

STATEMENT OF  
**MARY BONEY DENISON**  
**COMMISSIONER FOR TRADEMARKS**  
**United States Patent and Trademark Office**  
  
BEFORE THE  
**SUBCOMMITTEE ON COURTS, INTELLECTUAL PROPERTY,  
AND THE INTERNET**  
**COMMITTEE ON THE JUDICIARY**  
  
**U.S. House of Representatives**  
  
**Hearing on “Resolving Issues with Confiscated Property in Cuba,  
Havana Club Rum and Other Property”**  
  
**FEBRUARY 11, 2016**

Chairman Issa, Ranking Member Nadler and Members of the Committee:

Thank you for this opportunity to describe the United States Patent and Trademark Office's (USPTO's) role with respect to the renewal of the Havana Club trademark registration.

The USPTO is charged with carrying out the trademark registration process consistent with the law so as to provide a stable marketplace for the sale of goods or services identified by the registered mark for the benefit of both consumers and owners. The USPTO receives more than 300,000 applications for trademark registration each year and administers a trademark register of more than 2 million active registrations.

As a general matter, U.S. trademark law requires the submission of certain documents and payment of appropriate fees to maintain and renew a trademark registration. The actions we took at the USPTO in this case were straight-forward and consistent with the law.

In 1974, Cubaexport applied for registration of the Havana Club trademark. The USPTO approved the registration in 1976 and renewed it in 1996. The transactions were authorized under an existing general license pursuant to the Cuban Assets Control Regulations. In October of 1998, however, Congress included section 211 as part of the

Omnibus Appropriations Act which rendered that general license unavailable for transactions or payments for certain trademarks.

As a result, when Cubaexport attempted to renew the Havana Club trademark registration in 2005, the Treasury Department's Office of Foreign Assets Control (OFAC) advised the USPTO and Cubaexport that a specific license would be required to authorize the payment of renewal fees.

Cubaexport could not legally pay the required fees without an OFAC specific license authorizing the transaction.

Cubaexport applied for a specific license from OFAC, and OFAC denied the application. Because the requirements of the trademark law could not be met without an OFAC specific license authorizing the fee payment, the USPTO was unable to renew the registration.

Cubaexport sought review of the USPTO's refusal by filing a petition with the USPTO, the same petition that we acted on in January. Because Cubaexport also sued OFAC over its decision not to issue Cubaexport a specific license authorizing the fee payment, the USPTO suspended action on the petition until that litigation was over. Cubaexport's challenges in federal court were unsuccessful.

In November of 2015, Cubaexport submitted a new specific license application to OFAC and OFAC issued the requested license on January 11, 2016.

On January 12, 2016, Cubaexport supplemented its petition to include an OFAC specific license authorizing the 2005 payment of fees and all other transactions necessary to renew and maintain the Havana Club registration.

Because Cubaexport had satisfied the requirements of the Trademark Act, the USPTO took action to accept the now-authorized fee payment, grant the petition, and update the USPTO's records to reflect the renewed status of the Havana Club registration. This action does not, however, decide the Havana Club trademark dispute. The rights of all interested parties remain the same as they were before this action was taken.

That concludes my statement Mr. Chairman, and I would be happy to answer any questions.