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TRADEMARK ALERT

The Puerto Rico State Department issues Clarification on Presenting Declaration of First Use

On June 19, 2013, the Puerto Rico State Department issued Circular Letter 2013-03 clarifying the date of presentation of declaration of first use filed with intent to use. The following is an unofficial translation of the letter:

Clarification on Presenting the Declaration of First Use – Trademarks Registry

One of the requirements that must be met to maintain current registration of a trademark without prior use is the filing of the declaration of first use [see Trademarks Act of the Government of Puerto Rico, 10 L.P.R.A. § 223(b) (2012)].

Statutes, regulations and applicable case-law highlight the importance of filing the declaration of first use as a condition to keep an unused trademark active at the time of its registration. This requirement is mandatory and must be met irrespective of whether the Trademarks Registry has completed the registration process of a given trademark. This formality was upheld by our highest judicial forum in 2005 when it determined that “no trademark registration application shall proceed when, [during the established period], the applicant has not provided evidence of use.” *Arribas & Associates, Inc. v. Santa Clara C. by A.*, 165 D.P.R. 781, 793 (2005). The Court also emphasized that “[i]n cases where the registration process is particularly long, the applicant may always preserve its rights ... through the mechanism [provided.]” *Id.* at 794-95.

Given that the Trademark Registry is going through a restructuring process, we are experiencing a delay in the evaluation of trademark registration applications and the issuance of corresponding registration certificates. Notwithstanding, **it is the responsibility of the applicant for a trademark registration to meet all the requirements to prevent the Trademarks Registry from cancelling your registration and/or considering said transaction as abandoned.**

Therefore, every trademark submitted to the Registry with intent to use, must comply with the requirement regarding the declaration of first use.

If you have any questions or would like our assistance regarding this matter, you may contact any of the following attorneys:

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