

International Registration of Trade Marks under the Madrid Protocol



JIPO

Jamaica Intellectual Property Office

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The Jamaica Intellectual Property Office



Government agency responsible for administering Intellectual Property laws in Jamaica

- IP Registration – Trademarks, Designs, Patents, GIs, ©
- Public Education
- Liaising with interest groups
- IP Policy development
- Updating IP laws



JIPO
Jamaica Intellectual Property Office

Intellectual Property (IP)



- Legal Rights which result from intellectual activity in the scientific, industrial, literary, artistic, musical and dramatic fields etc.



IP Rights



- IPRs give the owner the right to prevent unauthorised copying, sale, offers for sale, use, passing off
- Right to compensation for infringement



Exclusive Rights

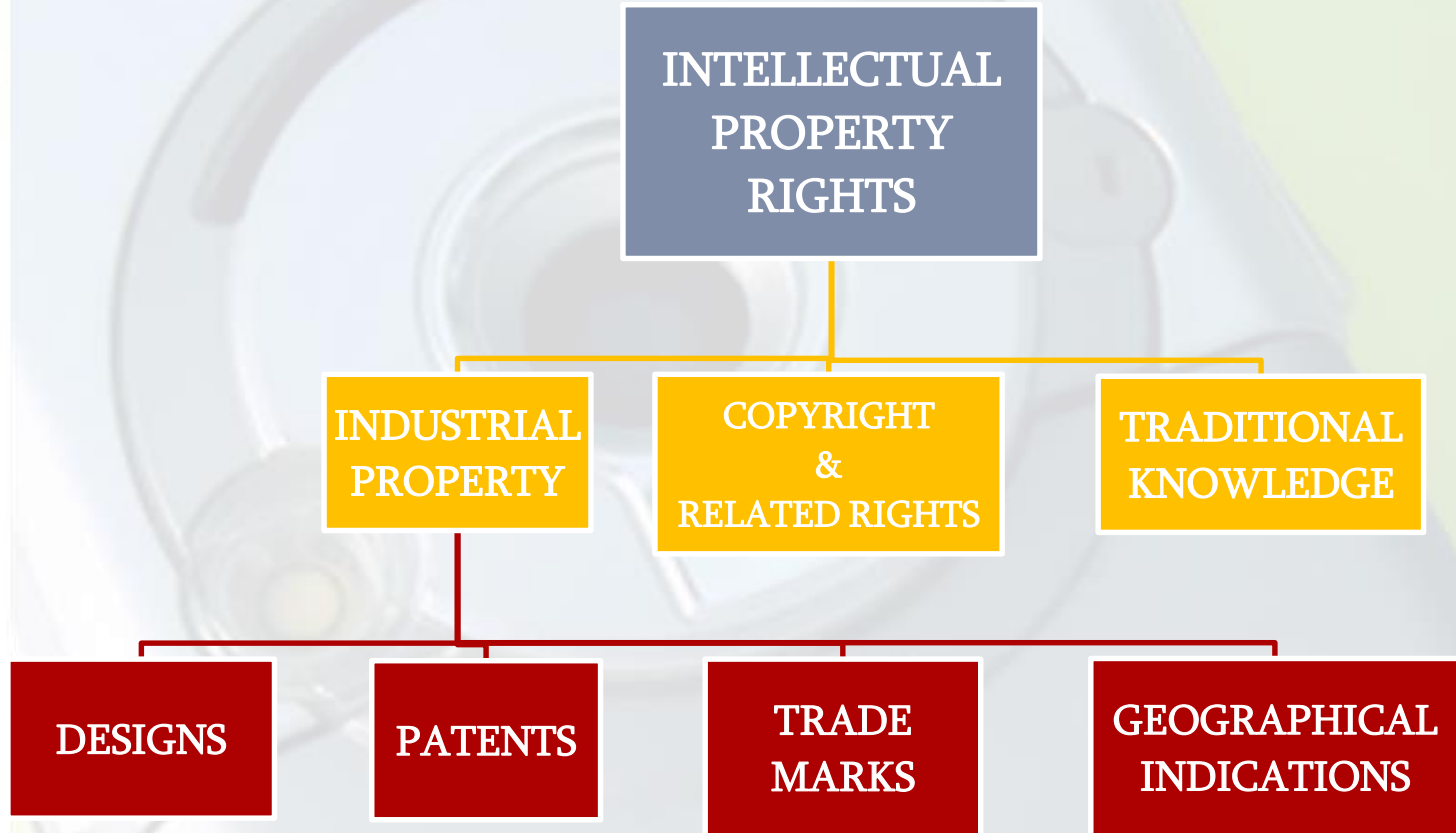


IP Owners:

1. are entitled to the rights and remedies provided under the relevant IP Law.
2. have exclusive rights to use and control use and copying of their IPR

Any use of the IP in Jamaica without the proprietor's consent, constitutes an infringement of such rights.

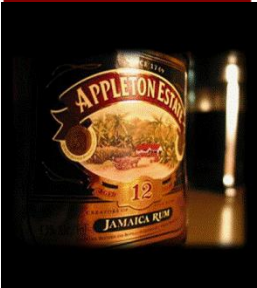
Intellectual Property



TRADE MARKS



- Trademarks are distinctive signs or symbols, including names, logos, shapes, colours, odours and sounds.
- Applied to the owner's products or services to distinguish them from those provided by competitors.
- Registration of a Mark makes it easier to prove ownership & prevent competitors from copying
- Trademarks must be distinctive for the products or services involved
- Different from any earlier trade mark for similar products or services.
- Your trademark is central part of your brand identity.



Animation Industry Trademarks



YOUTH EMPLOYMENT IN THE DIGITAL & ANIMATION INDUSTRIES PROJECT



Trademark Registration Options



- **The national route:** file application with the trademark Office of each country in which you want protection
- **The regional route:** where available, file application with a regional office with effect in all the member States covered by that region (ARIPO, BENELUX, EUIPO and OAPI)
- **The international route:** file through the Madrid Protocol

Madrid Protocol



- Allows trade mark registration in multiple countries via one application in the home country
- Facilitates easier global reach of brand to the world
- Procedurally easier than filing several national applications worldwide
- Cheaper than filing several national applications worldwide

What is the Madrid System?



- A centralized filing and management procedure
- It is convenient:
 - A one-stop shop for trademark holders to obtain and maintain trademark protection in export markets
 - File one application, in one language and pay one set of fees for protection in multiple markets
- It is cost-effective:
 - One international application is equivalent to a bundle of national applications, effectively saving time and money
 - Avoid paying for translations into multiple languages or working through the administrative procedures of multiple IP Offices

Who may use the Madrid System?



- The Madrid System is a closed system
- The applicant must have a connection (entitlement) with a Contracting Party to use the system, through:
 - real and effective industrial or commercial establishment
 - domicile, or
 - nationality
- A basic mark is required, which is a registration or application filed with your local IP Office – JIPO.

How the Madrid System Works



Stage 1

Basic application/
registration
"Basic Mark"

Applicant



Office of Origin

Certifies the international
application and forwards it
to WIPO

Stage 2

Formal examination; registers the mark in
the International Register and publishes the
international registration in the Gazette.
Issues a certificate of registration and notifies
the designated Contracting Parties

WIPO



Stage 3

Scope of protection of the international
registration will be determined by
substantive examination under
domestic law, within 12/18 months

Office of
the designated
Contracting Party



Office of
the designated
Contracting Party



Office of
the designated
Contracting Party



Stage 1: Application through your IP Office



- To be entitled to use the Madrid System, you must:
 - Have a real and effective industrial or commercial establishment in, or
 - Be domiciled in, or
 - Be a national of a member of the Madrid System
- Before filing an international application, you need to have registered or filed an application (**basic mark**) at JIPO.
- Submit an **international application** through JIPO.
- JIPO will certify and forward it to WIPO.

Stage 2: Formal examination by WIPO



- WIPO conducts a **formalities examination** of your international application.
- Once approved, the mark is **recorded in the International Register**.
- WIPO sends a **certificate of international registration** and notifies the IP Offices of the **designated Contracting Parties** in which protection is sought.
- **Substantive examination** and decision by the IP Offices, as outlined in Stage 3.

Stage 3: Substantive examination by the designated IPOs



- IP Offices make a **decision within 12 or 18 months** in accordance with their legislation. WIPO records the decisions and notifies you
- If an IP Office refuses to protect your mark, it will not affect the decisions of other offices. You can contest a refusal decision before the IP Office concerned.
- If an IP Office accepts to protect your mark, it will issue a **statement of grant of protection**.
- The international registration is **valid for 10 years**.
- You can renew your Intl TM registration directly with WIPO & it will have effect in the designated Contracting Parties.

Key features of the Madrid System



- Entitlement and basic mark
- One application - one registration covering multiple territories
- Fixed time limit for refusal – 12 or 18 months
- WIPO examines only for formalities and the designated CPs examine according to their domestic legislation
- Possible to later expand protection to new export markets
- Tailor the list of goods and services for the different markets
- Centralized management of portfolio
- Dependency and transformation

Fees for using the Madrid System



- Fees payable to WIPO in Swiss francs
- Basic fee* includes 3 classes of goods/services
 - 653 Swiss francs - black/white reproduction of mark
 - 903 Swiss francs - color reproduction of mark
- Fees for designating CPs:
 - Standard fees: Complementary (100 Swiss francs per DCP and supplementary (100 Swiss francs per class beyond 3)
 - OR
 - Individual fees where this is declared
- No local attorney fees are included

* Applicants from LDCs benefit from 90% reduction of the basic fee

Trade Marks in Jamaica



Unregistered Trade Marks:

- No formal registration required
- Protected by the common law of Passing Off

Registered Trade Marks:

- Formal registration required at JIPO
- Registration valid for 10 years, renewable indefinitely
- Protected by the Trade Marks Act against subsequent identical or similar registrations

TM Registration at JIPO



- Applicant's name and address (+ for service)
- a statement of the goods or services in relation to which (Nice Classification)
- A representation of the trade mark
- Examination by JIPO
- Publication in JIPO TM Journal
- Observations
- Oppositions
- Registration

Trade Marks Fees at JIPO



- The Trade Mark registration fee is payable in two stages:-
 - i. Upon application: \$7,800 (application fee include payment for the first class), plus \$2,200 for every additional class.
 - ii. Upon acceptance of the Mark for registration: \$2,200.00 for advertising the Mark in the Trade Mark Journal, and a further \$7,800.00 for registration.

Conclusion



- It is fundamentally important for MSMEs to protect their IP rights in all the markets that they intend to offer their goods & services.
- For international trademark registration, the Madrid Protocol offers MSMEs the opportunity to register their IP in multiple jurisdictions through one process.
- For Jamaicans in Jamaica, you have to have a TM application or registration filed in Jamaica at JIPO first, to be able to use the Madrid Protocol to register overseas.
- Visit us at JIPO!