

**RESPONSE TO THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)
MEETING OF THE STANDING COMMITTEE ON THE LAW OF PATENTS, JUNE 20 TO
30, 2016**

Information requested:

Practical experience regarding the effectiveness of exceptions and limitations to rights granted by patents and the problems involved, particularly in addressing development concerns.

Response

In the Dominican Republic, Article 30 of Law No. 20-00 on Industrial Property provides as follows in regard to limitations and exhaustion of patent rights:

- (a) acts performed privately and for non-commercial purposes;
- (b) acts performed exclusively for experimental purposes with respect to the patented invention;
- (c) acts performed exclusively for educational purposes or for scientific or academic research;
- (d) the sale, lease, usufruct, importation or any form of marketing of a product protected by a patent or obtained through a patented process, once such product has been offered for sale in any country, with the consent of the title owner or a licensee or any other lawful means, it being understood that products or processes in breach of industrial property rights shall not be considered as lawfully offered for sale;
- (e) acts referred to in Article 5 of the Paris Convention for the Protection of Industrial Property;
- (f) where the patent protects biological material capable of propagating itself, the use of such material as the initial basis for obtaining a new and viable biological material, save where such obtaining requires the repeated use of the patented material; and
- (g) those uses necessary for securing health approval and for marketing a product on expiry of the patents protecting it (Bolar Exception).

With respect to these exceptions, the health sector of the Dominican Republic explored the possibility of using an anti-retroviral that is patent-protected in the country and would be used in a nationwide program to benefit people who are carriers of the Human Immunodeficiency Virus (HIV/AIDS) through the National Council for HIV and AIDS (CONAVIHSIDA). However, these attempts were unsuccessful. Apart from the above, in accordance with the case at hand, we understand that other possibilities include compulsory licenses (provided for in Section IV of Law No. 20-00), whose condition must be complied with and which may be assessed and granted depending on the type most appropriate to the case. These types are as follows: (1) non-working; (2) anti-competitive practices; (3) in case of dependent patents; and (4) public interest. The entire process must be conducted by the National Office of the Dominican Republic.

Information requested:

Court cases concerning aspects of attorney-client privilege in patents in case of limitations or difficulties.

Response

Legal assistance is not a requirement in Dominican Republic legislation, except where the applicant is not domiciled in the Dominican Republic. In such cases, management of all information is strictly the responsibility of the agent, who is responsible for the management and receives communication of all results of formal and technical examinations concerning the pending application.

In general, professional secrecy is dealt with in Decree No. 1290, which ratifies the Code of Ethics of the Bar Association of the Dominican Republic.

CHAPTER II PROFESSIONAL SECRECY

ARTICLE 15.

Professional secrecy is a both a duty from which attorneys may not exempt themselves and a right before judges, so attorneys cannot entertain confidential information if they knew that they might be compelled to reveal it. Once an attorney is called to testify, he must obey the summons; however, in testifying, he should proceed with absolute independence of mind and must refuse to answer any questions which, in his view, might breach professional secrecy.

ARTICLE 16.

The secrecy obligation encompasses confidential information provided by third parties to attorneys by reason of their profession. For this reason, attorneys must maintain the confidentiality of conversations held for a transaction which fails and with respect to facts of which they gained knowledge solely by such means. Professional secrecy also includes inappropriate confiding by colleagues.

ARTICLE 17.

The obligation of secrecy yields to the needs of personal defense of the attorney, where he is being persecuted by his client. The attorney may then disclose what is necessary for his defense and provide for the same purpose the documents provided by his client.

ARTICLE 18.

The attorney shall maintain the strictest professional secrecy. This fundamental duty remains wholly intact after the he ceases to provide services to the client. The attorney has the right to refuse to testify against his client and may refuse to answer any question that would entail the disclosure of secrets or the violation of secrets his client entrusted to him. Nor may the attorney communicate to third parties any information that may come to him because of his profession. Professional secrecy shall encompass all the attorney's dealings with the attorney representing the opposing party.

ARTICLE 19.

The duty to maintain professional secrecy extends to confidential information imparted by third parties to the attorney by virtue of his profession, and confidential information deriving from conversations necessary for reaching an agreement that does not materialize. Secrecy must also include confiding by colleagues. The attorney must not intervene in matters that could lead him to divulge a secret or use, either for his own or for his client's benefit, confidential information received in the course of his duties, unless he secures the prior express consent of the confidant. The obligation to maintain professional secrecy further includes matters of which the attorney has knowledge as a result of working together or in association with others or through their employees or dependents.

ARTICLE 20.

An attorney against whom his client brings charges is discharged from the obligation to maintain professional secrecy within the limits necessary and indispensable for his own defense. Where a client communicates to his attorney the intention to commit a crime, the attorney may, according to his conscience, make the necessary disclosures with a view to preventing the commission of the crime in order to obviate moral and material damage that might result from the commission of the crime.

Accordingly, we infer that between the attorney and the client, there is a pre-contractual agreement as to the confidential treatment of the information contained in his application, which covers the rights and obligations of each of the parties.

Information requested:

- Aspects of national legislation available for consultation:

Response

The website www.onapi.gob.do provides information on existing legal basis or standards, regulations, decrees, international agreements and internal guidelines of the Department of Inventions. Future initiatives being considered include the possibility of creating a virtual library of decisions taken by the departments responsible for inventions, distinctive signs and legal advice, as the highest administrative body.

1) Information requested:

- System of opposition, cancellation or administrative invalidation provided for in national legislation

Response

Under current legislation, there is no provision for opposition as an administrative remedy in regard to patents. Articles 21(2) and 21(3) of Law no. 20-00 provide for observations.

“Any interested party may submit fundamental observations regarding the patentability of the invention that is the subject of the application, relying on the relevant factual and legal basis. The submission of observations shall not have suspensive effect on the processing of the application. The observations may be submitted within 60 days of the date of publication.

The National Industrial Property Office shall notify the observations to the applicant, who may submit comments, arguments or documents as desired, within 60 days of receipt of the observations. The observations and the comments shall be taken into account during the substantive examination of the application.”

It is important to highlight that the submission of observations do not stop the processing of the application; they are included in the record and a copy is notified to the applicant to allow him to present a defense, so the examiner evaluates the application during the substantive examination.

As regards patents, there are two remedies or types of action that may be brought before ONAPI's Department of Inventions:

Article 34. Invalidity and Expiry of the patent: (1) All patents granted in violation of the provisions of this law shall be invalid. Action for invalidity or expiry may be brought by any interested person. In particular, the National Industrial Property Office may, at any time, on request of any interested person or the competent authority, declare a patent invalid in any of the following cases: (a) the subject-matter of the patent does not constitute an invention having regard to Articles 1 and 2(1); (b) the patent was granted for an invention that is included in the prohibition at Article 2(2) or fails to meet that patentability requirements set forth in Articles 3, 4, 5 and 6; (c) the patent does not disclose the invention in accordance with Articles 13 and 14; (d) the claims included in the patent do not meet the requirements of Article 15; and (e) the patent granted includes a wider disclosure than the content of the initial application. (2) The National Industrial Property Office shall cancel a patent where it is granted to a person who did not have the right to it, in accordance with Articles 7, 8 or 9. In such case, the cancellation may only be requested by the person who claims ownership of the right to the patent, and action shall be limited to five years with effect from the granting of the patent. (3) Where the grounds for invalidity only affect a claim or part of a claim, invalidity shall be declared only with respect to that claim or the part of a claim, as the case may be. Where applicable, invalidity may be declared in the form of the limitation of the relevant claim. (4) An application for invalidation or cancellation may also be lodged as a defense or counterclaim in any action for infringement of

the patent. (5) Patents shall expire as of right in the following cases: (a) At the end of their term; (b) On failure to pay the fees to maintain their validity. The owner shall be afforded a grace period of 180 days to pay the fees owed, after which the patent shall become invalid. (6) the National Industrial Property Office may declare a patent expired in the following cases: (a) if, two years after the grant of the first compulsory license, the objectives for which it was granted are not met; and (b) where necessary to protect public health, human, animal or plant life, or to prevent serious damage to the environment.

Article 35. Request for reconsideration. (a) A request for reconsideration of a decision granting or cancelling a patent shall only be entertained if it is submitted in writing before the National Industrial Property Office within 30 days as from the date of notification of the decision. The request shall be accompanied by documentation setting out its grounds. (b) Once the arguments set out in the request are analyzed, the Office shall issue the appropriate decision, which shall be communicated to the requester in writing; (c) Where the decision rejects the request, it shall be communicated to the requester in writing and published in the official government gazette. Where the decision is favorable to the requester, Article 23 of this law shall apply, if relevant.

2) Information requested:

- Collaboration in the search and examination of patent applications and reuse of international search and examination results.

Response

Under our current legislation, the use of reports from other offices within the framework of the Patent Cooperation Treaty (PCT) is a tool for the substantive examination of patentability. This is reflected in Article 22(4) of Law No. 20-00 on Industrial Property:

“The examination may take into account documents concerning examinations of novelty or patentability conducted by other industrial property offices or under the procedure provided for by the Patent Cooperation Treaty (PCT), in respect of the same subject-matter claimed in the application under examination. The National Industrial Property Office may accept the results of such examinations as sufficient to prove compliance with the conditions of patentability of the invention.”