



STUDY ON THE FEASIBILITY OF DEVELOPING REGIONAL MECHANISMS FOR ADMINISTRATION OF TRADE MARKS FOR CARICOM COUNTRIES

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Intellectual Property, Science and Technology Issues

OVERVIEW

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Rationale

Underlying objectives

Findings and results

Next steps

Rationale

RATIONALE FOR THE STUDY

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- ❑ Facilitate intra-regional trade
- ❑ Obligations under the Revised Treaty of Chaguaramas
- ❑ International developments and trends

Underlying objectives

UNDERLYING OBJECTIVES OF THE STUDY

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- ❑ Clarify the existing national regimes, international obligations and international developments
- ❑ Determine benefits of, and the requirements for, a regional administration for trademarks

Findings and Results

REGIONAL SITUATIONAL ANALYSIS

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- ❑ The problems of territoriality
 - ❑ Individual national applications (forms and fees)
 - ❑ Separate legal representation (and legal fees)
 - ❑ Search required in each jurisdiction

REGIONAL SITUATIONAL ANALYSIS

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- ❑ The problems of territoriality (cont'd)
 - ❑ Varying scope of rights granted
 - ❑ Varying times to grant

TREATIES AND NATIONAL LEGISLATION

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- ❑ WTO TRIPS Agreement (13 States)
- ❑ Treaty establishing WIPO (All 14 States)
 - ❑ Paris Convention (All 14 States)
 - ❑ Nice Agreement (12 States, all use it)

TREATIES AND NATIONAL LEGISLATION

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- ❑ Treaties administered by WIPO
(cont'd)
- ❑ Nairobi Treaty (3 States)
- ❑ Vienna Agreement (3 States)
- ❑ Madrid Agreement (3 States)

TREATIES AND NATIONAL LEGISLATION

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- ❑ Treaties administered by WIPO
(cont'd)
 - ❑ Trademark Law Treaty (1 State)
 - ❑ Singapore Treaty (1 State)

TREATIES AND NATIONAL LEGISLATION

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- ❑ National laws range from 1946 (based on 1912 Royal Decree) to 2015
- ❑ Two (2) States still allow for the “re-registration” of UK trade marks based originally on 1938 UK Act

TREATIES AND NATIONAL LEGISLATION

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- ❑ Structure of legislation and definitions of terms similar but not identical
- ❑ Most offices combined with administration of corporate affairs, five (5) exclusively Intellectual Property

TREATIES AND NATIONAL LEGISLATION

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- ❑ Structure of legislation and definitions of terms similar but not identical
- ❑ IMPAC Justice Model Trade Mark Bill

SCOPE AND STRUCTURE OF OFFICE

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Scope and structure of other Regional Offices examined:

- ❑ EUIPO
- ❑ ARIPO
- ❑ OAPI
- ❑ Benelux

SCOPE AND STRUCTURE OF OFFICE

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- Scope and structure of other Regional Offices examined: EUIPO, ARIPO, OAPI, Benelux
- Most CARICOM offices combined with administration of corporate affairs, five (5) exclusively IP

SCOPE AND STRUCTURE OF OFFICE

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- ❑ Most office revenue from trademark administration (applications, registrations, amendments and renewals)
- ❑ Proposed Caribbean Patent Convention

KEY ADVANTAGES AND DISADVANTAGES

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Advantages

- Harmonised requirements for trade mark registration
- Consistency in the grant and scope of protection of trade mark rights throughout CARICOM
- Possible Community trade mark

KEY ADVANTAGES AND DISADVANTAGES

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❑ Disadvantages

- ❑ Cost of establishment if limited to trademark administration
- ❑ Viability depends on the number of States acceding
- ❑ Shift of applications (and revenue) from national to regional offices

PROPOSED STRUCTURE

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- ❑ Four (4) options identified:
 - ❑ An online search facility linking the databases of all the offices in the Region (no examination or grant)
 - ❑ Undertakes examination but national office determines national registrability

PROPOSED STRUCTURE

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- ❑ Four (4) options identified (cont'd):
 - ❑ OECS offices replaced by sub-regional office, other offices remain
 - ❑ Fully replacing national offices and offering both national registration and a regional mark

PROPOSED STRUCTURE

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- ❑ Elected regional examination and national grant for further examination
- ❑ Proposed institutional structure comprising:

PROPOSED STRUCTURE

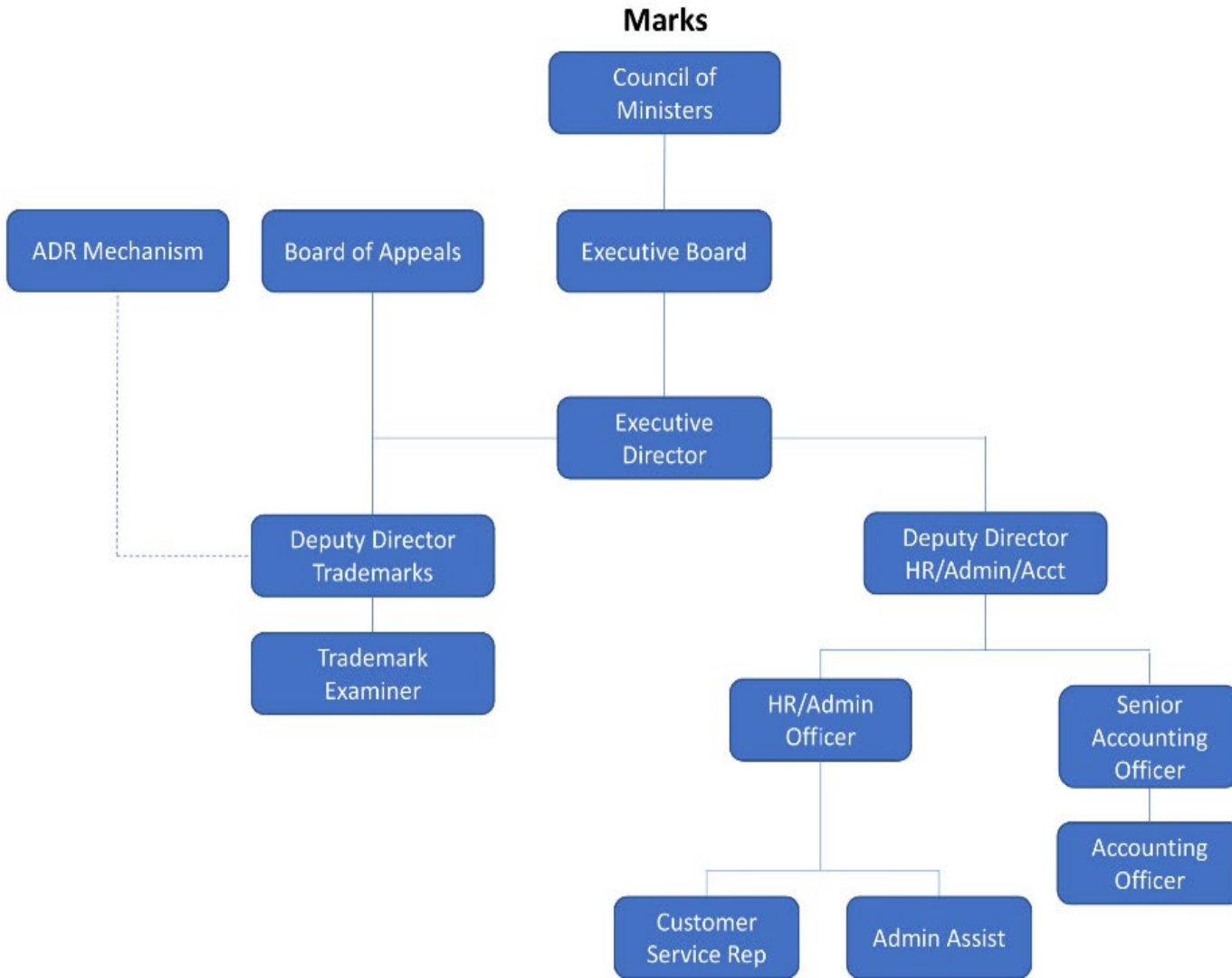
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- ❑ Ministerial Council
- ❑ Executive Board (Heads, CARICOM, E.D.)
- ❑ Technical and Administrative staff
- ❑ Board of Appeals

PROPOSED STRUCTURE

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DRAFT ORGANISATIONAL STRUCTURE - Caribbean Intellectual Property Office (CIPO): Trade



PROPOSED STRUCTURE

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- ❑ External support
 - ❑ Alternative Dispute Resolution
 - ❑ Information Technology
 - ❑ Education, Communications and PR
 - ❑ Audit
 - ❑ Legal
 - ❑ Project Management

FINANCIAL ANALYSIS

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- ❑ Establishment funded and managed as a project over two (2) years ~ \$500,000.00
- ❑ Financial and economic analysis for operations had to make assumptions for data gaps

FINANCIAL ANALYSIS

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- ❑ Gaps in:
 - ❑ WIPO records of the number of applications in some States
 - ❑ Number of classes applied for in each application and therefore fees paid per application

FINANCIAL ANALYSIS

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- ❑ Conservatively assumed one (1) class per application
- ❑ Assumed Regional office captures 25%, 50% and 75% of applications and registrations
- ❑ Used actual figures for 2011 – 2021

FINANCIAL ANALYSIS

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- ❑ About 40% of applications get registered
- ❑ Total applications – 267,026
- ❑ Figures projected for 2022 – 2028
- ❑ Five possible growth rates
- ❑ Five scenarios for level of fees

KEY CONCLUSIONS AND RECOMMENDATIONS

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- ❑ For a regional trademark office to be feasible, operating in parallel with national offices, the number of applications filed and registered has to increase significantly
- ❑ Full intellectual property rights administration improves feasibility

KEY CONCLUSIONS AND RECOMMENDATIONS

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- ❑ Requires a significant increase in the efficiency of examination and grant
- ❑ Requires harmonization of laws, practices and fees
- ❑ Requires online regional search facility

KEY CONCLUSIONS AND RECOMMENDATIONS

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- ❑ The regional office should accede to the Madrid Protocol
- ❑ The regional office should play a developmental role

Next steps

NEXT STEPS

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- Awaiting comments and decisions from Heads of IP Offices in Member States, including on financing and establishment of regional office and regional legal appeals process

NEXT STEPS

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- ❑ Proposed decision referred to Ministers
- ❑ Draft treaty prepared, discussed, finalised, approved and signed by sufficient number of Member States

CONTACT INFORMATION

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TREATIES AND NATIONAL LEGISLATION

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Country	Trade Marks Legislation
Antigua and Barbuda	Trade Marks Act No. 18 of 2003 , Trade Marks Regulations 2006
The Bahamas	Trade Marks Act Ch. 322 as amended up to Act. No. 5 of 1987 , Trade Marks Rules 1948 as amended up to Act. No. 5 of 1984
Barbados	Trade Marks Act Cap. 319, Trade Marks Regulations 1984
Belize	Trade Marks Act Cap. 257, Trade Marks Rules Cap. 257S of the Subsidiary Laws of Belize, Revised Edition 2003
Dominica	Marks, Collective Marks and Trade Names Act No. 12 of 1999 ; Marks Collective Marks and Trade Names Regulations, 2009

TREATIES AND NATIONAL LEGISLATION

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Country	Trade Marks Legislation
Grenada	Trade Marks Act No. 1 of 2012 , Trade Marks Regulations No. 18 Of 2012 , Trade Marks Amendment and Validation Act No. 22 of 2013
Guyana	Trade Marks Act Chap. 90:01, Trade Marks Rules 1955
Haiti	Law of July 17, 1954 on Trade Marks; Penal Code of Haiti 1985
Jamaica	Trade Marks Act No. 32 of 1999 , Trade Marks Rules

TREATIES AND NATIONAL LEGISLATION

Country	Trade Marks Legislation
Montserrat	Trade Marks Act Chap. 15.23, revised edition showing the law as at January 1, 2013
Saint Lucia	Trade Marks Act No. 22 of 2001 , Trade Marks Regulations 2003
St. Kitts and Nevis	Marks, Collective Marks and Trade Names Act Chap. 18.22 and Trade Marks Rules, revised edition showing the law as at December 31, 2002
St. Vincent and Grenadines	Trade Marks Act Cap. 315, Trade Marks Regulations 2004

TREATIES AND NATIONAL LEGISLATION

Country	Trade Marks Legislation
Suriname	Resolution No. 1862 of June 13, 1946 containing provisions on Factories and Trade Marks in the colonies and the Auxiliary Bureaus of Intellectual Property; Publication of October 21, 1912 announced by the Royal Decree No. 57 of August 29 th , 1912 containing provisions on Factories and Trade Marks in the colonies and the Auxiliary Bureaus of Intellectual Property
Trinidad and Tobago	Trade Marks Act No. 8 of 2015