

The Year in Review

Volume 51 *International Legal Developments*
Year in Review: 2016

Article 14

January 2017

International Intellectual Property Law

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Recommended Citation

Pamela Benzán Arbaje et al., *International Intellectual Property Law*, 51 ABA/SIL YIR 203 (2017)
<https://scholar.smu.edu/yearinreview/vol51/iss1/14>

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International Intellectual Property Law

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This article summarizes patent, trade secret, trademark, domain name, and copyright law developments in 2016, across multiple jurisdictions worldwide.¹

I. Patents²

A. UNITED STATES

Many federal court decisions in the past year have attempted to define the boundaries of the Supreme Court's broad language in precedent cases on the issue of patent eligible subject matter, specifically in the area of life sciences with respect to their interpretations of the holdings in *Mayo v. Prometheus*, *Ass'n for Molecular Pathology v. Myriad Genetics Inc.*, and in the area of computer science as a result of interpretations of *Alice Corp. v. CLS Bank Int'l*.³

Guidance in life science technology came this year regarding the application of the precedents set by *Mayo* and *Myriad*, in which the Supreme Court ruled that a law of nature is not eligible for a patent.⁴ In *Rapid Litigation v. Cellzdirect*, the United States Court of Appeals for the Federal Circuit (Federal Circuit) found the processes for cryogenically freezing liver

* Susan Brushaber, Reinhardt LLP, Denver, Colorado served as the editor for this 2016 review. Amanda Covington, Denver, Colorado, was assistant editor. Section editors are identified in each section.

1. For developments during 2015, see Susan J. Brushaber et al., *International Intellectual Property Law*, 50 Int'l Law. 193-209 (2015).

2. Patents Section Editor: Robin Fahlberg, State Farm Insurance Company, Bloomington, Illinois. Authors: Amanda Covington, Denver, Colorado (on the United States); Fabio Guzmán Saladin and Pamela Benzán Arbaje, Guzmán Ariza, Santo Domingo, the Dominican Republic (on the Dominican Republic).

3. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014); *Ass'n for Molecular Pathology v. Myriad Genetics Inc.*, 133 S. Ct. 2107 (2013); *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

4. Sean Sheridan, *How Mayo, Myriad and Alice May Impact Patent Valuations*, LAW 360 (Mar. 4, 2015, 8:48 AM), <http://www.law360.com/articles/626370/how-mayo-myriad-and-alice-may-impact-patent-valuations>.

cells to be patent eligible because they were directed toward an improved process of saving a type of liver cell called “Hepatocytes.”⁵ The inventors had found that the process of preserving cells could be improved upon by separating the viable cells from the non-viable ones and refreezing the viable cells.⁶ The twice-frozen cells behaved like once-frozen cells.⁷ The claims were patent eligible because they did more than identify or observe a concept; the claims were directed to a new cell preservation method.⁸ This case signals that the Federal Circuit may apply the Supreme Court’s decisions with a narrower viewpoint in the life science realm.

Under *Alice*, patents may be subject matter ineligible due to the broad language stating that inventions using a computer to implement an abstract idea are not patent worthy.⁹ This past year, the Federal Circuit applied *Alice* in two different cases involving computer technology and held that in each case the subject matter was patent eligible. The Federal Circuit held in *Enfish v. Microsoft Corp.* that the claims were patent eligible because they improved upon the way a computer operates by using a self-referential table to store data, which is superior to conventional databases.¹⁰ Similarly, in *Bascom Global v. AT&T Mobility* the Federal Circuit held that an improvement on computer function by the process of filtering internet content was not an abstract idea.¹¹ These rulings give some hope and guidance to software inventors. Until further direction is given by the Court, together *Enfish* and *Bascom* provide signposts to help inventors, patent practitioners, and litigants determine what is a patent subject matter eligible claim in a software patent.

B. THE DOMINICAN REPUBLIC

In September 2016 the National Office of Industrial Property (ONAPI) for the first time granted a national utility model patent to the Instituto Tecnológico de Santo Domingo, a Dominican university (INTEC). The registration involved the invention of an automatic heating catalyst in internal combustion engines. Two twenty-one-year-old engineering students developed the invention with the guidance of their professors and the help of the Technology and Innovation Support Center (TISC) of ONAPI based in INTEC. The invention is considered to be green and innovative because it seeks to inhibit the emission of vehicle gases, thus diminishing the pollution caused by such emissions.¹² After this favorable

5. *Rapid Litig. Mgmt. v. Cellzdirect, Inc.*, 827 F.3d 1042 (Fed. Cir. 2016).

6. *Id.* at 1047-48.

7. *Id.* at 1045.

8. *Id.* at 1048.

9. *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2352 (2014).

10. *Enfish, LLC v. Microsoft Corp.*, 822 F. 3d 1327, 1337-38 (2016).

11. *Bascom Glob. Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1353-54 (Fed. Cir. 2016).

12. *INTEC recibe primera Patente Nacional otorgada por ONAPI a una Universidad dominicana*, ONAPI, <http://www.onapi.gov.do/noticiascomunicaciones/191-septiembre-2016/924-intec->

private-public experience, ONAPI has entered into diverse collaboration agreements with other universities all over the Dominican territory for the opening of new TISCs.¹³

On May 27, 2016, the Supreme Court of Justice revoked and declared unconstitutional Article 157 of Law 20-00 on Industrial Property, which states that the resolutions issued by the General Director of ONAPI could be appealed to the Court of Appeals. In the decision, the Supreme Court indicated that resolutions issued by ONAPI are administrative acts; and therefore, according to the Dominican Constitution, the jurisdiction belongs to the Administrative Courts which are charged with ensuring the legality of the administrative proceedings.¹⁴ This decision invalidated the decision rendered by the Administrative Court on 2013 declaring it had no jurisdiction to rule on claims regarding resolutions issued by ONAPI.¹⁵

According to ONAPI statistics, from January 1, 2016 to October 13, 2016, 267 applications were filed for patents, of which 44 were national and 223 were international. Of the 267 applications, 213 of the applications were filed for patents, 14 for utility models and 40 for industrial designs. From 2010 to 2015 the number of patent applications declined significantly, with 406 applications in 2010 and only 309 in 2015.¹⁶

II. Trade Secrets¹⁷

A. UNITED STATES

On May 11, 2016, after unanimous passage in the Senate, and passage by a 410-2 vote in the House,¹⁸ President Obama signed into law the Defend Trade Secrets Act (DTSA).¹⁹ The DTSA, which was effective immediately,²⁰ amends the 1996 Industrial Espionage Act²¹ by creating a federal civil cause

recibe-primera-patente-nacional-otorgada-por-onapi-a-una-universidad-dominicana.html (last visited Nov. 7, 2016).

13. *ONAPI instalará Centro de Apoyo en Universidad de La Vega*, ONAPI, <http://www.onapi.gov.do/noticiascomunicaciones/145-marzo-2014/760-onapi-instalara-centro-de-apoyo-en-universidad-de-la-vega.html> (last visited Nov. 7, 2016).

14. *Shell Int'l Brands AG v. ONAPI*, S. Ct. of Justice, Third chamber, decision No. 237 (May 27, 2015).

15. *Barthel Intertrade Inc. v. ONAPI*, Super. Admin. Ct., decision No. 489-2013 (Dec. 27, 2013).

16. *Gráficas Estadísticas de Publicaciones*, ONAPI, <http://www.onapi.gov.do/graficas-estadisticas-publicaciones.html> (last visited Nov. 9, 2016).

17. Trade Secrets Section Editor: Susan J. Brushaber, Reinhardt LLP, Denver, CO. Authors: Amanda Covington, Denver, Colorado (on the United States); Virginia Brown, Keyder, New York (on Europe).

18. *S.1890 - Defend Trade Secrets Act of 2016*, CONGRESS.GOV, <https://www.congress.gov/bill/114th-congress/senate-bill/1890/all-actions?overview=closed&q=%7B%22roll-call-vote%22%3A%22all%22%7D>.

19. Defend Trade Secrets Act of 2016, Pub. L. No. 114-153, 130 Stat. 376 (2016).

20. Defend Trade Secrets Act amending US Code 18, s. 1836.

21. 18 U.S.C. §§ 1831-1839

of action joining state law as embodied in the Uniform Trade Secrets Act (UTSA) adopted by forty-eight states to allow for a federal cause of action for the misappropriation of a trade secret. The DTSA allows for new remedies to be sought under federal law instead of only through state law claims.

While there are some similarities with state trade secret laws, the DTSA does create some new remedies and caveats. One similarity is that the DTSA's definition of a trade secrets is the same as that of the Uniform Trade Secrets Act.²² Also, like the Uniform Trade Secrets Act, the DTSA provides for a three-year statute of limitations. Its damage remedies also mirror those of the Uniform Trade Secrets Act.²³

Other provisions in the DTSA do not have a parallel in the Uniform Trade Secrets Act. In the case of misappropriation, the DTSA provides a new seizure procedure in cases where the party being ordered would have to "destroy, move, hide, or otherwise make such matter inaccessible to the court" in order for the court to prevent dissemination of the trade secret.²⁴ It also creates protection for whistleblowers from any retaliatory accusations of a trade secret misappropriation. But this protection only exists so long as the whistleblower discloses the information pertinent to the trade secret to court or government officials in confidence.²⁵

The DTSA gives plaintiffs some new options and even though some of the provisions of the DTSA resemble those in the Uniform Trade Secrets Act, the DTSA does not preempt existing state law.²⁶ Thus, with the passage of the DTSA, plaintiffs can choose to file in state court or federal court. The benefit of filing in federal court, in addition to some new remedies, is that if the courts in a state are back-logged, the ability to file in federal court will generally expedite adjudication. While in-house preventative measures are the best course of action to secure trade secrets from being misappropriated, now there is an alternative avenue to pursue a claim of misappropriation.

B. EUROPE

In 2016, intellectual property (IP)—based on disclosure and secrecy—joined forces in new legislation enacted in both the United States and the European Union. Trade secrets, in the public mind centered around the formula for Coca Cola, dovetailed in an effort to provide a less costly and potentially longer-term form of protection of inventions than provided by

22. John Carson & Cameron Cushman, *DTSA Versus UTSA: A Comparison of Major Provisions*, LAW 360 (June 8, 2016), <https://www.law360.com/articles/803049/dtsa-versus-utsa-a-comparison-of-major-provisions>.

23. Defend Trade Secrets Act of 2016, Pub. L. No. 114-153, 130 Stat. 376, 380 (2016).

24. Defend Trade Secrets Act of 2016, § 2, 130 Stat. at 377 (2016).

25. Defend Trade Secrets Act of 2016, § 7, 130 Stat. at 385 (2016).

26. Defend Trade Secrets Act of 2016, § 2, 130 Stat. at 382 (2016).

patents, a common standard for employee non-compete clauses, and default protection of data, whether valuable or damaging.

The EU Directive²⁷ (the Directive) sets out harmonizing legislative goals, which EU Member States have until June 9, 2018 to implement. For readers unfamiliar with the structure of EU law, this basically means that the core provisions of the Directive will be inserted into national law where they will become subject to general principles of EU law, including fundamental rights, proportionality, protection against abuse of process, free movement of goods, services, capital and people, and legal certainty. Provisions of national law enacted pursuant to the Directive are also subject to the interpretation of the European Court of Justice.

At present, laws of the EU member states vary widely on the subject of trade secrets, with only Sweden having a specific Act on the Protection of Trade Secrets.²⁸ Other Member States situate and define trade secrets in a variety of categories from common law confidentiality in the UK, to unfair competition and provisions of Civil and Commercial Codes in other Member States.²⁹

The Directive institutes a common definition of “trade secret.”³⁰ Exceptions to its application include: freedom of expression and information; freedom and pluralism of the media; the public interest in disclosure for administrative or judicial authorities; disclosure of information submitted by businesses where necessary; and collective agreements.³¹ Article 1, § 3 of the Directive provides that mobility of workers shall not be hindered.

Article 3 identifies methods of legal acquisition of trade secrets that include independent discovery, reverse engineering by someone in legal possession of the object, information acquired through workers’ rights and honest commercial practice. Unlawful means of acquisition of trade secrets includes “unauthorized access to . . . any documents, objects, materials, substances or electronic files, lawfully under the control of the trade secret

27. Council Directive 2016/9433, art. 1–18, 2016 O.J. (L 157) 1, 1.

28. Om Skydd För Företagshemligheter, Lag (1990:409), (Swe.) *translated in, Act on the Protection of Trade Secrets (1990:409)*, WORLD INTELLECTUAL PROPERTY ORGANIZATION, <http://www.wipo.int/wipolex/en/details.jsp?id=3610>.

29. *See Study on Trade Secrets and Confidential Business Information in the Internal Market*, EUROPEAN COMMISSION (Apr. 2013), http://ec.europa.eu/internal_market/iprenforcement/docs/trade-secrets/130711_final-study_en.pdf.

30. Council Directive 2016/9433, *supra* note 27, at 9.

For the purposes of this Directive, the following definitions apply: (1) ‘trade secret’ means information which meets all of the following requirements: (a) it is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question; (b) it has commercial value because it is secret; (c) it has been subject to reasonable steps under the circumstances, by the person lawfully in control of the information, to keep it secret.

31. *Id.* Art. 1 § 2.

holder, containing the trade secret or from which the trade secret can be deduced,”³² and other conduct contrary to honest commercial practices.

Use of a trade secret is deemed unlawful if carried out by anyone who acquired it unlawfully, is in breach of a confidentiality agreement (or other duty not to disclose), or is in breach of a contractual duty to limit its use.³³ An action for disclosure will be dismissed where the disclosure involves the exercise of freedom of expression, as mentioned above, revealing of misconduct or illegal activity, disclosure by workers to their representatives, or protecting a legitimate interest recognized by EU or national law.³⁴

Extensive measures for protection of trade secrets during legal proceedings and for protection of personal data are contained in Article 9. Provisional and precautionary measures include cessation or prohibition of the use of the trade secret, prohibition of the production, marketing, importation, export, or storage of infringing goods, and seizure of suspected infringing goods, including imported goods.³⁵ Finally, Article 11 lists factors to be considered by the judicial authority and the nature of specific circumstances to be evaluated are also set out in detail.³⁶

Article 12 remedies—injunctions and corrective measures—include the “destruction of all or part of any document, object, material, substance or electronic file containing or embodying the trade secret or, where appropriate, the delivery up to the applicant of all or part of those documents, objects, materials, substances or electronic files.”³⁷

Pecuniary compensation may also be awarded in place of injunctions and corrective measures and damages may be awarded when the infringer “knew or ought to have known that he, she or it was engaging in unlawful acquisition, use or disclosure of a trade secret.”³⁸ Member States may “limit the liability for damages of employees towards their employers for the unlawful acquisition, use or disclosure of a trade secret of the employer where they act without intent.”³⁹

Although the Directive provides no criminal sanctions and expressly refrains from creating a new form of intellectual property, which leaves it outside the scope of application of the EU Enforcement Directive,⁴⁰ like its IP counterpart in the United States it risks undermining the basic justifications for intellectual property: that disclosure in return for monopoly fosters prosperity; and that individuals should be the beneficiaries of their own creative and inventive ideas. It makes the goose that laid the golden egg very uncomfortable.

32. *Id.* Art. 4 § 2.

33. *Id.* Art. 4 § 3.

34. *Id.* Art. 5.

35. *Id.* Art. 10.

36. *Id.* Art. 11.

37. *Id.* Art. 12.

38. *Id.* Art. 14.

39. *Id.*

40. Council Directive 2004/48, art. 2, 2004 O.J. (L 157) 16, 19.

III. Trademarks⁴¹

A. UNITED STATES

The Federal Circuit issued a landmark decision, *In re Tam*,⁴² holding that the federal prohibition on registration of “disparaging” trademarks is unconstitutional and in conflict with the First Amendment. In the case, applicant Mr. Simon Shiao Tam was denied registration of the mark THE SLANTS in connection with musical entertainment services. The court reasoned that the mark was disparaging to people of Asian descent. The Federal Circuit acknowledged that the district court correctly applied the disparagement test. In so holding the Federal Circuit overturned a thirty-five-year old case *In re McGinley*,⁴³ which had held that section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), does not implicate the First Amendment. After the Federal Circuit’s decision issued, the U.S. Department of Justice submitted a letter brief to the Federal Circuit stating its disagreement with the holding. The Department of Justice suggested that the ruling in *In re Tam* would lead to undesirable consequences because under the decision trademark registration would extend to scandalous and immoral marks covered under section 2(a) of the Lanham Act.⁴⁴ The USPTO’s reaction has been to suspend action on the SLANTS application as well as all applications that it has determined are disparaging, immoral or scandalous, on the ground that it is awaiting further court instruction. On April 20, 2016, the USPTO filed a petition for a writ of certiorari seeking Supreme Court review, which was granted in September 2016.

In *Belmora LLC v. Bayer Consumer Care AG*,⁴⁵ the Fourth Circuit overturned the United States District Court for the Eastern District of Virginia and held that the Lanham Act permits an owner of a foreign mark, even one who does not use its mark in the United States, to assert priority rights over a mark that is registered and used by another party domestically. Bayer Consumer Care AG (Bayer) sells naproxen sodium tablets in Mexico under the brand name FLANAX. In 2004, Belmora LLC (Belmora) began selling naproxen sodium tablets in the United States under the brand name FLANAX, and obtained a federal registration for FLANAX in 2005. Bayer petitioned to cancel the FLANAX registration in 2007, and seven years later, the Trademark Trial and Appeal Board (TTAB) cancelled the registration,

41. Trademarks Section Editor: Susan J. Brushaber, Reinhardt LLP, Denver, CO. Authors: Holly B. Lance, Smith, Gambrell & Russell, Washington D.C. (on the United States); Daniel Cooper, Cooper & Kurz, Stamford CT (on Europe); Fabio Guzmán Saladin and Pamela Benzán Arbaje, Guzmán Ariza, Santo Domingo, the Dominican Republic (on the Dominican Republic). Manish Dhingra, Mrityunjay Kumar, Sameep Vijayvergiya, Dhingra & Singh, Attorneys at Law, Delhi, India (on India); and David Taylor, Hogan Lovells, Paris (on Domain Names).

42. *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015).

43. *In re McGinley* 660, F.2d 481, 484 (C.C.P.A. 1981).

44. See Letter from U.S. Dept. of Justice, to Daniel E. O’Toole, Clerk, U.S. Court of Appeals for the Federal Circuit (Jan. 21, 2016), <http://src.bna.com/cd6>.

45. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016).

holding that Belmora was using the FLANAX mark to misrepresent the source of the goods. Belmora appealed the TTAB's decision to the district court, and Bayer sued Belmora for false designation of origin and false advertising. The district court, applying the Supreme Court decision *Lexmark Int'l, Inc. v. Static Control Components, Inc.*,⁴⁶ dismissed Bayer's claims. The Fourth Circuit held that the district court erred in its analysis, and that the Lanham Act does not require ownership and use of a mark in the U.S. as a threshold requirement. It further held that Bayer's claims fell within the statute's protected zone of interests and should be permitted to proceed. In October 2016, Belmora filed a petition for a writ of certiorari from the Supreme Court.

B. EUROPE

In mid-December 2015, the European Union issued a new directive and a new regulation, respectively, on the law of trademarks. The Directive came into effect in January 2016, and the Regulation came into force in March.⁴⁷ Implementation of the directive by EU Member States is required by January 2019. Several of the changes from previous EU trademark law are procedural and, indeed, one is cosmetic. Under the new Regulation, the European trademark office—which used to be known as the Office for Harmonization in the Internal Market (OHIM)—is now more appropriately called the “European Union Intellectual Property Office,” or EUIPO.⁴⁸ Similarly, when a trademark holder registers a trademark with this new office, the mark will be known as a “European Union trade mark” rather than a “Community trade mark” as it was formerly known.⁴⁹

On the more consequential side, under the new goods and services classification structure, only goods and services falling within the literal meaning of an individual item will be considered covered by the specification.⁵⁰ This amendment implements procedural changes made necessary by the Court of Justice's decision in the 2012 “IP Translator” case.⁵¹ Further, for International Registrations designating the European Union, the EU has amended the scope of the opposition period from six to nine months after publication to one to four months after publication. The three-month opposition period does not change. Also, trademark renewals must be applied for by the expiration date of the registration, not by the end of the month of the expiration date, as was the former practice.

46. *Id.* at 715.

47. Council Directive 2015/2424, art. 4, 2015 O.J. (L 341) 21, 88.

48. *Id.* at 27.

49. *Id.*

50. *Id.* at 35.

51. See, e.g., case C-307/10, *Chartered Inst. of Patent Attorneys v. Registrar of Trade Marks*, 2012 E.C.R., ¶ 56 (holding that the 2008 EU Trademark Directive did not preclude the use of class headings in a specification of goods and services so long as the specification identified with sufficient clarity and precision the goods and/or services for which protection is sought).

On the substantive end, perhaps the most sweeping change is one that for many trademark practitioners in the United States is a welcome one as it puts European substantive trademark law on par with the United States. Previously, under EU law the right to register a mark was limited to graphic marks only. There was no way to register a sound mark or a scent mark, for example. As of March 23, 2016, Article 3 of the new Directive removes this obstacle for mark holders. Under the new Directive and Regulation there is no longer a requirement that a trademark must be represented graphically in order to be afforded protection.⁵² As a result, the owners of both sound marks and scent marks can now apply to the EUIPO and national intellectual property offices for registration of these marks.

As for case law, perhaps the most significant intellectual property decision of the past year was the September 2015 decision by the Court of Justice of the European Union in *Societe des Produits Nestle SA*. In that case, the CJEU held, inter alia, that the bar to registration under the EU Trademarks Directive for signs that consist of a shape that is “necessary to obtain a technical result” (what U.S. practitioners might call utilitarian functionality) must be interpreted by reference to the *function* of the shape sought to be trademarked. The determination of whether the sign can be registered should not be made by reference to the method of manufacture of the goods whose shape is sought to be trademarked.⁵³ The Court further held that a sign that is held to be functional under the Article 3(e) bar to registration can never achieve acquired distinctiveness. The case was remanded to the High Court of England and Wales, where Justice Arnold held that the shape of the Kit Kat bar could not be registered. As a result, Nestle lost the latest round in a long-running battle between itself and Cadbury in the protection of the shape of the Kit Kat bar.

C. THE DOMINICAN REPUBLIC

In a decision that contradicts the principles of Law 20-00 on Industrial Property, the Court of First Instance of Santiago has held that a request to enjoin the use of a registered trademark on the grounds of confusing similarity must be based on a registered trademark.⁵⁴ According to this decision, tribunals cannot enjoin the use of a registered trademark on the grounds that it is substantially similar to an unregistered trademark, even if the unregistered trademark was in use prior to the registration date of the registered trademark. This decision contradicts the principles Article 113 of Law 20-00 on Industrial Property which establishes that the exclusive right to a trademark is acquired with its first use in commerce and not by registration.

52. Cf., Council Directive 2015/2436, art. 3, 2015 O.J. (L 336) 1, 7; Council Directive 2008/95, art. 2, 2008 O.J. (L 299) 25, 26.

53. Case C-215/14, *Societe des Produits Nestle S.A. v. Cadbury UK Ltd.*, 2015 E.C.R. ¶ 57.

54. Court of First Instance of Santiago, Ordinance no. 514-15-00466, Sept. 15, 2015.

The Court of First Instance of Santiago has also established that the use of a third party trademark constitutes unfair competition under Law 20-00 on Industrial Property. The decision indicates that the mere use of a trademark without the consent and authorization of the owner is unfair competition.⁵⁵

The Constitutional Court found that the fact that a company promotes its products as the best in the market alone is not unfair competition under the dispositions of Law 20-00 on Industrial Property. The decision establishes that unfair competition arises only when a company attacks competing products in the market with negative information.⁵⁶

The Supreme Court declared valid and legal the refusal to register a foreign trademark in the Dominican Republic, even though the mark was already registered in other countries, because the design was common and not distinctive in the Dominican Republic. This decision was based on Article 6 of the Paris Convention for the Protection of Industrial Property.⁵⁷

On December 2015, the Supreme Court of Justice declared that the prosecution for violations of law 20-00 on Industrial Property have to follow the same procedure established in the Dominican Criminal Procedural Code in all its aspects, including the claim for compensation due to a violation of a registered trademark owner's rights.⁵⁸

The statistics of the National Office of Industrial Property (ONAPI) show that during the last four years, from 2012 to 2016, there has been an increase in the registration applications for trademarks, especially for trade names, and a slight decrease in the registration applications for slogans.⁵⁹ The statistics also show that for the period of January 1, 2016 through September 30, 2016, 34,347 applications were filed for the registry of trade names and trademarks. Of these applications, 26,237 were for trade names, 7,734 for trademarks, 374 for slogans, and 2 for denominations of origin. Moreover, the statistics demonstrate that 3,516 applications were filed for trademark renewal and 1,046 for trade name renewals.

D. INDIA

In an important ruling, the Supreme Court of India provided clarification as to the place where a suit can be instituted by the plaintiff under the Copyright Act, 1957 and the Trade Marks Act, 1999.⁶⁰ The Court agreed that the very language of section 62⁶¹ of the Copyright Act and section 134⁶² of the Trade Marks Act provides an alternative forum, in addition to section 20 of Civil Procedure Code (the CPC) by including a district court within

55. Court of First Instance of Santiago, Decision 365-15-00769, June 02, 2015, *Loto Real del Cibao S.A. v. Banca Redy Miguel y/o Miguel C. Jáquez Espinal*.

56. Constitutional Court, decision TC/0600/15, Dec. 17, 2015, *Unilever Caribe, S.A.*

57. Supreme Court of Justice, decision No. 42, Feb. 12, 2014.

58. Supreme Court of Justice, decision No. 523, Dec. 21, 2015.

59. *Gráficas Estadísticas de Publicaciones*, *supra* note 16 (last visited Nov. 9, 2016).

60. *See Indian Performing Rights Society Ltd. v. Sanjay Dalia & Anr.*, (2015) 63 SCR 49 (India).

61. *See id.* at 10.

62. *See id.* at 7–10.

whose limits the plaintiff actually and voluntarily resides or carries on business or personally works for gain:

On a due and anxious consideration of the provisions contained in section 20 of the CPC, section 62 of the Copyright Act and section 134 of the Trade Marks Act, and the object with which the latter provisions have been enacted, it is clear that if a cause of action has arisen wholly or in part, where the plaintiff is residing or having its principal office/ carries on business or personally works for gain, the suit can be filed at such place/s. But, this right to institute suit at such a place has to be read subject to certain restrictions, such as in case plaintiff is residing or carrying on business at a particular place/having its head office and at such place cause of action has also arisen wholly or in part, plaintiff cannot ignore such a place under the guise that he is carrying on business at other far flung places also.

E. DOMAIN NAMES

The Internet experienced a historic and transitional year in 2016. After years of work and consultation, the Internet Corporation for Assigned Names and Numbers (ICANN) finally completed the transition of the functions of the Internet Assigned Names Authority (IANA) from the United States Department of Commerce's National Telecommunications and Information Administration (NTIA) to the global multi-stakeholder community. On March 10, 2016, the last day of the ICANN 55 Meeting in Marrakech, Morocco, the ICANN Board transmitted the IANA Stewardship Transition Proposal, a plan developed by the international Internet community, to the NTIA for approval. In early June, the NTIA informed ICANN that it had determined that the IANA Stewardship Proposal satisfied its strict transition criteria. Thus, on October 1, 2016, after nearly two decades of US government control, the contract between ICANN and the NTIA to perform IANA functions officially expired, and the IANA function was handed over to the global Internet community.⁶³

Eight years after the approval of the New generic Top-Level Domain (gTLD) Program in 2008, the first round of the gTLD Program is nearing completion, with the delegation of over 1,200 new gTLDs. Overall, the number of domain name registrations continues to grow exponentially, with approximately 335 million domain name registrations across all TLDs. As reported in the Verisign Domain Name Industry Brief, this growth represents an increase of 12.9 percent (or 38.2 million domain name registrations) compared to 2015.⁶⁴ Together under both .COM and .NET, 143.2 million domain names are registered. The number represents a 7.3

63. *Stewardship of IANA? Functions Transitions to Global Internet Community as Contract with U.S. Government Ends*, ICANN (Oct. 1, 2016), <https://www.icann.org/news/announcement-2016-10-01-en>.

64. *Internet Grows to 334.6 Million Domain Name Registrations in the Second Quarter of 2016*, VERISIGN (Sept. 15, 2016), <https://investor.verisign.com/releasedetail.cfm?releaseid=989318>.

percent increase year over year. At least 149.9 million domain name registrations are registered under country code Top Level Domains (ccTLDs). This number represents an 8.5 percent growth (or 11.7 million domain name registrations) year over year. Domain name registrations under new gTLDs have also experienced considerable growth, with over 22 million domain name registrations, representing 6.6 percent of total domain name registrations. The top five new gTLDs in terms of domain name registrations, XYZ, .TOP, .WANG, .WIN and .CLUB, account for over 50 percent of all new gTLD domain names. Overall, the 10 largest TLDs are .COM, .TK (Tokelau), .CN (China), .DE (Germany), .NET, .ORG, .UK (United Kingdom), XYZ, .RU (Russian Federation) and .NL (Netherlands).⁶⁵

Cybersquatting continues to be a growing problem for rights holders, and the number of complaints filed has increased considerably with the introduction of new gTLDs. For instance, the number of complaints filed under the UDRP before the World Intellectual Property Organisation (WIPO), has been steadily increasing since the introduction of the first new gTLDs in 2013. While the number of domain name disputes filed with WIPO in 2015 did not surpass the record high of 2,884 cases filed in 2012, it did reach the third highest level since 1999. As reported by the WIPO, domain name disputes under new gTLDs accounted for an impressive 10.5 percent of all UDRPs filed with WIPO in 2015,⁶⁶ with .XYZ, .CLUB and .EMAIL amongst the new gTLDs with most disputed domain names. As of November 2016, 2,647 complaints had been filed with WIPO in 2016 with the figure undoubtedly going up as a direct result of the introduction of new gTLDs into the DNS.

It is also worth noting that 71 ccTLD Registries have adopted the UDRP (or a variation of it) and have designated the WIPO as dispute resolution provider. As a result, ccTLD disputes represented 13.7 percent of cases filed with the WIPO in 2015, a figure which is also likely to increase this year. Furthermore, many trademark owners have now opted to file Uniform Rapid Suspension (URS) complaints instead of a UDRP, which has likely slowed the growth of UDRP complaints. Since the first URS case was filed in 2013, over 600 URS complaints have been filed before the Forum (formerly known as NAF), with a considerably high number of cases resulting in a decision in favor of complainants.

While the URS was originally designed for new gTLDs and is not an ICANN consensus policy, it is proving to be a useful and cost-effective mechanism for protecting rights, although clearly it has been subject to criticism as it only provides for the suspension of a domain name (as opposed to transfer) as remedy. Several legacy gTLDs have voluntarily adopted the

65. *The Verisign Domain Name Industry Brief*, VERISIGN, https://www.verisign.com/en_US/domain-names/dnib/index.xhtml#home.

66. *Cybersquatting Cases Up in 2015, Driven by New gTLDs*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (Mar. 18, 2016), http://www.wipo.int/pressroom/en/articles/2016/article_0003.html.

URS, including .TRAVEL, .PRO, .CAT and, more recently, .TEL and .XXX.

III. Copyright⁶⁷

A. UNITED STATES

The jury in a federal district court in California returned a stunning verdict determining that Google was shielded from liability for copyright infringement based on the affirmative defense of fair use.⁶⁸ Previously, the Federal Circuit Court of Appeals had reversed the lower court, ruling that Google's unauthorized copying of declaratory code for thirty-seven distinct application programming interfaces (APIs) from Oracle's popular JAVA computer program constituted copyright infringement.⁶⁹ Google had simply copied the APIs, rather than writing its own code for its Android software for smartphones,⁷⁰ but the lower court had ruled that the API structure was not copyrightable under section 102(b) of the Copyright Act because it was a system or method of operation. The Federal Circuit Court, however, found that the APIs contained sufficient "expression" to be deserving of copyright protection and remanded the case to the lower court for a determination of Google's affirmative defense of fair use.⁷¹ Google filed a petition for a writ of certiorari before the Supreme Court, but the Supreme Court declined to hear the case on appeal.⁷²

The fair use doctrine is codified in the United States Copyright Act.⁷³ In determining whether the unauthorized copying of a work is protected by the fair use doctrine, the court considers several factors, including the nature of the work, the purpose of the use (e.g., for profit vs. critical commentary or social good), the substantiality of the copying in relation to the work, and whether such copying adversely affects the market for the author's work.⁷⁴ On May 26, 2016, the jury returned a unanimous verdict holding that Google's use constituted fair use under the U.S. Copyright Act.⁷⁵

67. Copyright Section Editor: Michelle Wynne, Zillow Group, Inc., Seattle, WA. Authors: United States: Ralph H. Cathcart, Ladas & Parry LLP, New York, NY; European Union: Daniel B. Koburger, Benjamin N. Cordozo School of Law, New York, NY and Daniel Cooper, Cooper and Kurz, Stamford, CT.; India: Manish Dhingra, Dhingra & Singh, Delhi, India; Dominican Republic: Fabio Jose Guzman Saladin, and Pamela Benzán Arbaje, Guzmán Ariza, Santo Domingo, Dominican Republic.

68. *Oracle Am., Inc. v. Google Inc.*, No. C 10-03561 WHA, 2016 WL 3181206, at *1-2 (N.D. Cal. June 8, 2016).

69. *Oracle America, Inc. v. Google, Inc.*, 750 F.3d 1339, 1348 (Fed. Cir. 2014).

70. *Id.* at 1370.

71. *Id.* at 1381.

72. *Oracle America, Inc. v. Google, Inc.*, 750 F.3d 1339 (Fed. Cir. 2014); *cert. denied*, 2014 WL 5319724 (U.S. Oct. 6, 2014) (No. 14-410).

73. 17 U.S.C. § 107 (2016).

74. *Id.*

75. *Oracle Am., Inc.*, WL 3181206 at *1.

The verdict has far ranging implications, both for software developers and Oracle, who stood poised to demand over nine billion dollars in damages.⁷⁶ Further, as Google's Android products prospered, Oracle's JAVA licensing business, which relied heavily on "feature-phones," cratered.⁷⁷ Oracle immediately vowed it would appeal the verdict⁷⁸ and, on October 26, 2016, Oracle formally filed a notice of appeal before the Federal Circuit Court, seeking to appeal the jury's verdict.⁷⁹

In another case involving Google, the Supreme Court of the United States rejected Authors Guild's petition for writ of certiorari⁸⁰ to appeal the Second Circuit's ruling, which held that "Google Books" does not infringe the copyrights of published authors.⁸¹ In 2004, Google launched the "Google Library Project" and "Google Books Project," in cooperation with major research libraries around the world, to scan and digitally catalogue tens of millions of books.⁸² To date, Google has digitally copied approximately thirty million books to the Google Books digital catalog.⁸³ Essentially, Google copied (without permission) each book in its entirety, extracting and indexing the book's machine readable text.⁸⁴ Internet users could not view the entire book, but instead were limited to "text mining" where only small snippets containing the specific text searched were viewable by the public.⁸⁵ Google does not charge a fee or directly feature any advertising in connection with the Google Books Project.

Section 107 of the United States Copyright Act sets forth several factors relevant to identifying whether a particular use qualifies as a fair use.⁸⁶ Fair use is an affirmative defense to copyright infringement and thus does not negate the elements for a finding of infringement. Rather, the defense operates to excuse the infringer from liability and damages. The Second Circuit determined that Google was shielded from liability because 1) its unauthorized use promoted the arts and sciences; 2) Google's profit motivation did not outweigh the transformative nature of Google's use; 3) the "snippets" were not substantial in terms of copying expressive content;

76. Joe Mullin, *Google Beats Oracle-Android Makes "Fair Use" of JAVA APIs*, ARSTECHNICA (May 26, 2016), <https://arstechnica.com/tech-policy/2016/05/google-wins-trial-against-oracle-as-jury-finds-android-is-fair-use/>.

77. *Id.*

78. *Id.*

79. *Oracle America, Inc. v. Google, Inc.*, No. C 10-03561 WHA, 2016 U.S. Dist. LEXIS 74931 (Northern District of California entered June 8, 2016), *appeal filed*, No. CV 10-03561 WHA (9th Cir. Oct. 26, 2016).

80. *Google, Inc. v. Oracle America, Inc.*, 804 F.3d 202 (2d Cir. 2015), *cert. denied*, 84 U.S.L.W. 3357 (U.S. Apr. 18, 2016) (No. 15-849).

81. *Authors Guild*, 804 F.3d 202, 228 (2d Cir. 2015).

82. *Id.* at 208.

83. Tim Wu, *What Ever Happened to Google Books?*, THE NEW YORKER (Sept. 11, 2015), <http://www.newyorker.com/business/currency/what-ever-happened-to-google-books>.

84. *Authors Guild*, 804 F.3d at 209.

85. *Id.* at 208-210.

86. 17 U.S.C. § 107 (2016).

and 4) the use did not adversely affect the market for the authors' books or provide a substitute therefor.⁸⁷ The Court was especially focused on the highly transformative nature of Google Books and the fact that the text which was made available to users was sufficiently limited so as not to provide a market substitute for the full versions of the books.⁸⁸

Google has always maintained that Google Books provided the public with a new way to discover books of interest and that increased public awareness would help authors.⁸⁹ By using Google's tool, people would be able to formulate their own queries, review search results, and find books that they otherwise may not have found.⁹⁰ Of course, many authors vehemently disagree and view Google's actions as an infringement of both the Constitutional and statutory monopoly afforded to authors concerning their exclusive rights to copy, distribute, display, and make derivative works of their works. Indeed, the president of the Authors Guild, Roxana Robinson, remarked that "what we are seeing is a trend of redistribution of wealth from the creative sector to the tech sector across the entire spectrum of the arts."⁹¹ In either case, the Supreme Court's denial of certiorari appears to have "closed the book," if you will, on this chapter of the epic battle between Google and the Authors Guild.⁹²

B. EUROPE

The judgments by the Court of Justice of the European Union (CJEU) that received the most recognition in 2016 were *GS Media*⁹³ and *McFadden*.⁹⁴ Beyond these judicial landmarks, the EU has seen a policy-driven event with an unforeseeable and potentially wide-ranging scope: the EU copyright reform proposal.⁹⁵

One case, *GS Media*, referred to the CJEU by the Dutch Supreme Court,⁹⁶ concerned the liability of an individual who hyperlinked, without

87. *Authors Guild*, 804 F.3d at 207-208.

88. *Id.* at 229.

89. *Id.*

90. Adam Liptak & Alexandra Alter, *Challenge to Google Books is Declined by Supreme Court*, N.Y. TIMES (Apr. 18, 2016), <http://www.nytimes.com/2016/04/19/technology/google-books-case.html>.

91. *Id.*

92. Zosha Millman, *Closing the Book on Authors Guild v. Google Books*, THE LEXIBLOG NETWORK (Apr. 18, 2016), <http://www.lxbn.com/2016/04/18/closing-the-book-on-authors-guild-v-google-books/>.

93. Case C 160/15, *GS Media BV v. Sanoma Media Netherlands BV et al.*, ECLI:EU:C:2016:644.

94. Case C 484/14, *Tobias Mc Fadden v. Sony Music Entertainment Germany GmbH*, EU:C:2016:689.

95. Commission of the European Communities Proposal for a Directive of the European Parliament and of the Council on Copyright in the Digital Single Market, COM (2016) 593 Final (September 2016).

96. HR 3 April 2015, ECLI 2015, 841 m.nt. (*GS Media B.V./Sanoma Media Netherlands B.V. c.s.*) (Neth.).

consent, to photographs from a *Playboy* magazine photoshoot, which were initially made freely available online without authorization.⁹⁷ The CJEU clarified that holding someone responsible for infringing through ‘communication to the public’⁹⁸ in a case of linking to content made available without authorization, required an individual assessment.⁹⁹ The Court emphasized the role of the user and the deliberate nature of the user’s actions,¹⁰⁰ including: (1) if the actor did not act for personal gain, could he reasonably not have known the work had been made available on the internet without the copyright holder’s permission; (2) if the actor ought to have known; and (3) if the actor acted for personal gain, could he rebut the presumption that he had full knowledge.¹⁰¹ Thus, in the case, the CJEU allowed a distinction between hyperlinking as an ordinary internet user and hyperlinking to seek profit. It extended *Svensson*, where the CJEU referred to content made available with consent, which the CJEU held does not constitute “communication to the public.”¹⁰²

The second case, *McFadden*, was referred to the CJEU by the Regional Court, Munich I, Germany.¹⁰³ In *McFadden*, the issue was whether a rights holder can demand an injunction against an intermediary internet service provider that grants free access for purposes of its actual business services (e.g., a café) when a user makes a protected work available to the public through the intermediary without the right holder’s consent.¹⁰⁴ The CJEU held that it was permissible to require password protection by the intermediary,¹⁰⁵ but not to require monitoring of the data flow or termination of the connection.¹⁰⁶ The former is a dissuasive measurement if the users are required to identify themselves¹⁰⁷ and it is a measurement that does not damage the intermediary’s freedom to conduct business¹⁰⁸ or undermine the user’s right of freedom of information.¹⁰⁹ But, the CJEU did not answer who bears the costs of an injunction where the service provider cannot be held liable.

97. *GS Media*, ¶ 24.

98. Directive 2001/29/EC of the European Parliament and of the Council on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 O.J. L 167/11, art. 3(1).

99. *GS Media*, ¶ 33.

100. *GS Media*, ¶ 35.

101. *Id.* at ¶¶ 47, 49, 51.

102. *Id.* at ¶ 42.

103. Landgericht München I [LG München I] [Regional Court of Appeals, Munich I] September 9, 2014, 7 O 14719/12, GEWERBLICHER RECHTSSCHUTZ UND URHEBERRECHT [GRUR] 2015, 70.

104. *McFadden*, ¶ 2.

105. *Id.* at ¶¶ 90-96.

106. *Id.* at ¶¶ 87-88.

107. *Id.* at ¶ 96.

108. *Id.* at ¶ 91; Directive 2001/29/EC of the European Parliament and of the Council on Certain Legal Aspects of Information Society Services, in Particular Electronic Commerce, in the Internal Market, 2000 O.J. L 17/07, at art. 15(1).

109. *McFadden*, ¶ 92.

On December 9, 2015, the Commission unveiled its proposed regulation on the portability of copyrighted content aimed at furthering the Digital Single Market initiative.¹¹⁰ Under the regulation, providers of subscription-based online content must enable subscribers to that content from one EU member state who are “temporarily present” in another EU member state to access and use the subscription content in the second EU state.¹¹¹ While it is currently unclear what “temporarily present” means,¹¹² it does seem clear that the purpose of the new regulation is to allow users to be able to take the copyrighted content they have license to listen to, view, etc., with them across the borders of EU member countries. Concomitantly, the proposed regulation provides that the copyright license flowing from such subscription-based content—and the infringement of copyright that would come from actions violating the terms of the license—deal solely with the subscriber’s “member state of residence.”¹¹³ This obviates the need for, and eliminates the ability of, content providers to condition access to content outside the subscriber’s home jurisdiction on the agreement to a license in each EU member state wherein the subscriber attempts to access or use that content.

C. INDIA

The Delhi High Court elaborated on the interpretation of Section 15¹¹⁴ of the Copyright Act which in part states that, if copyright in a design is capable of registration under the Designs Act, even if the design is not registered, the copyright in the design will cease to exist as soon as the product or article incorporating the design is produced more than fifty times through an industrial process.

The Court first commented on the rationale behind Section 15¹¹⁵ of the Act and said, “[a]s evident from the language of Section 15¹¹⁶ of the Copyright Act, copyright does not subsist in a registered design.” The rationale for this is that someone’s choice of design registration is a conscious decision to use the underlying work for mass production. The design has a commercial element and reaches a wider audience through the medium of the product or the article. This is of course possible in the cases of designs of products and articles that are sold widely or have an expansive market. But, that is not always so in the case of an artistic work— typically a painting, a drawing or even a sculpture, for instance (which are the closest species of copyrights that overlap with designs). Yet the transformation of a work of art into a design results in the possibility of its protection as a

110. E.C. Reg. 2015/0284 (COD), art. 1 (Dec. 9, 2015).

111. *Id.* at art. 3(1).

112. *See id.* at art. 2(d) (defining “temporarily present” as presence in a Member State “other than the Member State of residence”).

113. *Id.* at arts. 4, 5(1).

114. *See* Indian Copyright Act (1957) at art. 15.

115. *Id.*

116. *Id.*

design. Section 15(1)¹¹⁷ dictates that if this kind of work is registered as a design, there is no copyright protection. Section 15(2)¹¹⁸ on the other hand, says that if a work is capable of design registration, and is not registered, but replicated as a product or article through a design more than 50 times through mechanical process, copyright in that work ceases. The Court said,

We do hold that in the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work. Thus, for instance a famous painting will continue to enjoy the protection available to an artistic work under the Copyright Act. A design created from that painting for the purpose of industrial application on an article so as to produce an article which has features of shape, or configuration or pattern or ornament or composition of lines or colors and which appeals to the eye would also be entitled design protection in terms of the provisions of the Designs Act. Therefore, if the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act but not the original painting.

D. DOMINICAN REPUBLIC

In April 2015, the Court of Appeals of the National District established a distinction between ideas and copyrightable work, choosing to follow the international jurisprudence criteria on the topic. The Court determined that, ideas alone, which are described, explained, illustrated or incorporated in a play, are protectable only in their form of expression, which must be original. Using this logic, the Court found that the use in an advertisement of a phrase contained in a musical piece does not by itself constitute a non-authorized reproduction if the phrase is not synced with the rhythm of the musical piece. In this particular case, the claimants were the copyright owners of a popular song in the Dominican Republic named “*El Teke*,” and the defendant was a lottery named *Loteka* that used a phrase of that song in an advertisement to promote their business. As part of its reasoning, the Constitutional Court analyzed the significance of the expression “*el teke*” in the national territory, the context in which the phrase was used, and the intention of the advertisement. The Court concluded that, in the context of the advertisement, the defendants were using the phrase because of its meaning and, because they did not use a musical rhythm, it could not be linked to the song of the claimants.¹¹⁹

The Court of First Instance of the Duarte Province has ruled that the collective rights of management organizations must demonstrate the repertoire over which they have rights to be able to collect on behalf of authors and composers. This ruling goes against the jurisprudential criteria

117. *Id.*

118. *Id.*

119. Court of Appeal of the National District, Decision 286-15, April 30, 2015, *José Rafael Colón y Carlos Napoleón Santana vs. Loteka SRL y Mario Peguero*.

of other countries that presume these organizations represent an unnamed repertoire.¹²⁰ Moreover, in a case regarding the collection of royalties, the Court of First Instance of the Duarte Province established that the collective rights management organizations must justify the origin and amount of the debt for which they request interim measures.¹²¹

In a case regarding architectural plagiarism, the Court of Appeal of the National District, when referring to the appointment of experts for performing studies and presenting reports, indicated that the fact that an appointed expert in architecture was a member of the same university that previously issued a study on the case could be considered a reason for recusal.¹²²

On July 20, 2016, the Constitutional Court declared in conformity with the constitution that the Beijing Treaty on Audiovisual Performances, which is currently awaiting ratification by the Congress, conforms to the constitution, thus exercising the preventive control of constitutionality conceived in article 185, numeral 2 of the Dominican Constitution.¹²³ This is an important measure to protect the performers in relation to their interpretations in audiovisual performances. The Dominican legislation does not have any national law in this regard and the WIPO Performances and Phonograms Treaty, ratified by the Dominican Republic in 2006, does not cover the protections established in the Beijing Treaty.

120. Court of First Instance of Duarte. Resolution number 00034/2015, September 7, 2015. *Sgacedom vs. El Tanque y Wellington Genao*.

121. Court of First Instance of Duarte. Resolution number 40/2015, July 27, 2015, *Sociedad de Autores Compositores y Editores Dominicanos de musica Inc. (SGACEDOM) vs Bomba La Fortuna y Alex Serrata*.

122. Court of Appeal of the National District, resolution No. 27-2015, October 19, 2015, *Jesus Osiris Garcia Pérez vs Víctor Durán & Asociados, S.A. and Víctor Manuel Durán Núñez*.

123. Constitutional Court, TC/0302/16, July 20, 2016.

