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Rights of publicity vs personality rights: a comparative analysis of the US and UK legal frameworks

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Trademark protection in Puerto Rico: a strategic analysis for international IP attorneys and corporate counsel

Puerto Rico's unique dual trademark system presents both opportunity and risk for brand owners navigating US market entry. In this article, Mayra C. Artilles Fonseca, Vanessa Carballido Clerch, Jeffrey Hernández Escobar, and Vanessa Díaz Carrasco of Estrella LLC explore the strategic importance of securing both federal and local trademark protection, offering practical guidance for companies and counsel operating within this complex and often overlooked jurisdiction.



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For companies expanding into new markets, intellectual property strategy typically follows the commercial playbook: identify the target jurisdiction, assess risks, and file where you operate. Puerto Rico, however, requires a different approach. The territory occupies a unique position in the US IP landscape – federal law governs it in part, yet it maintains an independent trademark registration system with distinct rules, timelines, and strategic implications. For brands operating in or entering Puerto Rico, understanding this dual framework from the outset can mean the difference between airtight protection and costly, avoidable exposure. This guide serves both international IP attorneys seeking technical precision and general counsel requiring practical guidance for brand protection strategies.

Puerto Rico occupies a unique position within the US intellectual property landscape. As a US territory subject to federal law, it falls

within the Lanham Act's protective scope. Yet Puerto Rico simultaneously maintains an independent trademark registration system under its own statutory framework – a duality that creates both opportunity and risk for brand owners. This article examines the legal architecture of trademark protection in Puerto Rico, analyzes the strategic benefits of registering with both the Puerto Rico Trademark Office (PRTO) and the United States Patent and Trademark Office (USPTO), and provides practical guidance for international IP attorneys and general counsel navigating this distinctive regulatory environment.

Two systems, one island: understanding the dual framework a. Federal framework

The Lanham Act (15 U.S.C. § 1051 et seq.) extends to all US states and territories, including Puerto Rico. A federal trademark

registration with the USPTO is therefore valid and enforceable throughout the Commonwealth, and commercial activity in Puerto Rico constitutes “use in commerce” sufficient to support federal registration. Federal courts in Puerto Rico – specifically the US District Court for the District of Puerto Rico, with appeals to the First Circuit – exercise original jurisdiction over trademark claims under 28 U.S.C. § 1338(a).

b. Puerto Rico’s local trademark regime

Parallel to the federal system, Puerto Rico maintains its own trademark registration framework under Act No. 169-2009 (10 P.R. Laws Ann. §§ 223 et seq.), known as the Puerto Rico Trademark Act. The PRTO operates independently of the USPTO and – critically – does not search the federal register when examining local applications. This structural separation means that a federally registered mark will not be cited as a bar to a third party’s confusingly similar local application. The converse is equally true: a PRTO registration carries no formal weight before the USPTO.

The PRTO uses the Nice Classification system, permits use-based and intent-to-use applications, and requires single-class filings at USD 225.00 per class (USD 150.00 initial filing fee plus USD 75.00 publication fee upon approval) – substantially lower than USPTO fees of USD 350.00 per class. Unlike the USPTO, which publishes marks automatically, the PRTO requires applicants to pay for publication in the official gazette upon approval; no mark is certified until publication occurs without opposition. Registrations remain valid for 10-year terms, renewable indefinitely. Registrants must file a declaration of continuous use between years five and six and a renewal and statement of use between years nine and 10. The registration process takes approximately two years absent office actions.

Analysis: the strategic value of dual registration

a. Addressing the “gap filing” risk

The structural separation between the PRTO and USPTO creates a significant vulnerability: a third party may obtain a Puerto Rico registration for a mark identical or similar to a federally registered mark, and vice versa. A PRTO registration constitutes prima facie evidence of validity, ownership, and exclusive use within the Commonwealth – legal presumptions stronger than those most US state trademark registrations provide. For companies with meaningful commercial presence in Puerto Rico, relying solely on federal registration leaves a gap in

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protection that could expose the brand owner to local enforcement actions or blocking registrations. Additionally, failing to search the PRTO before entering the market could expose US trademark holders to commercial disputes. Major companies have learned this lesson after being blocked from entering Puerto Rico markets under their already established marks.

b. Complementary enforcement remedies

Dual registration provides access to complementary enforcement mechanisms. Federal registration enables nationwide injunctive relief, treble damages, and customs enforcement under the Lanham Act. PRTO registration, by contrast, unlocks distinctly advantageous local remedies: automatic preliminary injunctions without posting bail; ex parte temporary restraining orders in counterfeiting cases upon submission of a certified registration copy; statutory damages of USD 750.00 to USD 30,000.00 per infringement (eliminating the need to prove actual damages); mandatory costs and attorney’s fees for all prevailing plaintiffs; and enhanced criminal penalties for possession of counterfeit goods. Additionally, the Puerto Rico Trademark Act permits courts to increase statutory damages to USD 150,000.00 per violation where the registrant proves intentional infringement, providing stronger deterrence for willful violations.

Notably, injunctive relief under Puerto Rico law may be available even if the locally registered mark is not currently in active use on the island – making PRTO registration a valuable prophylactic tool for companies managing regional brand strategy. Given Puerto Rico’s position as a major Caribbean shipping hub where counterfeit goods are prevalent, the combination of federal customs enforcement and local ex parte temporary restraining order procedures provides a particularly robust anti-counterfeiting toolkit.

c. Forum selection and jurisdictional flexibility

Dual registration enables enforcement in both the federal courts and the Puerto Rico commonwealth courts, as federal jurisdiction over trademark claims is not exclusive. This flexibility allows brand owners to select the most advantageous forum based on the specific circumstances of a dispute. General counsel should note that commonwealth courts conduct proceedings exclusively in Spanish, while federal courts operate in English – a distinction affecting forum selection, litigation strategy, and the need for counsel fluent in both systems. In

the event of conflict between Puerto Rico trademark law and the Lanham Act, federal law preempts, providing a legal backstop while local registration delivers enhanced enforcement tools.

Strategic considerations for Spanish-speaking companies

Puerto Rico's unique position as a US territory with a Spanish-speaking legal system, civil law heritage, and deep Latin American cultural ties makes it a natural entry point for Spanish-speaking companies seeking to establish a US trademark presence.

Puerto Rico's legal system blends civil law and common law, with civil law roots in the Spanish legal tradition. Latin American companies and their counsel, accustomed to civil law trademark regimes, may find PRTO procedures more intuitive than the common law-influenced USPTO examination process. The PRTO operates in Spanish (although English filings are acceptable), uses the Nice Classification system, and follows procedures familiar to civil law practitioners – reducing friction and allowing Spanish-speaking companies to engage directly with the trademark office without translation barriers.

PRTO registration's lower cost (USD 225.00 per class versus USD 350.00 for USPTO filing) allows companies to secure brand protection early, before committing to full federal registration and nationwide commercialization. A PRTO registration can serve as a strategic placeholder while a company prepares for broader US market entry, demonstrating commercial intent and establishing a registration date in US territory. Because commercial activity in Puerto Rico constitutes use in US commerce, brands establishing sales or services on the island can leverage this activity as a basis for subsequent federal registration. Puerto Rico's inclusion in the US free trade zones and customs system means goods marketed under a trademark there move within the US commerce framework.

As a US territory, Puerto Rico falls within international agreements to which the US is a party, including the Madrid Protocol, the Paris Convention, and the Berne Convention. Spanish-speaking companies that establish PRTO and subsequent USPTO registrations thereby gain access to the full international treaty framework available to US trademark owners.

The value of local counsel in Puerto Rico

For law firms advising clients on trademark protection in the US, establishing a relationship with dedicated Puerto Rico

local counsel offers significant strategic and client-service value. Puerto Rico's hybrid civil law/common law system, combined with its separate trademark statute, requires specialized local knowledge that mainland US practitioners may lack. A Puerto Rico-based partner provides fluency in both the local legal framework and the interplay between federal and commonwealth law – expertise difficult to replicate from outside the jurisdiction.

The enforcement tools under the Puerto Rico Trademark Act – automatic preliminary injunctions, ex parte temporary restraining orders, statutory damages, and mandatory attorney's fees – require local counsel experienced in navigating the PRTO and commonwealth courts. An established Puerto Rico partner ensures these tools can be deployed quickly when needed, without the delays of establishing new local relationships during a crisis. For law firms advising Latin American companies, a Puerto Rico partner offers a culturally and linguistically compatible contact within the US legal system, bridging the firm's US and Latin American practices.

Practical guidance

Companies entering or operating in Puerto Rico should incorporate the following elements into their IP strategy:

- dual clearance searches; trademark searches must cover both the PRTO and USPTO for a complete picture of potential conflicts;
- simultaneous filing; a local Puerto Rico filing operates alongside, but separately from, federal registration, and both filings are warranted for any brand with commercial activity in Puerto Rico – the cost of dual registration is modest compared to the risk of leaving a gap in protection;
- strategic use of intent-to-use applications; if market entry is planned but not yet underway, file on an intent-to-use basis to secure priority from the filing date; priority claims based on foreign national filings are unavailable under Puerto Rico's local system, making early filing essential for international companies;
- comprehensive docketing; track Puerto Rico's maintenance deadlines – declaration of continuous use in years five through six, renewal in years nine through 10 – independently of USPTO obligations; three years of non-use renders a registration vulnerable to cancellation for abandonment;
- independent monitoring; because

“As a US territory, Puerto Rico falls within international agreements to which the US is a party, including the Madrid Protocol, the Paris Convention, and the Berne Convention.”

Puerto Rico examiners do not cross-reference the federal register, monitor the PRTO independently – in addition to USPTO monitoring – for early detection of potentially conflicting applications.

Conclusion

Puerto Rico’s dual trademark system – operating under both federal law and the independent Puerto Rico Trademark Act – presents both risk and opportunity for brand owners. The structural separation between the PRTO and USPTO means neither registration alone provides complete protection. A federally registered mark remains vulnerable to local gap filings, while a local registration carries no weight before the USPTO.

The prudent approach is dual registration. Combining federal and local protection closes the gap filing risk, provides access to both court systems and their distinct procedural advantages, and delivers a comprehensive enforcement toolkit that neither registration offers alone. For companies with meaningful commercial presence in Puerto Rico, the modest cost of maintaining both registrations is far outweighed by the protection they collectively afford.

For Spanish-speaking companies, Puerto Rico offers an accessible, cost-effective gateway to US trademark protection, with procedural familiarity and linguistic advantages that reduce barriers to entry. For law firms serving international clients, a Puerto Rico trademark partner provides the jurisdictional expertise, bilingual capability, and local enforcement experience necessary to deliver comprehensive, jurisdictionally complete trademark advice. An IP lawyer’s impulse to rely solely on federal trademark registration could cause incalculable harm to the client; the dual registration strategy articulated herein represents the standard of care expected of sophisticated IP counsel advising clients with Puerto Rico market exposure.

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