

## ARGENTINA:

Possibility of requesting partial revocation of trademark registrations.

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**As of June 12, 2023, it will be possible to request the partial revocation of trademark registrations due to lack of use**, which will cause a significant change in the current practice, causing a great impact on trademark registration strategies.

In 2018, Law 27,444 introduced several changes to the Law on Trademarks and Trade Names. A noteworthy amendment was the incorporation of the possibility of requesting the partial revocation of trademark registrations, ex officio or upon request of third parties; however, a 5-year grace period was established to start filing these requests, a period that will end shortly.

**The partial revocation of a trademark registration will apply to those products or services protected by the registration for which the trademark has not been used within a period of 5 years prior to the filing of the revocation request.** The revocation will not apply if the trademark was used to identify related or similar products or services, even those included in other classes, or if it is part of a trade name related to the products or services protected by the registration. The revocation request may be filed against both new trademark registrations and renewals.

This new incorporation to the Law, represents a substantial amendment with respect to the current practice. Previously, the use of a mark to identify any product or service, even those included in other unrelated classes, would suffice to comply with the use requirement and avoid a revocation action. This allowed trademark holders to obtain the registration of

defense trademarks in classes without any relation to the products or services for which the trademark was used. This practice hindered the registration of marks that could peacefully coexist in the market without causing any risk of confusion amongst consumers. The partial revocation of trademark registrations is a new and powerful tool that will avoid these obstacles.

### How should the use be to avoid a revocation action?

The use of a trademark must be analyzed on a case-by-case basis to determine if it is sufficient to avoid a revocation action. In this regard, the Courts have adopted a broad approach. Any form of disposition of the product or service on the market can be considered sufficient use, as long as it is a serious and effective use that demonstrates a clear intention to market a product or provide a service with the trademark. The use of the trademark on the Internet will be considered sufficient use if the product or service is available for purchase or contracting by local consumers.

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Please note that well-known trademarks deserve special protection that goes beyond the principle of specialty. However, this consideration of a well-known trademark must be declared by a Federal Court in each case, which entails time and high costs associated with a judicial procedure.

Another relevant issue regarding the concept of use that arises with the amendment of the revocation regulation is that the use required to maintain the validity of the trademark in the event of a revocation action is stricter than the use required to renew the registrations:

- The use required to renew a trademark registration has a broad concept; the use is sufficient if the trademark identifies any product or service, even if it is different from those protected by the registration, or if the mark is part of the trade name.
- The use required to maintain the validity of a trademark registration against a revocation action is stricter and the trademark must have been used to identify the same products or services that the registration covers, or for related products or services, or as a trade name for an activity related to the registered products or services.

### Other aspects to be considered in order to maintain the registration of a trademark

Along with the incorporation of the partial revocation, the amendment of the Trademark Law in 2018 also included the **requirement to file a sworn statement of use within the 5th and 6th year from the granting of the registration or renewal**. The trademark holder can file this statement at a later time by paying a surcharge fee for late filing. The failure to file the statement of use does not cause the loss of rights, but serves as precedent of non-use of the trademark that can be disproved by submitting evidence of trademark use.

In relation to the issue concerning revocation requests, it is important to note that, **if the mid-term statement of use has been filed, the examiner of the Trademark Office will not be able to declare the revocation ex officio**. The Argentine PTO has not revoked any registration due to lack of use ex officio yet, but it is entitled to do so.

At the time of filing the abovementioned statement, proof of use should not be filed, but it is advisable to collect and keep evidence of the use of the trademark in relation to as many products and services as possible (it is important that a date can be determined), in order to be able to defend the registration against any possible revocation action.

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Therefore, we are on the eve of a change that will surely be very positive for the trademark system in Argentina. In a few days, trademark holders will have a very useful tool that will allow them to redesign strategies to overcome previous obstacles, and those applicants who have been prevented from registering certain trademarks will now have the opportunity to file them again.

Hoping that you find this information useful, please do not hesitate to contact us if you have any queries or require further details.