



Trade Marks Prosecution Fact Sheet

Spanish Speaking Caribbean

1 Cuba	Page 2
2 Dominican Republic	Page 3
3 Puerto Rico	Page 4

1 Cuba

Type of filings	Both National and Madrid based applications are accepted
Priority	Paris Convention Priority can be claimed. Cuba is a party to the Paris Convention.
Single or multi-class	Both single and multi-class applications are accepted
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected
Term of initial registration	10 years from the filing date, which is also deemed to be the effective date of registration.
Renewals	<ul style="list-style-type: none"> • Due every 10 years with a 6-month grace period • Restoration is not possible
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • Simply signed scanned Authorisation of Agent in Spanish • Original notarised accompanying documents in Spanish where relevant to the particular type of filing to be made, e.g. assignment or licence agreements / certificates of merger • Priority-based applications (new filings only): a scanned copy of the certified copy priority document issued by the relevant IPO with simple Spanish translation

Observations

Cuba is party to several international trade mark agreements, including, but not limited to, the Nice Agreement, the Paris Convention, the General Inter-American Convention for Trademark and Commercial Protection, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), and the Madrid Agreement and Protocol, some of which proved to be powerful tools when a flurry of bad faith applications were filed in 2014 and 2015 by opportunists during a period of relaxed sanctions between the US and Cuba.

There are two stages to the Cuban examination process: formal examination (which includes specification review) and substantive examination on absolute and relative grounds. The opposition period commences on publication, which occurs in between the formal and substantive examinations. Therefore, any oppositions will be considered by the examiner during substantive examination. The overall registration process typically takes 2 to 3 years.

Office actions are commonly issued where the specification is not sufficiently clear and precise, the mark is considered to lack distinctiveness, and/or there is a likelihood of confusion with earlier applications/registrations (the OCPI takes a stringent approach).

Letters of consent and co-existence agreements may be submitted to try and overcome citations in respect of earlier identical/similar marks. However, chances of success depend on whether the examiner considers that the public may still be confused despite the agreement.

2 Dominican Republic

Type of filings	National
Priority	Paris Convention Priority can be claimed. The Dominican Republic is a party to the Paris Convention.
Single or multi-class	Both single and multi-class applications are accepted
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected
Term of initial registration	10 years from the registration date
Renewals	<ul style="list-style-type: none"> • Due every 10 years with a 6-month grace period • Restoration is possible at the discretion of the Registrar
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • Simply signed scanned Power of Attorney in Spanish • Original notarised accompanying documents in Spanish where relevant to the particular type of filing being made, e.g. Assignment or licence agreements / merger certificates; however, it is possible to submit a simply signed scanned declaration of change of name and/or address in Spanish to record this type of change • Priority-based applications (new filings only): a scanned copy of the certified copy priority document issued by the relevant IPO with certified Spanish translation
Observations	<p>The National Office of Industrial Property (ONAPI) uses TM Class and accepts goods and services in the Harmonised list of the EUIPO's TM Class Database: http://euipo.europa.eu/ec2.</p> <p>Office actions are seldom issued based on specification queries. Office actions are normally issued where there is a likelihood of confusion with earlier trade mark applications/registrations/company names and/or the mark is considered to lack distinctiveness. Letters of consent and co-existence agreements are generally accepted at the discretion of the examiner to overcome citations.</p> <p>New applications are typically processed within a year in straight forward cases.</p>

3 Puerto Rico

Type of filings	National. However, limited protection in Puerto Rico can also be obtained through a US federal trade mark registration.
Priority	Paris Convention Priority cannot be claimed
Single or multi-class	Single class only
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected
Term of initial registration	10 years from the filing date, which is also deemed to be the effective date of registration
Renewals	<ul style="list-style-type: none"> • Due every 10 years with a 6-month grace period • Restoration is possible at the discretion of the Registrar
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • No Power of Attorney is required for most filings • The nationality / country of incorporation and telephone number of the proprietor / their agent is always required • Use: Filings can be made based on intent to use or actual use in Puerto Rico: <ol style="list-style-type: none"> i) If filing based on use, the date of first use in Puerto Rico and proof of use specimens showing use of the goods or services must be provided ii) If filing based on an intent to use, a Statement Establishing First Use must also be filed within three years from the date of filing of the trade mark application iii) In all cases, further proof of use evidence must be submitted between the fifth and sixth years following the filing/registration date and again on renewal • Scanned copies of accompanying documents are required where relevant to the particular type of filing to be made, e.g. <ol style="list-style-type: none"> i) Assignment or licence agreements ii) Companies Registry certificates certifying changes of name / address / mergers • All documents may be filed in Spanish or English
Observations	<p>It can take up to 2 years for trade mark applications to be processed in straight forward cases.</p> <p>Office actions are common in respect of new filings and typically concern:</p> <ul style="list-style-type: none"> • specification queries • requests for disclaimers in respect of any descriptive words and/or words lacking distinctiveness • requests for a description of any design/colour elements of the mark (note that if filing in colour, a colour claim must be included with a description of the colours on the application form (Pantone codes are not required); if the applicant prefers not to file with a colour claim, the mark must be filed in black and white • a likelihood of confusion with earlier similar applications/registrations