

Latin America – Law Firms

Trademarks In The Dominican Republic: New Law, Expanded Protection

By Luis R. Pellerano

In the past few months, this column has examined patent and copyright protection in the Dominican Republic as it exists today, following the Dominican Republic's recent reform of its intellectual property system. New intellectual property legislation in the Dominican Republic also has enhanced the country's protection of trademarks.

Under the new law, a trademark is "any visible sign that serves to distinguish the goods or services of one enterprise from those of other enterprises." This general definition includes both trademarks and service marks. Other types of marks, such as collective and certification marks, also benefit from legal protection. Collective marks are those owned by an association whose members are authorized to use the mark after having met the levels of quality and other requirements set by the association. Certification marks apply to products or services of any party where the owner of the mark certifies that the products concerned meet certain established standards of characteristics or quality. Commercial slogans also may enjoy trademark protection in the Dominican Republic.

What May Serve As A Trademark

The Dominican law provides a non-exhaustive list of signs that may serve as trademarks. Trademarks may be, among other things, words, invented denominations, names, nicknames, commercial slogans, letters, numerals, monograms, devices, portraits, labels, shields, patterns, vignettes, borders, lines and bands, color combinations, and three-dimensional devices. Furthermore, the shape, presentation, or arrangement of goods or their packaging, or of the medium or place of delivery or rendering of the products or services, also may serve as a trademark.

The law makes no specific reference to audible signs, olfactory marks, or invisible (recognized by touch) signs, some of which have been recognized by certain jurisdictions, such as the United States.

Inadmissible Trademarks

Signs may be refused trademark protection on objective or subjective grounds. Objective grounds take into account the characteristics of the mark itself, while subjective grounds take into account its effects on the rights of third parties.

In general, signs that do not allow the product or service to be distinguished from similar products or services may not enjoy trademark protection. For the same reason, the following categories of signs are specifically excluded from registration: usual shapes of products or their packaging, shapes granting the product or service a technical or functional advantage, usual commercial denominations of any of the characteristics of the relevant product or service ("descriptive signs"), usual language or commercial denominations of the product, whether in general or in scientific or technical fields ("generic terms"), and isolated single colors.

Luis R. Pellerano is a Partner with the Dominican Republic law firm of Pellerano & Herrera. He regularly represents foreign investors in transactions in the Dominican Republic and throughout the Caribbean and Latin America. Mr. Pellerano may be reached at l.pellerano@phlaw.com. The firm may be reached at www.phlaw.com.



Luis R. Pellerano

However, in some of these cases the mark may be registered upon presentation of evidence showing that the sign deserves trademark protection for having acquired, after a period of constant use in the country, sufficient distinctiveness among the public and the concerned business circles.

Signs that might tend to deceive or mislead the public regarding the origin, nature, method of fabrication, qualities, use, consumption, quantity, or any other characteristic of products or services may not serve as trademarks. For instance, signs copying or imitating medals, awards, or quality control certifications may not be registered as trademarks because this will tend to mislead the public as to the qualities of the relevant products or services.

Trademarks also may not include denominations, flags, or emblems from a state or an international organization, nor copy currency notes, coins or stamps; signs that are contrary to public order, morality or laws, or which make fun of persons, ideas, religions, or national symbols also are prohibited.

Subjective Grounds

Signs may be refused trademark protection because they affect the rights of third parties, unless such party has granted its consent to the registration, in which case the applicant must file evidence thereof to the trademark office.

In general, signs that affect the personality rights of a person (name, signature, portrait, etc.), the name or prestige of a company or entity, or that infringe any existing copyright or industrial property right may not be registered as trademarks.

More specifically, signs that are identical or similar to other trademarks may not be registered. In this regard, the law includes registered trademarks, trademark applications, expired trademarks, in-use trademarks, and well-known trademarks or signs.

For well-known or famous signs, however, protection goes beyond the scope of confusing similarity. The new Dominican law recognizes that these are signs that are known by the public or business circles in the country, or in international trade, regardless of the manner or medium by which the sign has become known. In these situations, it is irrelevant whether the sign that copies, imitates or translates the well-known sign refers to the same, or to a completely different category of, products or services. It suffices that the use of the trademark might

lead (i) to confusion with the products or services of the well-known trademark, (ii) to a risk of association with that party, (iii) to an unfair advantage from the notoriousness of the sign, or (iv) to a loss of distinctiveness, commercial or marketing value of the sign.

Registration Procedure

Historically, trademark protection could be obtained on the basis of either use or registration, but today systems around the world generally combine both elements. Under the new Dominican law, the use of a trademark grants certain priority rights for registration, but the exclusive right of use arises only with registration.

In general, any physical or legal person may file for trademark protection. However, only companies or institutions, whether national or foreign, public or private, state, regional or international, may own collective or certification marks.

Registration of a given trademark is normally granted on a "first come first serve" basis. However, if the trademark has been in use in the country for a continuing period of at least six months, the user, if in good faith, has a right of priority to register the trademark. If used for more than six months by several parties, the person that has used the trademark for the longer period is entitled to registration. All of this is subject to the recognition of priority rights for foreign filings made in a relevant country within six months before the date of filing of the local application.

Contents Of A Registration Application

Applications for trademark registration must contain the following information:

- Name and address of applicant;
- Name and address of local representative, if applicable;
- Reproduction of the trademark;
- Products or services to which the trademark will apply, listed per class number pursuant to the relevant international classification scale;
- Any additional supporting documentation, such as an authorization granted by an affected party;
- Signature of applicant or legal representative; and
- Receipt of payment of fees, which amount to approximately US\$5.

In addition, for collective and certification marks the regulations for using the trademark must be filed along with the registration application. The regulations of use of collective marks must contain provisions on the common qualities of the relevant products or services, the conditions or modalities for using the trademark, the persons who will be entitled to use it, the mechanisms for controlling that the mark is properly used, and the sanctions for non-compliance. The regulations of use of certification marks must indicate the products or services that may be certified by the trademark owner and set the qualities to be guaranteed by the mark, as well as the mechanisms for quality control, both before and after an authorization for using the trademark has been granted. Furthermore, they need to be approved by the competent authority for the relevant products or services.

Term, Renewal And Amendment Of Registration

Trademark registration is granted for a ten-year-period, starting from the date of

registration. Registration may be renewed for consecutive ten-year-periods upon presentation of evidence demonstrating that the trademark has been commercially used. To this effect, the applicant must file a sworn statement explaining how and how often the mark has been used, together with documentary proof of these declarations.

Renewal applications must be filed six months before the date of expiration of the trademark registration, upon payment of the respective fees, or within a grace period of six months after the date of expiration, upon payment of the respective surcharge.

Exhaustion

The new Dominican law provides for the international exhaustion of trademarks. Trademark registration does not entitle its owner to prevent the trademark from being used by third parties with respect to legally marked products that have been put into the market, in the country or abroad, by the trademark owner or by a person economically linked to the owner, provided the products or their direct packaging have not been amended, altered, or deteriorated. An economic link exists between two persons when one of them may exercise directly or indirectly a decisive influence in the exploitation of the trademark, or when a third person may exercise such an influence on them.

This means that the new Dominican law does not allow a trademark owner to object to parallel imports of products marketed in a foreign country with the owner's direct or indirect authorization. It should be emphasized that countries providing only for national exhaustion do enable the trademark owner to oppose parallel imports, the limitation applying solely to products placed by the owner in their own territory, while other countries allow the owner to object to parallel imports in the event of a risk of confusion for the consumer as to the origin or qualities of the products.

Improper Use

It should be noted that, unlike other countries' statutes, the Dominican law makes no general reference to the improper use of a trademark as a ground for cancellation. Other countries provide, for instance, that a trademark may be canceled if the registered owner has provoked or tolerated its transformation into a generic term by improper use, such as using the trademark instead of the product designation or description, or using the trademark as a noun and not as an adjective.

Only in relation to collective and certification marks may the trademark become liable to cancellation if the owner has used the trademark, or allowed it by lack of action or control to be used by others, in a manner that is contrary to the relevant regulations, or that is capable of misleading the public as to the origin or other characteristics of the concerned products or services.

Conclusion

The Dominican Republic recognizes the importance of intellectual property to businesses. Toward that end, it has adopted new legislation that expands protections for patents and copyrights and, as indicated here, for trademarks. This is yet another step the Dominican Republic has taken over the years to demonstrate its openness – and desire for – investment from the United States and elsewhere.