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TRADEMARK PROTECTION: STRATEGIES FOR CUBA – NOW

March 31, 2015

Following President Obama's December 2014 announcement of a relaxed policy towards Cuba, many companies await the opening up of the Cuban market. Some steps can be taken now to protect a company's valuable trademarks and other IP in Cuba.

An exception to the long-standing US embargo on trade with Cuba permits US companies to file for and obtain trademark registrations in Cuba. US companies should consider taking immediate action to protect their trademark rights in that country. Doing so is advisable because Cuba is a "first to file" jurisdiction – in other words, a Cuban registration for a trademark will be awarded to the first applicant, even if that applicant has no legitimate claim to the mark.

An applicant does not have to use the mark in Cuba, or even plan to expand its business into that country, before filing an application for trademark registration. Proactively seeking a Cuban trademark registration now will help ensure that the mark is available when trade with Cuba is allowed. Applying for trademark registrations now also will help avoid later conflicts with counterfeiters or serial infringers who may try to beat legitimate trademark owners to the registration punch.

How to Apply for a Trademark Registration in Cuba

There are two ways to apply for a Cuban trademark registration: (1) if a US company owns a current US trademark registration, a Cuban application can be based on the US registration and filed through the international Madrid Protocol treaty; or (2) a national Cuban trademark application can be filed through local trademark agents with the Oficina Cubana de la Propiedad Industrial (OCPI), the Cuban equivalent of the US Patent and Trademark Office.

A Cuban application is screened against existing registrations granted by the Cuban OCPI. As in the US, applications that conflict with existing registrations will be rejected.

The IP exception to the embargo allows US businesses to pay filing fees and retain local agents in Cuba in order to protect their intellectual property rights. In addition to obtaining trademark registrations in Cuba, US companies can seek patents in Cuba. US companies also are permitted to litigate or take other steps to protect their copyrights, trademarks and patents from infringement in Cuba. Lawyers in our Intellectual Property & Technology Practice Group can assist clients with all of these activities.

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Cuba Task Force

In addition to our capabilities in intellectual property and technology, our Cuba Task Force--a globally integrated, full-service team of lawyers and specialists--have broad expertise in a wide range of regulatory areas, including enforcement actions. In addition, we have a deep understanding of Congress and the ways in which it will drive developments in Cuba. With this deep expertise and a feel for the pulse of policy and regulatory developments, we can help companies seize potential business opportunities. Our Task Force experience is further enhanced by more than 30 years of knowledge in assisting emerging economies and market liberalization around the globe.

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