

ARGENTINA

Trademarks Law

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TABLE OF CONTENTS

Chapter I Trademarks

Title 1 Property Rights in Trademarks

- 1.
- 2.
- 3.
- 4.
- 5.
- 6.
- 7.
- 8.
- 9.

Title 2 Registration Formalities and Procedure

- 10.
- 11.
- 12.
- 13.
- 14.
- 15.
- 16.
- 17.
- 18.
19. [repealed]
- 20.
- 21.
- 22.

Title 3 Extinction of the Right

- 23.
- 24.
- 25.
- 26.

Chapter II Designations

- 27.
- 28.
- 29.
- 30.

Chapter III Illicit Acts

Title 1 Punishable Acts and Relevant Actions

- 31.
- 32.
- 33.
- 34.
- 35.
- 36.
- 37.

Title 2 Precautionary Measures

- 38.
- 39.
- 40.
- 41.

Chapter IV The Application Authority

- 42.
- 43.
- 44.
- 45.
- 46.
- 47.

Chapter V Transitional Provisions and Repeals

- 48.
- 49.
- 50.
- 51.
- 52.

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.

Anyone wishing to obtain registration of a trademark must submit an application that includes their name, physical address and special electronic address in accordance with the conditions established by the regulation, description of the trademark, and information on the products and/or services which it will 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.

When the application for registration has been filed, the Application Authority, if it considers that the legal formalities have been met, will publish it for ONE (1) day in the Trademarks Bulletin at the applicant's expense.

Within THIRTY (30) days of publication, the NATIONAL INDUSTRIAL

PROPERTY INSTITUTE will carry out a search into the background of the trademark applied for and will make a decision on 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.

Any oppositions to the registration of a trademark must be submitted electronically to the NATIONAL INDUSTRIAL PROPERTY INSTITUTE, indicating the name, physical and electronic address of the opponent, and reasons for the opposition.

15.

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

16.

Within THREE (3) months of notice of any oppositions provided for under article 15, if the applicant has failed to obtain the lifting of the oppositions, the NATIONAL DIRECTORATE OF TRADEMARKS will resolve any oppositions that remain in force in an administrative procedure.

(Supplementary Note: Art. 1 of Resolution No. 26/2018 of the National Industrial Property Institute B.O. 02/06/2018 establishes that claims arising from the replaced Art. 16, inc. a) of this Law, whose annual expiration date falls within the period of the three (3) months referred to in Art. 3 of Resolution No. 001/2018 of the National Industrial Property Institute—from January 12, 2018 to April 12 of the same year— will be received by this body and sent within ten (10) days to the court in the manner and with the formalities required, for any applicable purposes. If no claim is filed or an administrative procedure is chosen, the opposition(s) will be resolved in accordance with the regulated process.)

17.

The procedure for resolving oppositions will be laid down by the Application Authority, which must provide, at least, for the possibility of the opponent explaining its reasons, the right of the applicant to respond to the opposition, and the right of both parties

to provide evidence. The procedure must adopt the principles of speed, simplicity, and procedural economy.

Decisions on oppositions made by the NATIONAL DIRECTORATE OF TRADEMARKS will only be appealable directly before the National Federal Civil and Commercial Chamber of Appeals within THIRTY (30) business days of their notice. The appeal must be filed with the NATIONAL INDUSTRIAL PROPERTY INSTITUTE, which will refer it to the courts under the conditions set by the regulations.

18.

For any cases of opposition to trademark registration that to date are being processed before the courts or have been concluded without the result being notified, the NATIONAL INDUSTRIAL PROPERTY INSTITUTE may directly verify their status in the procedure Portal of the NATIONAL JUDICIAL AUTHORITY and resolve accordingly.

19. [repealed]

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.

Any decision made to reject registration for reasons other than those falling under Art. 17 may be contested before the National Federal Civil and Commercial Court. The action will be processed under the ordinary rules of procedure and must be filed within THIRTY (30) business days of notice of that resolution.

22.

The records of pending or registered trademarks are publicly and freely accessible.

Title 3 Extinction of the Right

23.

The right of ownership of a trademark is extinguished:

- a) by the owner's renunciation;
- b) by expiration of the term of validity, without its registration having been renewed; or
- c) due to a declaration of nullity or expiration of the registration.

24.

Trademarks are null and void if registered:

- a) in violation of the provisions of this law;
- b) by a person who, when applying for registration, knew or should have known that they were owned by a third party;
- c) for commercial use by a person whose usual activity is the registration of trademarks for this purpose.

The NATIONAL INDUSTRIAL PROPERTY INSTITUTE, through the NATIONAL DIRECTORATE OF TRADEMARKS, at its own initiative or at the request of a party, shall resolve the trademark nullities referred to in subparagraph a) of this article in an administrative procedure.

Decisions made in relation to trademark nullity may be appealed against within THIRTY (30) business days of their notice, only through a direct appeal filed with the National Federal Civil and Commercial Chamber of Appeals, which will be filed with the NATIONAL INDUSTRIAL PROPERTY INSTITUTE.

25.

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

26.

The NATIONAL INDUSTRIAL PROPERTY INSTITUTE, on its own initiative or at the request of a party, in accordance with the regulations issued, shall declare the revocation of a trademark, even partially, in relation to products or services for which it has not been used in the country within FIVE (5) years prior to the application for revocation, unless a force majeure event is involved.

Decisions made in relation to trademark revocation may be appealed against within THIRTY (30) business days of their notice, only through a direct appeal filed with the National Federal Civil and Commercial Chamber of Appeals, which will be filed with the NATIONAL INDUSTRIAL

PROPERTY INSTITUTE.

A registered trademark that has not been used in a class or for certain products or services does not expire if the same trademark has been used to market a product or to supply a service that is related or similar to these, even if the service is included in other classes, or if it is part of the designation of an activity related to the former.

Furthermore, after the fifth year of granting the trademark registration, and before the expiration of the sixth year, its owner must submit a sworn statement relating to the use of the trademark up to that time.

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.

Acts falling under any of the following shall be punished with a prison term of between three (3) months and two (2) years, with a possible fine of between four thousand pesos (\$ 4,000) and one hundred thousand pesos (\$ 100,000):

- (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 Authority may change the amount of the fine provided, if the circumstances so require.

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 conservation and custody of the administrative proceedings relating to the processing of trademarks must be carried out in accordance with the provisions of Decree No. 1,131/16 or any decree that replaces or amends it in the future.

47.

The NATIONAL INDUSTRIAL PROPERTY INSTITUTE, in its capacity as an Application Authority, is empowered to issue complementary regulations to this Law, with regard to the trademark registration procedure, in

all matters that facilitate the latter, eliminate requirements that become obsolete, and speed up and simplify the registration process. For this purpose, it may, among other things, amend the procedure described in the second section of this Law; restrict examination of applications to absolute prohibitions or those related to public order, subordinating applications made by third parties; establish the publication of third-party oppositions following the granting of the trademark; subject the validity of the title to the decision of the NATIONAL INDUSTRIAL PROPERTY INSTITUTE in the case of any oppositions it may receive, as well as to the expiration of the priority period of the Paris Convention in view of potential priorities which are unknown at the time the trademark was granted.

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.