

Client Alert

September 2015

Trademark Registration in Cuba

As the US diplomatic relationship with Cuba continues on its path of normalization and the possibility for increased economic opportunities for US companies with the island increase with the potential further loosening of restrictions prohibiting engaging in business in Cuba, US businesses looking at the Cuban market have begun taking steps to register their trademarks in Cuba. If this is a possibility for your business, then you should consider protecting your trademarks in Cuba because Cuba is a “first to file” jurisdiction, which means a Cuban trademark registration will be awarded to the first applicant, even if that applicant has not previously used the mark. Presently, US businesses may register their trademarks in Cuba in one of two ways. First, a national trademark application may be filed with the *Oficina Cubana de la Propiedad Industrial* (OCPI) — the Cuban counterpart to the US Patent and Trademark Office (USPTO). Alternatively, a US business that currently owns a US-registered trademark may file an international application based on the US registration through the Madrid Protocol Treaty.

Filing a National Trademark Application in Cuba

The US Department of the Treasury’s Office of Foreign Assets Control’s (OFAC) Cuban Assets Control Regulations (CACR) permit the filing, prosecution and renewal of any application for a patent, trademark or copyright issued by the Cuban government, as well as related filings or prosecutions of opposition or infringement proceedings. 31 C.F.R. 515.528. As a result of this general authorization, US businesses may avail themselves of the local process for filing trademark applications in Cuba.

To file a national trademark registration application in Cuba, you must use the assistance of an official local agent (*Agente Oficial de la Propiedad Industrial*). Prior to filing the trademark application, performing a search for the mark or any similar marks that may be registered, to ensure that there are no conflicts, is recommended.

The application process includes a formal examination and a substantive examination of distinctiveness. After the formal examination but prior to registration, the trademark application is published in the Industrial Property Bulletin (*Boletín Oficial de la Propiedad Industrial*). Any interested party has 60 days from the date of circulation of the Industrial Property Bulletin to oppose such application. After the publication and if no opposition is filed, OCPI will perform its substantive examination. If the trademark application is granted, the trademark registration fee must first be paid to OCPI before the trademark will be registered. If the concession fee is not paid, the application for the trademark will be considered abandoned.

A trademark registration in Cuba is valid for 10 years and is renewable for additional 10-year periods. However, if the trademark has not been used within three years of the date of registration or has not been used for a continuous period of three years, it may be subject to cancellation.

Filing an International Application through the Madrid Protocol Treaty

Cuba is a signatory to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol Treaty), which allows existing trademark holders to file one application with a single office in order to register the trademark in multiple jurisdictions. No official local

agent is needed to file the application. Although an international registration may be issued, each country retains the right to determine whether or not protection for a mark will be granted within its territory.

If you already have filed a trademark application or have a trademark registration issued by the USPTO, then you can submit an international application through the USPTO, which in turn forwards applications that meet all applicable requirements to the World Intellectual Property Organization (WIPO). WIPO conducts a formal examination of the international application. Once approved, a mark is recorded in the International Register. The local intellectual property offices in the territories in which the applicant seeks protection, such as Cuba, then undertake a substantive examination of the application and determine whether to protect the mark.

Conclusion

For some US businesses, trademark registration in Cuba may be the initial step before engaging in business in the island. In doing so, they must comply with the US and Cuban law. With two alternate methods to register trademarks in Cuba available to protect the mark, businesses must decide which method is preferable for them.

The Latin America group at Hunton & Williams LLP will continue to closely monitor related developments. Please contact us if you have any questions or would like further information regarding the registration of trademarks in Cuba or any other change to the regulations and sanctions governing the Cuban embargo. This client alert was prepared in collaboration with the law firm of Uría Menéndez and their attorneys licensed to practice in Cuba, with whom Hunton & Williams frequently partners on Cuba-related matters.

Contacts

Gustavo J. Membiela
gmembiela@hunton.com

Uriel A. Mendieta
mendietau@hunton.com

J. Michael Martinez de Andino
mmartinez@hunton.com

Rail Seoane
rseoane@hunton.com