



# THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

ERNESTO RUBIO | PORT-OF-SPAIN | 30-06-2021



CARIFORUM

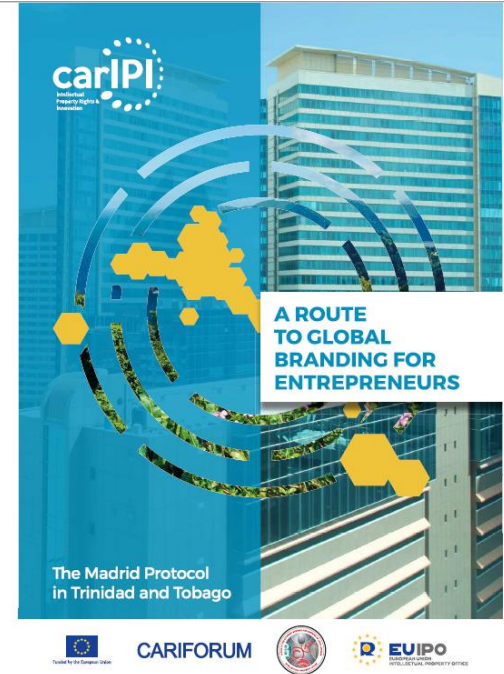


EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

[www.caripi-hub.com](http://www.caripi-hub.com)

## THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

- A brand protection system ... available today to nationals of 124 States, including Trinidad and Tobago
- A business competitiveness tool ... of special interest to export industries
- A trade mark protection route increasingly used by all types of companies, ... and particularly attractive for SMEs



## YOUR BRAND

- The **image** that differentiates you from your competitors
- Conveys a sense of **quality, credibility, customer satisfaction**
- Generates **loyalty** and plays a crucial role in **marketing** strategies
- It is at the core of business **competitiveness**
- It has a **value** ... it may well become **your strongest asset**

## HOW TO DEVELOP EFFECTIVE BRANDING STRATEGIES ?

- Creating an image in the consumers' minds through advertising campaigns
- Ensuring the legal protection of your brand through trade mark registration in your country and abroad (mark = legal expression of your brand)



## HOW DO YOU PROTECT YOUR BRAND IN TRINIDAD AND TOBAGO ?

- By having it registered at TTIPO
- You get an **exclusive right** on the commercial use of your mark for a period of **10 years, renewable**
- You can **prevent third parties from using your mark** or a similar sign to commercialize the same, or similar, goods or services in Trinidad and Tobago



## WHY DO YOU NEED TO PROTECT YOUR BRAND ABROAD ?

- Because of the territorial effect of TM law ...
  - ... if you wish to
    - export goods or services with your mark (adding value to them)
    - prevent third parties from using your mark in foreign markets
    - get a reputation abroad and gain new clients
    - generate new business opportunities (franchising, partnerships, etc.)
  - ... you need to get protection for your mark in each of the markets of interest to you

## HOW DO YOU GET YOUR MARK PROTECTED ABROAD ?

Country by country registration      National Laws and Offices – National TM

### Some regional systems

- Benelux Conventions 1962, 2005 – BOIP – BX TM (3 States)
- Bangui Agreement 1977, 1999 – OAPI – OAPI TM (17 African States)
- European Union TM, 1994, 2017– EUIPO – EUTM (27 European States)

International system      Madrid Protocol 1989 – WIPO

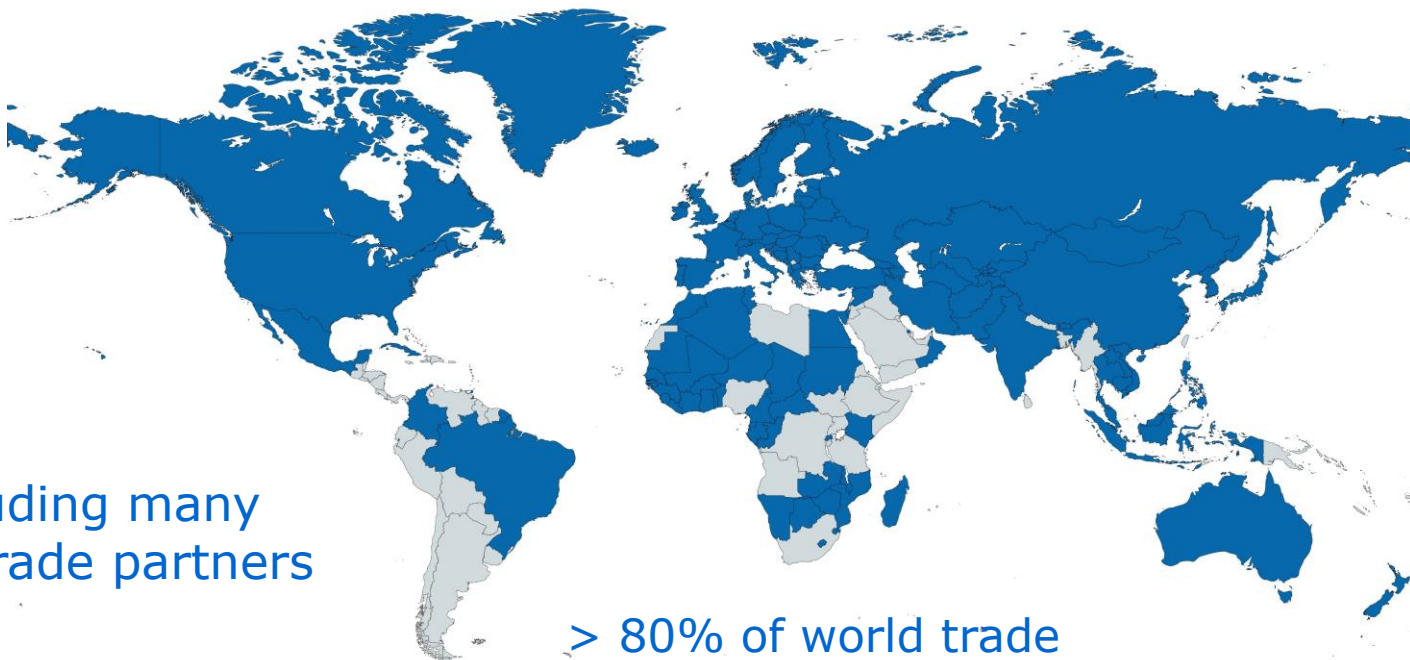
## THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

**Madrid Protocol = 108 members (including EU & OAPI)**  
**available to nationals of 124 States**  
**including Trinidad and Tobago, since January 2021**



## MADRID UNION COVERAGE

108 Members = 124 countries (by June 2021)

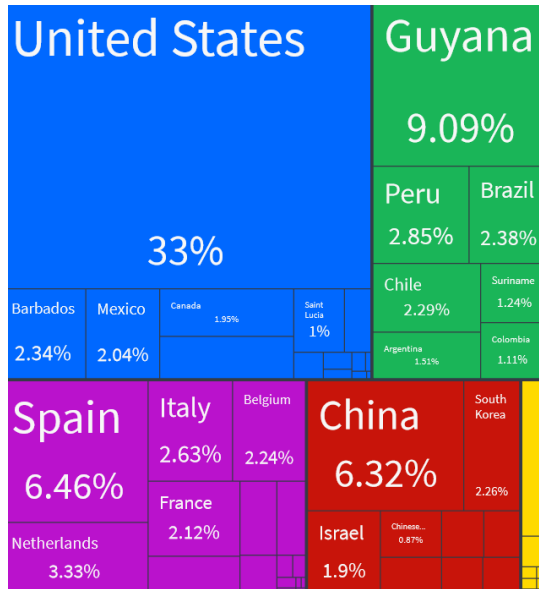


including many  
TT trade partners

> 80% of world trade

Created with mapchart.net

## TOP EXPORT DESTINATIONS FOR GOODS FROM TRINIDAD AND TOBAGO – 2019



Some 75% of exports by Trinidad and Tobago go to Madrid Union members, including

- United States of America 33.0%
- European Union 18.5%
- China 6.3%
- Other Madrid Union Members 16.9%

such as Brazil, Republic of Korea, Mexico, Canada, Israel, Morocco, Colombia, India, United Kingdom, Japan, Singapore, Turkey and Thailand

Source: <https://oec.world/en/profile/country/tto>

## ARE YOU ENTITLED TO USE THE MADRID SYSTEM ?

You can use the Madrid System if you have

- an **attachment to Trinidad and Tobago**
  - nationality, or
  - domicile, or
  - industrial or commercial establishment
- **and**
- a **basic mark in Trinidad and Tobago**
  - a TM application or a TM registration at TTIPO

## THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

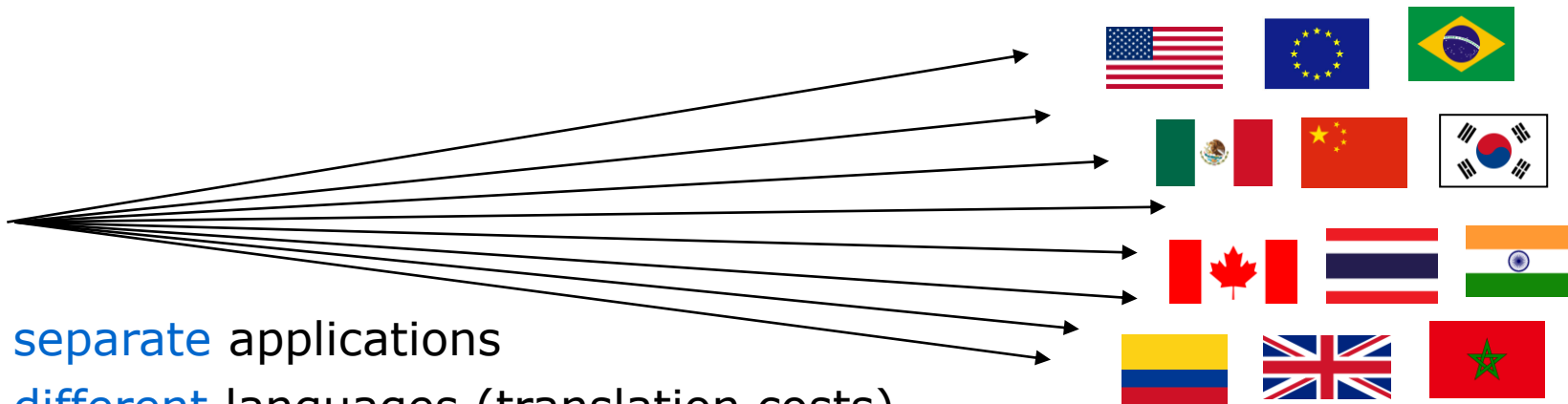
**A business competitiveness tool  
of special interest to export industries**

## THE MADRID PROTOCOL FACILITATES TM PROTECTION IN EXPORT MARKETS

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

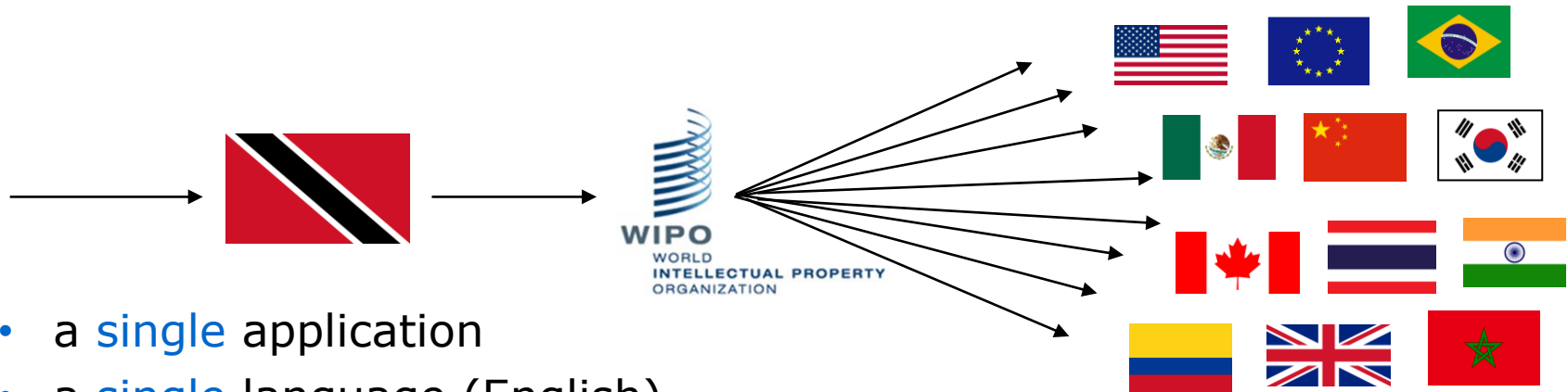
- apply for the legal protection of their brands in export markets = **central filing of trade mark applications**
- manage their trade mark rights valid in various countries = **central management of trade mark registrations**

## TRADITIONAL FILING VS MADRID CENTRAL FILING



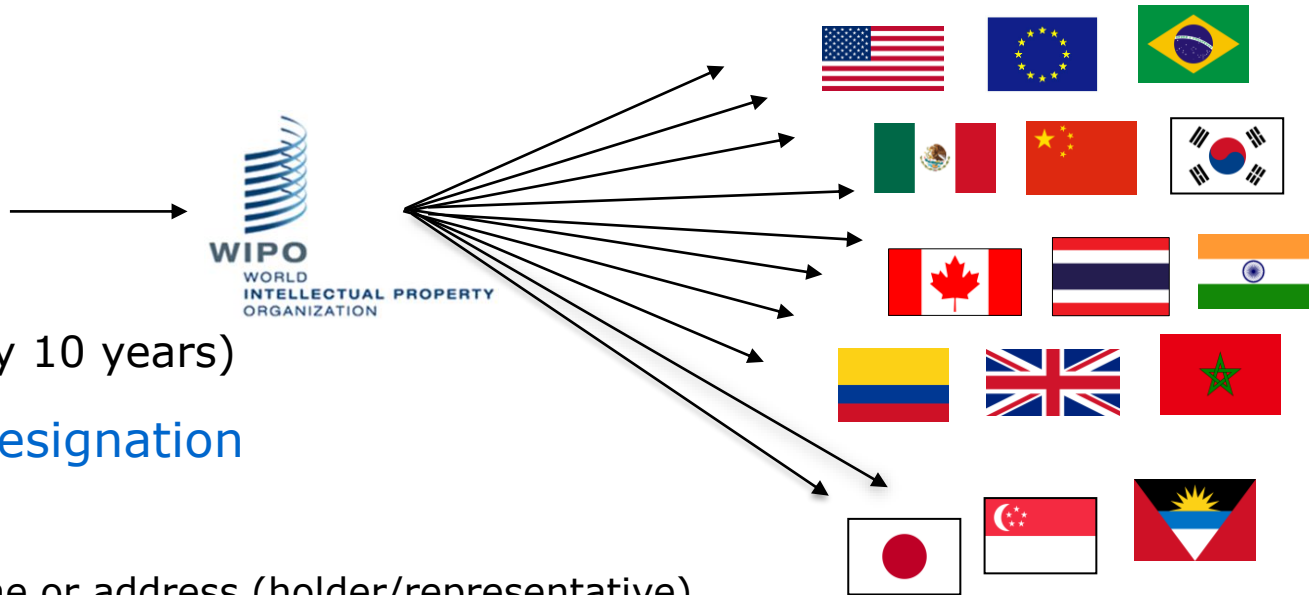
- **separate** applications
- **different** languages (translation costs)
- fees paid in **different** local currencies (currency exchange costs)
- local representative **usually required** (additional costs involved)
- **different** procedures from the start with **different timeframes**

## 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 the rest

## MADRID CENTRAL MANAGEMENT



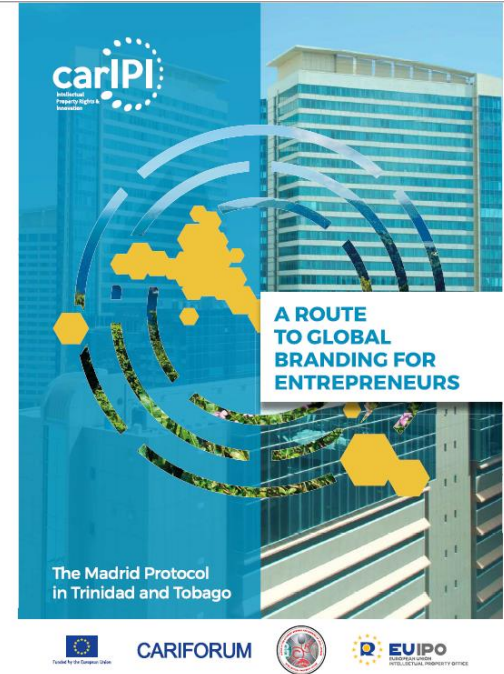
- renewal (every 10 years)
- subsequent designation
- modifications
  - changes in name or address (holder/representative)
  - assignments (change in ownership)



## THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

# Central filing of your application

## Basic steps



## CENTRAL FILING OF YOUR APPLICATION – BASIC STEPS

- Choose your trade mark – **TM search**
- Prepare your **international application (IA)**
- **File** your IA at **TTIPO**
- **Monitor** your IA at WIPO up to its **international registration (IR)**
- **Monitor acceptance** of your **IR** in each designated Contracting Party (DCP)

## WHY A TRADEMARK SEARCH ?

To make sure that your mark is not already protected by someone else in the export markets of interest to you

**International Search Tools** – user friendly databases offering free access to TM data

TMview

<https://www.tmdn.org/tmview/welcome>

> 94 million TMs from 75 TM offices

WIPO Global Brand

<http://www.wipo.int/branddb/en/>

> 47 million entries from 67 collections

## PREPARE YOUR INTERNATIONAL APPLICATION (IA)

MM2 Form (in English) – <http://www.wipo.int/madrid/en/forms/>

The guide offers **recommendations** regarding how to fill out MM2

- **Mandatory content** (having an impact on the date of your IA)
- **Other mandatory content**
- **Special requirements by certain DCPs** (USA, European Union)

## DRAW YOUR LIST OF GOODS AND SERVICES

- Make sure that the goods and services in your IA
  - are covered by the list in the basic mark
  - are not expressed in terms too vague, linguistically incorrect or incomprehensible
  - are correctly classified according to the International Classification
- Best practice – use online classification tools, free of charge

TMclass

<https://euipo.europa.eu/ec2/>

terms accepted by 84 TM Offices from around the world

MGS

<https://webaccess.wipo.int/mgs/>

terms accepted by WIPO and by 40 Madrid Union Offices

## DESIGNATE CONTRACTING PARTIES

- You can designate up to **107 CPs (including EM & OA)** by simply checking the box next to the name of each CP in the MM2 form
- If you designate the **US** – you must declare your intention to use the mark in the US by also filling in a separate form (MM18)
- If you designate the **European Union (EM)**
  - you must indicate a second language (fr, de, it, es) that may be used in opposition or cancellation procedures initiated by a third party
  - you may claim seniority of an earlier EU mark in a separate form (MM17)

## CALCULATING AND PAYING FEES

- Fees
  - basic fee CHF 653 or CHF903 (if colour mark)
  - designation fee per DCP individual or complementary fee (CHF 100)
  - supplementary fee per class beyond 3 (CHF 100)  
unless you only designate DCPs charging individual fees
- Fee calculator <http://www.wipo.int/madrid/en/fees/calculator.jsp>
- Average fee (2020) CHF 3,392 (2-3 classes; 7 DCPs)
- Payment directly to WIPO through
  - bank transfer or
  - your current account at WIPO

## FILE YOUR INTERNATIONAL APPLICATION AT TTIPO

TTIPO will check that

- you are the applicant or holder of the basic mark
- your mark in the IA is identical to the basic mark
- the goods & services in the IA are covered by those in the basic mark

If so, TTIPO will forward the IA to WIPO indicating

- date – the date on which the IA was received at TTIPO



## INTERNATIONAL REGISTRATION (IR) AT WIPO

If there are no irregularities (or if these have been remedied),

WIPO will

- register your mark in the International Register
- publish the international registration (IR) in the WIPO Gazette of International Marks
- notify the IR to the designated Contracting Parties (DCPs)
- inform TTIPO
- send you the IR certificate

## EFFECTS OF YOUR INTERNATIONAL REGISTRATION (IR)

- = a national (or regional) **application** – in all the designated Madrid Union Members (DCPs), **as from the date of the IR**
  
- = a national (or regional) **registration** – of a duration of **10 years** in all the DCPs that
  - have not refused protection within strict time limits (12 months, 18 months, or 18+ months in case of opposition), or
  - have subsequently withdrawn their refusal(s)

## MONITORING YOUR INTERNATIONAL APPLICATION / REGISTRATION

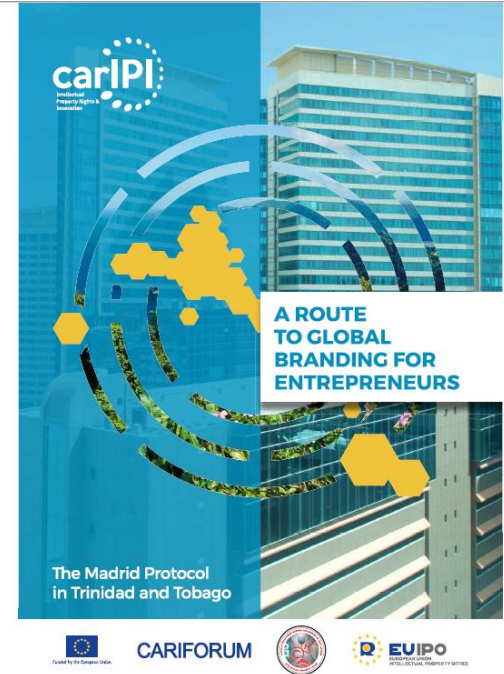
Madrid Monitor <http://www.wipo.int/madrid/monitor/en/index.jsp>

An online service enabling you to

- track the status of your international application (IA) at WIPO and your international registration (IR) in the DCPs
- access detailed information on all marks registered through the Madrid system
- request an email alert anytime a TM record is updated

## THE MADRID PROTOCOL : A ROUTE TO GLOBAL BRANDING

Central management of your  
international registration



## MANAGING YOUR INTERNATIONAL REGISTRATION (IR)

Madrid Portfolio Manager (MPM) – an online service enabling you to

- create and display your portfolio of international registrations (IRs)
- upload requests for renewal, for subsequent designation, and for the recording of various types of changes regarding your international registration, etc.

You access your MPM through the **WIPO IP Portal** - <https://ipportal.wipo.int/>

- to do so, you need a **WIPO User Account** linked to an email address
- You can create your user account for free at <https://www3.wipo.int/wipoaccounts/generic/public/register.xhtml>

## RENEWAL

E-Renewal (every 10 years)

through the WIPO IP Portal – <https://ipportal.wipo.int/>  
(available as from 3 months before renewal date)

Fees check fee calculator at <http://www.wipo.int/madrid/en/fees/calculator.jsp>

Payment

- bank transfer
- your current account at WIPO, or
- credit card

If you are the holder of an IR with effects in only some Madrid DCPs



You can extend protection to other Madrid Union members at any time by submitting a **subsequent designation** to WIPO



You can do this online at through the **WIPO IP Portal**

### Subsequent designation fees (check the Fee Calculator)

- basic: CHF 300
- designation: depends on each DCP (similar to designation in an IA)

**Fee payment** bank transfer, current account at WIPO, or credit card

**Effects** if not refused, your mark will be protected in the DCP concerned for the remaining duration of your IR; renewable for further periods of 10 years



## CENTRAL RECORDING OF MODIFICATIONS AT WIPO

### Change in ownership (assignment or transfer) – MM5 Form

- for all or some DCPs / in respect of all or some goods and services
- CHF 177 – effects in all DCPs concerned

### Change of name or address of the holder – MM9 Form

- no fee if change concerns only address for correspondence, email address, phone or facsimile number
- CHF 150 otherwise – effects in all DCPs

### Recording of a licence – MM13 Form

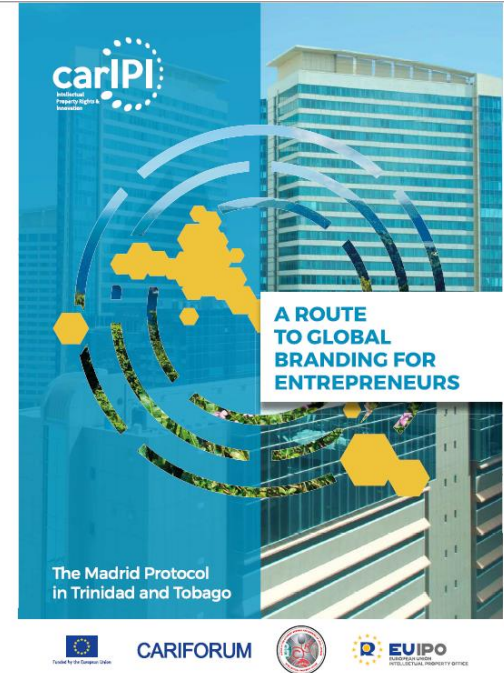
- CHF 177 – effects in up to 81 DCPs (26 CPs do not recognize effects)

## TO CONCLUDE – THE MADRID PROTOCOL OFFERS YOU ...

- A user-friendly, flexible, expeditious route to **acquire and manage your trademark rights abroad**
- Considerable **cost savings** in translation, local representation, currency exchange and various types of fees
- A valuable help to **export** goods and services **with your own brand**, thus **adding value** to your exports
- **Early brand presence** abroad helping you acquire global reputation and goodwill
- Increased **franchising and partnership opportunities** and facilities to integrate in global supply chains

TO CONCLUDE – I WOULD SUGGEST ...

**TAKE ADVANTAGE OF  
THE MADRID PROTOCOL  
TO PROTECT YOUR BRANDS ABROAD !**





THANK YOU



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