

108TH CONGRESS
1ST SESSION

S. 2002

To improve and promote compliance with international intellectual property obligations relating to the Republic of Cuba, and for other purposes.

IN THE SENATE OF THE UNITED STATES

DECEMBER 9, 2003

Mr. BAUCUS (for himself and Mr. CRAIG) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To improve and promote compliance with international intellectual property obligations relating to the Republic of Cuba, and for other purposes.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “United States-Cuba
5 Trademark Protection Act of 2003”.

6 **SEC. 2. FINDINGS AND PURPOSE.**

7 (a) FINDINGS.—Congress makes the following find-
8 ings:

1 (1) Trademarks and trade names are vital as-
2 sets of the many United States companies that en-
3 gage in international trade.

4 (2) Worldwide sales of branded products of
5 United States companies contribute in important
6 ways to the livelihood of American workers and the
7 well-being and continued healthy growth of numer-
8 ous United States businesses. These sales depend, in
9 turn, on the security of the United States trade-
10 marks and trade names protected by reciprocal trea-
11 ties and agreements for the protection of intellectual
12 property.

13 (3) Among such treaties and agreements are
14 the Agreement on Trade-Related Aspects of Intellec-
15 tual Property Rights (TRIPS) of the World Trade
16 Organization, the Inter-American Convention for
17 Trademark and Commercial Protection, and the Ma-
18 drid Protocol.

19 (4) The United States should ensure that the
20 trademark and trade names of United States compa-
21 nies continue to be protected abroad by working to
22 ensure that countries comply with intellectual prop-
23 erty rights treaties and agreements. At the same
24 time, the United States should adhere to its obliga-
25 tions under such treaties and agreements.

1 (5) Hundreds of United States companies have
2 registered their trademarks in Cuba in order to en-
3 sure the exclusive right to use those trademarks
4 when the United States trade embargo on that coun-
5 try is lifted. Indeed, following the enactment of the
6 Trade Sanctions Reform and Export Enhancement
7 Act of 2000, many United States companies are al-
8 ready exporting branded food products to Cuba.

9 (6) The United States District Court for the
10 Southern District of New York ruled that section
11 211 of the Department of Commerce and Related
12 Agencies Appropriations Act, 1999 abrogates, with
13 respect to Cuba, the Inter-American Convention on
14 Trademarks and Commercial Protection, and the
15 court's ruling was affirmed by the United States
16 Court of Appeals for the Second Circuit.

17 (7) Cuba's international remedy under cus-
18 tomary international law, as codified by Article 60 of
19 the 1969 Vienna Convention on Treaties, for a
20 breach by the United States of the Inter-American
21 Convention, is to suspend or revoke the protections
22 Cuba currently affords United States trademarks
23 and trade names.

24 (8) In order to preserve the rights of United
25 States nationals holding trademarks in Cuba, the

1 United States must repeal section 211 of the De-
2 partment of Commerce and Related Agencies Appro-
3 priations Act, 1999, and should take the necessary
4 steps to promote the long-term protection of trade-
5 marks, trade names, and domain names held by
6 United States nationals in that country.

7 (9) The recent actions by the Government of
8 Cuba to prosecute and imprison unfairly critics of
9 the government are unacceptable and should be met
10 with strong condemnation.

11 (10) Promoting greater respect for the rule of
12 law in Cuba, including through the provisions of this
13 Act, will it is hoped diminish the likelihood for ac-
14 tions taken in the future that undermine operation
15 of the rule of law or disregard fundamental fairness
16 in administrative and juridical proceedings.

17 (b) PURPOSE.—The purpose of this Act is to promote
18 global intellectual property rights protections by ensuring
19 that the United States and the Republic of Cuba continue
20 to comply with their obligations under international trade-
21 mark agreements and understandings.

22 **SEC. 3. ADHERENCE TO INTERNATIONAL AGREEMENTS**
23 **AND UNDERSTANDINGS.**

24 (a) CONSULTATIONS WITH CUBA.—The President
25 shall direct the Secretary of State to initiate consultations

1 with the Republic of Cuba not later than December 31,
2 2003, in order to obtain assurances that the Republic of
3 Cuba will—

4 (1) continue to adhere to—

5 (A) the Paris Convention for the Protec-
6 tion of Industrial Property;

7 (B) the Inter-American Convention for
8 Trademark and Commercial Protection; and

9 (C) the Madrid Agreement Concerning the
10 International Registration of Marks and Pro-
11 tocol Relating to the Madrid Agreement Con-
12 cerning the International Registration of
13 Marks;

14 (2) implement the Joint Recommendation Con-
15 cerning Provisions on the Protection of Well-Known
16 Marks adopted by the General Assembly of the
17 World Intellectual Property Organization (Pub 833
18 E) in September 1999; and

19 (3) commit that the manager of the Country-
20 Code Top-Level Domain (ccTLD) will subscribe to
21 the Uniform Dispute Resolution Procedure (UDRP)
22 approved by the Internet Corporation for Assigned
23 Names and Numbers (ICANN) and provide to
24 United States nationals nondiscriminatory access to
25 such procedures.

1 (b) CONSULTATION WITH SECRETARY OF COM-
2 MERCE.—The Secretary of State shall initiate and conduct
3 the consultations under subsection (a) in consultation with
4 the Secretary of Commerce.

5 (c) REPORTS TO CONGRESS.—The Secretary of State
6 and the Secretary of Commerce shall submit to the Con-
7 gress a report on the progress and results of the consulta-
8 tions under subsection (a) not later than 6 months after
9 the date of the enactment of this Act and not later than
10 every 6 months thereafter.

11 (d) REPEAL OF PROHIBITION ON TRANSACTIONS OR
12 PAYMENTS WITH RESPECT TO CERTAIN UNITED STATES
13 INTELLECTUAL PROPERTY.—

14 (1) REPEAL.—Section 211 of the Department
15 of Commerce and Related Agencies Appropriations
16 Act, 1999 (as contained in section 101(b) of division
17 A of Public Law 105–277; 112 Stat. 2681–88) is re-
18 pealed.

19 (2) REGULATIONS.—The Secretary of the
20 Treasury shall issue such regulations as are nec-
21 essary to carry out the repeal made by paragraph
22 (1), including removing any prohibition on trans-
23 actions or payments to which subsection (a)(1) of
24 section 211 of the Department of Commerce and
25 Related Agencies Appropriations Act, 1999 applied.

1 **SEC. 4. REGISTRY OF U.S. TRADEMARKS AND WELL-KNOWN**
2 **MARKS IN CUBA.**

3 (a) REGISTRY OF U.S. TRADEMARKS.—Not later
4 than December 31, 2003, the Director of the Patent and
5 Trademark Office shall establish a registry of trademarks
6 each of which is owned by a United States national and
7 was registered in, or submitted for registration to, the Re-
8 public of Cuba on or after January 1, 1959.

9 (b) REGISTRY OF WELL-KNOWN MARKS.—

10 (1) ESTABLISHMENT.—Not later than Decem-
11 ber 31, 2003, the Director of the Patent and Trade-
12 mark Office shall establish a registry of trademarks
13 each of which is owned by a United States national
14 and met the requirements for a well-known mark in
15 the Republic of Cuba under Article 6bis of the Paris
16 Convention for the Protection of Industrial Property
17 as of December 31, 1958, and the Joint Rec-
18 ommendation Concerning Provisions on the Protec-
19 tion of Well-Known Marks adopted by the General
20 Assembly of the World Intellectual Property Associa-
21 tion (Pub 833 E) in September 1999.

22 (2) REQUIREMENTS FOR INCLUSION ON REG-
23 ISTRY.—The Director of the Patent and Trademark
24 Office shall require any applicant seeking to register
25 a well-known mark on the registry established under
26 paragraph (1) to supply documentation to establish

1 that the mark met the requirements set forth in
2 paragraph (1).

3 (c) ACCESSIBILITY.—The Director of the Patent and
4 Trademark Office shall ensure that each registry estab-
5 lished under subsections (a) and (b)—

6 (1) is accessible to the public through the Inter-
7 net;

8 (2) allows trademark examiners and applicants
9 seeking to register trademarks on the registry to
10 send and receive communications electronically;

11 (3) allows the United States Patent and Trade-
12 mark Office to process, maintain, and search elec-
13 tronically the contents and history of each applica-
14 tion to register a trademark, and trademark reg-
15 istration, included in the registry; and

16 (4) allows the public to access and search elec-
17 tronically the contents and history of each such ap-
18 plication and trademark registration.

19 **SEC. 5. AMENDMENTS TO CUBAN ASSET CONTROL REGULA-**
20 **TIONS.**

21 The Secretary of the Treasury shall amend the
22 Cuban Assets Control Regulations (part 515 of title 31,
23 Code of Federal Regulations) so that—

24 (1) the following transactions by any person
25 who is not a designated national are authorized:

1 (A) the filing and renewal of a blocked for-
2 eign domain name, the transfer or receipt of a
3 blocked foreign domain name, and the filing
4 and prosecution of proceedings to determine
5 rights to a blocked foreign domain name and
6 the prosecution of defenses to such proceedings;
7 and

8 (B) the filing and renewal of a blocked for-
9 eign trade name, the transfer or receipt of a
10 blocked foreign trade name, and the filing and
11 prosecution of proceedings related to a blocked
12 foreign trade name and the prosecution of de-
13 fenses to such proceedings;

14 (2)(A) the transfer or receipt of any trademark,
15 trade name, or domain name subject to United
16 States law in which a designated national has an in-
17 terest is authorized; and

18 (B) the filing and prosecution of opposition and
19 infringement proceedings related to any trademark
20 or trade name in which a designated national has an
21 interest, the filing and prosecution of proceedings to
22 determine rights to any domain name in which a
23 designated national has an interest, and the prosecu-
24 tion of defenses to such proceedings, are authorized;
25 and

1 (3) the payment of fees to the government of
2 any foreign country, either directly or through an at-
3 torney or representative, is authorized for research
4 of registries, directories, and government records
5 with respect to blocked foreign trademarks, blocked
6 foreign trade names, or blocked foreign domain
7 names, and the protection and enforcement thereof.

8 **SEC. 6. CONFORMING AMENDMENTS.**

9 (a) INTERNATIONAL CONVENTIONS.—Section 44 of
10 the Trademark Act of 1946 (15 U.S.C. 1126) is amended
11 by adding at the end the following:

12 “(j)(1) Any designated national shall be entitled to
13 the benefits of this Act to the extent necessary to give
14 effect to any provision of any convention or treaty relating
15 to trade or commercial names, or relating to the repression
16 of unfair competition, to which the United States and the
17 Republic of Cuba are parties, or to any reciprocal rights
18 relating to trade or commercial names or the repression
19 of unfair competition, that are extended by the Republic
20 of Cuba to nationals of the United States by law. The ab-
21 sence of commercial activities within the United States
22 shall not constitute a lack of standing or any other reason
23 for the dismissal of any action brought by any such des-
24 ignated national pursuant to this subsection.

1 “(2) No other provision of this section shall be con-
2 strued to limit the applicability of paragraph (1).

3 “(3) As used in this subsection, the term ‘designated
4 national’ has the meaning given that term in subpart C
5 of part 515 of title 31, Code of Federal Regulations, as
6 in effect on April 28, 2003, and includes any national of
7 a foreign country that is a successor-in-interest to that
8 designated national.”.

9 (b) CIVIL ACTIONS.—Section 43(a) of the Trademark
10 Act of 1946 (15 U.S.C. 1125(a)) is amended by adding
11 at the end the following:

12 “(4)(A) For purposes of this subsection, any person
13 who is engaged in the bona fide production, distribution,
14 marketing, or sale of spirits outside the United States and
15 who lawfully uses a mark or geographical indication in
16 connection with such spirits shall be considered to be or
17 likely to be damaged by a mark or geographical indica-
18 tion—

19 “(i) which, when used on or in connection with
20 other spirits, identifies a place other than origin of
21 such other spirits; and

22 “(ii) of which the first use in commerce on or
23 in connection with such other spirits was made on
24 or after one year after the date on which the WTO
25 Agreement (as defined in section 2(9) of the Uru-

1 guay Round Agreements Act) entered into force with
2 respect to the United States.

3 The preceding sentence shall also apply to any person in
4 any proceeding under section 13 or 14 of this Act.

5 “(B) As used in this paragraph, the term ‘spirits’
6 means any article provided for in heading 2207 or 2208
7 of the Harmonized Tariff Schedule of the United States.”.

8 **SEC. 7. AUTHORITY OF COURTS.**

9 United States courts shall have the authority to rec-
10 ognize, enforce, or otherwise validate any assertion by a
11 designated national of rights in any mark or trade name
12 based on common law rights or registration or under sub-
13 section (b) or (e) of section 44 of the Trademark Act of
14 1946. In this subsection, the term “designated national”
15 includes any national of a foreign country that is a suc-
16 cessor-in-interest to that designated national.

17 **SEC. 8. DEFINITIONS.**

18 In this Act:

19 (1) **BLOCKED FOREIGN DOMAIN NAME.**—The
20 term “blocked foreign domain name” means a do-
21 main name in which a designated national has an in-
22 terest, including any domain name issued by a des-
23 igned national.

24 (2) **BLOCKED FOREIGN TRADE NAME.**—The
25 term “blocked foreign trade name” means any trade

1 name in which a designated national has an interest,
2 including any such trade name issued by a des-
3 ignated national.

4 (3) **BLOCKED FOREIGN TRADEMARK.**—The
5 term “blocked foreign trademark” has the meaning
6 given that term in section 515.528(c) of title 31,
7 Code of Federal Regulations, as in effect on April
8 28, 2003.

9 (4) **DESIGNATED NATIONAL.**—The term “des-
10 ignated national” has the meaning given that term
11 in subpart C of part 515 of title 31, Code of Federal
12 Regulations, as in effect on April 28, 2003.

13 (5) **DIRECTOR OF THE PATENT AND TRADE-**
14 **MARK OFFICE.**—The term “Director of the Patent
15 and Trademark Office” means the Under Secretary
16 of Commerce for Intellectual Property and Director
17 of the United States Patent and Trademark Office.

18 (6) **DOMAIN NAME; MARK; TRADEMARK.**—The
19 terms “domain name”, “mark”, and “trademark”
20 have the meanings given those terms in section 45
21 of the Trademark Act of 1946.

22 (7) **INTEREST.**—The term “interest” has the
23 meaning given that term in section 515.312 of title
24 31, Code of Federal Regulations, as in effect on
25 April 28, 2003.

1 (8) TRADEMARK ACT OF 1946.—The term
2 “Trademark Act of 1946” means the Act entitled
3 “An Act to provide for the registration and protec-
4 tion of trademarks used in commerce, to carry out
5 the provisions of certain international conventions,
6 and for other purposes”, approved July 5, 1946 (15
7 U.S.C. 1051 et seq.).

8 (9) TRADE NAME.—The term “trade name”
9 means a trade name or commercial name as those
10 terms are defined in section 45 of the Trademark
11 Act of 1946.

12 (10) UNITED STATES NATIONAL.—The term
13 “United States national” means—

14 (A) any United States citizen; or

15 (B) any other legal entity which is orga-
16 nized under the laws of the United States, or
17 of any State, the District of Columbia, or any
18 commonwealth, territory, or possession of the
19 United States, and which has its principal place
20 of business in the United States.

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