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# Intellectual Property

## Legal Guide



The content of this guide is not intended to constitute legal advice on specific matters. Readers should consult legal counsel for advise.

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## FOREWORDS

The Secretary of State of Industry and Commerce of the Dominican Republic is pleased to provide this Legal Guide on Intellectual Property to businesses and individuals interested in further exploring this important aspect of commercial operations, which lately has received a great deal of attention.

This publication offers the reader ample information regarding Dominican legislation on trademarks, trade names, patents, industrial designs and utility models and provides a detailed description of the required administrative procedures. References to the Bill on Intellectual Property, proposed by the World Intellectual Property Organization, complete the general overview offered in this guide.

The Secretary of State for Industry and Commerce thanks the law firm of Pellerano & Herrera for preparing this guide. The Secretary selected Pellerano & Herrera to prepare this guide after reviewing proposals from a number of Dominican law firms.

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## INTRODUCTION

Intellectual property refers to the rights obtained by an inventor or discoverer with respect to the creation or discovery of any business-related invention or by a producer, manufacturer or merchant with respect to the creation of special signs that are intended to distinguish their products from other similar items. Intellectual property rights are obtained by appropriate registration.

As a result of economic globalization and the worldwide marketing of goods and services, national and multinational businesses have developed a keen interest in their intellectual property rights. Nevertheless, they often do not have a complete understanding of intellectual property legislation, the rights it protects, or the means for obtaining legal protection of those rights.

With a special interest in providing businesses and citizens with basic legal knowledge about intellectual property in the Dominican Republic, the law firm of Pellerano & Herrera has prepared this Legal Guide at the request of the Intellectual Property Registration Department of the Secretary of State for Industry and Commerce.

This guide discusses the following topics:

- distinctive symbols;
- invention patents;
- industrial designs and utility models; and
- other rights related to intellectual property, such as license agreements, franchises, and the like.





## **TRADEMARKS AND TRADE NAMES**

The Dominican Republic has the following laws regulating the registration of, and protecting, trademarks and trade names:

- Law No. 1450 dated December 29, 1937, on the Registration of Trademarks and Business and Trade Names;
- Law No. 1918 dated January 29, 1949, which requires names to be written in Spanish for entities and establishments;
- Resolution No. 912 dated May 4, 1928, which approves the Paris Union for Intellectual Property;
- Resolution No. 5102 dated April 18, 1912, which approves the Convention on Trademarks and Trade Names;
- Resolution No. 276 dated November 20, 1925, which approves the Convention for the Protection of Trademarks, Commercial and Agricultural Marks and Trade Names;
- Resolution No. 3143 of 1945 of the National Congress on the Functioning of the Board of Counsels;
- Resolution No. 205 dated December 5, 1994, of the State Secretariat of Industry and Commerce;
- Resolution No. 71 of 1989 of the State Secretariat of Industry and Commerce;
- Resolution No. 1/92 regarding renewal terms;
- Resolution No. 2 dated February 3, 1993, of the State Secretariat of Industry and Commerce on the time limit for opposition for the registration of trademarks and trade names; and

- Other internal procedures of the State Secretariat of Industry and Commerce related to this matter.

## **OVERVIEW OF TRADEMARKS**

### WHAT IS A TRADEMARK?



Trademarks are any word, slogan, design, picture or other symbol used to identify or distinguish a specific product from others of the same nature offered in the market. Any identifying symbol, including a word, design or shape of a product or its packaging, can qualify as a trademark, service mark, or trade name or as trade dress.

In this sense, Law No. 1450 provides that:

*“Every manufacturer or merchant can protect the articles or goods they manufacture or sell by means of special marks, to distinguish them from other similar products of different origin.”*

From this definition it follows that products launched in the market are identified by a distinctive mark or symbol by which they are recognized and through which consumers can distinguish them from other products of the same kind. Furthermore, a trademark must be a mark or symbol that, in addition to distinguishing a product, can be used exclusively by its manufacturer to prevent its products from being confused with products of others.

The usefulness of this distinctive feature is based on the fact that it not only distinguishes a product from another, but also allows the consumer to relate a specific product to the manufacturer and, thus, with certain standards of quality or certain special characteristics that have been made known by advertising and marketing. A mark constitutes an effective tool for sales promotion, influencing customers in such a way that the consumer links the product closely with the mark and with the characteristics and quality promoted. In effect, a well-promoted and extensively distributed mark acquires importance, great notoriety and value to the point that many companies have considered their marks as important assets with a high value.



Given the great economic and strategic value of trademarks for business, a large number of countries have had to protect them against imitators and/or counterfeiters to make certain that trademark owners have the exclusive use of their trademarks. The economic objective of trademark legislation in the Dominican Republic was stated by the Dominican Supreme Court of Justice in a decision it rendered more than 50 years ago. It declared then that:

*“the passing of Law No. 1450 has been brought about by the need to establish, in our country, a set of provisions that, by regulating the registration of trademarks and trade and industrial names, favor the economic development of the country, guaranteeing the rights of the proprietors of these names and marks and especially protecting them against the fraud to which they could be subjected.”*

Currently, trademarks are considered intangible goods that can be used by their creators. The person beginning to use a mark to distinguish and promote products, of which members of the public become aware, is the exclusive owner of this symbol with the right to benefit from its commercial use.



However, the ownership of a mark is not enough; it also must be protected. For this reason, countries have created a system for the registration of trademarks to assure more efficiently the exclusive rights of a mark to its owner.

## ESSENTIAL CHARACTERISTICS OF TRADEMARKS

To be valid, a trademark should have the following characteristics:

### *a) Originality*

The originality of a mark is essential because it gives its owner the exclusive right to use it in commerce. In effect, a term that is indispensable to every manufacturer wishing to offer products of the same nature cannot be considered a trademark. For example, the words “soft drink” cannot be accepted as a mark to distinguish a product of that class, as every manufacturer wishing to offer soft drinks needs to use the term to describe the offered product.



Consequently, a generic term can never be accepted as a trademark, because, on appropriating it as a mark, the owner takes a general term from public domain, not allowing its use by third parties for their benefit without authorization of its owner. In this sense, Law No. 1450 is clear inasmuch as it prohibits the registration of “generic terms.”

Likewise, the Paris Union Convention for Intellectual Property states that the following may be refused or invalidated:



*“Marks without any distinctive character, or composed exclusively of signs or indications that may serve in commerce to designate the species, quality, quantity, destination, value, place of origin of the products or the time of its production or that are frequent in conventional language, or habitual and constant practices of the commerce of the country where protection is claimed.”*

The genericness of a term is, nevertheless, relative: a term considered generic for one class of products can be a distinctive term for another. For example, the term “lace” is generic for a merchant selling lace, but “lace” has no meaning for a manufacturer selling soap. It is not essential, therefore, that the term be completely original, but it is necessary that it not be indispensable to any other business dedicated to offering the same type of products.

To classify products to avoid registering similar marks for products of the same category, Law No. 1450 establishes a “National Classification of Products and Goods,” which is explained below.

In addition, words that exclusively indicate an attribute of the product or of its composition also do not have the necessary originality to constitute a trademark. Because of this, the word “natural” cannot distinguish a fruit juice nor can the word “alcohol” serve as a mark for an alcoholic product.

However the mixture of descriptive and/or generic terms in such a way as to make an original combination can constitute a registrable trademark. This does not mean that the terms that make up this mark will be withdrawn from the public domain; only the original combination of the terms cannot be reproduced or developed for commercial use.



It is important to clarify that the use of generic terms as marks or as distinctive features of a product is not forbidden; a mark's genericness only prevents its exclusive use. For this reason, businesses should seek or invent the most arbitrary or original term possible to avoid exclusivity problems in the future.

*b) Availability*

As with originality, it is essential that the mark be available to be used; that is, no other business dedicated to manufacturing or marketing a closely-related product should have a mark equal or similar to the desired mark. This characteristic is important inasmuch as the mark's purpose is to prohibit another entity from using a mark equal or similar to the one already in use.



Law No. 1450 forbids the registration of terms similar to those of previously registered marks for the same class of products. This law also prohibits "the total or partial imitation of a previously registered mark for a product of the same class that could induce error or confusion to the consumer. The possibility of error or confusion will be assumed if there is similarity between the two marks, even though differences may be observed between them."

Consequently, a mark is available only if it has not previously been appropriated by another business, and a similar mark is not being used. To determine the amount of similarity permitted, the Department of Trademarks and Trade Names examines each application and determines, based on the circumstances, the possibility of confusion that a likeness may cause among consumers.

*c) Legitimacy*

Finally, in addition to a mark being original and available, it must not contain immoral matter or be contrary to the public order. In this sense, Law No. 1450 forbids the registration of marks that offend public decorum. The basis for this prohibition is that countries cannot guarantee the protection of marks that offend their citizens and the national public order.

However, the Paris Union for Intellectual Property states that "The nature of the product, on which the trademark or trade name must be placed, can in no case be an obstacle to the



registration of the mark.” In other words, even though a mark cannot be a term contrary to public order and morality, it is completely independent from the product and does not depend on the product’s nature or legitimacy.



#### WHAT DOES A TRADEMARK CONSIST OF?

Law No. 1450 states that trademarks or trade names “can consist of all the words and distinctive features not forbidden by this or any other law, and, without prejudice to all advertising and commercial propaganda media, may be used engraved in the articles themselves, and in the containers and wrappers containing them.”

Law No. 1450 continues that names, signatures, corporate names, figures or letters may be used as trademarks or trade names when they are covered with forms that constitute special distinctive features.

Consequently, the following symbols may be used as trademarks, provided they meet the characteristics previously detailed: figures; letters and words; proper names; business names, signatures, initials and abbreviations; phrases or slogans; and designs or logotypes and other distinctive features.

On the contrary, according to Dominican law, the following terms are unregistrable: generic and general-use terms, as previously detailed; designations used to distinguish the nature or class of products; terms that constitute the reproduction and/or total or partial imitation of a mark previously registered for products of a similar nature; terms that go against good habits; words, images or representations that imply an offense to individuals or public decorum; color or form of a product; coat of arms, medals or public, official, national or foreign insignia, letters, words, names, or distinctive features used by a government; indication of a specific locality or establishment not of the article’s origin, with or without an additional assumed or different name; words, images or representations referring to a person, without that person’s express authority; and geographical names when, of themselves, they constitute the proposed mark.



## OVERVIEW OF TRADE NAMES

### WHAT IS A TRADE NAME?

Trade names are distinctive terms that identify a commercial establishment and distinguish it from other establishments of the same category. Although a trademark identifies the products manufactured or distributed by a company, a trade name identifies the company and the type of business it runs.

A trade name has the same legal and economic importance for a business as a trademark, for the same reasons, and it is essential that government assure an owner of a trade name of its exclusive use. In this sense, Law No. 1450 states that the “names of the commercial and industrial establishments are included in the benefits of this Law to distinguish them from other establishments of a similar type.”



These names designate a business or a company; and, similar to trademarks, their registration is provided by the law for a trade name’s exclusive commercial exploitation. Even though the registration of a trade name is optional, that is to say, any company can adopt a name without registering it, registration is advisable to assure a trade name owner that no other business can adopt the same name, or a very similar one, and take advantage of its present or future popularity.

### CHARACTERISTICS OF TRADE NAMES

#### *a) Originality*

As with trademarks, registrable trade names must be original. A registrable trade name constitutes a term or symbol sufficiently distinctive to be used exclusively without limiting other businesses’ ability to operate except for their inability to use the trade name.

It is important, when deciding on the adoption of a trade name, to choose a term whose appropriation and exclusivity is possible. As mentioned above, the appropriation of a term is possible if it is not needed in the everyday language of merchants dedicated to a business of the same nature as that of the desired name.



By the same token, arbitrary names or names made up exclusively for a particular business usually are the best trade names; the names and surnames of the owners of a business also may be used. It should be noted, however, that if using a proper name, Law No. 1450 forbids the registration of “words, images or representations that refer to persons, without the express authorization for this by that person.” Therefore, businesses should be careful when adopting someone’s first name or a surname for a trade name.

*b) Availability*

It is important to clarify that, even though it is possible to register a trademark that is the same or similar to one already registered, provided it is for a product in a different class and protects non-related products, this does not occur in the case of trade names. There is no class division for trade names as there is for trademarks; there only is a common registry. And, even though, in principle, the important thing is that the name proposed is not the same or similar to one already registered for establishments of the same nature, the government is highly unlikely to register a name the same or similar to another already registered, no matter what business the registered owner is in.



*c) Legitimacy*

Finally, as in the case of trademarks, it is not enough that a trade name be original and available to be appropriated; it is also necessary that it not be an immoral term or symbol or contrary to public order, in accordance with Law No. 1450.

#### WHAT DO TRADE NAMES CONSIST OF?

The same requirements for a valid registrable trademark also apply to trade names.

In addition, Law No. 1918 prohibits “giving names not written in the Spanish language, to bodies, institutions, corporations, societies, companies, associations, syndicates, stores, shops, grocery stores, small grocery stores (pulperias), pharmacies, and, in general, any entity or establishment, except proper names.”



These prohibitions, however, are applicable only to entities whose main offices are in the Dominican Republic. It does not include “those entities or establishments instituted or with their main office abroad, with branches, agencies or other dependencies in the Republic, duly authorized by the corresponding central entities bearing their names.”

#### SERVICE MARKS AND TRADE DRESS

“Service marks” are marks that are created to protect services offered by a company or business, rather than to protect goods or products.

“Trade dress” is the configuration of the trademark itself; it is the combination of elements that give the appearance, perception or atmosphere of a business or a good protected by a trademark. This term also refers to individual elements of a business or to the image of a product as well as to the image of all those elements together. The Dominican Republic currently has no legislation governing trade dress.



#### **OBTAINING RIGHTS IN TRADEMARKS, TRADE NAMES AND SERVICE MARKS**

As noted above, the owners of trademarks and trade names have the following rights:

- the right of ownership, that is, the right to use, exploit and transfer a mark and/or name; and
- the right of exclusivity, that is, the right to withdraw the term or symbol from the public domain for its sole use.

The creation and use of marks and names is sufficient to obtain these rights. In effect, the creation and use of a mark or name is the best method for obtaining these property rights.

Law No. 1450 provides that the “registration of a trademark or trade name or the name of a commercial or industrial establishment . . . is declaratory of property and guarantees the interested party with the exclusivity of use of this mark or name for a period of time equal to the period for which it was effected, without prejudice to the renewals the registration could be subjected to for an equal or longer period.”



The law also makes clear that the registration of a mark or name is simply declaratory of property, but does not create the property. However, to assure the exclusive benefit of a mark or name, an owner must register it.

The need to actually use a mark or name should not be underestimated. As Dominican law indicates, registration of a mark or name “is to be considered void and without value if within a one-year period, beginning at the date of the registration, the owner of the registered mark or name does not use it.”

## **REGISTRATION**

Law No. 1450 sets forth the requirements to register a trademark: “To obtain the registration of any trademark or trade name or the name of any commercial or industrial establishment, the interested party or the person that legally represents him shall submit a request to the Secretary of State of Industry and Commerce.”

In this request, the name or corporate name, profession, domicile and citizenship of the applicant and, if the applicant should reside in the Dominican Republic, the number and date of expiration of the personal identification card of the interested party or a business’ president or manager, and the name, profession, domicile, citizenship and number and date of issue of the personal identification card of the person acting on behalf of any executive officer, must be included with a registration request.

Such a request also must contain a detailed explanation of all the elements that characterize the mark or name to be registered; the type of industry or business the mark or name will designate; the products, goods or establishments to which the mark or name will be applied; the period of time requested for the registration; and, if it does not concern the names of commercial and industrial establishments (which are registered in a special book), the category of the product or goods.

With respect to the registration of trademarks, Law No. 1450 validates the Dominican Classification of Products and Goods, which contains 70 different classes, including the following: non-processed raw materials and agricultural products (Class Nos.

1-6); processed and semi-processed matter (Class Nos. 7-15); tools, machinery and transport articles (Class Nos. 16-28); construction articles (Class Nos. 29-34); furniture and furniture articles (Class Nos. 35-42); threads, fabrics, carpets, curtains and garments (Class Nos. 43-47); fantasy articles (Class Nos. 48-52); food articles (Class Nos. 54-62); and teaching, sciences, fine arts and other articles (Class Nos. 63-70).

Because Dominican law prescribes that the Secretary of State of Industry and Commerce must order “a meticulous investigation, to specify if the registration of the mark or name requested can be made without contradicting any disposition of this Law or any other law and also without damaging third-party rights,” an applicant first must request the availability of a mark or name. If it concerns a mark, the request must mention the class of the product that will bear the mark to be registered.

According to Law No. 1450, on requesting the registration of marks, goods falling in more than one class require “formulating as many separate requests for registration as classes there are of the products or goods whose marks are to be registered.” In like manner, the registration of a trademark or of a trade name and of a commercial or industrial name or establishment cannot be submitted in the same request.

The entity in charge of the registration of trade names and trademarks is the Department of Trademarks and Trade Names that is part of the Department of Registration of Industrial and Commercial Property of the State Secretariat of Industry and Commerce.

When they receive an application, the members of the staff of the Department of Trademarks and Trade Names make the pertinent investigations and determine if the term or corresponding symbol is available for registration, taking into account the prohibitions and requirements for registration. This investigation takes into account any reproductions or intent of imitating another mark or name previously registered.

If the mark or name is registrable, the department will issue a “Certification of Availability,” authorizing the interested party to request the formal registration of the proposed mark.

If a term or symbol cannot meet the necessary requirements for registration, a “Rejection Certificate” is issued, which sets forth the basis for the rejection of availability.



An applicant has thirty days from the date of issuance of a Certification of Availability to file for a formal registration. If an applicant fails to file a formal request within the appropriate time, the availability granted expires and the procedure must be started again with another request for availability.

After formal registration has been requested, a petition for its publication in a newspaper also should be filed to comply with the publication requirements of the law. The law demands that marks be published in the Bulletin of the State Secretariat of Industry and Commerce; it should be noted, too, that Dominican law also provides that the Chambers of Commerce and Production are entrusted with “publications concerning the Registration of Trademarks and Trade and Industrial Names.”

At present, publication requirements of Law No. 1450 are fulfilled by an official monthly publication of the Chamber of Commerce and Production of the National District. All registrations of requested marks and names in a given month must appear in this publication. The reason for this publicity requirement is that the government must make certain that the rights of third parties will not be damaged by the proposed registration.

Forty-five days after this publication, if there has been no opposition to the registration, the Department of Trademarks and Trade Names will proceed to issue the corresponding “Certificate of Registration” for a period of 5, 10, 15 or 20 years, on the basis of the request and the fee paid by the interested party.

Payment of these fees is necessary for the Department to accept the request for registration. In this respect, the law establishes that the State Secretariat of Industry and Commerce “will not accept requests unless accompanied by receipts proving that the interested party, or the person legally representing him, has paid in an Internal Revenue Collection Office, the fee that corresponds to the term requested in the registration and the publishing expenses of the Bulletin.”



Once the interested party has the registration, the party has the guarantee and support of the law to assure the benefits and exclusive commercial exploitation of the registered mark or name.

It is important to clarify that protection of exclusivity rights granted by registration goes beyond the country of registration. Through international conventions, the Dominican Republic is committed to protect the marks and names registered abroad, especially marks and names internationally known. In the same way, the rights of marks obtained in the Dominican Republic must be protected in the other countries that are signatories to such conventions. For this reason, registration has extraterritorial validity, inasmuch as it not only protects a term's rights nationally, but in many other countries as well, subject to the term's compliance with such countries' laws.

## **OTHER PROCEDURES**

There are other important procedures related to the registration and protection of trademarks and trade names, such as:

### **RECONSIDERATION PROCEEDINGS**

Even though this procedure is not provided by the law, interested parties are permitted to request reconsideration of a decision taken by the Department of Trademarks and Trade Names of the State Secretariat of Industry and Commerce rejecting the availability of a mark.

Reconsideration may be sought by a written petition filed with the Director of the Department of Trademarks and Trade Names expressing all arguments that the interested party believes to be important for the department to reconsider its decision.

The interested party is told of the decision on appeal through another Certification of Availability or Rejection, as the case may be.



## OPPOSITION PROCEEDINGS

As stated above, the essential purpose of the publicity requirement is to avoid damage to third parties arising from the registration of a mark or name. Even though Dominican law does not specifically provide for this, any party has the right to oppose any registration that he or she believes violates ownership rights on a registered mark or is a generic or general-use term.


The interested party may file an opposition before the Secretary of State of Industry and Commerce, through the Legal Counsel Office, within a 45 days time period from the day in which the application for registration was published on a national newspaper. At the expiration of this term, if no opposition has been filed, the formal registration certificate is issued. This has been established by Resolution No. 263/98, published on January 6, 1999, by the Secretary of State of Industry and Commerce. This Resolution has also introduced new provisions related to the terms in which the parties may defend their rights.

From the day in which the opposition is filed, the party will have a fifteen (15) day term to present all the documents and proofs in which he or she has based the opposition. It is very important to point out that this term may not be extended; if the documents and proofs are not deposited before the term expires, the opposition will automatically be inadmissible, and the formal registration certificate will be issued for the opposed trademark. If the mark is going to continue being objected, then a new cancellation action must be filed.

**DEFENSE OF THE APPLICANT:** Once the opposition is filed, the Legal Counsel Office will notify it to the applicant, along with all pertaining documents, in order for him to proceed with his defense, within a 15 day term. This term, as the one for the opposing party, may not be extended. If no response is received, then the Opposition is accepted.

The parties also have the opportunity to respond and file rejoinders in a 15 day time limit, which may be extended if the parties request it, and if they have valid reasons.

When the process is complete, at the discretion of the Legal Counsel, it is sent to the Secretary of State for a decision. It does so with the help of the Body of Advisors, an organization



commissioned to assist the Secretary of State of Industry and Commerce. The Body of Advisors meets once a month.

The final decision is issued in the form of a Resolution by the Secretary of State of Industry and Commerce.

#### CANCELLATION PROCEEDINGS

The cancellation of a registered mark or name is expressly provided for by Law No. 1450, which states that if “by mistake or inadvertence a registration is carried out when an existing one is in force that protects the same mark or name, or similar ones, with rights better founded than those of the second registration, the latter will be void if the error is known or appealed within the three (3) years following the date the former came into effect; otherwise, the second registration will remain with all its effects.” The law also states that “the nullity of registered marks, whose registrations have been obtained with bad faith, may be claimed at any time.”

Similarly, Law No. 1450 provides that if “a mark or name with a prior registration is found, equal or similar to the mark or name to be registered, susceptible therefore of producing confusion to the public due to this similarity, the Secretary of State of Industry and Commerce shall provide the cancellation of the first registration, if the mark or name that protected this registration had been used for a period of time inferior to one-fourth of the time during which the person or entity that requested the second registration had used the same mark or name.”

On the other hand, on the international level, the Paris Union for Intellectual Property permits the request of the invalidation of marks that are a “reproduction or imitation, susceptible of creating confusion of a mark that the competent authority of the country of registration estimates is notoriously known in that country, and is already the mark of a representative of another contracting country and used for products of the same class or a similar class.”

On the basis of these dispositions and others established in international conventions, a person that believes that his or her rights with respect to a trademark or trade name have been damaged by a registration may file formal appeal for cancellation

of this registration before the Secretary of State of Industry and Commerce.

Cancellation proceedings also can be lodged against a trademark registration that has not been used within the first year from the date of its issuance, as required by Law No. 1450.

Cancellation proceedings are the same as opposition proceedings, described above, and are completed by means of a decision by the Secretary of State of Industry and Commerce with the help of the Body of Advisors.

#### RENEWAL PROCEEDINGS

Dominican law provides that at the expiration of the time limit for which any registration was effected, the registration “can be renewed for any new period, within the scale established in this Article, through the payment of the corresponding fees.”

This renewal allows the owner of a mark to continue exercising its rights over it for 5, 10, 15 or 20-year periods, according to the renewal request filed by the interested party.

Under applicable law, a renewal application must be filed within 60 days before the existing registration lapses.

#### ASSIGNMENT OF A REGISTRATION

Law No. 1450 provides that a trademark or trade name can “only be transferred together with the industry of the product or commerce, or together with the commercial or industrial establishment to which they were assigned, making the necessary annotation in the registration in each case, in view of the documentation that proves that the transfer has been effected.”

As provided by the law, a request for transfer must be addressed to the Director of the Department of Trademarks and Trade Names accompanied by the pertinent documentation demonstrating the transfer, and in which the former owner of the trademark or trade name formally and expressly transfers the mark and/or name to the new owner.



## AMENDMENT OF A REGISTRATION

A request for amendment is made for a registration when the owner desires to change information contained in the Certificate of Registration.

Amendments are requested from the Department of Trademarks and Trade Names.

## NAME AND/OR ADDRESS CHANGE OF THE HOLDER OF A REGISTRATION

When the holder of a registration modifies its corporate name by merger, acquisition or otherwise, or moves its domicile to another location, the holder must request the amendment of the corresponding Certificate of Registration so that it shows these changes.

The request for name and/or address change must be addressed to the Department of Trademarks and Trade Names.

## LICENSE TO USE A REGISTRATION



As indicated, under Dominican law, a mark or name can “only be transferred together with the industry of the product or commerce, or together with the commercial or industrial establishment to which they were assigned, making the necessary annotation in the registration in each case, in view of the documentation that proves that the transfer has been effected.”

It is possible, despite this provision of the law, to transfer rights to use a mark. This transfer can be accomplished through a “Contract of Use” of a mark signed by the parties.

## LEGAL ACTION AGAINST TRADEMARK INFRINGEMENTS

The following are considered trademark infringements:

- the use of a mark or name belonging to another person;
- the reproduction, in whole or in part, through any means, without the consent of the owner or the owner’s legal



representative, of any registered mark or name, or the imitation of a mark or name in a way that induces the public to error;

- the use of a spurious mark or name;
- the sale or offer of articles that exhibit a spurious mark, if the seller cannot prove its origin;
- the use in products of a trade name or a corporate name that does not belong to the user, whether it constitutes or not part of the registered mark;
- the use without due authorization of a trademark or commercial mark or the name of a commercial or industrial establishment, a coat of arms or national or foreign public official insignia;
- the use of trademarks or commercial marks or names of commercial or industrial establishments provisions that offends the public decorum;
- the use of a trademark indicating a locality or establishment that is not the source of the goods or products, whether or not a name of another or a supposed name is joined to this indication;
- the sale or offer of any goods or products that show marks, if its origin cannot be proven; and
- the use of a trademark or commercial mark or the name of a commercial or industrial establishment containing something that is personally offensive, or the sale or offer for sale of articles that exhibit these marks.

For any of these infringements, the interested party whose rights are injured will be able to obtain the following:

- a fine of RD\$100.00;
- confiscation and destruction of counterfeit or spurious marks and confiscation and deposit of goods or products that contain marks that violate any provision of Law No. 1450; and

- damages for losses incurred by the production and sale of articles exhibiting counterfeit or spurious marks.

## **PROPOSED BILL ON INTELLECTUAL PROPERTY**



At present, a bill proposed by the World Intellectual Property Organization (WIPO), is being drafted and eventually will be introduced to the legislative bodies of various countries for approval. This bill would extensively modify the Dominican Republic's current legislation related to trademarks and trade names and, in general, would regulate this matter with more detail.

For example, the bill protects a wider range of distinctive features or terms than current Dominican legislation on this matter, such as:

- service marks, which are the distinctive features used to identify services offered by a company, such as meal dispatch services, stylist services, advertising services, legal services, etc.;
- collective marks, that is, marks that denote some common characteristics of products or services of different companies authorized to use a mark under the control of its holder;
- emblems, which are figurative signs used to identify or distinguish a company; and
- signs used to identify or distinguish a given commercial location.

The bill includes the possibility of registering as trademarks “words, fanciful denominations, names, pseudonyms, commercial mottoes, letters, numbers, monograms, figures, portraits, labels, shields, prints, vignettes, ornamental borders, lines and bands, combinations and color arrangements. The marks also may consist of the signature, presentation or conditioning of the products or their containers or wrappers, or of the means of dispatch or dispatch sites of the corresponding products or services.”

Likewise, they can “consist of national or foreign geographical indications, as long as they are sufficiently distinctive



concerning the products or services to which they are applied, and that their use is not susceptible to creating confusion as to their origin, source, qualities or characteristics of the products or services for which these marks are used.”

Another important change provided by the bill relates to what constitutes the use of a mark and how to prove it. The bill also eliminates the “Request for Availability” and establishes a sole request for registration. It abrogates the “National Classification of Products and Goods” established by Law No. 1450 and implements the “International Classification of Goods and Services for the Registration of Trademarks,” established by the Nice Arrangement of June 15, 1957.

The bill also only permits registration for 10 years and not for periods of 5, 10, 15 or 20 years, as is presently established by Law No. 1450, but it permits renewals. The bill describes the rights of action against the use of unauthorized marks or names and its limitations. Finally, the bill facilitates the transfer of a registered mark, regulates it, and grants the rights to its use or licensing.



## **INVENTION PATENTS**

### **LAWS OF THE DOMINICAN REPUBLIC ON INVENTION PATENTS**

The laws and regulations that govern invention patents in the Dominican Republic include the following:

- Law No. 4994 dated May 24, 1991, on Invention Patents;
- Resolution No. 5070 of April 18, 1912, approving the 1910 Buenos Aires Convention on Invention Patents, Industrial Drawings and Models;
- Resolution No. 912 of May 4, 1928, approving the Paris Union for Intellectual Property; and
- internal administrative dispositions of the State Secretariat of Industry and Commerce related to this matter.



### **OVERVIEW**

#### WHAT IS A PATENT?

A patent is a grant made by the government to an inventor that excludes others from manufacturing, using or selling the invention for a specific period of time and in a specific geographic area.

#### KINDS OF PATENTS

In the Dominican Republic, there are two kinds of patents: “invention patents” and “introduction patents.”



Invention patents give the holder the exclusive right to sell or use the object of the patent under the conditions stated by the law.

Introduction patents give the holder the right to manufacture, produce and sell products within the country; they do not give the right to prohibit others from introducing similar products in foreign countries, subject to certain restrictions.

An owner of a patent who improves the object of the patent may claim protection for such improvements with an “Addition Certificate.” This document is an accessory to the primary patent, producing the same effects and having the same term as the primary patent.

Law No. 4994 provides that every “new discovery or invention, in every type of industry, bestows to its author, under the conditions and time that will be determined later, the exclusive right of working it in his benefit.” This right “is made known by the titles issued by the Executive Power with the name of invention patents.”



Thus, to obtain exclusive rights for an invention, a request for a patent must be made to the appropriate authorities.

#### WHAT DOES AN INVENTION PATENT CONSIST OF?

As indicated above, an invention patent is issued to protect an invention or a discovery. Law No. 4994 defines discoveries and inventions as:

- a new way to manufacture industrial products;
- a new manual or mechanical appliance that serves to manufacture a product; and
- the discovery of a new industrial product and the application of perfected means to obtain results superior to those already known.

The Convention on Invention Patents, Industrial Drawings and Models states that an invention is “a new manner of manufacturing industrial products; a new machine, or manual or mechanical appliance that serves to manufacture said



products; the discovery of a new industrial product; the application of known means for the purpose of obtaining superior results; and all new, original and decorative drawing for an industrial article.”

In summary, a patent can be issued for: discoveries and inventions; appliances or equipment for industrial application; manufacturing methods; and pharmaceutical compositions.

## CHARACTERISTICS

### *a) Industrial character*

Law No. 4994 states that “Every new discovery or invention, in all types of industries” is patentable. Also, in all definitions of invention or discovery, contained in Article 2 of that law, the word “industry” is mentioned. This suggests that, for an invention or a discovery to be patentable, it must have an industrial, business or commercial character.

The commercial character required for the issuance of a patent means that the invention, discovery, or method must have a useful purpose, a technical purpose. It must serve for use in any type of industry, understanding this to mean any operation intended for obtaining, transforming, or transporting natural products.

In this respect, merely artistic, aesthetic or ornamental inventions and exclusively scientific or mathematical discoveries that have no industrial application are not patentable. Law No. 4994 also establishes that “plans and combinations of credit and finance” are not patentable because they lack industrial character.

### *b) Innovative character*

The novelty of a discovery and/or invention is essential for the issuance of a patent, inasmuch as a patent grants to its holder the exclusive commercial exploitation of a discovery or invention. In this sense, what has already been patented or what is in the public domain cannot be given exclusively to one person to exploit commercially.

Law No. 4994 states that discoveries, inventions or methods that are not new are not patentable. Moreover, the law also provides that it will “not be considered new any discovery, invention or application that, in the Republic or abroad, and before the date of the deposit of the request, has received sufficient publicity to be carried out.”

*c) Inventive level*

A creation, invention or method is considered to have an inventive level if it is not obvious to a person proficient in the specific matter for which it was created. An alternative method, very similar to a previous one but not providing a new or different method, would not have an inventive character.

*d) Legitimacy*

Law No. 4994 states that patents are considered void “if the discovery, invention or application is recognized as contrary to order, public security, good mores, or to the laws of the nation, without prejudice in this case and the preceding paragraph, of the penalties it could incur for the manufacture or sale of forbidden articles.”

## **REGISTRATION PROCEDURE**

The registration of an invention patent is obtained by a request to the State Secretariat of Industry and Commerce, addressed to the Department of Registration of Industrial Property. The following must be included in this request:

- the applicant’s domicile in the country and certain personal data;
- the representative’s personal data, in case a representative is requesting the patent;
- the desired validity period for the patent, which could be 5, 10, or 15 years; and
- a term that summarizes and identifies the invention.

The documents that must be annexed to the application are:

- Internal Revenue receipt of the required fee for the issuance of the patent, in an amount that depends on the validity period, and a receipt for the payment of publication rights;
- descriptive report of the discovery, invention or application motivating the patent's request written in Spanish, without alterations, scratching or space between lines and with weight and measure denominations in the metric and decimal systems (in two copies and signed by the applicant and proxy, in case there is one);
- the drawings or necessary samples to comprehend the written description. Drawings must be made with ink and in metric scale (in two copies and signed by the applicant and proxy, in case there is one); and
- authentic power duly legalized to be used in the country in case the patent request is effected by proxy.



After depositing the request, the Department of Registration of Industrial Property of the State Secretariat of Industry and Commerce will study the file and determine if the discovery, invention, method, device or composition presented is patentable and if all requirements of the law have been met.

If so, a patent certificate duly registered and filed in the State Secretariat of Industry and Commerce will be issued.

A copy of this certificate is given to the applicant at no charge. One original of the description and one of the drawings will be annexed to this copy. The original documents remain in their corresponding file, deposited in the archives of the State Secretariat of Industry and Commerce.

Law No. 4994 also provides that issued patents must be published in a newspaper by the State Secretariat of Industry and Commerce. Once the patent is published, the applicant must send to the Secretariat three copies of the newspaper with a certification of publicity by the administrator of the newspaper.

Patent use is very important. After receiving a Patent Certificate, if within the first five years its owner has not



commercially exploited the discovery or invention, the owner will lose exclusivity rights on it. In the same way, a patentee who imports objects of foreign manufacture similar to those guaranteed by the patent, except in case of machine models whose introduction the Secretariat permits, will lose those rights.

## **MAINTENANCE OF PATENT RIGHTS**

According to Law No. 4994, the loss of all rights afforded by a patent occurs when the owner of a patent does not work or execute the discovery or invention in the Dominican Republic within five years from the issuance date of the patent or every three successive years unless the owner of the patent can establish the reasons for this inactivity.

There are two kinds of patent exploitation by a patent owner that can avoid it losing rights to the patent. “Nominal exploitation” occurs if a Formal Invention Patent Certificate has not been used for five years in the Dominican Republic following its issuance; the patent owner has the right to maintain its validity by publishing a notification in a newspaper of national circulation offering said invention to interested parties.

After publication, the notification is deposited in the State Secretariat of Industry and Commerce, together with a request for the expedition of a formal certification of “Nominal Exploitation,” corresponding to the patent.

If an invention patent is being used in Dominican territory, the patent can be effectively exploited by the same procedure as stated above, with the difference being that notice is given in the name of the company or business that is commercially exploiting the invention, stating that it has been using the invention for a specific time.

After publication, the notification is to be deposited with the State Secretariat of Industry and Commerce.



## **OTHER PROCEDURES**

### RENEWAL

Patents for five or ten years may be extended to 15 years. To do this, the patent owner must pay the taxes for the difference between the five or ten-year fee, and the 15-year fee.

### MODIFICATION

The owner of a patent or his successor has the right, during the patent's validity, to make changes, improvements or additions to the invention. If that occurs, the patent owner must re-register the patent and pay the corresponding taxes. These changes and improvements will be shown as certifications issued in the same way as the primary patent and will have the same effects as the primary patent, until its maturity.

### ASSIGNMENT

A patentee may transfer rights on a patent by registering an assignment in the State Secretariat of Industry and Commerce, so that third parties are notified.

### CHALLENGING A PATENT

An action to challenge a patent or to confirm its expiration may be filed in the courts.

## **VIOLATION OF THE LAW**

It is against the law if a person:

- on insignia, announcements, prospects, cartels, marks or stamps, assumes the position of a patentee without having a patent issued according to the law;
- commits patent infringement; or
- consciously conceals, sells or offers for sale counterfeit objects.

In case of repeated offenses, a person can be sentenced to prison for one to six months.



Counterfeit goods can be confiscated, and a patent holder can sue a counterfeiter for damages.

## **PROPOSED BILL ON INTELLECTUAL PROPERTY**

A bill proposed by the World Intellectual Property Organization (WIPO) extensively modifies Dominican legislation on invention patents. In general, the bill clarifies many points, including the following:

The bill clarifies what cannot be patented, including:

- discoveries, scientific theories and mathematical methods;
- existing matter in nature or its copy;
- creations that are exclusively aesthetic;
- plans, principles or business or economic methods and those referring to purely mental or intellectual activities or games;
- information presentations;
- computer programs;
- therapeutic or surgical methods for human or animal treatment and diagnostic methods;
- inventions whose publication or commercial exploitation is contrary to public order and morals;
- inventions clearly contrary to the health and life of persons or animals, or the preservation of the environment; and
- plants and animals, except microorganisms, and essentially biological procedures for the production of plants or animals.



The bill also mentions and explains the characteristics that an invention must have to be patentable. It must be susceptible to industrial application, novel, and have an inventive level.

The bill also explains who owns the rights to a patent, which is particularly important when an employee or a contractor invents something.

The bill includes a chapter dedicated to “utility models,” defined as “any form, configuration or disposition of elements of an appliance, tool, instrument, mechanism or other object, or a part of it, that permits a better or different operation, utilization or manufacture of the object incorporating it or providing it with utility, advantage or technical effect that it did not previously have.” These are protected under patents.

At the same time, the bill includes protection for owners of trade secrets against the “revelation, acquisition or use of said secret by third parties without their consent.”

If this bill is approved, the following changes in Dominican law would take place:

- the term of a patent would be 20 years from the date of filing, rather than 15 years from the date of issuance (as is currently the law);
- the official fees for certain inventors would be reduced;
- interested parties could oppose patent applications, in the same manner as they can oppose trademark applications; and
- examination of patent applications would be by a board of people skilled in these matters, who would determine whether the object of the application is patentable or not.





## **UTILITY MODELS AND INDUSTRIAL DESIGNS**

### **LEGISLATION ON THE MATTER**

Even though in the Dominican Republic no specific legislation has been promulgated extensively regulating rights with respect to models and industrial design, a specific law exists regulating the registration of one of its classes. The law in question is Law No. 2926 dated June 23, 1951, on The Use of Empty Bottles for the National Industry.

In the same way, the following texts provide international protection to industrial models and designs in general:



- Resolution No. 912 dated May 4, 1928, which approves the Paris Union for Intellectual Property; and
- Resolution No. 5070 dated April 18, 1912, which approves the Convention on Invention Patents, Industrial Designs and Models held in Buenos Aires in 1910.

### **OVERVIEW**

#### Definitions

“Industrial designs” are any bidimensional or tridimensional shape that, once incorporated to a product, gives it a special appearance to be used as a reference or a model for its fabrication. In other words, industrial designs are decorative elements about the shape of a specific apparatus or machine.

“Utility models” are any shape, configuration or disposition of elements on any apparatus, tool, instrument, mechanisms or any other object, or in any part of such, that allows a better or different way of function, use or manufacture of the object that incorporates it or that gives any utility, advantage or effect that



it did not have before. In other words, a utility model is a design that allows the apparatus or machinery to have another utility in addition to the one it had before.

The protection of both industrial designs and utility models is the same as the protection for patents.

## CHARACTERISTICS

### *a) Novelty and originality*

As with any other invention, an industrial model or design must be new and original. In this sense, when there is lack of novelty, there is no creation and, consequently, there is no right to be protected. If a design or model is already protected or is in the public domain, no other exclusivity protection can be provided.

It is important to clarify, however, that a set of elements in the public domain can have sufficient novelty to be protectable. A color mixture conforming to an original design, for example, could have the necessary novelty to comply with this essential characteristic.



### *b) Legitimacy*

It also is necessary that the design or model not be contrary to public order and to good mores to be protected by the law.

## **PROTECTION**

### DESIGNS

Although there is no specific legislation protecting industrial designs, they can be registered as trademarks following the same procedures established for other trademarks registrations. These designs of color and drawings are also called logotypes, and they have the protection given to trademarks.





## MODELS

Industrial models have the protection offered by the law on the Use of Empty Bottles for the National Industry. This law guarantees to the owner of an industrial model or design its benefits and commercial exploitation. The law states the following:

“The manufacturers of soft drinks, beer, liquor and other industrial liquid products of the country who offer their products in glass bottles can only use the empty bottles they elect for their own products and it remains forbidden for them to acquire, use or store for this purpose and for any other purpose new or used empty bottles corresponding to other manufacturers unless there is an express authorization of the latter sent by the most diligent party to the State Secretariat of Industry and Commerce and a notice to the public appearing in the daily newspaper.”

However, “small businesses or industries” may use, “in moderate quantities, as containers for their products, the empty bottles originally imported as containers for other liquids.”

## **REGISTRATION PROCEDURE**


Generally speaking, because Dominican legislation does not expressly contemplate industrial designs and utility models, the registration procedure is the same as for invention patents.

Thus, the following documents must be filed at the Patents Department of the Secretary of State for Industry and Commerce:

- formal drawings of the design or model;
- description of the drawings; and
- specifications and claims.

In addition, pertinent documents corresponding to both the applicant and inventor and a document of assignment of rights from inventor to applicant (if the applicant is other than the inventor) must be filed.

Dominican law also requires that “every manufacturer of soft drinks, beer, liquors or other industrial liquid products deposit



at the State Secretariat of Industry and Commerce two or three empty bottles selected for each product so that in cases of penal action and at the requirement of the Public Ministry, the mentioned Secretariat of State can contribute authorized information allowing the judicial authorities to establish whether there is a violation of the Law or not, taking into account the weight, size, shape and color of the bottles and their trademarks in high or low relief. The depositor will receive a descriptive certificate of the corresponding bottles.”

Consequently, the only requirement is a deposit, together with a letter of request duly signed by the representative of the proprietor of the container’s design in question or by a proxy, of two of the empty containers of the same at the Registration Department of Industrial Property.

After receiving this request, the department must issue a certificate describing the containers deposited and their ownership, on behalf of the petitioner.

## **PROPOSED BILL ON INTELLECTUAL PROPERTY**

The bill suggested by the World Intellectual Property Organization (WIPO) mentioned above contains a chapter dedicated to industrial designs. According to this bill, industrial designs are “any bidimensional or tridimensional form that, incorporated in a utilitarian product, gives it a special appearance and can serve as a type or model for its manufacture.”

According to this definition, the bill protects, under the denomination of industrial design, designs (images or bidimensional designs) and models (tridimensional forms related with the product). Additionally, the bill applies not only to containers and bottles, as in fact is the current state of Dominican legislation, but also to every model and industrial design.

The bill likewise establishes a new registration procedure and the necessary documentation for the corresponding request. The duration of the registration would be 15 years, nonrenewable.



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