

# Intellectual Property 2018

# **Dominican Republic**

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Mary Fernández and Gabriella Paulino  
Headrick Rizik Alvarez & Fernández

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Reference

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Mary Fernández and Gabriella Paulino  
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### 1 What are the novelty or inventiveness requirements for a patent to be granted?

An invention is novel when it does not exist in the prior art. This includes everything that has been disclosed or made accessible to the public, in any place in the world, by means of a publication in tangible form, oral disclosure, marketing, use or any other means, before the date of filing of the patent application in the Dominican Republic or before the date of filing of the foreign application whose priority is claimed.

An invention has inventive step if to a specialised person or expert in the corresponding technical field, the invention is neither obvious nor evidently derived from the relevant prior art.

### 2 What are the criteria for considering whether an invention is obvious in view of prior art?

The criteria for considering whether an invention is obvious in view of prior art may be complex. In principle, comparing one or more pieces of prior art with the invention and then analysing both similarities and differences may aid in determining the obviousness of the invention.

### 3 What are the different types of patent protection that can be obtained in your country, for example, utility, design database? How do these types of patent protection differ?

Under Dominican law, patents may be obtained to protect inventions, utility models and industrial designs.

Inventions are understood as any idea, creation of human intellect, capable of being applied to industry. An invention may refer to a product or to a procedure.

A utility model is considered to be any new form, configuration or arrangement of elements of any device, tool, instrument, mechanism or other object, or some part of the same, which permits better or different functioning, utilisation or manufacture of the object incorporating it, or which gives it some utility, advantage or technical effect that it did not have before. This protection is only available to products, thus excluding procedures.

Whereas an industrial design is considered to be any arrangement of lines or combination of colours or any

two-dimensional or three-dimensional outward shape embodied in an industrial or handcraft product, including, inter alia, parts intended to be assembled into a complex product, packaging, presentation, graphic symbols and typefaces, except computer programs, intended to give the product a special appearance without the intended use or purpose of the product being thereby changed.

### 4 What is the duration of patent rights protection?

Patent protection has a duration of 20 years counted from the date of filing of the application in the Dominican Republic. However, pursuant to the Dominican Republic–Central America Free Trade Agreement (DR–CAFTA) and Dominican Republic IP Law 20–00, an extension of the term of patent term may be granted when the patent is issued on or after 1 March 2008, can be requested in order to compensate for unreasonable delays attributable to the governmental authorities in the following cases: (i) the patent granting process (patent term adjustment or PTA), or (ii) the issuance of the marketing approvals (MA) for the first commercialisation of the pharmaceutical product in Dominican territory. To qualify for a PTA, the patent application must have suffered a delay attributable to the National Office of the Industrial Property (ONAPI) of more than five years from its filing date or three years from the date of payment of the merit examination fee. In the case of marketing approvals, the extension is permitted for delays attributable to the Ministry of Health of more than two years and six months from the time of filing for regulatory review.

The extension is equivalent to one day for each day of delay, and can be obtained for a maximum of three years. PTA should be requested within 60 days from the issuance of the patent or the marketing approval.

The patent for utility models expires in 15 years from the filing date of the application in the Dominican Republic.

The registry of an industrial design expires after five years from the filing date of the respective application at the National Office of Industrial Property. The registry of an industrial design may be extended for two additional periods of five years each by payment of the established extension fee.

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**5 If an invention is conceived in your country, does the first filing have to be made there?**

No. International patent applications are possible.

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**6 What are the foreign filing licence requirements if an application conceived in your country is filed first in another?**

Dominican Law does not establish foreign filing licence requirements for patent applications conceived in the country but filed abroad. The Dominican Republic is a party to the Paris Convention and Patent Cooperation Treaty (PCT). To protect an invention, foreign patent applications can be filed using the Paris route or the PCT route. Depending on which pathway is chosen, the applicant will have 12 months or 30 months before having to initiate the procedures for the national phase and complying with local requirements.

The minimum documentation consists of: application form, description, claims, summary, figures (if applicable), payment of official fees, priority claim declaration, priority certified copy, power of attorney, assignment documents and drawings (if applicable).

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**7 Are business and computer methods patentable? If yes, what are the standards for determining this? If no, are other technological areas that are not eligible for patent protection?**

No, business and computer methods are not patentable. However, software (whether in source or object code) and databases are protected by copyright in the same terms as literary works.

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**8 Summarise the current level and nature of patent litigation in your country? Are there particular litigation trends related to specific industries, such as the pharmaceutical, payments, data analytics?**

The current patent litigation trend in the Dominican Republic is regarding the Patent Term Adjustment (PTA) or restoration due to the unreasonable delays incurred by the administration in the granting of patents.

ONAPI's Inventions Department has only granted PTAs for patents filed after 1 March 2008. ONAPI has not recognised PTAs for patents filed prior to 1 March 2008, albeit granted after 1 March 2008, arguing that the adjustment of the term of patents requested prior to the entry into effect of the DR-CAFTA Implementation Law 424-06, which modified Dominican legislation and introduced the compensation of patent term, would constitute a violation of the principle of non-retroactivity of the law. However, considering that the legal basis for the granting of a patent term adjustment is the unreasonable delay in the granting of the patent, the right to the same is born when the patent is granted. As a result, many patent holders have initiated legal actions before the Administrative Court and the Court of Appeals.

The compensation is applicable to all patents granted after 1 March 2008, whenever there is a period of more than five years between the filing of the application and the granting of the same or more than three years from the date of the merit examination request. Patent applications filed prior to 1 March 2008 benefit from PTA provided that the patent is granted after the

entry into force of the provision, namely, patents granted after 1 March 2008. Please see question 4 for further information regarding the duration of patent rights.

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**9 What remedies are available for patent holders? For example, are monetary damages and injunctive relief available? If monetary damages are available, are such damages based on a reasonable royalty, lost profits or other provisions?**

Civil claim remedies are available for patent holders against any person infringing that right or against any person who carries out acts that evidently show the imminence of an infraction. In this regard, a patent holder can request cessation of the action infringing his rights, attachment of the objects resulting from the infraction, measures to avoid the continuation or repetition of the infraction (including destruction of the attachment), and indemnity for losses and damages.

Article 175 of Industrial Property Law governs the calculation for losses and damages. In civil judicial proceedings concerning enforcement of the rights covered by said Law, the judicial authorities shall have the authority to order the infringer to pay the titleholder damages adequate to compensate for the injury that he has suffered as a result of the infringement.

For the purpose of calculating damages, the portion corresponding to the lost profit for which compensation is due is calculated in accordance with one of the following criteria, taking into account the value of the infringed-upon good or service based on the suggested retail price or other legitimate measure of value that the titleholder presents: (i) the profits that the titleholder would have expected to obtain without competition from the infringer; (ii) the price that the infringer would have had to pay to the titleholder for a contractual license (taking into account the commercial value and the contractual licenses that have already been granted).

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**10 Is your country considering major changes to its patent system?**

No.

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**11 Does your country recognise the “patent exhaustion” doctrine, and, if so, how does the application of the doctrine compare with those in other jurisdictions?**

The “patent exhaustion doctrine” or “first sale doctrine” is recognised by article 30 of Industrial Property Law 20-00. In this regard, the patent does not give the right to prevent the sale, lease, use, usufruct, importation or any means of marketing of a product protected by patent or obtained by a patented process, once said product has been placed in the market in any country with the consent of the holder or of a licensee or in any other legal manner. However, products and procedures shall not be considered legally placed on the market if placed in violation of the Industrial Property Law.

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**12 Is your country a signatory to or likely to join the Madrid Protocol and if so, when? Is it a signatory to the TRIPS agreement?**

The Dominican Republic is not a signatory to the Madrid Protocol but could join it in the near future. This agreement was

approved by the Senate on 11 May 2011, and was remitted to the House of Representatives on 7 June 2011.

The Dominican Republic is a signatory to the TRIPs agreement. The agreement entered in effect on 1 January 2000.

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**13 Do your trademark clients make use of the Andean Community's or Mercosur's regional trademark systems and if so, how?**

No.

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**14 What is the duration of trademark rights protection?**

Ten years counted from the date of granting of the registration and renewable for successive periods of 10 years, counted from the date of expiration of the preceding period.

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**15 What rules govern the use of the registered trademark symbol, ®, or the unregistered trademark symbol, ™, in your country?**

Our legislation does not provide any distinction for the use of these symbols. Only registered trademarks receive protection for 10 years. Unregistered trademarks do not have any protection in the Dominican Republic.

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**16 What are the main problems affecting trademark owners in your country, and what strategies have successfully addressed these problems?**

The main problems affecting trademark owners in the Dominican Republic is the counterfeiting of products and, in particular, pharmaceutical products. The Ministry of Health and the National Directorate for Drug Control (DNCD) are being more rigorous with health surveillance by carrying out raids in order to identify those products in violation of health laws that require marketing approval.

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**17 Does a trademark licence have to be recorded in your country to be effective?**

It is not mandatory to record a trademark licence. However, a licence for a registered trademark or in process of registration shall have legal force for third parties only after being recorded in the ONAPI.

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**18 What strategies have been successful in combating counterfeiting in your country?**

The Customs Agency issued Resolution No. 01-2010, which created a Registry of Intellectual Property Titleholders.

As a result of this Resolution, registered trademarks and copyrights can also be recorded before the Customs Agency to maximise border protection. The holders of unregistered copyrights and related rights, which have not been registered before the National Copyright Office, can also apply for registration before the Customs Agency.

This procedure aids customs personnel with infringement determinations by making intellectual property rights information available at the ports. Customs is authorised to exclude, detain and seize imported merchandise that infringes trademark and copyright laws.

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**19 Does a foreign company's website infringing trademarks constitute use of a trademark in your country?**

Dominican Industrial Property Law 20-00 establishes that a trademark is in use when the products or services that it distinguishes are available in the national market under that trademark, in the quantity and manner normally appropriate considering the size of the market for the product in question, the nature of the product and the ways in which its marketing is carried out. Additionally, it states that the use of a trademark in relation to products destined for exportation from the national territory, or with relation to services rendered abroad from the national territory, also constitutes use of the trademark. Consequently, these are the recognised forms of use.

The World Intellectual Property Organization has recognised the use of trademarks on the internet and the effects of such use in multiple jurisdictions. For instance, circumstances such as the following could be taken into account by the competent court if the proper evidence is filed in order to sustain these arguments: (i) serving of customers in the particular territory or country; (ii) actual visits to the web site for which or on which the sign is used from persons in the particular territory or country; (iii) use of the language predominantly used in the particular territory or country; (iv) activities in the particular country or territory which are not carried out over the internet; (v) other similar circumstances that can be taken into account.

However, we have no court precedents in the Dominican Republic that could be used as persuasive authority in order to obtain a favourable decision, and therefore the theory of Internet use should be well argued with proper evidence.

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**20 Do you recommend that companies register their domain name in your jurisdiction if they do business there?**

Yes, for a greater protection of its intellectual property rights. However, a generic top-level domain (gTLD) would suffice since in the Dominican Republic it is not mandatory register the domain names.

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**21 Briefly highlight any particularities of your trademark law that is not well understood by foreigners doing business in your country.**

Under Dominican law, the rule is that the right to exclusive use of a trademark is acquired by means of its registration. However, our legislation also provides for exceptions, such as when the person who has been using the trademark (for more than six months) in this country without interruption and in good faith from the earliest date shall have preference for obtaining the registry of a trademark. If a trademark has not been in use in this country, the first person to file the corresponding application shall have preference.

This might not be well understood by foreigners doing business in the Dominican Republic as many of them come from first-to-use legislations.

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**22 What are the key legal issues to be considered when registering a trademark in your country?**

When registering a trademark in the Dominican Republic, the applicant must not incur in any of the absolute or relative grounds for refusal provided in articles 73 and 74 of Industrial

Property Law 20-00 to secure registration and avoid third party oppositions or other legal remedies.

As defined by Industrial Property Law 20-00, inadmissible trademarks based on absolute grounds refer to the following cases: descriptive marks; when they consist of usual forms for products or which give them a functional or technical advantage; generic designations; scientific or technical names; simple colours; insufficient distinctive character with regards to the product to which they are applied to; contrary to morality or public order; expressions that ridicule; deceptive trademarks; reproduction of registered appellations of origin; imitation of flags, emblems, denominations or abbreviations of any state or international organisation, official symbols, coins, bills, titles, commercial documents, medals, prizes or diplomas; when they include the denomination of a variety of vegetation protected in the country or abroad; contrary to the provisions of Law 20-00 or any other law; and when they reproduce an expired or voluntarily cancelled registration applied to the same or associated products or services unless one year has passed after the date of expiration or cancellation.

On another note, relative grounds for refusal apply when a trademark would affect third-party rights, such as, when it is identical or resembles a registered trademark or in the process of registration that distinguishes the same or similar products or services; when it could create confusion with an unregistered trademark used by a third party who would have better rights to obtain the registry for the same or similar products or services; resembles a trade name or emblem used by a third party as of an earlier date; reproduces, imitates or is the translation of a well-known trademark; when it would affect the personal rights of a third party regarding the name, signature, title, hypocoristic or portrait different from the person applying for registration; when it would affect the right to the name, image or prestige of a local or foreign company; when it would infringe a copyright or a pre-existing industrial property right or has been applied for as to perpetrate or consolidate acts of unfair competition.

In addition, it is recommended that the applicant obtain registration before beginning local use.

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**23 Can a multi-class trademark application be filed in your country?**

Yes.

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**24 Does your country allow trademark opposition proceedings? Can the deadline to file an opposition be extended?**

Yes, our country complies with the pre-registration opposition system. Any third party can oppose a trademark application within a time limit of 45 days counted from the publication date in the Official Gazette of the ONAPI. The deadline cannot be extended.

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**25 Does your country have a judicial or other governmental process to restrict the importation of counterfeit goods? If so, give details.**

Yes, Industrial Property Law 20-00 as amended by Law 424-06 on Implementation of the DR-CAFTA, provides for border measures. The holder of a trademark right may request customs authorities to suspend the release of suspected counterfeit or confusingly similar trademark goods into free circulation. The

competent customs authority shall require the titleholder to provide adequate evidence that there is prima facie an infringement

Dominican courts can order precautionary measures only where the person requesting them demonstrates, with reasonably available evidence that the court considers sufficient, that an infringement has been committed or is imminent, before, at the same time as or after the start of infringement proceedings.

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**26 What are the key issues to be considered when licensing trademark use rights in your country? Does your jurisdiction invalidate trademarks based on “naked licences” (ie, where the licensor does not impose quality standards on the goods and services associated with the licensed trademark)?**

Under Dominican law, there are minimum legal provisions for trademark licensing. However, the rules set forth by our industrial property legislation only apply unless otherwise stipulated in a licence contract. In this regard, the parties enjoy freedom to contract.

Some of the key issues that should be considered as outlined by Law 20-00, include the following: (i) if the licensee shall be entitled to use the mark during the whole period of validity of the registration, including renewals thereof, throughout the country and with respect to all the goods or services for which the mark is registered; (ii) if the licensee may or may not assign the licence or grant sub-licences; (iii) if the licence shall be exclusive or not; and if the licensor may grant other licences to use the mark in the Dominican Republic as well as using the mark him or herself in the Dominican Republic.

There are no special provisions on “naked licences”.

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**27 Are there any limits on the scope of licensee indemnification relating to workmanship, material, or design of any products, articles, logos, characters, etc, bearing the licensed trademark?**

No. However, Copyright Law 65-00 provides that authorisation for a form of use of the work protected by copyright does not extend to others. In any case, the effects of the assignment or licence are limited to those rights expressly assigned or licensed, and for the time and territory agreed upon. Consequently, there will only be limits if such materials or designs are protected by copyright.

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**28 Under what circumstances may a trademark licence be deemed a franchise arrangement under the laws of your country?**

Both the licence and franchise agreements are considered innominate contracts under Dominican law. There are no specific provisions for them in our Civil Code.

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**29 Are there any conditions or limitations on the ability of a trademark licensor to enforce or terminate a trademark licence agreement?**

There are no specific provisions to enforce or terminate a trademark licence agreement under Dominican law. The general rules that would apply are those set forth by the parties in the agreement. In practice, the parties establish a period to remedy any breach.



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**30 Under what circumstances may a trademark be legally deemed “abandoned” under the laws of your country where there is no obvious decision by the trademark owner to abandon the trademark?**

Under Dominican law, a trademark might be considered “abandoned” when the same has not been used in the country for an uninterrupted period of three years. However, the National Office of Industrial Property will not cancel the “abandoned” trademark ex officio. In this regard, an interested party must initiate a non-use cancellation action.

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**31 Is copyright registration recommended for local packaging and marketing materials?**

Copyright registration would be recommended only if the local packaging and marketing materials could be considered as artistic or literary works.

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**32 What is the duration of copyright protection?**

The economic aspects of copyright shall accrue to the author during his lifetime and to his spouse, heirs and successors in title for 70 years after his or her death.

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**33 Are there any recognised legislative safe harbours that protect internet service providers in your country from liability for the activities of its users? If so, what are the requirements or processes Internet providers must follow to claim safe harbour?**

Yes. The DR-CAFTA, in article 15.11.27.b) establishes the limitations on liability for service providers. The safe harbours provided by the DR-CAFTA include: (i) transmitting, routing, or providing connections for material without modification of its content, or the intermediate and transient storage of such material in the course thereof; (ii) caching carried out through an automatic process; (iii) storage at the direction of a user of material residing on a system or network controlled or operated by or for the service provider; and (iv) referring or linking users to an on-line location by using information location tools, including hyperlinks and directories.

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**34 Does your country recognise the ‘first sale’ doctrine for purposes of limiting copyright enforcement?**

Our legislation does not recognise the “first sale” doctrine for purposes of limiting copyright enforcement. The limitations and exceptions to copyright are interpreted restrictively and cannot be applied in ways that conflict with the normal exploitation of the work or unreasonable prejudice of the interests of the titleholder.

However, there are special situations in which it might be limited, such as: reproduction of a single copy of a literary or scientific work for personal use and for non-profit purposes; compulsory licences (granted by the stated); quoting authors; reproduction by reprographic means of articles or brief extracts; current events published by the press or broadcasted; reproduction of public daily news; public speeches, sermons and conferences; public libraries may reproduce a copy of protected works that are out of print; works permanently located on public streets or squares; lectures or talks; official texts (Constitution,

laws, decrees, ordinances, regulations, agreements, judicial decisions, administrative instruments, etc); protected works or fragments when this is indispensable for the purposes of judicial or administrative proceedings; the author of an architectural design may not prevent the owner from making modifications to it; communications for educational purposes; communications made in the domestic environment; communications for sightless persons and persons with other physical disabilities; communications in commercial establishments.

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**35 What is the standard of contributory copyright infringement in your country?**

In the Dominican Republic, liability for copyright infringement extends to persons that order or arrange for the commission thereof, the legal representatives of legal persons, and all persons that, in the knowledge that an act is unlawful, take part in it, facilitate it or are complicit in it.

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**36 What are the criminal sanctions for intellectual property infringements?**

Dominican law provides for criminal sanctions of a prison sentence of three months to three years and a fine of 50 to 1,000 times the minimum wage.

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**37 Does your country recognise intellectual or industrial property protection in databases?**

Yes. Copyright includes the protection of databases or compilations of data or other material, machine-readable or any other form, which due to selection or arrangement of their contents, constitute intellectual creations.

Softwares are expressly excluded from industrial property protection.

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**38 Does your country recognise a right of publicity?**

Yes. Industrial Property Law 20-00 states that the registration of a trademark confers upon its holder the right to act against any third party who uses the trademark in publicity, publications, documents, written or oral commercial communications without the holder’s consent.

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**39 Is alternative dispute resolution used in your country to resolve intellectual property disputes? What are the benefits or dangers of using ADR for IP disputes?**

It is being promoted within the country. However, it has had little impact. Most intellectual and industrial property cases are still resolved through judicial review.

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**40 Can intellectual property rights be recorded with certain government agencies in your country, like Customs or the Border Control, to help prevent the import or export of counterfeit goods?**

Yes, these rights may be recorded in the Registry of Intellectual Property Titleholders at the Customs Agency.

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#### 41 Describe any recent major developments or anticipated changes in your intellectual property law.

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration was submitted to Congress on 28 March 2016. However, it has not yet been approved.

As of 1 May 2018, all trademarks and trade name applications need to be registered through an online system of the ONAPI. Paper applications are no longer accepted.

On 1 June 2017, the Law against Money Laundering and Terrorism Financing No. 155-17 was enacted, effective immediately. Such Law No. 155-17 considers as precedent or determining infractions of money laundering the infraction against intellectual property, contraband, piracy, counterfeiting and adulteration of medicines, food and beverages, high-tech crimes and infractions, illicit trafficking of goods and misuse of confidential or privileged information. Consequently, the aforementioned infractions, including the violation of rights over inventions, distinctive signs, and copyrights, could imply the imposition of serious sanctions if they have been carried out for the purpose of obtaining illicit goods or assets to be involved in money laundering. According to the terms of the Law, a preceding or determining infraction is one that generates assets susceptible to money laundering.

According to the terms of Law No. 155-17, those who commit such type of infractions may be punished with up to 20 years in prison, fines of up to 400 minimum salaries, permanent or temporary disqualification for the performance of certain functions, among others.

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#### 42 Describe any significant recent court decisions in your country relating to intellectual property.

On 8 June 2016, the SCJ issued a decision favorable to patent term adjustment (PTA) irrespective of the date the patent application was filed, and stated that:

*This right is generated with the issuance of the patent, and not with the application thereof, as the court has erroneously interpreted (...) the law applicable to the request for patent term adjustment is the one that was effective when the patent was granted.*

Contradictory decisions have been issued by the Court of Appeals and the Supreme Administrative Court, where both courts have decided that the other has exclusive jurisdiction to hear PTA cases. However, the Supreme Court of Justice has decided that all administrative acts, such as the decisions rendered by the ONAPI should be appealed before the Superior Administrative Court and not before the Court of Appeals.

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#### 43 Are there any licence agreement formalities for intellectual property that must be observed?

The formalities that must be observed include: apostille, public filing, translation and recordation. The licence agreement or a certified copy of it must be filed in original. Although recordation is not mandatory by law, it is advisable as the public filing makes it easier to oppose it to third parties.

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#### 44 Does your country have a cybercrime law that provides for civil remedies in connection with either computer intrusions or theft of intellectual property? Are other causes of

#### action or remedies available in your jurisdiction as regards unauthorised computer intrusion and misappropriation of electronic information?

Yes. Law 53-07 on High Technology Crimes and Offenses provides that when there is an infringement of the legal dispositions of Industrial Property Law 20-00 or of Copyright Law 65-00 committed using a computer, telematics or telecommunications or any of its components, electronic systems are punishable per the penalties provided for by the legislation for these unlawful acts.

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#### 45 Briefly describe the tax considerations for intellectual property in your jurisdiction including any incentives.

According to the Dominican Tax Code, income tax considerations apply for intellectual property on all gross earnings from income received by the transfer of trademarks, patent rights and other similar concepts. Said Tax Code also allows for deductions resource depletion of the tax cost of intangible assets, including patents, copyrights, drawings, models, contracts and franchises defined by a term limit, using the straight-line method.

The Dominican Tax Code also allows for deductions, with the consent of the Tax Administration, of expenses incurred in or payments made in research and experimentations during the fiscal year, as current expenses. Such treatment must be consistently applied during the fiscal year and subsequent years, unless the Tax Administration authorises a different method for all or part of such expenses.

According to the VAT Regulation, the transfer of copyright, industrial property rights, permits or licences is not subject to VAT, nor the lease of rights or of intangible assets.

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#### 46 Briefly describe the intersection between intellectual property and competition law in your jurisdiction.

Industrial Property Law 20-00 contemplates the application of several articles regarding competition law; however, these only refer to unfair competition in cases of infringement of intellectual property rights. Other figures such as abuse of a dominant position are not contemplated in said law.

The Dominican Republic also has a separate legal framework, Competition Law 42-08. In general terms, this law prohibits concerted practices and horizontal anticompetitive agreements as well as abuse of dominant position, and unfair competition.

Law 42-08 defines agreements as any exchange of will expressed through a contract, either express or implied, written or oral, susceptible of aligning the competitive behaviour of competing economic agents; it does not specifically refer to licence agreements.

The types of agreements that are banned by said law include: (i) agreeing on prices, discounts, exceptional charges, other sales conditions and exchange of information with the same objective or effect; (ii) concerting or coordinating offers or the abstention in tenders, competitions and public offers; (iii) dividing or assigning segments or market share for goods and service stating time and space, suppliers and customers; (iv) limiting the production, distribution or marketing of goods; provision or frequency of services, regardless of the nature thereof; and, (v) eliminating competitors from the market or limiting their access to it because of their position as buyers or sellers of certain

products. Consequently, any agreement (including license agreements) would be subjected to the provisions of said law, as they may be deemed null and void.

Furthermore, the following conducts are understood as abuse of dominant position: (i) subordinating the decision to sell to the fact that the buyer refrain from buying or distributing products or services of other competitors; (ii) when the supplier imposes prices and other sale conditions to its resellers, with no commercial reason to justify it; (iii) sale or other conditioned transaction to acquiring or providing other goods or additional services, different from the first; (iv) the sale or other transaction subject to the condition of not hiring services, acquiring, selling or providing produced goods, distributed or marketed by a third party; (v) refusal to sell or provide, to a certain economic agent, goods and services that are normally available to third parties; and, (vi) applying unequal conditions for equivalent transactions, which places some competitors at disadvantage when compared with others, without there being any commercial reason to justify it.

There is no restrictive licensing under Dominican law. In addition, there is no regulation similar to the EU's Technology Transfer Block Exemption Regulation.

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**47 Briefly explain the implications of a bankruptcy filing under the laws of your jurisdiction on intellectual property licensed rights.**

Law 141-15 on Restructuring and Liquidation of Companies and Business Persons establishes mechanisms and proceedings to protect creditors in cases of financial difficulty of their debtors by allowing the latter to remain in operation and overcome the economic difficulties that prevent them from complying with previously undertaken obligations, thus achieving business continuity of companies and business persons.

According to said law, in the event of a temporal lack of liquidity or cessation of payments, a debtor can restructure its operations and continue operating, facilitating the preservation of assets in favour of the creditors recognised by the debtor. The restructuring of the debtor must be requested before the court through a petition. Said petition must include a detailed account of current contracts to which it is a party (including all accounts receivables and accounts payables).

In cases of restructuring filings, said law provides that it is not within the contractual freedom of the parties to automatically terminate contracts. Article 90 provides that in spite of any contractual clause, termination is not possible if it results from the mere fact of accepting to request for a restructuring.

The creditor must meet its obligations under the contract. It is the court-appointed conciliator who will provide the court with a list of all existing contracts (including licences), recommending the termination or continuation of them. The court will decide and notify the decision to the parties.

If the process reaches liquidation, the same principle would apply; the liquidator would have such control.






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## Mary Fernández

Headrick Rizik Alvarez  
& Fernández

Founding partner at Headrick Rizik Alvarez & Fernández, she serves as counsel to national and international clients in matters of foreign investment, corporate law, banking and international finances, negotiation and execution of contracts involving public or private entities; franchising and distribution relations; structuring and implementation of real estate and tourist projects, aviation law and intellectual property matters in general, including arbitration and litigation.

Mary has been designated National Ambassador of the International Chamber of Commerce (ICC) Commission on Intellectual Property representing the Dominican Republic. She is presently Chair of the Latin American Council of the International Section of the New York State Bar Association (NYSBA). Arbitrator and President of the Mediation, Conciliation and Arbitration Committee of the Asociación Interamericana de Propiedad Intelectual (ASIPI). Judge of the Disciplinary Panel of the ASIPI. Arbitrator and member of the Board of the Centre for Resolution of Controversies (CRC) of the Chamber of Commerce and Production of Santo Domingo, Inc (CCPSD). Past president of the board of directors of the American Chamber of Commerce (AMCHAMDR) and past chair of its legal committee. Editor for the Caribbean of the International Opposition Guide of the International Trademark Association (INTA) and, member of the editorial committee of *Gaceta Judicial*, the only legal periodical in the country. President of the board of Instituto Tecnológico de Santo Domingo (INTEC). Mary is past president of the Asociación Dominicana de Propiedad Intelectual, Inc (ADOPI) and of Fundación Institucionalidad y Justicia, Inc (FINJUS).

She specialises in corporate and business law, banking law, agency and distribution law, foreign investment, intellectual property, arbitration and trusts and estates. Her professional practice has been recognised and ranked in Band 1 by Chambers Global 2017 in corporate/commercial and in intellectual property, by Chambers Latin America 2017 in corporate/commercial and intellectual property. She is recommended by Latin Lawyer 250 2017. She is also recommended by the Latin American Corporate Counsel Association (LACCA) for corporate/M&A in 2018. She teaches contracts in intellectual property for a master's programme in intellectual property at the Pontificia Universidad Católica Madre y Maestra (PCUMM).

Mary is Dominican, studied law at the Universidad Pedro Henríquez Ureña (UNPHU), where she graduated summa cum laude in 1979. Immediately after, 1979–80, she attended postgraduate courses in political science and International Relations at Georgia State University. She has an LLM in intellectual property from the John Marshall Law School of Chicago, Illinois. She graduated in 2016, with honours. She speaks Spanish and English.



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## **Gabriella Paulino**

Headrick Rizik Alvarez  
& Fernández

Gabriella Villanueva is an associate at Headrick Rizik Alvarez & Fernández. Her practice is focused in the area of intellectual property, regulatory and business matters.

Her practice includes intellectual property, in every aspect related to copyright, national and international trademark portfolio management, assignments, licences, constitution of guaranty of industrial property rights, patents, utility models, industrial designs, legal actions and defences, among others.

Gabriella is Dominican, studied law at the Pontificia Universidad Católica Madre y Maestra (PCUMM), where she graduated cum laude in 2013. She attended an LLM programme on arbitration and international contracts at Fribourg University, Switzerland. She speaks Spanish and English.

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## **Headrick Rizik Alvarez & Fernández**

Mary Fernández  
mfernandez@headrick.com.do

Gabriella Paulino  
gvillanueva@headrick.com.do

Avenida Gustavo Mejia Ricart Avenue  
No. 106, Piantini Tower, 6th Floor  
Santo Domingo, National District  
Dominican Republic  
Postal Code #10148

Tel: +1 809 473 4500  
www.headrick.com.do