
ARGENTINA



NEW ADMINISTRATIVE PROCEDURES: NULLITY AND CANCELLATION OF TRADEMARK REGISTRATIONS

Within the framework of the changes introduced to the Trademark Law, the regulation of the procedures for processing the requests for nullity and cancellation of registered trademarks was still pending. These regulations were finally approved by the INPI Resolution No. 279/2019, published in the National Official Gazette of last October 10.

The regulations are incorporated as Annexes III and IV of Resolution 183/2018, which established the Administrative Procedure for Resolution of Oppositions.

Both procedures are simple. Once the request for nullity or expiration has been raised, either at the request of an interested third party or ex officio, the INPI will notify the trademark owner granting a 15-working-day term to file the response and submit evidence. Once the response has been filed or the deadline for doing so has expired, the INPI will make a decision.

The INPI's final decision can be appealed to the Federal Civil and Commercial Appeals Chamber through direct appeal.

In those cases, in which the nullity or expiration claim is made in defence of an opposition, it will be resolved in the opposition administrative resolution procedure.

As for the nullity process, only the nullity of registered trademarks that have been granted in contravention of the provisions of the Trademark Law can be requested at an administrative stage, either at the request of any party invoking a subjective right or ex officio. The nullity ex officio will only proceed in case of detecting any serious non-rectifiable defect in the trademark registration procedure. As regards this last point, it should be mentioned that the Law on the General Administrative Procedures establishes that administrative acts that are firm and consented and have generated subjective rights, can only be revoked by means of a judicial declaration of nullity, therefore, the INPI may validly declare the nullity of registered trademarks whose granting decision has not yet been notified to the applicant, but not after such notification.

Regarding the cancellation process, it may be raised at the administrative stage when the trademark has not been used for a term of 5 years after registration, either at the request of any party invoking a subjective right or ex officio. Ex officio cancellation will only proceed when the following conditions are jointly verified: a) The trademark has not been used within the previous five years; b) The owner has not submitted the mid-term statement of use established in Article 26 of the Trademark Law; c) It is not a well-known mark in the terms of the Paris Convention and TRIPS; and d) the trademark owner does not have an identical trademark registered in a related or linked class; or if he had, he would not have filed the mid-term statement of use in those registrations either. The partial cancellation may only be filed as of June 12, 2023.

These regulations will come into effect on December 9, 2019.

The full text of the Resolution can be accessed through the following link:

<https://www.boletinoficial.gob.ar/detalleAviso/primera/218564/20191010>

GOODBYE TO “THE WHOLE CLASS”

On October 22, 2019, it was published in the National Official Gazette the INPI Resolution No. 288/2019 implementing new electronic forms for the presentation of new trademarks, renewals and oppositions.

Although all forms will have to be completed electronically, the possibility to file applications in paper remains open by printing the electronic document obtained. The date of submission of the application will be the date of the physical presentation of the application with the INPI and not the date of

loading the form on the Web Portal of that Institute.

For requesting new trademarks, these forms will implement the classification tool “TMClass” and the EUIPO harmonized database to select the products and services to be covered by the application. In addition, the INPI will not allow applications indicating “to cover the whole class” or similar text in the description of goods and services, such applications will be rejected.

Resolution 288/2019 will come into effect on November 15, 2019.

The full text of the Resolution can be accessed through the following link:

<https://www.boletinoficial.gob.ar/web/utills/pdfView?file=%2Fpdf%2Faviso%2Fprimera%2F219370%2F20191022>