



QUESTIONS & ANSWERS



The Madrid System in Trinidad and Tobago. A route to global branding for entrepreneurs.

30/06/2021

Zoom



Funded by the European Union

CARIFORUM



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

www.caripi-hub.com

The Madrid System in Trinidad and Tobago. A route to global branding for entrepreneurs.

Questions and Answers

1. Can you go over transformation of the mark please?

If your international registration gets cancelled and you have designated the EU as one of the designated contracting parties, you will have 3 months to submit an application for the registration of a European TM at the EUIPO. During those 3 months after the cancellation of your international registration, you may submit your application to the EUIPO. That application will be treated by the EUIPO in accordance with the extent of your international registration. If your international registration had already been accepted, meaning that all procedures were already completed, then the EUIPO will not examine again your new application (EUTM application based on transformation). It will simply go ahead and issue your European TM equivalent to your international registration, that will be valid from the date of your international registration.

On the other hand, if the IR had been already accepted, if the procedures were not completed and your international registration was not completed, the process will pick up from the point it was left off. Once the process is complete and everything is in order, the EUTM will be issued as valid from the original date of your international registration.

2. An expansion of DCP while already registered will give you coverage only for the time remaining in the 10-year period? So, if 9 years have passed and you add 4 more countries you will be covered in the 4 additional countries for 1 year? If so, does the cost/fees remain the same?

If you submit a subsequent designation in the year 9 and there is only one year left, then you will have only one year of protection for the additional countries designated. In other words, once the subsequent designation is accepted, it will last for the period remaining on the international registration. Unfortunately, you will have to pay the full fees because there is no reduced fee for a shorter period. However, you will be able to renew for another period and you can opt to make the expansion effective only from the date of renewal. That, of course, means that you will not get protection for the new designations during the remaining year of the international registration.

In the rare case, if you are thinking of extending your TM in year 9, for example in many more countries, it would be more convenient to file a new application (given that the cost is the same). That means you will have 2 international applications for the same TM but in different countries.

3. Under the Madrid system, the mark must still be monitored in each contracting country that it is registered in. How is this done in practice?

You can monitor what happens with your international registration in each designated Contracting Parties by using the Madrid Monitor tool at the WIPO website (<https://www3.wipo.int/madrid/monitor/en/>).

If there is a refusal in a given country, you will need to appoint a representative who can take care of the procedures that need to be followed.

- 4. If you successfully file a mark locally, then while filing in multiple DPCs through the Madrid Protocol it is discovered that something similar exists in one of the DPCs is that automatic refusal in that particular DPC or do you get an opportunity to modify the mark? If so, would it mean you have to file this modification as a new mark in your local office?**

To avoid this, you can use TMview (<https://www.tmdn.org/tmview>) or WIPO's global brand database beforehand to check for already existing similar brand.

If you have a national TM which is going to be the basic TM for international application and you designate the EU, if there is an identical TM and there is no opposition by the owner of the earlier TM, the office will grant protection to the international application.

By contrary, TTIPO examines based on absolute and relative grounds as well as its domestic law, a previously existing similar mark in TT would be grounds to refuse an international application on relative grounds.

It depends on individual countries, as some countries do not examine based on relative grounds, in other words, they do not check if a similar mark is already registered. The mark is published and can be opposed.

It also depends on the goods/services for which you are seeking protection. There may be an objection in a particular country for your TM being used or registered for certain goods and services but not to others. There is a possibility in the Madrid system to limit the number of goods and services to a smaller number or more specific goods and services, so as not to fall into conflict with the owner of the same mark for other goods and services.

5. Can you expand on "central attack" under disadvantages?

By way of example, a Spanish university filed an application with the Spanish TM Office and 6 months later applied for international registration designating Columbia, Brazil and a few other countries. The Spanish TM Office took more time to decide on whether the mark should be registered or not. The application was eventually rejected. It was appealed and again rejected. The final rejection of the basic registration made the international application ineffective. As a result, the international designations had to be converted to individual national registrations in those countries. In this case, using the international system resulted more costly than using the national route. This is something that owners of TMs should have in mind at the time of filing an international application. It is strongly recommended to file the international application once the basic application is already registered.

6. Where can I find those cocoa stout locally?

You can find all the information online at www.ttfinecocoa.com. Hopefully soon there will be other breweries in the Caribbean making it, so that it will be available all over the region.

In the meantime, it can be ordered online and currently it is being shipped by DHL all over the world. This reinforces the importance of IP protection and also allows identification of the countries where the product should be protected.

7. In the instance of something common like a country festival. Can you trademark a design as opposed to the phrase or word?

A trade mark is the symbol your customers use to pick you out, to distinguish your product or service from that of a competitor. A TM can take many different forms. There are the so called 'word marks' (consisting of a name/words), but there are also figurative marks (logos), figurative marks containing word elements, shape marks, position marks, pattern marks, (single) colour marks, sound marks motion or multimedia marks. In most countries TMs can be any signs that can be represented graphically. In other countries, such as the EU, the only condition is that it must be clearly defined what the TM is. Probably most TMs registered currently, are figurative or combined marks, in other words images/logos or combination of image and word.

The legislation in Trinidad and Tobago, for example, defines TMs as a sign that is capable of being represented graphically. It can be a word, device, colour, sound mark, taste mark, or combination of any, as long as it is distinctive. In the case of sound marks, for example, the graphic representation would be achieved by notes.

Distinctiveness is an important requirement in most legislations. The TM cannot be descriptive of the goods or services for which it is registered, and it should be distinctive.

8. Will the date you filed your Trademark in your country be the official date that you will be judged on?

The filing date is important. It gives the possibility of claiming priority for an application. The office will judge based on what the situation was on the date the TM was filed, or if it has a priority, at the priority date. That will be the date by which the office will judge whether the application is new or not and determine your recognition as the owner of the TM.

With the international registration, it is similar. The date of the international application will be in principle, the date your application was filed at the country of origin. This is provided that it is received by WIPO within 2 months, if so, that would be the date of your international registration.

9. Is the local office available for information? I know we currently have restrictions because of COVID and the staff was working from home.

TTIPO is conducting business. All services are available online at <http://ipo.gov.tt/>. Requests for virtual meetings can be made by email.