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TRADEMARK ALERT

Amendments to Government of Puerto Rico Trademark Act

On July 12, 2011, Act 169-2009, known as the "Government of Puerto Rico Trademark Act" (the "Act"), was amended. The amendments made several important changes and clarifications to the Act, including the following:

- Certificates of Registration issued by the U.S. Patent and Trademark Office may be recorded with the Puerto Rico Trademark Office for notice purposes.
- Reduces from five to three years the period for filing a declaration of use for a mark registered without use in commerce in Puerto Rico, subject to a one-year extension for just cause if requested within such three-year period.
- The principle of "likelihood of confusion" is explicitly included as the basic standard for trademark infringement actions and as a statutory bar to trademark registration.
- Clarifies that a declaration of use for all registered marks must be filed between the fifth and sixth year after the filing date and at the end of each successive ten-year period following such date, subject in each case to a six-month grace period.
- Clarifies the remedies that are available to a plaintiff in an action for false designation of origin, false advertising, dilution of a famous mark, or cybersquatting (i.e., trademark infringement with Internet domain names).
- Clarifies that the provisions of the Act with respect to the qualification, review, maintenance or renewal of trademark registrations apply to applications filed on or after December 16, 2009; provided, however, that any registrant or trademark owner may claim in its favor any procedural or substantive provision of the Act.

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

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