

# Madrid System & Caribbean Overseas Territories

Abraham Thoppil (Cayman Islands)

20 May 2018

## **Who can use the Madrid System?**

- Need personal or business connection to a “Contracting Member State”
  - domiciled in or have commercial establishment in, or be a citizen of one of the 117 countries.

Contracting Member State = Office of Origin

## **Members of Madrid Union:**

- Contracting parties of
  - (i) Madrid Agreement
  - (ii) Madrid Protocol
- has 101 members, covering 117 countries

A **State or intergovernmental organisation (IGO)** can accede to the Madrid Protocol

## **IGO**

- European Union
- African Intellectual Property Organisation.
  - CARICOM is eligible

## **Parties to Madrid Protocol in the Caribbean**

- Antigua and Barbuda
- Cuba
- Curaçao, Sint Maarten, Bonaire, Sint Eustatius and Saba
- Guadeloupe, Martinique, Saint Martin and Saint Barthélemy

## Status of Territories

### The Kingdom of the Netherlands:

- **The Netherlands**
  - **Bonaire, Sint Eustatius and Saba** – Madrid Protocol applies
- **Aruba**
  - Member of Madrid Agreement, but not Madrid Protocol
- **Curaçao** – Madrid Protocol applies
- **Sint Maarten** – Madrid Protocol applies

### France: - Accession to Madrid Protocol included all Overseas Departments and Territories

- **Guadeloupe**
- **Martinique**
- **Saint-Barthélemy**
- **Saint Martin**
- **French Guiana.**

## Status of Territories

**UK British Overseas Territories** – None of them are parties to the Madrid Protocol

- **Caribbean BOTs**
  - **Anguilla**
  - **Bermuda**
  - **British Virgin Islands**
  - **Cayman Islands**
  - **Montserrat**
  - **Turks and Caicos Islands**

## UK Crown Dependencies

- **Guernsey**
- **Jersey**
- **Isle of Man** – Madrid Protocol applies

## Madrid Protocol Accession - protocols



<http://www.wipo.int/madrid/en/future-members/accession-guide/>

## **Advantages of Accession by Territories to Madrid Protocol**

- Financial Services – a major part of economy for most Territories
  - Attract IPHoldCo's to jurisdiction
    - IP HoldCo's in Contracting Member States will be able to be proprietor of Madrid Protocol IRs issued by other States
- With accession the Territories are on the same footing as mother country.

## **Advantages of Accession by Territories to Madrid Protocol**

- Employment generation – IP registry/Private Sector
- IPHoldCo's -> moving towards 'physical presence' to satisfy OECD's BEPS.
- Advantages for multinationals
  - Expedited processing
  - Cost Savings



## Cons

- home country application may include a 'clear and definite identification of goods and/or services' ...whereas other member countries might allow broader identifications, including claiming an entire international class.
- e.g. International Class 25 for clothing, footwear and headgear. Since all filing under the Madrid Protocol will be based on a trademark owner's home country application or registration, the trademark owner will not be able to take advantage of the broader identifications available in other member countries

- Questions?