



## **AMENDMENTS TO NEW TRADEMARKS LAW CLARIFY CERTAIN PROVISIONS, RAISE NEW QUESTIONS**

By: Nikos Buxeda-Ferrer, Esq.

In our newsletter dated January 14, 2010, we discussed the repeal of Puerto Rico's Trademarks law and the adoption of a new Trademarks Law, which was enacted on December 16, 2009. We noted that the new Trademarks Law changed the registration procedure for trademarks that are not currently used in commerce in Puerto Rico. The old law provided that a trademark would remain registered for 10 years, whether or not it was actually used. However, for those trademarks that were not being used at the time of registration, regulations issued under the old law required the filing of a sworn statement, with supporting evidence, that the trademark was being used within 5 years of registration.

Article 4 of the new law incorporated the requirements of referred regulation, requiring the filing of a sworn statement, with supporting evidence, that the trademark was being used within 5 years of registration for trademarks that were not being used at the time of registration. In addition, and confusingly, Article 18 provided that all registrants of trademarks were required to submit a sworn statement, with supporting evidence, that the trademark was being used, between the 5th and 6th year from the date of registration. Therefore, it seemed that in the case of trademarks that were not used in commerce at the time of registration, sworn statements of use would be required to be filed during the 4th year of registration and again during the 5th year of registration.

Also, although trademarks registered under the old law remained registered and protected under the old law "for the time issued" pursuant to Article 32 of the new law and therefore trademarks not in use when registered would appear not to

have to comply with the sworn statement of use required under the new law, it was unclear whether those trademarks still had to comply with the sworn statement of use required by the old, and now repealed, regulations.

On June 30, 2011, the new Trademarks Law was amended. New Article 18 specifically provides that the sworn statement requirement of that section does not apply to trademarks registered under the old law. In addition, new Article 4 provides that if a trademark is registered which is not used at the time of registration, the registrant is required to provide a sworn statement, with supporting evidence, that the trademark is being used within 3 years of registration (not 5), again during the 5th year, and if it wants to renew the trademark, then again during the 9th year. If the trademark is being used when registered, then the sworn statement must only be filed during the 5th year, and again during the 9th year if renewal is sought.

Strangely, Article 4 does not exclude trademarks registered under the old law, leaving open the question of whether trademarks not used in commerce when registered under the old law still have to comply with the sworn statement required by the repealed regulations. Furthermore, Article 32 was also amended, and no longer provides that trademarks registered under the old law remain in effect and protected. New Article 32 only provides that the qualification, testing, maintenance and renewal provisions of the new law apply exclusively to registrations made under the new law. This raises the question as to the legal status of trademarks registered under the new law, despite certain references in the amendment to the old law (such as in Article 18 cited above).

In addition, the amendments clarify that registrations are not automatic and may be rejected if a similar mark is registered, include provisions regarding confusion between

registered marks or marks already used in commerce, and the remedies available to persons whose registered trademark rights are violated.

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The above summary is intended for information purposes only. It cannot be considered a legal opinion, and it does not intend to consider all the tax and legal considerations that could be relevant to any particular person or entity. It should also be noted that the changes discussed herein were recently enacted, and that the PR Treasury has not yet issued regulations, tax forms or interpretative announcements on such changes.

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