

The Madrid System in Trinidad and Tobago

Perspective of the Intellectual Property Office of the Trinidad and Tobago



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Overview



- Accession to Madrid Protocol
- Declarations made by Trinidad and Tobago
- TTIPO as an Office of Origin (OO)
- TTIPO as a Designated Contracting Party (DCP)
- Fees under the Madrid Protocol
- Trade Mark Resources
- Trade Mark Application Statistics in Trinidad and Tobago
- Measures undertaken by TTIPO to implement the Madrid Protocol
- Public Education Initiatives
- Staff Structure

Contracting Parties to the Madrid Protocol



- **October 12, 2020-** instrument of accession deposited with WIPO's Director General.
- **January 12, 2021-** T&T became the 123rd country to join the Madrid Protocol (<https://bit.ly/3qv4H6Z>).



<https://bit.ly/3djV9pJ>



Members



As at January 12, 2021, the Madrid Union had 107 members, covering 123 countries.

Declarations made by Trinidad and Tobago



**Extension of the refusal period
to 18 months (Article 5(2)(b) of
the Protocol).**

**Individual Fee
(Article 8(7)(a) of the Protocol)**

**Merger of divided international
registrations not provided (Rule
27ter(2) of the Regulations)**

**Intent to use the mark
(Rule 7(2) of the Regulations
under the Protocol)**



Two Roles of the IP Office

OFFICE OF ORIGIN	OFFICE OF DCP
<ul style="list-style-type: none">• Provides information to local companies/ individuals/ agents regarding IAs• Certification• Responds to irregularities	<ul style="list-style-type: none">• Receives designations from foreign trademark owners• Performs substantive search and examination to determine scope of protection

TTIPO as an Office of Origin



- Certifies the IA
([Regulation 29\(3\) of the TM \(International Registration\) Regulations, 2020](#))
- No handling fee
- Filing language – English ([Regulation 4\(2\)\(a\) of the TM Regulations, 2020](#))
- The Office uses the current version of Nice Classification
([Section 3 of the Trade Marks Act, No. 8 of 2015](#))
- Translation and/or transliteration of the mark may be required ([Regulation 13\(3\) of the TM \(International Registration\) Regulations, 2020](#))



TTIPO as a DCP

- Marks must be capable of being represented graphically ([Section 3 of the Trade Marks Act, No. 8 of 2015](#))
- Applicant must have an intention to use the mark ([Section 5\(2\)\(e\)\(ii\) of the Trade Marks Act, No. 8 of 2015](#))
- English translation and/or the transliteration of the mark may be required ([Regulation 13\(3\) of the TM \(International Registration\) Regulations, 2020](#))
- Additional forms of representation of the mark are optional for specific types of mark

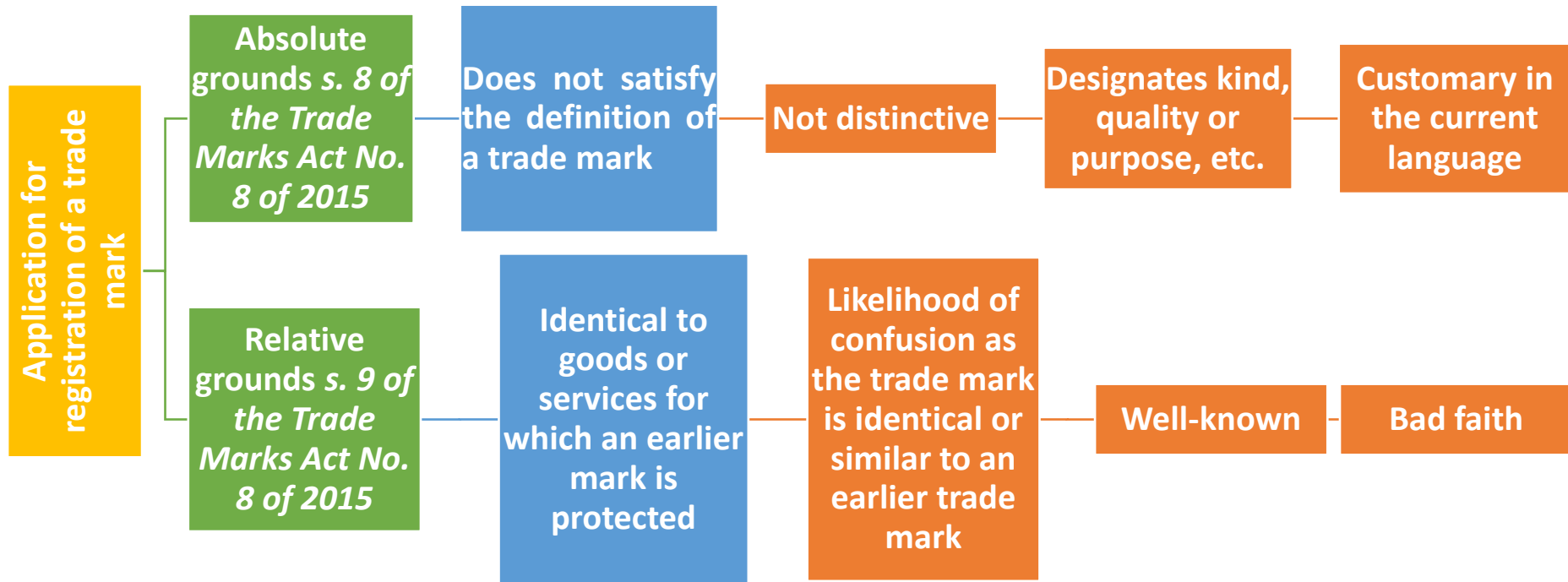


TTIPO as a DCP

- **Search & Examination before the Office:**

- The Office conducts searches for the rights of other rightsholders (Regulation 13(2) of the TM (International Registration) Regulations, 2020)
- The Office examines on absolute and relative grounds (Sections 8 and 9 of the Trade Marks Act No. 8 of 2015)
- Subsequent to the publication of the mark on the Online TM Journal (<http://ipo.gov.tt/journals/>) , Oppositions can be filed at the TTIPO prior to registration (3 month period) (Regulation 15(1) of the Trade Marks (International Registration) Regulations, 2020).

Trade Marks



TTIPO as a DCP



Requirements for responding to "refusals" under the Madrid Protocol:

- Holders must appoint a local representative to respond to any refusals. The representative must file a Form TM 1 ("Authorization of Agent") in accordance with the Trademark Regulations ([Regulation 13\(7\) of the TM \(International Registration\) Regulations, 2020](#))
- The response must be submitted in English.

Notifications by Trinidad and Tobago



- Notifications of refusal ([Regulation 18 of the TM \(International Registration\) Regulations, 2020](#)):
 - Provisional Refusal
 - Refusals based on an opposition after the 18month time limit ([Article 5\(2\)\(c\) of the Protocol](#)).
 - Total Refusal
 - Final Decision
- Irregularity responses
- Statement of Grant

Fees under the Madrid Protocol



- Fees are payable to WIPO in Swiss francs (CHF).
- **Basic fee:**
 - 653 CHF (Approx. \$4,483TTD) or
 - 903 CHF (Approx. \$6,200TTD) (for marks in colour)
 - Includes three (3) classes of goods and services
- **Individual fee (Trinidad and Tobago):**
 - (\$1400TTD which includes one class)
 - (\$150TTD per each additional class)

Madrid Fee Calculator: <https://madrid.wipo.int/feecalapp/>

Trade Marks Resources

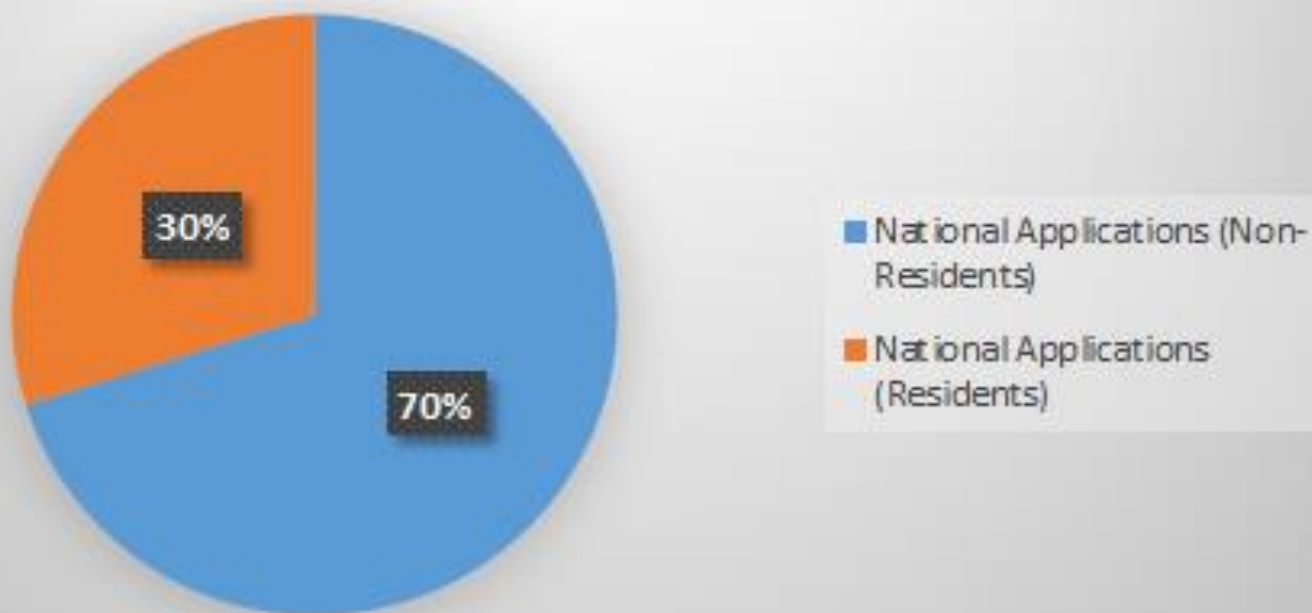


- Trade Mark Act No 8 of 2015
(<http://www.ttparliament.org/legislations/a2015-08.pdf>)
- Legal Notice No. 137 - Trade Marks Regulations, 2020
(http://ipo.gov.tt/downloads/Trademark/trade_marks_regulations.pdf)
- Legal Notice No.138 - The Trade Marks (Border Enforcement Measures) Regulations, 2020
(http://ipo.gov.tt/downloads/Trademark/border_enforcement_measures.pdf)
- Legal Notice No. 290 - Trade Marks (International Registration) Regulations, 2020
(http://ipo.gov.tt/downloads/Trademark/inter_reg_marks.pdf)
- Information on the Madrid Protocol: <http://ipo.gov.tt/related-links-tm/madrid-protocol/>
- Information on Trade Marks: <http://ipo.gov.tt/types-of-ip/trade-marks/>

Trade Mark Application Statistics 2020



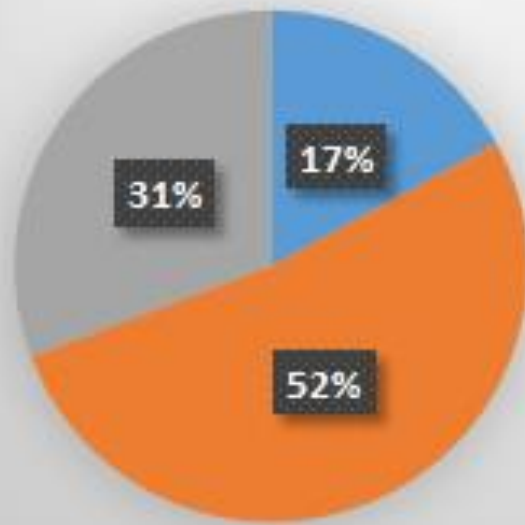
Applications filed at the TTIPO for the period Jan 12, 2020 - June 24, 2020



Trade Mark Application Statistics 2021



Madrid Applications filed at the TTIPO for the period Jan 12, 2021 - June 24, 2021



- Madrid Designations
- National Applications (Non-Residents)
- National Applications (Residents)

1st IA filed through the TTIPO



Access Madrid Online Tools



← → ↻ ⚠ Not secure | ipo.gov.tt/related-links-tm/madrid-protocol/

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- Practice Direction for Online
 - > Filing and Payments

- > Madrid Protocol
 - WIPO Alternative Dispute
 - > Resolution
 - > WIPO Proof

<http://ipo.gov.tt/related-links-tm/madrid-protocol/>

Access Madrid Online Tools



The Madrid Protocol will be implemented in Trinidad and Tobago on Tuesday 12th January, 2021.

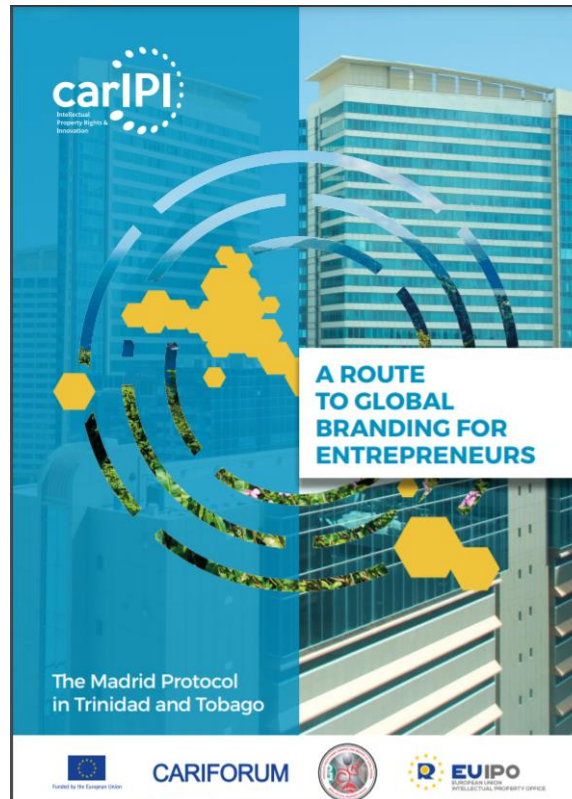
Madrid Online Resources

- Madrid Application Form
- Madrid Forms
- Form Request To Transform An International Registration Into A National Application (MP1) / word format
- Form Application to Record Replacement of Registered Trade Mark with International Registration (MP2) / word format
- Fee Calculator
- Madrid Goods & Services Manager
- Madrid Presentation
- Madrid Booklet
- A Route to Global Branding for Entrepreneurs – The Madrid Protocol in Trinidad and Tobago
- Trade Marks (International Registration) Regulations 2020

<http://ipo.gov.tt/related-links-tm/madrid-protocol/>

Access to Booklet "The Madrid Protocol in Trinidad and Tobago: A ROUTE TO GLOBAL BRANDING FOR ENTREPRENEURS"

http://ipo.gov.tt/downloads/Madrid_Protocol/ttipu_euipo_mpb.pdf



TTIPO Training Initiatives



- Study Visit to the Madrid Registry, Brands and Designs Sector, WIPO
- Workshop for National Offices on the Operations of the Madrid System
- Mission on Madrid Protocol Concerning the International Registration of Marks
- Mission with Mr. Adel Baccouche, Project Manager, Industrial Property Office Business Solutions Division, WIPO
- WIPO Technical Training Workshop for Industrial Property Automation System (IPAS) Administrators
- Dec 2020, the first virtual desk audit was conducted in preparation for implementation of the Madrid Protocol in Trinidad and Tobago in January 2021.

Public Education Initiatives

EXPORTT

- January 29, 2020 – Workshop with WIPO and EXPORTT on Madrid Protocol
 - ExportT provides "**Financing Facilities**" to companies
 - For further information please visit their website <https://exportt.co.tt/financing-facilities/>

SPORTT

- September 3 and September 4, 2019 – National Workshop on the Optimization of Intellectual Property Rights: <https://www.youtube.com/watch?v=t6n1Dx5aAZs> and <https://www.youtube.com/watch?v=7Ef8S2iv2ck>
- March 25, 2021- TTIPO-SporTT Knowledge Building Session for NGBs
- April 13, 2021- TTIPO / Rugby Knowledge Building Session

Public Education Initiatives

- **NEDCO IP Clinic**
- **NIHERST IP Clinic**
- **CARIRI IP Clinic**
- **PLANTING SEEDS IP Clinic**
- **UNIVERSITY OF THE WEST INDIES IP Clinic**

Staff Structure



Cabinet Minute No. 1638 of June 12, 2014

Cabinet agreed to the establishment of a Madrid Protocol Processing Unit in the Intellectual Property Office to administer Trinidad and Tobago's treaty obligations upon accession to the Madrid Protocol.

Staff Structure



Madrid Protocol Processing Unit Posts:

Trademark Systems Specialists

Trademark Operations Administrator

Trademark Operations Officer



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