



MEMORANDUM TO CLIENTS AND FRIENDS

October 6, 2006

One-Time Six-Month Grace Period to File Statements of Use for Certain Marks Registered Without Use in Commerce

The Puerto Rico Department of State (the “Department”) has adopted an amendment to its trademark regulation (Regulation on Procedures for Registering Marks, No. 4638) which is of particular importance for trademark owners who obtained registration without having used the mark in commerce. Effective October 3, 2006, such registrants who did not submit the required Statement of Use within five (5) years of registration will have a six-month grace period (*i.e.*, until April 3, 2006) to file said Statement. In the Statement, the registrant must certify under oath that it commenced use of the mark within five years of registration. After April 3, 2006, the Department will not accept Statements of Use filed more than five years after the mark’s registration. (Please note that a mark’s registration is retroactive to the date of filing of the application.) Therefore, any mark registered without use in commerce and for which a Statement of Use was not filed within five years after the filing date will be deemed canceled by operation of law, consistent with the Puerto Rico Supreme Court’s holding in Arribas & Associates, Inc. v. Santa Clara C. por A., 2005 TSPR 143 (October 3, 2005).

If you have any questions or comments, or wish additional information regarding this matter, please contact any of the following attorneys:

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