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Should You Join the “Havana Club”? Trademarks in Cuba

By Kevin R. Casey

Following President Obama’s recent announcement that the U.S. is normalizing relations with Cuba, we encourage clients to consider registering at least their most important trademarks in Cuba. Although patents and trademarks can be protected in Cuba on behalf of U.S. individuals and corporations, the question has long been, “Why do so?” given that U.S. individuals and corporations have not been conducting business in Cuba. One reason is to avoid “brand theft,” the unfortunate experience of having a Cuban individual or company register marks of a U.S. trademark owner in bad faith anticipating a change in the political climate that would allow U.S. entry into Cuba. When the U.S. trademark owner does decide to do business in Cuba, and to use and register its trademarks there, such use and registration may be precluded by the Cuban individual or company’s prior registration. U.S. trademark owners confronted a similar experience when South Africa lifted its practice of apartheid, allowing for U.S. expansion into that country in the 1990s. U.S. trademark owners still confront this experience in certain Asian countries today.

The current policy change is likely to generate a new wave of applications to register trademarks in Cuba. Before a U.S. trademark owner joins the charge, however, at least two cautions should be noted. First, changes in the political status quo are likely to be slow — the opportunity to do business in Cuba may not open for some time. Second, like the United States, Cuba has a legislative requirement that trademarks must be used in commerce to avoid claims of abandonment. Specifically, although use is not required to obtain a trademark registration in Cuba, a third party can petition to cancel a registered trademark if the mark is not used for three consecutive years after registration. Therefore, the inability of U.S. trademark owners to use their trademarks to promote goods or services in Cuba renders them vulnerable to attack. This caution is tempered somewhat: our colleagues knowledgeable about Cuban trademark law advise that in more than 30 years of filing applications in Cuba on behalf of U.S. and European companies, they have never seen a cancellation action filed by a third party on the basis of non-use. ■

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