A. [Commonwealth] Trademark Registration Statute

1. Code Section

The Model Act is not in effect.

3. Administrator
Secretary of State of Puerto Rico
Puerto Rico Department of State
San Jose Street
San Juan, Puerto Rico 00901
(787) 722-2121, ext. 4401; 4404; 4405

4. Procedure for Applying for Registration
   a. Forms
The application form is set forth by the Department of State of the Commonwealth of Puerto Rico. Some forms can be downloaded from the Internet at https://ptmfilng.ft1st.com/pubs/help/Help_en.html#Forms. Electronic filing is now mandatory.

   b. Number of Copies
One copy filed electronically.

*Since 1965, the firm of Reichard & Calaf, P.S.C. with offices in San Juan, has practiced in the areas of trademark, unfair competition, commercial, and general corporate law. The firm’s services include all aspects of local registration and all related administrative proceedings and litigation involving federal and commonwealth statutes in both federal and local courts. The firm’s attorneys practice before the Federal District Court for Puerto Rico and the Court of Appeals for the First Circuit. The attorneys who participated in the preparation of this entry are Federico Calaf-Legrand and Carla Calaf Garcia.
A.4.c. STATE TRADEMARK LAW

**c. Fee**
The registration fee of $150.00 is prescribed by Regulation.

**d. Specimens**
One specimen (in the form of, among others, an image of labels or tags attached to the product or packaging for goods, i.e. trademarks, and publicity and advertisement materials for services, i.e. service marks) if the application is filed based on use in the commerce of Puerto Rico. If the application is filed without use, prints of the mark will suffice.

**e. Drawing**
With every trademark application, applicant must include a drawing (printout) of the mark as used in commerce or as applicant intends to use it in commerce.

**5. Intent to Use Provision**
The trademark law provides for Filing of Intent to Use applications. Use of the mark must begin and proof of it together with a declaration under penalty of perjury must be filed within three years from filing date. An extension of up to one year can be requested for just cause.

**6. Classification**
The classification system follows the International Classification.

**7. Search Prior to Application**
The Secretary of State does not conduct a search prior to the actual filing of an application. However, the Secretary of State keeps for public examination a record of marks registered or pending registration before the Puerto Rico Trademark Office.

**8. Search Prior to Registration**
The Secretary of State conducts a search of the Puerto Rico Trademark Office’s records as the initial step in processing an application filed to determine availability.

**9. Doing Business Requirement**
There is no doing business requirement for registration.

**10. Types of Marks Registrable**
The following marks are registrable:

1) Trademarks,
2) Service Marks,
3) Certification Marks,
4) Collective Marks

PR-2
11. Restrictions
The statute precludes registration of any of the following:

1) Illegal matter and immoral matter and matter contrary to public order;
2) The flag or coat-of-arms or any other insignia, sign or symbol of Puerto Rico, the United States, or its states, territories, cities, municipalities or any foreign city or nation; or an imitation thereof;
3) Name, portrait or signature of a living person unless written consent is obtained. Surnames of living individuals who are only known by their surnames unless written consent is obtained. Marks which are primarily merely a surname unless they have acquired secondary meaning.
4) Descriptive terms unless they have acquired secondary meaning;
5) Generic terms
6) Geographic terms which indicate the source or origin of the products or services on which they are used unless they have acquired secondary meaning;
7) A similar or identical mark that may cause likelihood of confusion as to the source of the goods or services of a previously registered or used mark belonging to another and that is used or will be used on products or services identical or similar to those of the previously registered or used mark.
8) Geographically deceptive terms.
9) A mark identical or substantially similar to a famous or notorious mark of any country and that is known by the relevant market in Puerto Rico, even if the famous or notorious mark is not used in Puerto Rico.
10) Form or packaging when functional.

12. Use in [Commonwealth]
Use means legal use, in good faith, of a mark in Puerto Rico's commerce. It is not a prerequisite for registration; yet, priority in use will generally establish ownership when conflicting marks compete for registration.

13. Term of Registration
A mark remains in effect for ten years as of the filing date of the application.

14. Renewal
Renewal requires filing a renewal application and either a Declaration
of Use with evidence that proves use of the mark in Puerto Rico’s commerce or a Declaration of Excusable Non-Use. Must be requested within one year prior to the expiration date of the registration. There is a 6 month grace period with payment of an additional fee.

15. Renewal Form
Electronic filing is now mandatory. The Trademark Office’s electronic filing system provides a ready to fill form. Any relevant documents may be uploaded.

16. Other Forms
The Department of State also provides model forms for trademark assignment, opposition and petition for cancellation.

17. Post-Registration Forms
There are no forms other than the Declaration of Use, Declaration of Continued Use and renewal forms. Electronic filing for these events is now mandatory.

18. Fees
The fees are $150.00 for trademark applications, trade name applications, US Deposits, renewals, oppositions and cancellations; $10.00 for a deed of assignment, mergers, declarations of use and change of name; $5.00 for a change of address; $15.00 through $20.00 for amendments; and $10.00 through $15.00 for answers to office actions.

19. Use Requirement for Renewal
Use is required for renewal. For registrations based on intent to use, a Declaration of Use must be filed within three years from filing /registration date, with one specimen of the mark as used in commerce. All registrants must file a Declaration of Continued Use (or a Declaration of Use, for renewal) with evidence showing use of the mark in Puerto Rico’s commerce, or a Declaration of Excusable Non-Use, between the 5th and 6th year after filing/registration date, between the 9th and 10th year after filing/registration date with the renewal application and between the 9th and 10th year of every subsequent period of 10 years with the renewal application.

A mark becomes uncontestable after any period of five years of continuous uninterrupted use from the date of registration subject to compliance with other applicable requisites. However, lack of use of the mark with the intention of not resuming it gives rise to the presumption of abandonment. Failure to file any of the Declarations of Use or Continued Use or Excusable Non-Use will render the registration automatically cancelled.
20. Presumptions

   a. In Favor of Registrant
   A Certificate of Registration is prima facie evidence of the validity of the registered mark and of ownership, as well as of the exclusive right of the Registrant to use the mark in commerce subject to any conditions or limitations stated in the certificate, and of the use in commerce of, the trademark since the date shown in the certificate of registration.

   b. Presumption of Doing Business
   Registration does not create a presumption of doing business to allow the registrant to qualify as a foreign corporation, or for purposes of personal jurisdiction.

21. Remedies for Infringement
   Remedies against infringement include injunctive relief, seizure of infringing articles, damages, costs, and attorney’s fees; statutory damages (a remedy only available to registrations); and treble damages for willful or bad faith infringement; any other appropriate remedy.

22. Persons Entitled to Sue
   The registrant of record or trademark owner.

B. Dilution

1. Code Section
   Article 28 of the Trademark Act provides for a civil action against dilution.

2. Judicially Created Dilution Doctrine
   There are no cases that have interpreted the dilution doctrine pursuant to the Trademark Act.

3. Tarnishment
   Dilution by tarnishment is contemplated in the Trademark Act.

4. Likelihood of Confusion
   Likelihood of confusion or association is not required.

5. Competition Between the Parties
   It would be applicable to competitive as well as noncompetitive goods.
6. **Fame or Distinctiveness**
The mark would have to be famous.

7. **Remedies**
An injunction is available. Damages, costs, attorney’s fees, statutory damages (only for registrants), destruction of infringing products, among others, are available if the owner of the famous mark proves that defendant acted intentionally.

8. **Leading Cases**
There are no reported dilution cases.

9. **Extraterritorial Effect**
There is no statutory provision or case law that has specifically recognized or addressed the issue.

10. **Preemption Cases**

   a. **Cases**
   None.

### C. Unfair Business Practices Acts (Little FTC Acts)

1. **Code Section**
Title 10 of Laws of Puerto Rico Annotated sections 257-276 covers unfair business practices; Title 3, sections 341-341w covers consumer remedies.

2. **Scope**
The foregoing provision regulates monopoly, restraint of trade and unfair and deceptive trade practices.

3. **Prohibited Activities**
Prohibited activities include unfair methods of competition and unfair or deceptive acts or practices in trade or commerce.

4. **Remedies**
   a. **State Administrative Enforcement**
The Secretary of the Department of Consumer Affairs may assert administrative fines of up to $10,000.00 per violation (3 LPRA §341(q)).
b. Criminal Enforcement
Criminal penalties for certain unfair methods of competition and unfair or deceptive acts are punishable by a fine of between $5,000 and $50,000 and/or imprisonment not exceeding one year. 10 LPRA §266.

c. Civil Penalties
Administrative penalties for violation of the provisions in consumer affairs include fines of $10,000 maximum. Each day the same violation is incurred shall be considered as a separate violation. 3 LPRA §341(q).

d. Private Actions and Remedies
Aggrieved persons may file private actions for damages, for which there is neither maximum nor minimum dollar recovery. Proceedings may include accounting and injunctive relief. Costs will be imposed on the losing party. Attorney’s fees may be imposed on losing party if it acted in a reckless manner or with frivolity.

e. Class Actions
Class actions are permitted by Rule 20 of Civil Procedure.

f. Notice
Notice is not a prerequisite to suit.

g. Standing
In general, any affected person or any person who wants to prevent losses or damages to his/her business or property has standing.

h. Consumer Products
In general, defined by Regulation as any type of goods that may be bought or sold.

i. Jurisdiction of Courts
The Court of First Instance of Puerto Rico has jurisdiction.

j. Rules
In general, deceptive Advertising and Practices Regulation of the Department of Consumer Affairs of May 29, 2015; Unfair Trade Practices Regulation of the Department of Justice of May 29, 1980.

k. Administrative Investigative Authority
Administrative investigative authority for consumer affairs is the Secretary of Consumer Affairs; his authority extends to false advertising and deceptive trade practices.
D. Uniform Deceptive Trade Practices Act

The Uniform Deceptive Trade Practices Act, or any variation thereof, has not been adopted.

1.–5. Not applicable.

E. Trademark Counterfeiting

1. Specific Statutes
The Trademark Act, Article 30, establishes a special proceeding that allows a registrant-plaintiff to obtain, without a bond, and on ex parte motion, a provisional cease and desist order, and an order for preventive seizure of objectionable goods without bond. In addition, under Article 26 of the Trademark Act, a registrant/trademark owner can file a civil action and obtain a seizure order; damages; statutory damages (for registrant only); treble damages for bad faith infringement; costs; attorney’s fees; injunction.

2. Definition
“Counterfeiting” is not defined. However, the procedure available under Article 30 is directed to violations through “forgery, copy, imitation or adoption of a mark that is so similar to that of the registered owner that it creates the likelihood of confusion.” Article 26 addresses violations through reproduction, forgery, copy, imitation, use or intent of using an identical or similar mark belonging to another and that can cause likelihood of confusion or deception as to the origin of the goods or services or as to sponsorship or association.

   a. Registration Requirement
The procedure under Article 30 is available for violation of property rights on a trademark registration. Under Article 26, a trademark owner that does not own a trademark registration can sue.

   b. Identity of Types of Goods
Any article substantially similar or related to those of the registered mark or the preexisting mark.

3. Who Can Sue
To obtain the benefit of the special procedure of Article 30, only the registered owner of a mark can file a complaint (sworn or supported by a sworn statement) before the Superior Court. Under Article 26, a trademark owner can also file a complaint.
4. Remedies

a. Civil
The registrant of the mark may obtain, on an ex parte motion, and without a bond, a provisional cease and desist order and an order for preventive attachment and seizure of objectionable goods without bond under Article 30. The trademark owner and registrant can obtain damages, statutory damages (for registrant only); treble damages in case of willful infringement; injunction; seizure order; attorney’s fees and/or costs under Article 26. Additionally, in both cases the trademark registrant or owner may obtain any other appropriate remedy.

b. Criminal
Trademark infringement is not regulated by any criminal statute.

5. Protective Provisions for Defendants
There are no specific provisions until trial on the merits.

F. False Advertising

1. Statute
Title 3 Laws of Puerto Rico Annotated §341, creates the Department of Consumer Affairs with powers and authority to regulate and inspect deceptive trade practices. Article 27 of the Trademark Act, now provides a cause of action for false advertising or misrepresentation of fact.

2. Prohibited Practices
Prohibited practices include deceptive commercial practices, false advertising, any false or deceptive representation, advertising that tends to constitute fraud and/or deceit, and/or misrepresentation about the brand, quality, size, price, amount and guaranty or safety of a product, article or services and any false designation of origin.

3. Limitations
None.

4. Who Can Sue
A consumer can sue directly or initiate administrative proceedings before the Department of Consumer Affairs. In the latter case, the Department can seek from the superior court an order of compliance with the administrative order; however, such proceedings do not include any award of damages to the consumer. Under Article 27 of the Trademark Act, the person that suffers damages can sue.
5. Remedies
See C.4 above and subsections (a), (c) and (d). Under Article 27 of the Trademark Act an injunction, seizure order, damages, statutory damages (for registrants only), treble damages for willful infringement, costs, attorney fees and any other appropriate remedies are available.

6. Leading Cases
The leading cases construing consumer affairs are Garage Ruben, Inc. v. Superior Court, 101 DPR 236 (1973); India Brewery, Inc. v. Superior Court, 103 DPR 686 (1975); Costa, Piovanetti v. Caguas Expressway Motors, 149 DPR 881 (2000); Sanchez v. Swiss Chalet, Inc., 178 DPR 363 (2010); González Cabán v. JR. Seafood, 2017 TSPR 187.

G. Corporate Name Reservation Prior to Incorporation

1. Statute

2. Reservation
120 days.

3. Limited Partnerships
Can be created by way of deed.

4. Restrictions on Use of “Corp.” and Similar Terms
Only companies incorporated or authorized to do business in Puerto Rico may use “Corp.” or similar terms.

5. Required or Authorized Use of “Corp.” or Similar Term
“Corp.,” “CRL,” “SRL” or “Corporation,” “Inc.,” and/or “Incorporated” and/or other symbols or abbreviations that have similar meaning in other languages, provided they are written in the lettering of the Roman alphabet.

6. Search Provision
A search is conducted by the Secretary of State for conflict with names of previously registered corporations.

7. Policy Regarding Identical Words
Identical words are permitted within composite corporate names; however, there must be sufficient differences to avoid confusion in the records of the Secretary of State.

PR-10
8. Substantive Rights
As to trademark or service mark protection, no substantive rights arise, as a result of incorporating under a specific name.

9. Prohibited Terms
There is no statutory prohibition of corporate names with any specific type of words.

10. Administrative Agency
Puerto Rico Department of State, Minillas Government Center, De Diego Ave., San Juan, Puerto Rico 00912, Att.: Corporations Section. This is the agency responsible for corporate registrations.

11. Forms
Sample forms are available at the Secretary of State for incorporations, qualifications, annual reports, amendments, dissolutions and others. Forms can be downloaded from the Internet at https://estado.pr.gov/es/formularios-para-corporaciones (Spanish Version) or at https://estado.pr.gov/en/forms-for-corporations (English Version). Electronic filing is now mandatory.

12. Fees
These are $150 for registration of domestic and foreign corporations; and from 2011 on, a $150 filing fee must be included with the annual report. When filing annual reports after due date, an additional $500 or $750 penalty fee must be included. Other fees apply for additional transactions, including mergers, amendments, etc.

H. Trade Name Registration (Fictitious Name Statutes)

1. Purpose
The Puerto Rico Trade Name Act, found in Title 10 Laws of Puerto Rico Annotated (“LPRA”) §225-225e, came into effect in December 1992. Its purpose is to create a Registry, whereby a registrant obtains the exclusive right to use a trade name to identify his/her commercial activities and to distinguish such commercial activities from those of others in Puerto Rico.

2. Entities Required to File
Filing is not mandatory. However, applicant may file the electronic form provided by the Department of State.

The application must: (1) specify the kind of business activity that is sought to be associated with the requested trade name, (2) be
accompanied with a sworn statement, in accordance with the laws of the jurisdiction in which it is executed, and (3) present evidence that the applicant has applied for or obtained the licenses and permits required by law or regulations to run the business whose trade name registration is requested. Also, the application form requires specimens of the trade name as used in commerce in Puerto Rico. Instead of specimens, drawings (print-outs) showing the name as it will be used must be submitted if trade name has yet to be used.

3. Limited Partnerships
Not applicable.

4. Where to File
Electronic filing via the Puerto Rico Department of State’s webpage (www.estado.pr.gov) is now mandatory.

5. Fees
The registration fee of $150.00 is prescribed by Regulation.

6. Publication
One publication in a local newspaper of daily general circulation.

7. Foreign Companies
As part of the application, the applicant must submit evidence of having applied for or obtained licenses and permits required by laws and regulations to run the business for which the trade name application is filed.

8. Civil Penalties
Generally, remedies available under trademark law are applicable.

9. Criminal Penalties
Not applicable.

10. Certificate
The term of registration is ten (10) years from the date of application, as for marks under the Trademark Act.

11. Renewal or Deletion
The renewal form must be filed within one year before the registration expires.

12. Substantive Rights
Registration of a trade name provides exclusive right of use in the course of business in Puerto Rico. However, the prior user of a trade
name can request the cancellation of a registered trade name that can cause confusion with the one he/she owns within 5 years of registration of the trade name sought to be cancelled.

13. Search
The Department of State does not conduct a search prior to the actual filing of an application.

However, the Department of State conducts a search as the initial step in processing an application. The search will encompass the Trade Name Registry and the Trademark Registry, which also covers service marks, in the manner described in A-8 above. A trade name is not registrable if it is identical or similar to a trademark, service mark or trade name which is registered, or for which an application for registration has been previously filed, so as to probably cause confusion or error in the public’s mind.

14.-15. Not applicable.

I. [Commonwealth] Statutory and/or Unfair Competition or Passing Off Provisions

1. Statutory Section
Generally, unfair methods of competition, and unfair or deceptive acts or practices in trade or commerce, are prohibited by Title 10 LPRA §259(a).

2. Derivation
The unfair competition statute originates from U.S. common law, and related Federal statutes.

3. Intent
Intent to deceive or defraud is an element of a cause of action, and may be shown by proof of the manufacture, sale, import, export, or possession of goods with the false trademark. As to trademark infringement, courts adopt the likelihood of confusion test.

4. Defenses
Defenses in trademark infringement cases may include laches, fraud and abandonment, among others.

5. Remedies
Available remedies include injunctive relief, damages, and attorney’s fees.

PR-13
6. Common Law Action for Unfair Competition
Local courts will recognize an action for unfair competition, imitation of unregistered trade names, and registered or unregistered trademarks.

7. Elements of a Common Law Cause of Action
Generally, for elements of a cause of action, see I.3, above.

8. Remedies
Generally, for remedies against infringement, see I.5, above.

9. Leading Cases

J. Statutes of Special Application and Personal Name Statutes

1. Special Statutory Sections
Statutes regulate certain specific industries, including containers and their respective labels and trademarks, as follows.

(a) Alcoholic Beverage and Beer, Code of Internal Revenue;
(b) Filled Milk Products, Title 5 LPRA §1092-§1125(b);
(c) Misbranding Foods, Drugs and Cosmetics, Title 24 LPRA §711-§732;
(d) Pesticides, Title 5 LPRA §1001-§1013;
(e) Roasted, Ground and Processed Coffee, Title 10 LPRA §231-§236;
(f) Meat Products, Title 10 LPRA §241-§241i;
(g) Eggs, Title 10 LPRA §242-§242f;
(h) Carbonated Beverage Containers, 10 LPRA §213-§215; and
(i) Hydrogenerated Vegetable Oil, 10 LPRA §244-§244g.

Prohibited activities include matters related to branding and labeling.
2. Use of Personal Name
There is no statutory prohibition of use of a name of a person except as described in section A(11)(3). There are no statutory civil and/or criminal penalties, nor any reported cases.

K. Right of Publicity
Act number 139 of 2011 is Puerto Rico’s Right of Publicity Act.

L. Criminal Statutes

1. Statutory Provision
The statute regulating the soft drinks industry makes a misdemeanor of the refilling of containers bearing the trademark of another bottler. Maximum penalties are fines not to exceed $100 and/or imprisonment not to exceed sixty days.

M. Trade Disparagement or Trade Libel

1. Statute or Common Law Doctrine
There is no specific statute or common law doctrine prohibiting trade disparagement or trade libel; however, civil libel under 32 LPRA 3141-3149 seems an available remedy authorizing civil actions for damages by libel generally if the writing maliciously discredits or scorns.

2. Elements of Cause of Action
Any writing or publication that maliciously discredits and/or scorns may constitute trade libel.

3. Presumptions
In general, a publication is not presumed malicious when made in any proceeding authorized by law. Malice is, however, presumed in any injurious communication made without justifiable motive and addressed to certain persons.

4. Remedies
General tort damages principles apply.

5. Punitive Damages
Punitive damages are not available.

6. Single Publication
Repetition of a publication goes to the measure of compensatory damages.
7. **Defenses**
The usual defense is the truth of the allegedly libelous matter, and that it was done with justifiable ends; and privileged communication.

### N. Franchising or Business Opportunity Statutes
There is no statute governing the sale or offering for sale of franchises or business opportunities.

1.–20. Not applicable.