RUSSIN, VECCHI
& HEREDIA BONETTI

Patents and Distinctives Signs

Within the Training Protection of Works, Patents and Distinctive Signs
Given on April 24, 2020

INDUSTRIAL PROPERTY

Industrial property rights are permits or authorizations that the State, specifically the National Office of Industrial Property (ONAPI), grants to its creator or owner, for the exclusive use and economic exploitation of its creation, be it patents, designs or distinctive signs for a determined period of time and to prevent third parties without authorization, from using its creation and benefiting from it.

Patents are granted for a period of up to 20 years and initially, they cannot be extended, while trademarks and trade names are granted for 10 years and can always be renewed.

All these industrial property rights are territorial. That is, the owner has protection only in the country where he registers and uses them. Therefore, if you want a more extensive protection, you should look for the markets of your interest and register them there. It is important to emphasize that since you are being given the right to an exclusive use, the owner has to use it and if he does not use it, it can be cancelled in the case of trademarks and names or given to a third party to exploit them for him, as it happens with patents.

In addition, we must say that these rights are based on a system of advertising, since all applications for registration will be advertised before or after being granted so that any person who has a previous registration and who understands that this new application is equal or similar to his trademark or patent already registered, will oppose and ONAPI will decide whether or not such opposition, proceeds.

INVENTION

Is every idea or creation of the human intellect that intends to solve a technical problem. It can be a product or a procedure.

Inventions are protected by registration at the National Office of Industrial Property (ONAPI) who grants a certificate of "patent of invention" after analyzing compliance with the requirements contained in the law, which are mainly: NOVELTY: that is to say that there is nothing like it before created in the country or in the world; (ii) that it has INVENTIVE LEVEL: That it is not obvious or evident for a person knowledgeable of the area of the object of the invention at the time it was requested. Remember that the person who will evaluate the application is who dominates the matter, object of his invention and will review what exists in the "state of the art" at the time of filing your application and will determine if you have actually invented something; (iii) INDUSTRIAL APPLICATION: that can be used in a productive activity such as fishing, mining, pharmaceutical industry, food industry, etc.

With respect to novelty, it is convenient to note that it is possible that a product or medicine for malaria has been invented, as we are seeing with the medicine hydroxychloricine and it turns out that it is now being discovered that it also works for Covid-19. It was novel when it was invented more than 70 years ago. Now it simply has a different use, but it is no longer new and therefore, according to our law, it cannot be patented for that new purpose.

Likewise, when that patent called **"hydroxychloricine composition and its preparation method",** was applied for in 1949, it was not obvious that its components could be joined and have a result for malaria treatment. At that time, it had an inventive level. Today that composition is obvious and you would not be solving a technical problem, and for that reason, it is not patentable either.

We note that there are some things that according to our law cannot be patented. For example, things as they exist in nature, computer programs, (these are protected by copyright), therapeutic or surgical methods for human or animal treatment, as well as diagnostic methods; inventions that may cause damage to the environment or health.

In plain words let's see how the patent system works:

A person has an idea, develops it, and manages to patent it as a **"formulation of acetaminophen for the relief of joint pain"** that we know commercially under the brand name Tylenol. During the 20 year term of the patent, the patent holder will have no competition and all laboratories or pharmaceutical companies that want to sell **"acetaminophen formulation for the relief of joint pain",** will have to buy it from the patent holder or come to an agreement with him to assign his formulation in exchange for the price. During those 20 years, anyone can search the scientific publications on how the **"formulation of acetaminophen for the relief of joint pain"** was made to continue research and perhaps improve it, and even apply for a new related patent, provided it is something new, with an inventive level and industrial application or wait for its patent to expire, so that they can manufacture and market the same product, but under their own brand. For example, under the name of Tempra or Panadol.

The application for registration of a patent can be made directly by the inventor or applicant. However, due to the required formalities, it is advisable to seek the advice of your lawyer and a technician in the area of the invention who will collaborate with the drafting and preparation of the documents that are part of the file. Meaning you will be disclosing your invention to ONAPI to be examined and determined if it is patentable or not.

Patent examples of invention, we will say that not so complicated: "Composition for cleaning, with natural components origin" (disinfectant). https://patentimages.storage.googleapis.com/74/9a/df/a451f85a596e1c/US6432395.pdf

"Potato tortilla type food product, or scrambled potato or other ingredients, partially precooked and procedure for its preparation" (the recipe of how to make a Spanish tortilla). http://www.oepm.es/pdf/ES/0000/000/02/13/20/ES-2132039_B1.pdf

UTILITY MODEL

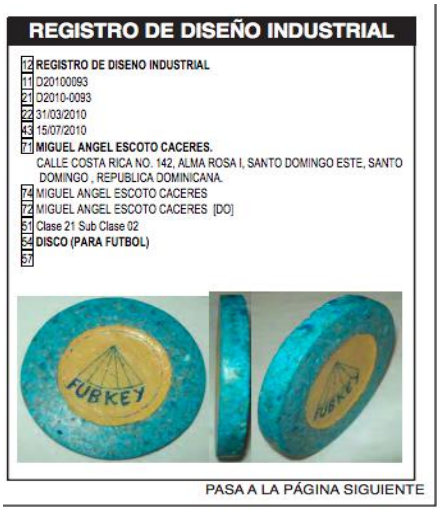
They are simpler patents, in the sense that they refer to the new form, configuration or arrangement of elements of some device or part of the object, which allows a better or different operation. In other words, they provide an object with some advantage or utility that it did not have before. Utility models do not protect procedures or substances or compositions. They are valid for 15 years and, like invention patents, are subject to the payment of maintenance fees.

I found as an example, a Dominican utility model patent called, SPECIALIZED CONCRETE BLOCK, which was registered in 2010, INDUSTRIAS AGUAYO DE CONSTRUCCION, SRL, and was invented by Jorge Aguayo Saladin. In which the inventor was presented with a problem in his daily life and found a solution according to his summary published in www.onapi.com:

"The present invention consists of a specialized concrete block, of the rectangular type with hollow sections used in construction, which contains a lateral groove that allows easy insertion of the rod and placement of the block in the rod column, without having to cut rod sticks for subsequent tie, or having to climb great heights for those purposes, by allowing the block to be placed laterally. This saves time and steel in the installation, maintains the integrity of the steel rod, eliminates the cost of man-hours required to cut and join each rod stick, and provides physical safety for the mason, reducing the risk of accidents and avoiding fatigue.

INDUSTRIAL DESIGN

On the other hand, an industrial design is any gathering or combination of colors or any external two-dimensional or three-dimensional shape, which is incorporated to an industrial or craft product to give it a special appearance, without changing the destination or purpose of such product. In other words, the external appearance must be new and unique. It does not protect the technical aspects. The validity of an industrial design is five (5) years from the date of application and can be renewed for two periods of five years, each by paying the corresponding fees.


REGISTRO DE DISEÑO INDUSTRIAL

(12) REGISTRO DE DISENO INDUSTRIAL
(11) D20100093
(21) D2010-0093
(22) 31/03/2010
(45) 15/07/2010
(71) MIGUEL ANGEL ESCOTO CACERES.
CALLE COSTA RICA NO. 142, ALMA ROSA I, SANTO DOMINGO ESTE, SANTO DOMINGO , REPUBLICA DOMINICANA.
(74) MIGUEL ANGEL ESCOTO CACERES
(72) MIGUEL ANGEL ESCOTO CACERES [DO]
(51) Clase 21 Sub Clase 02
(54) DISCO (PARA FUTBOL)
(57)

PASA A LA PÁGINA SIGUIENTE

E.g. Antonio Meucci's Telephone or Teletrófono invented in 1854, where we see invention patents, utility models and industrial designs.

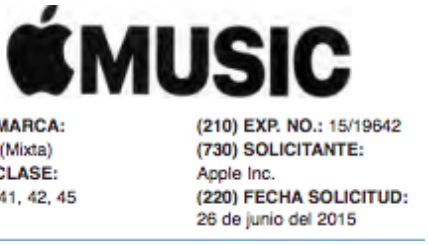
In 1876 Alexander Graham Bell, who, according to history, stole his invention from Meucci, obtained his patent called Improvement in Telegraphy, which was a "method and apparatus for transmitting vocal and other sounds telegraphically" This was because Meucci, publicized his invention without registering it and then did not have the economic resources to claim in justice. Moral, if you have an idea, when in doubt, take advice and apply for registration. If it is not patentable, then continue your research and if it is, perhaps you have invented the telephone.

DISTINCTIVE SIGNS:

It is the sign with which we recognize in trade those products that have been patented or that are in the public domain. You do not go to the pharmacy and say give me a **"formulation of acetaminophen for the relief of joint pain"** but you say, give me the branded product Tylenol. Nor will you say let me go to an interactive online website that offers a listing and temporary hosting rental" you will say let me go to the brand website airbnb.com

A **trademark** is any visible sign capable of distinguishing the products or services of one company from the same products or services of other companies: Coca Cola and Pepsi Cola. You are aware that one Coca-Cola Company **factory** and the other Pepsi Co. The mark tells you the origin of that product, who the **factory** is and allows you for your second purchase, to choose **which** of the two you liked best. From the manufacturer's point of view, it makes the consumer identify your product. That is why it is important that it is original and distinctive and does not resemble that of your competition. They are those in words, (Coca Cola, which is the combination of its two original ingredients: coca leaf and cola nut) fancy names (a word you invented), names (Oscar de la Renta), commercial slogans (If it's Goya it has to be good) letters, numbers, (7Up), portraits, (a person's face like Gerber's compote) labels, among others.

The brands can also be figures,  or the Apple apple and can be mixed, combining figures and words like:



When you are going to apply for registration of your trademark, having checked that it **is original and not going to be confused with that of the competition**, in the application to be filed with the ONAPI, in addition to your name and the description of the trademark, if you have a design, you must specify for which products or services you seek protection (the same as when you are going to apply for your trade name). Because you will not have exclusivity to use your trademark in the universe of products and services, but those that you protect in your registration and what you actually market with that mark.

That is why we see that there is a Banco Popular brand for financial services and a Ferreteria Popular brand for the sale of hardware and construction articles or the National and Cigarettes National newspapers.

What cannot happen is that two identical or similar trademarks are registered and on the market for the same products and services. For example, LA ESMERALDA and ESMERALDA for rice, because the consumer could confuse one product with the other or believe that both products are manufactured by the same person. In that case the owner of the primary registration, at the time the application for registration of the trademark Esmeralda is published by ONAPI (if not objected by it first) the owner of LA ESMERALDA will oppose.

But let's imagine that ESMERALDA does not apply for a registration because it knows that it will not prosper and what it expressly wants is that people get confused and are already selling their product with a similar brand or even with their brand (i.e. a counterfeit). In that case the primary owner goes to the Public Prosecutor's Office, files a complaint or lawsuit to prosecute that infringer, who may be punished by closing his business, seizing that fake merchandise and may receive fines and prison sentences. As well as paying the primary owner a compensation.

Turning to another distinctive sign, we find the **trade name** which is the name, denomination, designation or abbreviation that identifies a company or establishment.

Examples:

PUBLICACION REGISTROS SIGNOS DISTINTIVOS

(NOMBRES COMERCIALES)

Esta publicación incluye todas las solicitudes con pago de publicación recibidas del 9 al 22 de Septiembre del 2015

[210] EXP.	[220] SOL. FECHA	[561] NOMBRE COMERCIAL	[510] ACTIVIDAD	[730] SOLICITANTE	[111] REGISTRO
2E/2011-18496	28/7/11	CLINICA DENTAL DRA. WENDY SHEPHARD BAEZ DE COLE	SERVICIOS ODONTOLOGICOS EN GENERAL.	WENDY SHEPHARD BAEZ	318713
E/2012-20340	10/8/12	FUNDACION IMPLANTES SIN FRONTERAS, FISF	ENTIDAD SIN FINES DE LUCRO, DEDICADA A BRINDAR SERVICIOS DE IMPLANTES DENTALES, SALUD BUCAL, A PERSONAS DE ESCASOS RECURSOS	JOSE ADAN FRANCISCO GUZMAN COMPRES	419608
E/2012-18831	04/9/15	GRUPO SALUD & AGUA-GRUSA	SERVICIO DE SALUD DE ATENCION PRIMARIA; PROCESAMIENTO DE AGUA PURIFICADA, HIELO.	SANTIAGO FERNANDO GUANCE	419242
E/2009-2893	11/2/09	HIDROMAX	BOMBAS PARA AGUA, POZOS, VENTAS Y SERVICIOS.	PEDRO HERIBERTO ESPINAL TAVERAS	266586
E/2008-28057	01/7/08	TRANSPORTE HERRERA PERALTA	TRANSPORTE DE MATERIALES DE CONSTRUCCION.	FELIX ALBERTO DE JESUS HERRERA PERALTA	254661

When the names have graphic elements and serve to identify the establishment, it is called a label (like the one on all Bon Ice Cream stores or Gas Pumps).

We remind you that names and brands are registered for 10 years and can be renewed after that period, indefinitely.

Another distinctive sign is the **geographical indications**. These are the names or denominations that identify a product as originating from a certain territory or place, and that, because they are from that place, have special characteristics. If in addition to the place there are natural and human factors, such as a historical culture of cultivating the product in a particular way, the geographical indications are called, denominations of origin.

For example, "Tequila" "Rioja" "Ribera del Duero" "Café Valdesia" (which is cultivated in Ocoa, Peravia and San Cristóbal), "Café Barahona" (Barahona, Pedernales, Bahoruco and Independencia), "Oro Verde de Cambita", (Province of San Cristóbal), "Café Juncalito" (Municipality of Janico in Santiago de los Caballeros)".

Then, a group of people from that region, an association or a regulatory body, draw the guidelines to follow, that is, the regulations to manufacture that product and authorize the people from that area to use that distinctive sign on their products (in addition to their trademark), provided they comply with the regulations, so that consumers know that it is from that area and that it has the special characteristics. To see an example of the specifications of a designation of origin go to valdesia.com. If you include a false geographical indication on the label of your product, the association can sue you to stop that use and repair the damage that this unauthorized use has caused.

This is one of the only rights that in is not a creation but arises from the place where it occurs and does not have a defined term date. As long as the conditions are maintained, and the product has the characteristics indicated in the regulations, the record is maintained over time.

CONTRACTS CONCERNING INDUSTRIAL PROPERTY RIGHTS

Like all movable goods, patents, trademarks, and all industrial property rights can be traded, sold or "rented", i.e. licensed for use for a certain period of time. These businesses can be free of charge or in exchange for an economic consideration. Likewise, they can be inherited.

In case of assignment or sale, when we sell a car, we draw up our written contract, identify the contracting parties, describe the object of our sale, clarify when the registration certificate of that right expires, and set the conditions of price and date of payment. Instead of registering it at the DGII (the car) you register it at the ONAPI. It is the same. Obviously, you will be advised by your lawyer in the drafting of this document.

Likewise, when we grant a license, we must establish in our contract, at least the following:

1. Identification of the parts
2. The Object: sale or license of use
3. Whether it is exclusive or not
4. Territorial scope of use: I may allow you to market my invention (disinfectant or acetaminophen composition) in the Dominican Republic and another person to market it in Haiti (remember that you must have it registered here and in Haiti because the rights are territorial and if you do not have it registered in Haiti, there is public domain).
5. The quality standards and use in a general sense.
6. Period of validity of the agreement, which obviously must be equal or less than the time of registration of the right.
7. Penalties for non-compliance (e.g. early termination and payment of compensation)
8. Applicable legislation and competent jurisdiction.

These licenses and transfer of rights must be registered with ONAPI so that everyone knows who the new owner of my creation is or who I have given permission to exploit it commercially. Whoever I have not sold or licensed my right to, cannot use it and the owner shall have the right to prevent such unauthorized use and to request in justice that he be punished with fines, imprisonment and payment of compensation for the damage caused by such unauthorized use, among others.

Finally, practical example of IP contracts and all IP rights in one product:

It turns out that the University of Florida soccer team is having trouble with the athletes' performance and the university's science team started looking for something to hydrate them and discovered a formula they call **"composition and method to achieve a better physical response when exercising"**. The team of inventors wants to sell it and patent it in their name, because after all they invented it, but the University of Florida when it finds out says, yes you invented it, but you invented it in my lab and with my equipment. In other words, I also participated in the result. So, they agreed, not so easy, but they agreed and created a fund in which the inventors, the University, and the company they d to manufacture and market the product, receive income from sales. That happened in 1965 and that product is called GATORADE

By 2015 inventors and their families had received more than $1 billion in profits and the University of Florida, in 2015 alone, according to a report by ABC News Go, reported about $280 million in profits from those sales of which it accounts for 20%. GATORADE's patent has already expired, meaning that other people can sell the product formulation under another brand, but the GATORADE brand, the designs, the good name of the product continue and so do the profits.

What rights do we see here?

1. Patent: "composition and method to achieve a better physical response when exercising".
2. Word mark: GATORADE
3. Mixed Brand 

4. Another mixed brand: the full label 

5. Three-dimensional brand: The bottle, which if it meets the necessary characteristics could also be an industrial design.
6. We see a contract of assignment of rights or agreement between the inventors and the university and also the company that markets the products.
7. We see the trade name Quaker Oats Company, which is the company that markets the product.
8. We also see sponsorship contracts for soccer teams (or any team) to use the brand on their uniforms in exchange for Gatorade paying them money for that advertising and for the consumer seeing that Gatorade is good for exercise because their favorite team drinks it and therefore buys it.
9. Which else do you see?

In that bottle of GATORADE we see the industrial property rights, the profits they generate and we see the importance of protecting and registering them in a timely manner.

Prepared by:
Mónika Fiallo Paradas (mfiallo@rvhb.com)
Russin, Vecchi & Heredia Bonetti
www.rvhb.com
Monte Mirador Building, 3rd. Floor
Calle El Recodo No. 2, Santo Domingo, 10108
República Dominicana
+1 809 535 9511