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A new dawn for IP enforcement

Yumari Torres de Guerra and **Deborah Guzmán I** provide an update on the state of IP rights and enforcement in the Dominican Republic

The changing global economy and rapid advances in the sphere of intellectual property mean that IP systems demand more efficient protection measures. The Dominican Republic has undertaken this challenge by providing a balance between the necessary legal framework and a reliable institutional structure.

The country has seen significant progress in the protection of IP. There is no doubt as to the relevance of IP for the country's economic development and as an essential component in the interaction with other markets. With the introduction of the concept of IP as a guaranteed right in the Constitution of 1854, the government began restructuring the national agencies to meet the growing need for enforcement.

Border enforcement

In the implementation of border measures, the General Customs Office of Dominican Republic (DGA) has been playing a crucial role. The DGA has taken precautionary measures for the protection of IP rights, such as the creation of several units for enforcement of DR-CAFTA, including a new Intellectual Property Department. It also has implemented educational workshops to train personnel for detection of false or forged cigarettes, an industry that generates income of \$500 million dollars per year, and where 7% of its world sales belong to false or forged brands.

Moreover, the DGA occupied the last presidency of the regional group on Intellectual Property in the Customs World Organization, whereby said institution, acting as a representative of the Dominican Republic, posed the need to create a task force in charge of fighting piracy, and in general, strengthening the battle against infringements in intellectual property.

Among other entities that in recent years have also improved their implementation of measures for the protection of intellectual property rights is the National Office of Industrial Property (ONAPI), the

trade marks and patents office of the Dominican Republic. The ONAPI is one of the few government entities that have earned the ISO certification 9001, which sets out standardised requirements for a quality management system, and has also received the National Quality Prize 2008 for being the government office with the most outstanding service standards. Also, the National Office of Copyrights (ONDA) is working on developing an efficient system for copyright protection. The Department of Drugs and Pharmacy of the Ministry of Public Health and Social Assistance (SESPAS) has started an aggressive battle against counterfeit drugs in favour of protection of pharmaceutical patents; and the Department of Intellectual Property, Telecommunications and E-Commerce of the Attorney General's Office of the Republic, whose duty has been directed mainly in the last years towards continuous work of inspection of accounting and seizure of equipment in companies using software programs illegally.

Copyrights

Copyright protection is governed by Law 65-00 on Copyrights, as amended by Law 424-06 pursuant to the implementation of DR-CAFTA. Article 2 of Law 65-00 extends the scope of protection "to literary and artistic works, as well as the literary or artistic form of scientific works, including all creations of the spirit in the above fields, in any manner of expression, disclosure, reproduction or communication, or genre, merit, or destination".

Regarding violations of copyrights, the owner of a copyright or similar right, his successors or whoever represents them is presented with the decision of choosing civil, criminal or administrative actions to prosecute the offenders. Sanctions range from six months to three years in prison and fines range from RD\$10,000 to RD\$1,000 monthly minimum salaries.

The Second Courtroom of the Civil and Commercial Chamber of the First Instance Court of

the District of Santiago, in a case of alleged infringement filed by Franklin Romero, producer of the film “Sanky Panky”, against Transporte Espinal, declared: “FIRST: the claim for damages brought, as legal and valid regarding formalities. SECOND: condemned the accused party and ordered the payment in favour of Franklin Romero of RD\$500,000.00”. Transporte Espinal was accused of violating article 20 of Law 65-00 that provides that reproduction,

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distribution, public communication or other manner of partial or total use of the film without consent of its producer is illicit.

Article 185 of Law 65-00 also provides that, when the owner of a copyright or similar right, his successors or whoever represents them, has reasons to believe there is an import or export of merchandise that affect the copyright or similar rights thereof, they can request suspension of the shipment for free circulation.

The courts are familiar with such petitions and have

ordered on a regular basis the suspension of alleged counterfeit merchandise. In that respect, Resolution No. 9-03, August 20, 2003 states that: “Notwithstanding the wide powers granted by LDA and RLDA to ONDA for implementation of preventive and precautionary measures to avoid infringement of rights as stated by such Law, Article 185 thereof authorises DGA to order suspension of the goods shipment (to take measures in the borders) when there are valid reasons to believe

there is a goods import or export taking place, that damage the copyright or similar rights, and ordering the notification of such measures to the recipient of such goods, so that he can go to the competent courts to request for modification or revoking thereof”.

Industrial property

The Dominican Republic, in compliance with the provisions stated in the DR-CAFTA, has implemented in its legal system civil procedures and actions for the observation of industrial property rights and their enforcement.

Although the legal framework on Industrial Property, Law 20-00 in effect since May 8 2000, acknowledges the Trade-Related Aspects of Intellectual Property Rights (TRIPS), an amendment was necessary through the above mentioned Law 424-06, to make it

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suitable to the industrial property regime provided in DR-CAFTA.

Law 20-00 provides that the holder of a right protected shall be entitled to file a civil action before a competent court against any person infringing the acquired right. The holder can also act against the person carrying out actions that evidently manifests the imminence of an infraction. Likewise, the law provides that the liability of the action shall be extended to those who order or provide its execution, to the legal representatives of companies, and to all whom, knowing the unlawfulness of the action, take part in it, facilitate its commitment or conceal it.

The legal system, with the purpose of eradicating violations in the intellectual property field, has established a series of precautionary measures that can only be ordered by a Court. Among the measures that the Courts may adopt, with the assistance of the Intellectual Property, Telecommunications and E-Commerce Department of the General Attorney's Office of the Republic are the following:

- Confiscation of the goods presumably forged and the materials and accessories used for the execution of the offence, as well as any material related with the offenders' activity and the relevant documented evidence of the offence;
- Seizure of all the materials related with the activity of the offender;
- Seizure and destruction of any forged goods, without any compensation to the defendant;
- Donation for charity of the goods pertaining to the forged brands, and counterfeit copyright goods and related rights, prior authorisation granted by the right holder;
- Order the offender to provide any information regarding any person involved in any aspect of the offence and concerning the production means or distribution channels for the products or offender serv-

ices, including the identification of third parties involved in its production and distribution and its distribution channels, and provide this information to the holder of the right.

Accordingly, the Second Courtroom of the Criminal Chamber of the Court of First Instance of the National District, in a case of alleged infringement filed by Colgate Palmolive Company against Shun Pu Ho Lip, condemned the accused party and ordered: "the imme-

"Public institutions still face an arduous task in preserving and protecting IP rights"

diately and final cease of the import and trading of all kinds of dental paste of the trade mark COLGA, object of this process ... and ordered the destruction of the goods confiscated of such dental toothpaste COLGA".

Moreover, among the applicable criminal sanctions for intellectual property infringements are reformatory imprisonment of six months to three years, and a fine of RD\$50,000 thousand to RD\$1,000, or both penalties for those intentionally participating in any of the activities classified as infractions by Law 20-00.

The Dominican Republic has come a long way, establishing measures and entities oriented for the safekeeping of the protection of intellectual property rights. It can be ascertained that the legal framework in force in the Dominican Republic places in the hands of the right holder the necessary tools for the effective protection of their intellectual property rights and the public institutions created are implementing and enforcing the dispositions set forth. However, the public institutions, including ONAPI, ONDA, DGA and the Intellectual Property, Telecommunications and E-Commerce Department of the General's Attorney's Office of the Dominican Republic, still face an arduous task in preserving and protecting IP rights.