

ARGENTINA

Trademarks Law

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Chapter I Trademarks

Title 1 Property Rights in Trademarks

1.

The following may be registered as trademarks to distinguish goods and services: one or more words, with or without meaning; drawings; emblems; monograms; engravings; stampings; seals; images; bands; combinations of colors applied to a particular place on the goods or their packaging, wrappers or containers; combinations of letters and of numbers; letters and numbers insofar as they concern the special design thereof; advertising phrases, relief having distinctive capacity; and all other signs having such capacity.

2.

The following shall not be considered trademarks, nor shall they be capable of registration:

(a) names, words and signs that constitute the necessary or usual designation of the product or service to be distinguished thereby, or that are descriptive of its nature, function, qualities or other characteristics;

(b) names; words; advertising signs and phrases that have passed into general use prior to the application for registration thereof;

(c) the shape given to the goods;

(d) the natural or intrinsic color of the goods, or a single color applied thereto.

3.

The following may not be registered:

(a) a trademark identical to one previously registered or applied for to distinguish the same goods or services;

(b) trademarks similar to others already registered or applied for to distinguish the same goods or services;

(c) appellations of origin, whether national or foreign. "Appellation of origin" is understood to mean the name of a given country, region, place or geographical area that serves to designate a product emanating therefrom, the qualities and characteristics of which are exclusively due to the geographical environment. An appellation of origin shall also be considered to be that which refers to a given geographical area for

the purposes of particular goods;

(d) trademarks which are liable to induce error as to the nature, properties, merit, quality, manufacturing methods, purpose, origin, price or other characteristics of the goods or services that they are intended to distinguish;

(e) words, drawings and other signs that are contrary to morality or public order;

(f) letters, words, names, distinctive signs and symbols that are used or must be used by the State, provinces and municipalities and by religious and health organizations;

(g) the letters, words, names or distinctive signs that are used by foreign States and international bodies recognized by the Argentine Government;

(h) the name, pseudonym or portrait of a person, without his consent or that of his heirs down to the fourth degree inclusive;

(i) the names of activities, including names and company names which describe an activity, to distinguish goods; nevertheless, acronyms, words and other signs having distinctive capacity and forming part of such names may be registered to distinguish goods or services;

(j) advertising phrases that lack originality.

4.

The ownership of a trademark and the exclusive right to use it shall be acquired through registration. In order to become the registered owner of a trademark, or exercise the right to oppose the registration or use thereof, it shall be essential that the applicant or opponent have a legitimate interest.

5.

The term of validity of a registered trademark shall be ten years. It may be renewed indefinitely for like periods provided that it was used, within five years preceding each expiry date, in the marketing of a product, the performance of a service, or as part of the designation of an activity.

6.

The transfer of a trademark shall be valid as regards third parties once it has been registered with the National Board of Industrial Property.

7.

The assignment or bulk sale of an establishment shall include that of the trademark, provided that there is no stipulation to the contrary.

8.

The right of priority in the ownership of a trademark shall be granted according to the day and hour when the application was filed, without prejudice to the provisions of international treaties ratified by the Argentine Republic.

9.

A trademark may be registered jointly by two or more persons. The registered owners shall act jointly when licensing, transferring and renewing the trademark; any one of them may file opposition to the registration of a trademark, institute the proceedings provided for in this Law for the protection thereof and make use thereof, provided that there is no stipulation to the contrary.

Title 2 Registration Formalities and Procedure

10.

Persons wishing to obtain registration of a trademark shall file an application for each class in which registration is sought; the application shall include their name, domicile and a special address stipulated in the Federal Capital, a description of the trademark and a statement of the goods or services that it is intended to distinguish.

11.

The special address referred to in Section 10, stipulated by a person domiciled abroad, shall be valid to establish jurisdiction and for serving notice of legal proceedings for invalidation, replevin (reivindicación) or lapse of the trademark concerned, and for all notices to be served in connection with the registration proceedings.

However, in cases involving legal proceedings for invalidation, replevin or lapse, the court shall allow an extension of the term for replying thereto and for filing exceptions, having regard to the actual domicile of the defendant.

12.

Where the Application Authority finds that the legal formalities have been complied with in respect of the filing of an application for registration, it shall publish the application for one day in the Bolétin de Marcas (Trademark Gazette) at the applicant's expense.

Within 30 calendar days following the said publication, the National Board of Industrial Property (Dirección Nacional de la Propiedad Industrial)

shall carry out an anticipation search of the trademark applied for and shall render an opinion as to its registrability.

13.

Oppositions to the registration of a trademark must be lodged at the National Board of Industrial Property within 30 calendar days from the publication provided for in Section 12.

14.

Oppositions to the registration of a trademark must be made in writing, stating the name and domicile of the opponent and the basis of the opposition, which may be enlarged upon when replying to the Bill of Complaint in court proceedings. A special address in the Federal Capital shall be stipulated in the opposition brief, which shall be valid for service of such Bill of Complaint as the applicant may file.

15.

The applicant shall be given notice of the oppositions filed and of the objections that may have been raised to the application.

16.

After one year has elapsed from the notification provided for in Section 15, the application shall be declared abandoned in any of the following cases:

(a) if the applicant and opponent have failed to reach an agreement enabling an administrative decision to be taken, and if the applicant fails to institute court action within the said term;

(b) if the court action instituted by the applicant lapses.

17.

Court action to have an opposition set aside shall be brought before the National Board of Industrial Property. Within ten days of receiving the Bill of Complaint, the Board shall forward it together with the attachments thereto and a copy of the administrative proceedings relating to the opposed mark to the Federal Court of Civil and Commercial Matters of the Federal Capital.

The case shall be tried in accordance with the rules for ordinary proceedings.

18.

The judge assigned the case shall inform the National Board of Industrial Property of the outcome of the action brought to have the opposition set aside, for such purposes as may be relevant.

19.

Where an opposition has been filed, the applicant and opponent may, by common consent, waive judicial action and, within the one-year term fixed in Section 16, communicate this to the National Board of Industrial Property. A decision shall then be rendered, after both parties have been heard and any pertinent evidence has been submitted, and such decision shall not be subject to appeal. The regulations shall establish the procedure to be followed.

20.

Where application is made for renewal of a registration, the procedure established in Section 10 shall be followed and, in addition, a sworn declaration shall be filed stating whether the trademark has been used within the term fixed in Section 5, in at least one class, or whether it was used as a trade name, also indicating the product, service or activity, as the case may be.

Once a decision has been rendered granting registration or renewal, the corresponding certificate shall be issued to the applicant.

21.

Decisions refusing registration shall be subject to appeal to the Federal Court of Civil and Commercial Matters. The appeal shall be tried in accordance with the rules for ordinary proceedings and must be lodged, within 30 working days from notification of the adverse decision, before the National Board of Industrial Property, which shall proceed as established in Section 17.

Should action not be brought within the prescribed period, the application shall be declared abandoned.

22.

The files of trademark registrations or pending applications shall be public. Any interested party may, at his expense, request a full or partial copy of a file in which a final decision has been rendered.

Title 3 Extinction of the Right

23.

The property right in a trademark shall become extinguished:

- (a) by renunciation on the part of the registered owner;
- (b) by expiry of the period of validity, without the registration having been renewed;
- (c) by court decision invalidating the registration or declaring its lapse.

24.

Trademarks are null and void which were registered:

- (a) in contravention of the provisions of this Law;
- (b) by those who, when applying for registration, knew or should have known that they belonged to a third party;
- (c) for the sale thereof, by those regularly engaged in the registration of trademarks for the said purpose.

25.

The right of action to seek invalidation shall become statute-barred after ten years.

26.

On request, a trademark shall be declared to have lapsed if it has not been used in the country within five years preceding the date on which the action was instituted, except where reasons of force majeure prevented such use.

A trademark registered and not used in one class shall not lapse if the same trademark has been used in the marketing of a product or provision of a service included in other classes, or if it forms part of the designation of an activity.

Chapter II Designations

27.

The name or sign used to designate an activity, whether for profit or otherwise, shall constitute property for the purposes of this Law.

28.

Ownership of a designation shall be acquired through use thereof and only in relation to the activity for which it is used, and it must be incapable of confusion with pre-existing designations for the same activity.

29.

Anyone with a legitimate interest may oppose the use of a designation. Such action shall be statute-barred one year from the time when the third party commenced public and manifest use thereof, or from the date on which the plaintiff became aware of the use thereof.

30.

The right to a designation shall become extinguished with the cessation of the activity designated thereby.

Chapter III Illicit Acts

Title 1 Punishable Acts and Relevant Actions

31.

Imprisonment from three months to two years shall be imposed, in addition to which a fine from one million to 150 million pesos may be levied upon those who:

(a) counterfeit or fraudulently imitate a registered trademark or designation;

(b) use a counterfeit or fraudulently imitated registered trademark or designation, or one belonging to a third party, without his consent;

(c) offer for sale or sell a counterfeit or fraudulently imitated registered trademark or designation, or one belonging to a third party, without his consent;

(d) offer for sale, sell or otherwise market goods or services with a counterfeit or fraudulently imitated registered trademark.

The National Executive Power shall update the amount of the fine annually on the basis of the variation recorded in the index for general level wholesale prices, officially published by the National Institute of Statistics and Census.

32.

Penal action shall be public and the general provisions of Book 1 of the Penal Code are applicable insofar as they are compatible with the present Law.

33.

The Federal Courts in Criminal and Correctional Matters shall be competent to try penal actions, which shall be dealt with in accordance with the procedure for correctional cases; and the Federal Courts in Civil and Commercial Matters shall be competent to try civil actions, for which the procedure for ordinary actions shall be applicable.

34.

The aggrieved party may, regardless of the kind of action elected, apply for:

(a) seizure and sale of goods and other objects bearing an infringing trademark;

(b) destruction of the infringing trademarks and designations and of all objects bearing the same, unless they can be separated therefrom.

Upon request, the court shall order the publication of the judgment at the cost of the offender, where the latter was condemned or defeated in the proceedings.

35.

In civil actions instituted to enjoin use of a trademark or trade name, the plaintiff may demand that the defendant post a bond if the latter does not discontinue the questioned use. The court shall set the amount of the bond according to the apparent claim of the parties, and may also require that counter-security be given.

In default of the posting of security, the plaintiff may apply for the suspension of the use of the trademark or trade name and the attachment of the infringing objects, giving sufficient security if called upon to do so.

36.

The right to institute any civil action shall become statute-barred after three years from the commission of the offense, or after one year from the date on which the owner of the trademark became aware of the fact.

37.

The proceeds from the fines provided for in Section 31, and from the sales referred to in Section 34, shall accrue to the general treasury.

Title 2 Precautionary Measures

38.

Every owner of a registered trademark to whose knowledge information is brought of the existence of objects bearing an infringing trademark as provided for in Section 31, may appear before the competent court, requesting:

- (a) the attachment of the objects;
- (b) the drawing up of an inventory and description thereof;
- (c) the seizure of one of the infringing objects.

Without prejudice to the power vested in the court to order these measures

to be taken ex officio, the court may demand adequate security of the petitioner if it considers that the latter lacks the necessary responsibility to be able to respond in the event that the attachment was wrongfully sought.

39.

Any person in whose possession infringing goods are found shall produce proof of and information as to:

(a) the name and address of the person who sold him the goods or procured them for him and the date on which such act occurred, evidenced by the corresponding invoice or bill of sale;

(b) the number of units manufactured or sold and the price thereof, evidenced by the corresponding invoice or bill of sale;

(c) the identity of the persons to whom he sold or delivered the infringing objects.

All of the foregoing shall be entered in the report that shall be drawn up when the measures provided for in Section 38 are carried out.

Refusal to produce the information referred to in this Section, or the absence of documents affording commercial endorsement of the infringing objects, shall give cause for the presumption that the holder is an accomplice in the counterfeiting or fraudulent imitation. The said information may be enlarged upon or completed in the course of the legal proceedings, either on the initiative of the interested party or at the request of the court, which may call upon the interested party to do so within a fixed period.

40.

The owner of a registered trademark may make application for the precautionary measures set forth in Section 38 in connection with a similar or unlawfully used trademark, even in situations where no criminal act is involved. Where the corresponding suit is not brought within 15 working days after the attachment or seizure was effected, the attachment or seizure may be cancelled at the request of the owner of the objects attached or seized.

41.

The owner of a registered trademark consisting of an advertising phrase may make application for the measures provided for in Section 38 only with respect to the objects that bear the infringing advertising phrase.

Chapter IV The Application Authority

42.

The application authority of this Law shall be the National Board of Industrial Property, a dependency of the Secretariat of State for Industrial Development of the Ministry of Economy, and it shall decide as to the granting of trademarks.

43.

The National Board of Industrial Property shall record the applications for registration and renewal in the order in which they are filed. For this purpose it shall maintain a book with numbered pages sealed by the Secretariat of State for Industrial Development. In this book shall be noted the date and hour of filing, the application number, the trademark applied for, the name and domicile of the applicant and the goods or services to be covered.

44.

The certificate of registration shall consist of a certified copy of the decision granting the trademark, together with the duplicate copy of the description thereof, and it shall bear the signature of the Head of the Trademark Department of the National Board of Industrial Property.

45.

Registration, renewal, reclassification, transfer, abandonment and refusal of trademarks, as well as the extinction of the right therein through voluntary cancellation or by order of the court, and changes in the name of the registrant, shall be published by the National Board of Industrial Property.

46.

The National Board of Industrial Property shall keep the files or true copies thereof. The original files may only be destroyed when a copy thereof has been obtained and stored.

47.

Proceedings before the National Board of Industrial Property shall be subject to payment of fees, the amount of which shall be fixed by the Regulations. Such amounts shall be updated in the manner stipulated in connection with fines, as set forth in Section 31 in fine.

Chapter V Transitional Provisions and Repeals

48.

Trademarks registered prior to the date of entry into force of this Law, but which expire more than six months after that date, shall be reclassified at the time of their renewal in accordance with the classification to be established by the Regulations, or before that time at the request of the owner.

49.

The present Law shall enter into force 30 days following its publication in the Boletín Oficial (Official Gazette).

50.

The statutory Regulations under this Law shall issue within 60 days of the promulgation date.

51.

Laws Nos. 3.975 and 17.400, Sections 2, 3, 5, 6, 7 and 8 of Decree-Law No. 12.025/57, the Decree dated November 3, 1915, relating to escutcheons and flags and Decrees Nos. 126.065/38, 21.533/39 and 25.812/45 are hereby repealed.

52.

The foregoing shall be communicated, published, conveyed to the National Board of Official Registration and placed on record.