



The extraordinary Official Gazette No. 40, dated 10 August 2018, published the legislative packet concerning Intellectual Property issues our legal system was lacking.

The present material is focused on getting familiar with the subject.

Decree-Law **No. 336** "On Intellectual Property contractual provisions in legal transactions", dated 30 June 2016, effective on 10 October 2018, aims to establish rules related to contractual provisions concerning intellectual property that must be included in legal transactions for acquiring technology and in economic and scientific-technical collaboration agreements, and to identify restrictive contractual provisions that unjustly or abusively prevent, limit or distort industrial and business performance. Its provisions are applied to legal transactions in which technology is acquired from a foreign party by foreign or national natural persons and legal entities with actual and effective registered offices or industrial or commercial establishments in the Republic of Cuba.

Likewise, in Chapter II it establishes the Licensing and Assignment Agreements for the Acquisition of Disembodied Technology, defining in Section One, General Provisions, the concepts of: contracts on confidential information, licensing contacts for Intellectual Property applications or rights, assignment agreements on IP applications or rights and assignment agreements on confidential information. In sections Two to Seven it further describes all of the provisions that each one of these contracts must separately include, providing an exhaustive list of the clauses that must not be missing.

A specific section of Chapter III is dedicated to agreements concerning the Acquisition of Embodied Technology, specifically stating the provisions they must include.

In turn, Chapter IV includes the Economic and Scientific-Technical Collaboration Agreements, defining them and establishing all of the provisions they must include, the exception being in the case of the transfer of biological material, in which an additional agreement on the transfer of biological material will be required, also describing the clauses it must include.

Chapter V defines the restrictive provisions in the licensing agreements, declaring the invalidity thereof and establishing clauses that will not be admissible. Article 25 of Chapter VI is on Notes, establishing that the Cuban Intellectual Property Office (OCPI) shall be governed by the provisions of the present Decree-Law.



Lastly, it includes the Final Provisions, repealing Title XI of Decree-Law 68 dated 14 May 1983.

Decree-Law **No. 337** "On protection against unfair practices with regard to Intellectual Property", establishes in Chapter 1 the rules for protecting against unfair practices in industries and businesses, as well as protection of confidential information. In article 2 it defines unfair practice as... "any act that infringes against the honest use and practice in industries and businesses, given that it causes or may cause substantial effects in the promotion and supply of products or services in the national market in favor of the perpetrator of the illegal act or a third party", strictly regulating the specific cases prohibited in article 2.2.

The First Section of Chapter II describes the requirements or conditions information must have to be classified as confidential, as well as the way it is transmitted through licenses to authorize the use thereof. There is also a section on confidential information that is necessary to provide to any administrative or judicial authority requiring the same.

It regulates and defines unfair commercial use by third parties, as well as the persons authorized to file a claim in court, specifically: natural persons or legal entities that participate in the market, whose economic interests are directly harmful or threatening due to unfair practices; legally recognized associations and the public prosecutor, when consumer safety, interests, moral rights or other public interests are directly or indirectly affected.

In the final provisions there are no derogation articles because no prior legislation of a similar nature had existed beforehand.

Decree **No. 341** strengthens the Cuban Intellectual Property Office, establishing it as a self-financing entity with legal character and its own capital structure, assigned to the Ministry of Science, Technology and Environment. It defines its leading role in the System of Intellectual Property and its mission to register Intellectual Property rights in the Republic of Cuba and provide scientific-technological services specialized in the field in order to contribute to the development of science, technology and innovation, foreign and national investment, industry and business. It defines the functions and the legal representation of a General Director, whose obligations and functions are defined in the organic Regulations of that entity.



7 years after the enactment of Decree-Law No. 290 "On Inventions and Drawings of Utility Models", dated 20 November 2011, it is now a reality that Decree **No. 342**, containing the Regulations thereof, has finally been enacted; **AT LAST**.

Said Regulations consist of II Titles, XIV Chapters and 128 articles, set forth in the following way:

**Title I:** Granting procedure, which defines the general aspects in the filing of the application, regulating the applications, formal examination, substantive examination, conversion in the form of protection to the division of the application.

**Title II:** Common Provisions, divided into IX Chapters, namely:

Chapter I: General procedures, defining and regulating opposition proceedings, Appeals, procedure for declaring invalidity and cancellation, Reestablishing Rights, Notes, Modifications and Corrections.

Chapter II: Joint Ownership.

Chapter III: Remuneration for inventors or authors.

Chapter IV: Documents that accredit representation.

Chapter V: Special requirements and communication

Chapter VI: Notifications.

Chapter VII: Procedure for obligatory granting of a license.

Chapter VIII: Waiver.

Chapter IX: Disclosure.

Thus, it defines that the patent applications and registration are filed in the Cuban Intellectual Property Office (OCPI) on business days and hours and the documents that make up the application must be filed in duplicate in paper and duly signed, and if the applicant were interested in receiving a copy, an additional application must be filed.



If the applicant seeks to obtain priority, they must provide a copy certified by the office of the country in which the documents of the priority application were issued in a maximum and non-renewable time period of three months. In the case of claiming more than one priority, as many documents as necessary shall be filed.

When the patent application or utility model is filed, the office records the date, hour and minute in which said registration took place on the form established by the same. The invention patent application or the application for registering a utility model is done using the forms provided by the Office.

During the formal examination, the examiner checks the following: that the documents that make up the application are in the language of Spanish, or if necessary, the corresponding translation and verification thereof, if the object is patentable or not, if it meets the requirements established in the Decree-Law for filing, among other possibilities that are specifically established in the Regulations. The substantive examination is then carried out, in which the office will analyze the following aspects:

- a) If the object of the application constitutes an invention and is patentable, or if it can be filed as a utility model.
- b) If the priority date or dates claimed are accepted and if said claim and filing of the corresponding document have been made within the legally established terms.
- c) If the invention is disclosed in a clear and complete way.
- d) If the invention patent application fulfills the unity of invention requirement.
- e) If the invention is novel, has inventive step and industrial applicability.
- f) If new subject matter is added with respect to the contents of the original application.

The examination of novelty and inventive step is done based on the search of the existing state of the art. The subject matter that is finally included in the description or in the claims of the patent or utility model of an application of a prior date, and which is published in the Official Gazette, is considered part of the state of the art for determining the novelty of any other application with a later date.

If during the substantive examination of an application it is detected that there is another invention patent application or application for registering a utility model of a prior date that has not been published, in which subject matter that may affect



all or part of the novelty or that is claimed in the application under examination is described or claimed, the Office will suspend the current examination until the publication of the prior application.

Once the substantive examination is concluded, the Head of the corresponding department may partially grant the invention patent application or the registration of the utility model, with respect to the accepted claims. The office may modify the title of the invention so that it corresponds to the patentable object or objects. Once the invention patent application or registration of the utility model has been granted, and the corresponding fees have been paid, the Office will issue the corresponding Certificate.

It is further established in Chapter III of Title One, "Conversion of the form of protection" that the applicant may convert the application for registering a utility model to an invention patent application, or vice versa, at the request or requirement of the Office, by means of the provided form prior to the payment of the fees.

Appearing for the first time in our legislation is the long sought after remuneration for inventors or authors, which in article 100 establishes that it shall be the head of the entity who shall enforce the internal regulations for implementing the remuneration for inventors or authors, according to the provisions of the Decree-Law established for said purpose. Along these lines, the Minister of Science, Technology and Environment, Elba Ros Pérez Montoya, issued Resolution No. 152 on 29 June 2018, in which the Procedures on remuneration for inventors, authors and breeders are established. It defines that remuneration is done annually and the remuneration percentage shall be between 1 and 10% of the economic gain obtained from the exploitation of the patent, registration or plant variety. In the cases where these gains are obtained by royalties or fixed payments derived from the granting of licenses, the percentage will be determined between a range of 10 to 30 percent of the economic gain.

Chapter VII provides a detailed description of the procedure for granting obligatory licenses. It includes a Chapter on Waivers, and another on Disclosure and Publications.

Furthermore, Decree-Law **No. 343/2018** On the Intellectual Property System was also published, defining the objective and scope thereof, the main objectives and bases of the system, the indications for managing the P. Containing a Single Annex that makes up the Guide for diagnosis and supervision.