

# INTELLECTUAL PROPERTY

ABOGADOS-ATTORNEYS AT LAW



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& Alemán

ESTABLISHED 1920



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## **I. REGISTRATION OF TRADE MARKS (FOR PRODUCTS, FOR SERVICES, COLLECTIVE AND GUARANTY MARKS) TRADE NAMES, SLOGANS AND ADVERTISING SIGNS, PATENTS OF INVENTION, UTILITY MODELS AND INDUSTRIAL DESIGNS AND NEW VARIETY OF PLANTS IN THE GENERAL DIRECTORATE OF INDUSTRIAL PROPERTY OF THE MINISTRY OF COMMERCE AND INDUSTRIES**

### **A. TRADEMARKS**

#### **Requirements:**

1. Power of attorney showing the applicant's nationality, full name and address, duly acknowledged before a Notary Public and legalized by a Panama Consul or with the Apostille of The Hague Convention.
2. In the case of corporations, certificate as to the existence (or good standing) and legal representation thereof, duly legalized by a Panama Consul or certificate by the Apostille of The Hague Convention.
3. Information on the use of the trademark in international commerce or in Panama.
4. Ten facsimiles of the mark by means of a drawing.

**Priority claim:** At the time of filing of the application in Panama it is possible to claim a priority right based on the Paris Convention by indicating the number and date of the previous application and the country in which it was made. A copy of the previous application must be filed within the six months following the date of filing of the Panamanian application, certified as true and correct by the authority which received the previous application. This copy must be accompanied by a certificate from the same authority showing the date of filing.

**Filing without Power of Attorney** It is possible to file the Panamanian application without the immediate submittance of the Power of Attorney and Certificate of existence and legal representation by posting a US\$100.00 bond. The Power of Attorney and Certificate of existence and legal representation must be filed within the two months following the date of filing of the Panamanian application.

**Duration:** The registration of a trade mark has a duration of ten years as from the date of filing of the application, and may be renewed for identical periods.

**Governmental fees:** US\$132.20 which include maintenance fees for ten (10) years.

#### **A.1. Renewal of Trademarks (for Products, for Services, Collective and Guaranty Marks)**

##### **Requirements:**

1. Power of attorney duly acknowledged before a Notary Public and legalized by a Panama Consul or with the Apostille of The Hague Convention.

The renewal application must be filed within the year preceding the expiration date of the trademark registration. There is a grace period for late renewal of six months after the expiration date of the trademark registration, subject to the payment of a surcharge of US\$10.00 per month or fraction of month..

**Filing without Power of Attorney:** It is possible to file the renewal application without the immediate filling of the Power of Attorney and Certificate of existence and legal representation by posting a US\$100.00 bond. The Power of Attorney and Certificate of existence and legal representation must be filed within two months following the date of filing of the renewal.

**Governmental fees:** US\$130.20 which include maintenance fees for ten (10) years.

## **B. Trade Names**

**Requirements:** The requirements for filing an application for registration and renewal of a trade name registration are the same as those stated above for trade marks, with the following exceptions:

1. For Panamanian corporations: It is necessary to submit a certified photocopy of the commercial or industrial license showing that the trade name of the applicant is the trade name sought to be registered.
2. For foreign corporations: It is necessary to submit a certificate issued by the competent authority of the country of origin stating that the applicant is engaged in commerce or industry using the trade name sought to be registered. This certificate must be legalized by the Panama Consul or with the Apostille of The Hague Convention.

**Duration:** The registration of a trade name has a duration of ten years as from the date of filing of the application, and may be renewed for identical periods.

**Governmental fees:** US\$132.20 for registration; US\$130.20 for the renewal of the registration, which include maintenance fees for ten (10) years.

## **C. Slogans and Advertising Signs**

**Requirements:** The requirements for filing an application for registration and renewal of a slogan or advertising sign registration are the same as those stated above, for trade marks.

**Duration:** The registration of a slogan or advertising sign has a duration of ten years as from the date of filing of the application, and may be renewed for identical periods.

**Governmental fees:** US\$132.20 for registration; US\$130.20 for the renewal of the registration, which include maintenance fees for ten (10) years.

## **D. Patents of Inventions**

A patent is only granted for the new inventions resulting from a creative activity and susceptible of industrial application.

An invention can be a product and/or a procedure, or the special use of a product or the non evident use of the same.

**Novelty requirement:** An invention is deemed to be new when, in connection therewith, there does not exist priority in the state of the art. The state of the art comprises all that has been disclosed or made accessible to the public anywhere in the world, by means of a tangible publication, an oral disclosure, the sale or merchandising, the use, or by any other means, before the date of filing of the application for a patent in Panama. It also comprises the contents of a previous patent application in Panama.

**Grace period:** The disclosure which occurs within twelve months prior to the filing of the patent application in Panama will not be taken into consideration to determine the novelty of an invention provided that said disclosure has been the result, directly or indirectly, of acts performed by the inventor himself, or by his successor, or from a breach of confidence, breach of contract or unlawful acts committed against any of them. Nevertheless, the disclosure resulting from a publication made by an industrial property office during the procedure for granting a patent is not included in the grace period, unless that the application which originated the publication had been filed by a person not having the right to obtain the patent, or that the publication had been made due to a mistake of the industrial property office.

**Requirements:**

1. Power of Attorney showing the applicant's nationality, full name and address, duly acknowledged before a Notary Public and legalized by Panama Consul or with the Apostille of The Hague Convention.
2. In the case of corporations, a certificate as to the existence and legal representation, duly legalized by a Panama Consul or certified by means of the Apostille of the Hague Convention.
3. Description in Spanish (in triplicate): It must disclose the invention in a sufficiently clear and complete manner, so as to enable the evaluation thereof, and that it may be executed by a person skilled in the corresponding technical field. It must include the following information:
  - a) The technological area to which it refers or to which the invention is applicable;
  - b) The prior technology known by the applicant, which may be deemed useful for the understanding and for the examination of the invention, as well as the references to the documents and prior publications relating to said technology;
  - c) The description of the invention, in such terms as to allow an understanding of the technical problem and the solution provided by the invention, as well as an explanation of its advantages with respect to prior technology;
  - d) The description of the drawings, if there are any;
  - e) The description in the best manner known by the applicant, to execute or put in practice the invention, using examples and reference to the drawings;
  - f) The manner in which the invention may be manufactured or used in some activity, except when it becomes evident from the description or the nature of the invention.
4. Claims, in Spanish (in triplicate)
5. Drawings, if there are any.
6. Summary, in Spanish (in triplicate)
7. Title
8. Copy of the assignment of the invention if the applicant is not the inventor, duly legalized by Panama Consul or with the Apostille of The Hague Convention.

If the description, claims and summary are filed in a language other than Spanish, their corresponding translation into Spanish must be filed within the two months following the date of filing of the application in Panama.

**Priority claim:** At the time of filing of the application in Panama it is possible to claim a priority right based on the Paris Convention by indicating the number and date of the previous application and the country in which it was made. A copy of the previous application must be filed within the six month following the date of filing of the Panamanian application, certified as true and correct by the authority which received the previous application. This copy must be accompanied by a certificate from the same authority showing the date of filing.

**Filing without Power of Attorney:** It is possible to file the Panamanian application without the immediate submittance of the Power of Attorney and Certificate of existence and legal representation by posting a US\$100.00 bond. The Power of Attorney and Certificate of existence and legal representation must be filed within the two months following the date of filing of the Panamanian application.

**Duration:** A patent of invention has a duration of twenty years from the date the application is filed, subject to payment of the fees fixed by the Law. It is not renewable.

**Governmental fees:**

- US\$132.20 for filing the application, which include payment of maintenance fees for the first quinquennium
- US\$240.00 for requesting the report on the state of the art
- US\$200.00 maintenance fee (2nd. quinquennium)
- US\$200.00 maintenance fee (3rd. quinquennium)
- US\$300.00 maintenance fee (4th. quinquennium)

## E. Utility Models

A utility model registration is granted if the utility model is new and susceptible of industrial use.

The requirements are the same requirements for patents of invention, as indicated above.

**Duration:** The registration of a utility model has a duration of ten years as from the date of the filing of the application. It is not renewable.

**Governmental fees:**

- US\$82.20 for filing the application, which include payment of maintenance fees for the first quinquennium
- US\$ 37.00 for requesting the report on the state of the art
- US\$100.00 maintenance fee (2nd. quinquennium)

## F. Industrial Models and Designs

An industrial model or design may be registered if it is new. It is new if it has not been disclosed to the public, or made available to it anywhere in the world either by tangible publication or through sale, trading, use or any other means.

### **Requirements:**

1. Power of Attorney showing the applicant's nationality, full name and address, duly acknowledged before a Notary Public and legalized by Panama Consul or certified with the Apostille of The Hague Convention.
2. In the case of corporations, a certificate as to the existence and legal representation issued by the competent authority of the country of origin, duly legalized by the Panama Consul or certified with the Apostille of the Hague Convention.
3. An introduction indicating the industrial object that it is, and its application of preference.
4. A description of the industrial model or design which must briefly refer to the graphic reproduction of the industrial model or design.
5. The basic characteristics of the pattern or industrial drawing that contribute the originality and innovation that distinguishes it, giving it appearance and its own characteristic.
6. A graphic representation of the industrial model or design.
7. Title.
8. Copy of the assignment of the industrial model or design if the applicant is not the creator, duly legalized by the Panama Consul or certified with the Apostille of The Hague Convention.

**Priority Claim:** At the time of filing of the application in Panama it is possible to claim a priority right based on the Paris Convention by indicating the number and date of the previous application and the country in which it was made. A copy of the previous application must be filed within the six months following the date of filing of the Panamanian application, certified as true and correct by the authority which received the previous application. This copy must be accompanied by a certificate from the same authority showing the date of filing of the application.

**Filing without Power of Attorney:** It is possible to file the Panamanian application without the immediate submittance of the Power of Attorney and Certificate of existence and legal representation by posting a US\$100.00 bond. The Power of Attorney and Certificate of existence and legal representation must be filed within the two months following the date of filing of the Panamanian application.

**Duration:** The industrial model or design registration has a duration of ten years as from the date of the filing of the application, renewable for an additional period of five years. The renewal application must be filed within the six months prior to the expiration of the registration. There is a grace period for late renewal of six months after the expiration date of the registration.

**Governmental fees:** US\$82.20 for filing the application, which include payment of maintenance fees for the first quinquennium  
US\$30.00 for requesting the report on the state of the art  
US\$100.00 maintenance fee (2nd. quinquennium)  
US\$100.00 maintenance fee (3rd. quinquennium)

### **G. New Varieties of Plants**

The rights of production and commercialization of a plant variety are obtained in our country through a "Certificado de Obtentor" issued by the General Directorate of Industrial Property Registry of the Ministry of Commerce and Industry. The duration thereof is twenty (20) years from the date of issuance. In the event of grapevines, forest, fruit and ornamental trees, duration is increased to twenty-five (25) years.

The requirements to be complied with by the relevant plant variety are the following:

1. Must be new: that is to say, must not have been offered for sale nor commercialization in Panama for a period of one year prior to the date of the application or for a period of four years if abroad or, in the event of grapevines and trees, six years prior to the date of the application. If application has been filed in another country member of the UPOV Convention (International Convention for the Protection of New Varieties of Plants), application must be filed in Panama within the year following presentation thereof in any other such country.
2. Must be distinctive: that is to say, must have one or several clearly distinctive and important characteristics that make it different from any other variety which, at the time of submitting the application, is notoriously known.
3. Must be homogenous: that is to say, must be sufficiently uniform in its main characteristics, except for the foreseeable changes, having due regard to the particularities of its reproduction or its vegetative multiplication.
4. Must be stable: that is to say, must remain with the same important characteristics subsequent to its reproduction or continuation.
5. Must have a denomination: which must be unique for that particular variety in all countries members of the UPOV Convention, regarding that specific variety and species.

The documentation which must be presented is as follows:

- a) Power of Attorney
- b) Technical questionnaire which is to be provided for by DIGERPI, duly endorsed by a qualified professional and acknowledged by the National Technical Board of Agriculture.
- c) Franchise Tax payment receipt.
- d) Technical description of the plant variety.
- e) Application form for registration of any such plant variety and of its denomination.
- f) Material to be subjected to examination at the moment in which said examination is ordered, in such quantities to be subsequently determined.

Since 23 May 1999, the Republic of Panama has been a member of the International Convention for the Protection of New Varieties of Plants (UPOV).

## **II. REGISTRATION OF INTELLECTUAL PROPERTY RIGHTS AT THE COLON FREE ZONE AND CUSTOMS**

All trademarks, slogans, trade names, patents of invention, utility models, industrial models drawing and designs and copyrights, may be registered before the authorities of the Colon Free Zone and customs.

This registration shall serve as a database for the notification to the holders of the intellectual property rights, of any merchandise that may be deemed, according to the inspectors, as counterfeited.

### **Requirements for the registration:**

1. Power of attorney showing the applicant's nationality, full name and address, duly acknowledged before a Notary Public and legalized by Panama Consul or certified with the Apostille of The Hague Convention.
2. In the case of corporations, certificate as to existence and legal representation thereof, duly legalized by a Panama Consul or certified with the Apostille of The Hague Convention.
3. Certified copy of the intellectual property right registration, as registered at the General Directorate of Industrial Property, or at the National Directorate of Copyrights.
4. Information on the licenses and authorized distributors.
5. The deposit of original samples of the merchandise is voluntary. The purpose of this deposit is to serve as a reference to the inspectors.

### **Duration:**

The registration shall have the same duration of the Industrial Property Right original registration at the General Directorate of Industrial Property or at the National Directorate of Copyrights. Likewise, it shall be renewed for the same period.

## **III. OPPOSITION AND CANCELLATION PROCEDURES**

### **A. Judicial Opposition Proceedings**

Our Industrial Property Law establishes that any natural or juridical person may institute judicial opposition proceedings against applications for registration in Panama of trade marks, commercial names, models or industrial drawings, expressions or advertising signs published at the Industrial Property Official Bulletin. The official term granted for the filing of any such judicial opposition proceedings is two (2) months starting from the date of publication of the relevant distinctive sign at the aforementioned official bulletin.

Judicial opposition proceedings must be submitted together with a Power of Attorney in favour of designated lawyers and a certification attesting to the existence and goodstanding of the plaintiff. In cases when the Power of Attorney is yet to be available at the time of expiration of the aforementioned official term, plaintiffs may alternatively submit the relevant documentation along with a guarantee bond, the amount of which is to be determined by the Court. However, guarantee bonds stipulated for said proceedings usually amount to US\$300.00.-

Both the Power of Attorney and Goodstanding Certificate must have been submitted by the Plaintiff before the end of the two (2) months immediately following the date of presentation. If and when necessary, said official term may be extended for one (1) additional month, upon official request to that effect. The required goodstanding certifications must be issued by any of those competent authorities of plaintiff's country of incorporation, and they must be legalized by the Hague Apostille or by Consular Official of the place of issuance.

Once the relevant judicial opposition proceedings have been officially admitted, the admitting Court must then notify defendants of the same. Serving of notice on defendants may be effected in any of the following manners, depending on defendant's place of domicile, that is to say:

- a. personally if defendants are domiciled within the territory of the Republic of Panama.
- b. through Summons by Publication if defendants' domicile is not known.
- c. by means of Letter Rogatory after it has been established that defendants are domiciled abroad. This particular procedure is carried out through diplomatic channels, both in Panama and in the country of defendants' domicile.

Once defendants' reply to the official summons regarding proceedings instituted against them is received by the relevant Court, said Court must then proceed with the establishment of the date for the oral hearing. At the time of the oral hearing, both parties must submit and adduce any and all evidence considered relevant and convenient to their interests. Upon conclusion of hearings and once all relevant evidence is adduced and/or submitted, the competent Judge must then proceed with the pronouncement of judgment. Our legislation grants defendants the option to file a remedy of appeal against any such judgment.

The Panamanian Courts competent to admit and handle first instance judicial opposition proceedings are the Eighth and Ninth Civil Circuit Courts of the Judicial Circuit of Panama. Second instance appeal proceedings are received and handled by the Third Superior Court of the First Judicial District of Panama.

## **B. Judicial Trade Mark Cancellation and Nullity Proceedings**

Pursuant to our Legislation, intellectual property rights on a registered mark shall terminate upon the cancellation of the relevant registration. The following are causes for the cancellation of any such rights:

1. Express waiver by the owner of record.
2. Lack of use of the relevant trade mark for more than five (5) consecutive years.
3. Expiration of the registration term without having timely submitted an application for renewal thereof. Our legislation establishes that applications for any such renewals must be submitted within the stipulated term, that is to say, between the immediately preceding year and the six (6) months immediately following expiration date.
4. Judgment pronounced by a competent authority whereby the nullity of the registration is declared and its official cancellation is ordered.

On the other hand, the official expiration term stipulated for judicial proceedings instituted to demand the cancellation of a trade mark is ten (10) years beginning on the date of filing, unless such registration is proved to have been obtained illicitly in which case proceedings may be instituted at any time during the term of said registration. The following are causes to demand the nullity of a trade mark:

- a. When the granting thereof contravenes those established trade mark registration requirements.
- b. When granted on the basis of applications or accompanying documents containing essentially false or inaccurate data. In such cases the registration shall be deemed as illicitly obtained thereby allowing judicial nullity proceedings to be filed at any time.
- c. When the attorney, legal representative, user or distributor of the mark registered abroad applies for and obtains, whether in its own name or on behalf of any third party, the registration of said trade mark or

of another so similar as to be confusing, without the express consent of the titular thereof. In such cases the registration shall be deemed as illicitly obtained thereby allowing judicial nullity proceedings to be filed at any time.

Those legal procedures and steps to be taken for the institution of judicial opposition proceedings are also applicable for the filing of judicial cancellation and nullity proceedings. Likewise, the Eighth and Ninth Civil Circuit Courts of the Judicial Circuit of Panama (in first instance) and the Third Superior Court of the First Judicial District of Panama (in second instance) are the receiving entities competent for the handling of the aforementioned judicial proceedings.

#### **IV. INFRINGEMENT**

##### **A. Enforcement of Industrial Property Rights**

- **Power of Attorney**

To enforce an intellectual property right, the registered owner thereof must appear before the competent authorities. In order to do so, an authorized representative of the company must grant a Power of Attorney in favour of our firm.

The Power of Attorney may be a General Power of Attorney or a Special Power of Attorney.

- **Certificate of Existence**

To enforce an intellectual property right, the registered owner must also submit a document issued by a competent authority of the place of its incorporation or domicile, stating that the owner is a company duly organized and in existence. This document is known in some jurisdictions as a “Goodstanding Certificate”. An extract of the Commercial Register may also be considered as a Certificate of Existence. This document must be legalized by the Panamanian Consulate, or certified with the Apostille of the Hague Convention.

- **Acting without Power of Attorney and Certificate of Existence**

A civil, criminal or administrative action may be initiated without these documents, provided that the unofficial agent (an attorney registered with the Supreme Court of Justice) submits a security (in criminal cases it must be set by the District Attorney between US\$2,000.00 – US\$5,000.00). The Power of Attorney and Certificate of Existence must then be filed within the two months following the action.

- **Infringement of trademark’s rights**

Enforcement of industrial property rights may be sought through a civil action, an administrative action or a criminal action:

1. **Civil Action:**

Article 167 of Law No. 35 of 1996 states that “The owner of rights protected under this Law may institute civil proceedings before the competent court against any person who infringes his rights.”

**Plaintiff:** It is the registered owner of the industrial property right.

**Defendant:** It is the person that has infringed the industrial property right, that is, the manufacturer, marketer, distributor and all persons who in any way have taken part in the production and circulation of the counterfeit products.

In addition to the Power of Attorney and Certificate of Existence, the writ of complaint must be filed together with a certified copy of the Panamanian registration of the infringed industrial property right.

**Claims:** The owner of the rights may request that one or more of the following measures be applied:

- a. cessation of the acts infringing the rights;
- b. indemnification for damages sustained;
- c. the measures necessary to prevent the continuation or repetition of the infringement;
- d. publication of the condemnatory sentence in the Official Gazette.

**Statute of Limitations:** Six years counted from the most recent date on which the infringing act was committed.

- a. Precautionary measures: To ensure the effectiveness of the civil action, the plaintiff may request precautionary measures. The defendant is not heard. The plaintiff must deposit security, the amount of which shall not exceed 50% of the total estimated value of the infringing material and the means of committing the infringement.

## 2. Administrative Actions:

The General Customs Administration and the Colon Free Zone Administration have the authority to make an inspection and withhold a merchandise that may be in breach of the provision of industrial property rights.

The General Customs Administration may inspect and seize any merchandise awaiting customs clearance anywhere in the national territory. The Colon Free Zone Administration may inspect and seize any merchandise in transit in the Colon Free Zone.

Both administrations may act:

- a. Ex officio. After the seizure of the merchandise, the administration must notify this action to the owner of the industrial property right, who has the right to request a sample of the products for inspection. If the sample violates industrial property rights, the owner must submit a writ opposing the liberation of the merchandise, together with a security, the amount of which shall not exceed 50% of the total estimated value of the infringing material and the means of committing the infringement. The file is then sent to the District Attorney's Office, for the criminal investigation.

- b. On the instructions of the competent authority, which may be a civil or criminal court.
- c. On the request of the owner of the industrial property right. In this particular case, the interested party must submit a petition together with a US\$2000.00 bond, and pay official fees for the inspection. After the seizure, the amount of the bond is adjusted, according to the total estimated value of the infringing material and the means of committing the infringement. This file is then sent to the District Attorney's Office.

In addition to the Power of Attorney and Certificate of Existence, the writ requesting the participation of the owner of the industrial property right must be filed together with a certified copy of the Panamanian registration of the infringed industrial property right.

### **3. Criminal action:**

The action may be initiated ex officio by the District Attorney, who orders the provisional seizure of the merchandise and of the means used for the commission of the offending act.

The action may also be initiated by means of a denounce or querella submitted by the industrial property owner, before the District Attorney.

The industrial property owner may participate in the summary proceedings and the criminal trial in either of the following capacities:

- a. as a collaborating party, with the power to adduce or submit proof and other evidence in substantiation of the offending act and the liability therefore;
- b. as an accuser or querellante, with the power to request the criminal liability of the offender and damages. The accuser may participate in the proceeding as a party, with all the privileges, including, the right to participate in the hearings and file appeals.

In addition to the Power of Attorney and Certificate of Existence, the writ requesting the participation of the owner of the industrial property right must be filed together with a certified copy of the Panamanian registration of the infringed industrial property right.

At any stage of the criminal procedure, the court may order the conclusion of the proceedings if the industrial property right owner and the accused jointly request so.

**Statute of Limitations:** Six (6) years counted from the most recent date on which the crime was committed.

## **V. COPYRIGHTS**

In the Republic of Panama, copyrights are governed by Law N° 15 of Aug. 8, 1994 and by Decree N° 261 of Oct. 3, 1995. They are granted for life of author and for 50 years thereafter. Literary, musical, phonographic, audiovisual and radiophonic works are protected, as well as software, paintings, maps, drawings, photography, and architecture and engineering works are protected. Right to exploitation of copyrights is transferable and transfer must be made in writing. Copyrights may be registered in National Directorate of Copyrights (Ministry of Education). Civil and Criminal actions before circuit courts and administrative actions before General Directorate of Copyrights may also be instituted against infringers.



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The Republic of Panama has ratified the following international conventions: Convention on Literary and Artistic Copyright, 1910; Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of their Phonograms; 1971; Interamerican Convention on Rights of Author in Literary, Scientific and Artistic Works; Convention Establishing World Intellectual Property Organization; Universal Copyright Convention as Revised in Paris, 1971; Convention Relating to the Distribution of Programme Carrying Signals Transmitted by Satellite, 1974; International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations; 1886 Berne Convention for the Protection of Literary and Artistic Works, as revised in Paris on July 24, 1971 and amended on Sept. 28, 1979.