

TRADEMARK ALERT

October 6, 2009

Proposed Bills to Enact a New Puerto Rico Trademark Act

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. The proposed legislation entails major changes to the law currently in effect, including the following:

- Defining terms such as “dilution,” “blurring,” “tarnishment,” “trade dress” and “secondary meaning”.
- Establishing alternatives to show “use in commerce” in Puerto Rico.
- Shortening the time period for triggering the “abandonment” of a mark not in use.
- Requiring the filing of sworn statements of continuous use for all registered marks.
- Restricting the registration of personal names and geographically descriptive or deceptive marks.
- Protecting “famous marks” against the likelihood of dilution.
- Extending the term to oppose the registration of a mark.
- Providing for the filing of trademark licenses and security interests.
- Establishing a grace period for renewing the registration of a mark after its expiration.
- Providing for treble or statutory damages for trademark infringement in certain cases.
- Establishing causes of action for false advertisement and false designation of origin.
- Protecting a mark against the registration, marketing, sale, licensing, transfer or use of a domain name that is confusingly similar to the mark.

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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