

TRADEMARK ALERT

January 8, 2010

New Puerto Rico Trademarks Act

As indicated in our Trademark Alert of October 6, House Bill No. 1995 and Senate Bill No. 1114 were filed on September 8 and 10, 2009, respectively, with the Puerto Rico Legislative Assembly to enact a new Trademark Act. Both bills are identical and, among other things, incorporate provisions from the U.S. Trademark Act (known as the “Lanham Act”) and the Model State Trademark Act.

On December 16, 2009, Senate Bill No. 1114 became Act. No. 169 - the new Trademarks Act of Puerto Rico. This legislation repealed Act No. 63 of August 14, 1991, the previous Trademarks Act, and went into effect immediately after its approval. All trademark applications pending registration are now governed by the new legislation, which made major statutory changes, including the following:

- Defines terms such as “dilution,” “blurring,” “tarnishment,” “trade dress” and “secondary meaning”.
- Establishes alternatives to show “use in commerce” in Puerto Rico.
- Shortens the time period for triggering the “abandonment” of a mark not in use.
- Requires the filing of sworn statements of continued use for all registered marks.
- Restricts the registration of personal names and geographically descriptive or deceptive marks.
- Protects “famous marks” against the likelihood of dilution.
- Extends the term to oppose the registration of a mark.
- Provides for the filing of trademark licenses and security interests.
- Establishes a grace period for renewing the registration of a mark after its expiration.
- Provides for treble or statutory damages for trademark infringement in certain cases.
- Establishes causes of action for false advertisement and false designation of origin. Protects a mark against the registration, marketing, sale, licensing, transfer or use of a domain name that is confusingly similar to the mark.
- Eliminated the alternative of filing for registration based on the deposit of a U.S. certificate of registration.
- Maintains existing registrations under the previous Trademarks Act until the scheduled expiration date, unless renewed in accordance with the new Trademarks Act. Pending applications must comply with the new Trademarks Act.

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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