such in Country of Origin
- Competent Authority files IA (E, F or S) with IB
- IA indicates product, area of production, legal basis in CO (Fee 1,000 CHF)
- IB registers AO and notifies IR to all other Member States (29)
- IR is protected in each of those Member States unless refused within 1 year

LISBON AGREEMENT – INTERNATIONAL PROTECTION

Refusal of protection – must specify the grounds

- For example
- generic character of the denomination
 - conflict with an earlier right

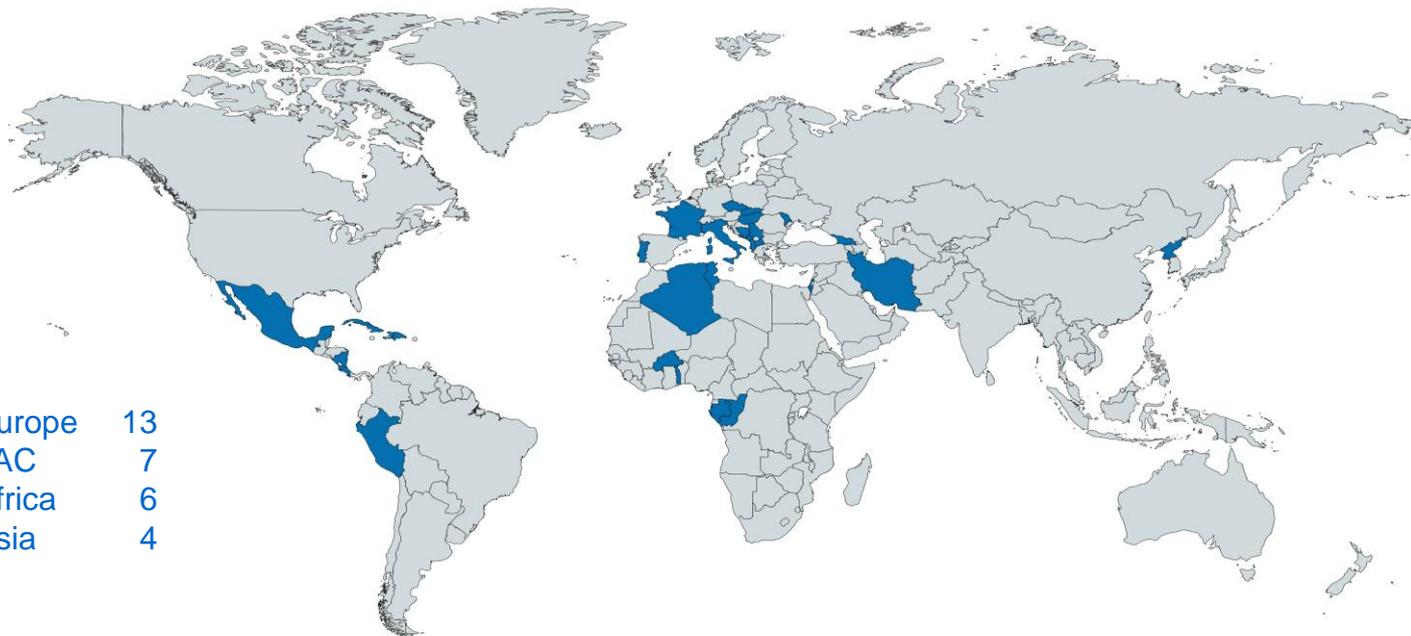
Content of protection - against any usurpation or imitation of the AO,

- even if the true origin of the product is stated, or
- if the AO is used in translated form or
- if used accompanied by terms such as “kind”, “type”, “make”, “imitation” and the like

Term of protection - indefinite as long as the AO is protected in C. of Origin

LISBON AGREEMENT GEOGRAPHICAL COVERAGE

30 Member States (by Jan 2020)



- Europe 13
- LAC 7
- Africa 6
- Asia 4

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Geneva Act (2015)

- allows membership by certain IGOs
- extends protection to both AO and GI
- allows trans-border rights (AO or GI)

GI = - a sign (not necessarily a denomination)

- used on products of a specific geographical origin

- qualities, reputation or characteristics essentially attributable to that place (link not necessarily as strong as for an AO)

Extent of protection

Members must provide legal means to prevent the use or imitation of a Lisbon AO or GI in respect of goods or services under certain conditions

Geneva Act allows flexible means of protection

CPs may ensure protection through **any type of legislation** (*sui generis* law, trademark law, administrative provisions, other legal means) provided that they meet the requirements of the Geneva Act

Protection of third party rights

Whoever could be affected can request the national CA to notify a refusal of protection (e.g., based on prior trademark rights, generic character, etc.)

Additional flexibilities – CPs may declare their intention to request:

- the payment of **an individual fee**
- a declaration of **intention to use** the AO or GI
- additional information on the **link** between product and place of origin

GENEVA ACT WILL COME INTO FORCE ON 26 FEBRUARY 2020

Members grouped according to the most recent Act applicable:

Geneva Act 2015:

Albania, Cambodia, DPRK, [European Union](#), Samoa ([5 Contracting Parties](#))

Stockholm Act 1967:

Algeria, Bosnia and Herzegovina, Burkina Faso, Congo, Costa Rica, [Cuba](#), [Dominican Republic](#), France, Gabon, Georgia, Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Northern Macedonia, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, Togo, Tunisia ([27 Member States](#))

Lisbon Act 1958: [Haiti](#) ([1 Member State](#))

Lisbon System geographical coverage = 50 countries

MADRID PROTOCOL, HAGUE GENEVA ACT, LISBON GENEVA ACT

**Are these treaties
of interest to the Caribbean countries ?**

**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

CUBA – 156 MADRID REGISTRATIONS = > 2,000 NATIONAL OR REGIONAL MARKS



Source: WIPO Madrid Monitor – January 2020

ANTIGUA AND BARBUDA – 3 ACTIVE REGISTRATIONS = 60 NATIONAL MARKS



KAI COLLECTIVE

ARISE COLLECTIVE

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

Source: WIPO Madrid Monitor – January 2020

349 MADRID REGISTRATIONS BY HOLDERS FROM OTHER CARIBBEAN COUNTRIES



CooperVision



ESTABLECIDO EN
1852

FABRICADO EN LA REPUBLICA DOMINICANA. LICENCIA N.º 21.0287. INSCRIPCIÓN N.º 214



esquire group



EL DORADO



CORPAG



CLYDESDALE ESTATE COFFEE

Source: WIPO Madrid Monitor – January 2020

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

Are there many Caribbean design creators
wishing to protect their designs abroad?

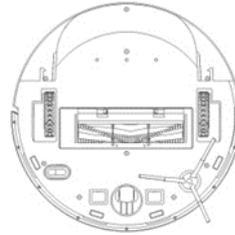
CARIBBEAN DESIGNS – PROTECTED ABROAD – CARIBBEAN PRIORITY



container for alcoholic beverages
including spirits (CU)



multiuse container (DM)



cleaning robot (CU)

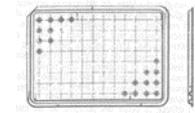
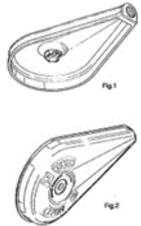


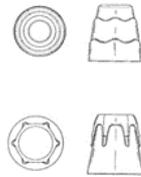
plate for multiple
analytical reactions (CU)



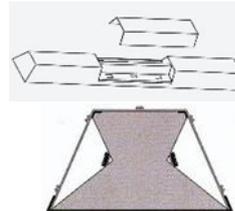
cover-rotor cover
for conveyor axis (AG)



jug and glass set (DM)

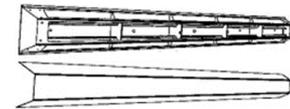


packaging for ice creams
in the form of a boat (AG)



advertising devices (DO)

WHY NOT VIA THE HAGUE SYSTEM ?



advertising device for
tire barriers in parking slots (DO)

Source: WIPO Global Design Database – January 2020

CARIBBEAN GEOGRAPHICAL INDICATIONS

**Would Caribbean producers be interested in getting
GI protection for their products internationally?**

CARIBBEAN GEOGRAPHICAL INDICATIONS

CUBA - appellations of origin (AO)

20 AO protected under Lisbon system

Tobacco



CUBA HABANOS HABANA HABANEROS TUMBADERO
PARTIDO REMEDIOS HOYO DE MANICARAGUA SAN LUIS
VUELTA ARRIBA VUELTA ABAJO CABAÑAS EL COROJO
CUCHILLAS DE BARBACOA SAN JUAN Y MARTÍNEZ SAN VICENTE
LAS MARTINAS HOYO DE MONTERREY PINAR DEL RIO

Rums

CUBA



Coffee

ALTO LA MESETA
EL NICHU



ELGUEA

Mud



LOS PORTALES

SAN DIEGO DE LOS BAÑOS

Mineral Water

CARIBBEAN GEOGRAPHICAL INDICATIONS

DOMINICAN REPUBLIC – AO, GI, collective and certification marks

Coffee



VALDESIA (AO)



BARAHONA (AO)

JUNCALITO (AO)



MONTE BONITO (CertM)

BARRANCOLÍ (CoIM)



CACAO DOMINICANO (GI)

EL RAMONAL (GI)

LOS BEJUCOS (AO)

CONACADO (CoIM)



Cocoa



Rum RON DOMINICANO (CoIM)



CIGARRO DOMINICANO (GI)

Cigars



Petrified wood

ORO VERDE CAMBITA (AO)

Avocados

Mangoes



Blue pectolite stone

LARIMAR BARAHONA (AO)



MANGOS DOMINICANOS (GI)

UVAS DEL VALLE DE NEIVA (M)

Grapes

CARIBBEAN GEOGRAPHICAL INDICATIONS

GUYANA

DEMERARA RUM
Rum



DEMERARA SUGAR



Sugar

Molasses
DEMERARA MOLASSES



JAMAICA

JAMAICA BLUE MOUNTAIN COFFEE (CoIM)



Coffee

Rum



Jerk

JAMAICA JERK (GI)



JAMAICA RUM (GI)

TRINIDAD AND TOBAGO



MONTSERRAT HILLS (PGI)



Cocoa

OTHER CARIBBEAN PRODUCTS POTENTIALLY QUALIFYING FOR GI PROTECTION

ANTIGUA AND BARBUDA



**Black
pineapple**

BAHAMAS



Cascarilla

BELIZE



Cohune oil

BARBADOS

Rum



GRENADA



Nutmeg

ST KITTS & NEVIS



Sarsaparilla

How can CarIPI cooperate with countries
interested in taking advantage of these treaties?

MADRID PROTOCOL, HAGUE GENEVA ACT, LISBON GENEVA ACT

CarIPI will be available to work jointly with interested Caribbean countries in

- identifying requirements and preparatory work needed to join these treaties
- offering pre- and post-accession training to IPO staff involved in operations
- promoting the use of these international protection systems by national producers, design creators and entrepreneurs, especially SME, through
 - awareness raising events
 - tailor-made promotional material



THANK YOU



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

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