

LAW ON TRADEMARKS (Law No. 22,362 – Official Gazette January 2, 1981)

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CHAPTER I

TRADEMARKS

SECTION 1

Right of trademark ownership

Article 1 – The following may be registered as marks in order to distinguish goods and services: one or more words with or without conceptual content; drawings; emblems; monograms; engravings; patterns; seals; images; bands; combinations of colours applied in a particular place on goods or packaging; wrapping; packaging; combinations of letters and numbers; letters and numbers drawn in a particular way; advertising slogans; distinctive embossments and any other sign with such capacity.

Article 2 – The following shall not be considered trademarks and may not be registered:

- (a) Names, words and signs that constitute the necessary or usual designation of the good or service to be distinguished or that describe its nature, function, qualities or other characteristics;
- (b) Names, words, signs and advertising slogans that have passed into general use before the application to register them;
- (c) The shape of a good;
- (d) The natural or intrinsic colour of a good or a single colour applied to the good.

Article 3 – The following may not be registered:

- (a) A mark that is identical to one previously registered or applied for in order to distinguish the same goods or services;
- (b) Marks similar to others already registered or applied for in order to distinguish the same goods or services;
- (c) National or foreign appellations of origin. "Appellation of origin" means the name of a particular country, region, place or geographical area that serves to designate a good originating from one of them whose qualities and characteristics are due exclusively to the geographical environment. A name that refers to a particular geographical area for the purposes of certain goods shall also be considered an appellation of origin;
- (d) Marks that may mislead as to the nature, properties, merit, quality, processing techniques, function, origin, value or other characteristics of the goods or services to be distinguished;
- (e) Words, drawings and other signs that are contrary to morality and decency;
- (f) Letters, words, names, badges or symbols that are used or reserved for use by the nation, provinces, municipalities or religious or health organizations;
- (g) Letters, words, names or badges used by foreign countries and international organizations recognized by the Government of Argentina;

- (h) The name, pseudonym or likeness of a person, without his or her consent or that of his or her heirs down to the fourth degree inclusive;
- (i) The designations of activities, including names and company names that describe an activity in order to distinguish goods. However, distinctive abbreviations, words and other signs that form part of such designations may be registered in order to distinguish goods or services;
- (j) Advertising slogans that lack originality.

Article 4 – Ownership of a mark and exclusivity of use shall be obtained through registration. In order to be the owner of a trademark or exercise the right to oppose its registration or use, the applicant or opponent must have a legitimate interest.

Article 5 – A mark shall be registered for a period of ten (10) years. It may be renewed indefinitely for the same period if it has been used within the five (5) years prior to each expiry for the marketing of a good, the provision of a service or as part of the designation of an activity.

Article 6 – The transfer of a registered mark shall be valid in respect of third parties once the mark has been registered with the National Directorate of Industrial Property.

Article 7 – The assignment or sale of goodwill shall include the mark, unless otherwise stipulated.

Article 8 – The right of priority for ownership of a mark shall be granted at the date and time of filing of the application, without prejudice to the provisions of international treaties ratified by the Argentine Republic.

Article 9 – A mark may be registered jointly by two (2) or more persons. The owners shall act jointly when licensing, transferring and renewing the mark; any of them may oppose the registration of a mark, institute the proceedings provided for in this Law to defend their mark, and use the mark, unless otherwise stipulated.

Section 2

Registration formalities and procedure

Article 10 – Anyone wishing to obtain the registration of a trademark shall file an application for each class in which registration is requested, including his or her name and actual domicile, a special domicile established in the Federal Capital, a description of the mark and a statement of the goods or services to be distinguished by the mark.

Article 11 – Where the special domicile referred to in Article 10 is established by a person domiciled abroad, it shall be valid for establishing jurisdiction, for notifications of legal action relating to nullity, ownership or expiry of the mark and for all notifications to be made with regard to the registration process.

However, where legal action is brought for nullity, ownership or expiry, the court shall extend the time period for contesting such action and raising defenses, bearing in mind the actual domicile of the defendant.

Article 12 – Once the registration application has been filed, the implementing authority shall, if the legal formalities have been completed, publish the application for one (1) day in the Trademark Gazette at the applicant's expense.

Within thirty (30) days of publication, the National Directorate of Industrial Property shall conduct a prior art search in respect of the mark applied for and shall rule on its registrability.

Article 13 – Objections to the registration of a mark shall be filed with the National Directorate of Industrial Property within thirty (30) days of the publication provided for in Article 12.

Article 14 – Objections to the registration of a mark shall be filed in a written notice stating the name and actual domicile of the opponent and the reasons for opposition, which may be elaborated on if the claim is considered in the courts. The notice of opposition shall specify a special domicile within the Federal Capital, which shall be valid for notification of any legal action brought by the applicant.

Article 15 – The applicant shall be notified of the objections raised and any observations on the application.

Article 16 – One (1) year after the notification provided for in article 15, the application shall be declared abandoned in the following cases:

- (a) Where the applicant and the opponent do not reach an agreement allowing for an administrative solution and the applicant does not bring legal action within the period indicated;
- (b) Where legal action is brought by the applicant but the period of limitation expires.

Article 17 – Legal action for the withdrawal of opposition shall be brought before the National Directorate of Industrial Property. The Directorate shall refer the application for legal action and additional information within ten (10) days of receipt to the Federal Civil and Commercial Court of the Federal Capital, together with a copy of the administrative acts relating to the opposed mark.

The relevant court case shall be heard under ordinary-law procedures.

Article 18 – The competent judge shall inform the National Directorate of Industrial Property of the outcome of the case brought for the withdrawal of opposition, as appropriate.

Article 19 – Following opposition, the applicant and the opponent may decide by mutual consent to settle the matter outside the courts and, within the period of one (1) year established in Article 10, inform the National Directorate of Industrial Property accordingly. In this case, a decision, which shall not be appealable, shall be issued once

both parties' cases have been heard and the relevant evidence has been submitted. The applicable procedure shall be determined in the regulations.

Article 20 – Applications for renewal of registration shall be made in accordance with the provisions of Article 10 and shall be filed together with an affidavit, which shall state whether the mark was used during the period established in Article 5 in at least one of the relevant classes, or whether it was used as a designation, indicating, as appropriate, the good, service or activity in question.

When a decision has been issued to approve the registration or renewal, the relevant certificate shall be delivered to the applicant.

Article 21 – A decision to refuse registration may be contested before the Federal Civil and Commercial Courts. The case shall be heard under ordinary-law procedures and must be brought, within thirty (30) working days of notification of the refusal decision, before the National Directorate of Industrial Property, which shall take action in accordance with the provisions of Article 17.

If the case is not brought within the specified period, the application shall be declared abandoned.

Article 22 – Records relating to marks that are registered or for which applications are in process shall be public. Any interested party may, at his or her own expense, request a full or partial copy of a record of the issuance of a final decision.

Section 3

Termination of rights

Article 23 – The right of trademark ownership shall be terminated:

- (a) on surrender by the owner;
- (b) on expiry of the term of validity if the registration is not renewed;
- (c) by judicial declaration of the nullity or lapse of the registration.

Article 24 – The following marks shall be null and void:

- (a) those registered in breach of the provisions of this Law;
- (b) those registered by anyone who, at the time of applying for registration, knew or should have known that the marks belonged to a third party;
- (c) those registered for the purpose of marketing by persons who habitually register marks for that purpose.

Article 25 – The period of limitation for legal proceedings relating to nullity shall be ten (10) years.

Article 26 – At the request of a party, a mark shall be declared to have lapsed if it has not been used in Argentina within the five (5) years preceding the date of institution of proceedings, unless the non-use was for reasons of force majeure.

A trademark that is registered and not used in one class shall not lapse if it has been used to market a good or provide a service in other classes or if it forms part of the designation of an activity.

CHAPTER II

DESIGNATIONS

Article 27 – A name or sign designating a profit-making or non-profit-making activity shall constitute property for the purposes of this Law.

Article 28 – Ownership of the designation shall be acquired with its use and only in relation to the field in which it is used, and there must be no possibility of confusion with pre-existing designations in the same field.

Article 29 – Any person with a legitimate interest may oppose the use of a designation. The relevant proceedings shall be limited to one year from the time when the third party began using the designation publicly and openly or from the time when the opponent became aware of its use.

Article 30 – The right to the designation shall be terminated on cessation of the designated activity.

CHAPTER III

OFFENSES

SECTION 1

Punishable acts and proceedings

Article 31 – A penalty of imprisonment for a term of three (3) months to two (2) years, with the possible addition of a fine of one million (\$1,000,000) to 150 million (\$150,000,000) pesos, shall be imposed on the following persons:

- (a) anyone who forges or fraudulently copies a registered mark or a designation;
- (b) anyone who uses a registered mark or a designation that is forged or fraudulently copied or belongs to a third party without that party's authorization;
- (c) anyone who offers for sale or sells a registered mark or a designation that is forged or fraudulently copied or belongs to a third party without that party's authorization;
- (d) anyone who offers for sale, sells or otherwise markets goods or services with a forged or fraudulently copied registered mark.

The National Executive shall adjust the amount of the aforementioned fine annually on the basis of recorded movements in the general wholesale price index, as published officially by the National Institute of Statistics and Censuses.

Article 32 – Criminal proceedings shall be public and the general provisions of Book I of the Penal Code shall be applicable insofar as they are compatible with the present Law.

Article 33 – The Criminal and Correctional Federal Courts shall be competent to hear criminal cases, which shall follow correctional-law procedures; the Civil and Commercial Federal Courts shall be competent to hear civil cases, which shall be heard in accordance with ordinary-law procedures.

Article 34 – The injured party may seek, by whatever means chosen:

- (a) the seizure and sale of the goods and other items with the offending mark;
- (b) the erasure of the offending marks and designations and the destruction of all items bearing them, if they cannot be separated from them.

The judge shall, at the request of a party, order publication of the ruling at the offender's expense if the offender is convicted or defeated in legal proceedings.

Article 35 – In civil cases that are brought in order to obtain cessation of the use of a mark or designation, the plaintiff may seek security *in rem* from the defendant, if the defendant does not cease the use in question. The judge shall determine the security in accordance with the ostensible right of the parties and may order bonds for costs. If no security *in rem* is provided, the plaintiff may seek suspension of the use of the offending items and their seizure, providing sufficient security if so requested.

Article 36 – The right to bring any civil claim shall expire three (3) years after the offense was committed or one (1) year from the day on which the owner of the mark became aware of the offense.

Article 37 – The proceeds of the fines provided for in Article 31 and the sales referred to in Article 34 shall be used as general income.

Section 2

Precautionary measures

Article 38 – Any owner of a registered trademark who becomes aware of the existence of items with an offending mark, as set out in article 31, may apply to the competent judge for:

- (a) seizure of the items;
- (b) an inventory and description of the items;
- (c) attachment of one of the offending items.

Without prejudice to the judge's power to order these measures *ex officio*, he or she may require adequate security from the petitioner where the judge considers that the petitioner does not have enough funds to cover any penalty he or she may be liable to pay if it is found that the seizure has been requested without entitlement.

Article 39 – Anyone who comes into possession of offending items shall report and provide evidence of:

- (a) the name and address of the person who sold or supplied the items and the date on which this took place, with presentation of the relevant invoice or purchase receipt;
 - (b) the number of units produced or sold and their price, with presentation of the relevant invoice or sale receipt;
 - (c) the identity of the persons to whom the offending items were sold or delivered.
- All this information shall be included in the official report to be made when the measures set out in Article 38 are taken.

Refusal to supply the information referred to in this Article, and also the absence of documentation serving as commercial endorsement for the offending items, shall constitute grounds for presuming that the holder is involved in forgery or fraudulent copying. This information may be elaborated on or supplemented in court both at the initiative of the interested party himself or herself and at the request of the judge, who may set a specific deadline for this purpose.

Article 40 – The owner of a registered trademark may seek the precautionary measures set out in Article 38, even if no offense has taken place in respect of a similar or illegally used mark. If the relevant proceedings have not been instituted within fifteen (15) working days of the seizure or attachment, the latter may be revoked at the request of the owner of the seized or attached items.

Article 41 – The owner of a registered trademark consisting of an advertising slogan may seek the precautionary measures set out in Article 38 only in respect of items to which the offending slogan has been applied.

CHAPTER IV

IMPLEMENTING AUTHORITY

Article 42 – The implementing authority for this Law shall be the National Directorate of Industrial Property under the State Secretariat for Industrial Development in the Ministry of Economy, which shall rule on matters relating to the granting of trademarks.

Article 43 – The National Directorate of Industrial Property shall record applications for registration and renewal in the order in which they are filed. For that purpose, it shall maintain a ledger initialled and with pages numbered by the State Secretariat for Industrial Development. The ledger shall set out the date and time of filing of the application, its number, the mark applied for, the name and domicile of the applicant and the goods or services to be distinguished.

Article 44 – The registration certificate shall consist of an attestation of the decision to grant the trademark, together with a duplicate of the description thereof, and shall bear the signature of the Head of the Trademarks Department of the National Directorate of Industrial Property.

Article 45 – The registration, renewal, reclassification, transfer, abandonment and refusal to register marks, their expiry by surrender or by court decision, and changes in owner names shall be published by the National Directorate of Industrial Property.

Article 46 – The National Directorate of Industrial Property shall keep records with authentic copies thereof. Original records may be destroyed only when a copy of them has been obtained and stored.

Article 47 – Procedures with the National Directorate of Industrial Property shall be subject to the payment of fees, the amounts of which shall be determined in the regulations. These amounts shall be adjusted in accordance with the provisions relating to fines at the end of article 31.

CHAPTER V

TRANSITIONAL PROVISIONS AND DEROGATIONS

Article 48 – Trademarks registered prior to the entry into force of this Law, which expire more than six (6) months after that date, shall be reclassified at the time of their renewal in accordance with the classification to be established in the regulations, or earlier, at the request of the owner.

Article 49 – The present Law shall enter into force thirty (30) days after its publication in the Official Gazette.

Article 50 – Regulations under the present Law shall be issued within sixty (60) days of its enactment.

Article 51 – Laws No. 3.975 and 17.400, Articles 2, 3, 5, 6, 7 and 8 of Decree-Law No. 12.025/57, the Decree of November 3, 1915 on Coats of Arms and Flags, and Decrees Nos. 126.065/38, 21.533/39 and 25.812/45 are hereby repealed.

Article 52 – This Law shall be disseminated, published, transmitted to the National Official Registry and placed in the archives.