



Argentina: New Government Decree that modifies the prosecution of trademarks, patents and designs

On January 11, 2018, the Argentine Government published Decree No. 27/2018, whose purpose is essentially to simplify and reduce the length of proceedings before public institutions. A few days later, on January 16, 2018, the National Institute of Industrial Property ("INPI") published Resolution No. 1/2018, partially implementing some of the resolutions of Decree No. 27/2018 that affect procedures before the INPI, relative to trademarks as well as patents and designs.

Among others, we can highlight the following modifications:

TRADEMARKS

Oppositions

- The new opposition procedure establishes a period of three months from the date of notification of the INPI to the parties to try to reach an agreement (until now it has been one year).
- If no agreement is reached, instead of having the application withdrawn, except for the filing of a lawsuit for allegedly unfounded opposition, the INPI will now resolve the opposition in progress.
- The new procedure is applied to those opposition notices sent by the INPI as of last January 12th. Therefore, the dies a quo will not be the date of filing the opposition, but the date of notification; hence the new procedure will affect oppositions filed prior to last January 12th and still pending notification.
- In the event that no agreement is reached, the INPI is expected to give the applicant a deadline to argue what they consider appropriate in their defense, also opening a contradictory test period before deciding on the admissibility (or not) of the opposition.
- Finally, the resolutions of the INPI can only be appealed before the courts, specifically, before the National Chamber of Federal, Civil and Commercial Appeals (hereinafter, the "National Chamber"), although the appeal must be filed before the INPI.

Nullity Actions

- As of last January 12th, the nullity of a trademark may be requested before the INPI, but since the regulations defining the procedure has not been developed, we are still lacking clarity on the process if someone files this type of action now. Everything indicates that to interpose the same mark, the mark in question will have to be before the INPI, being in suspense until the aforementioned regulation is implemented. The decisions of the INPI may be appealed before the National Chamber.

Expiration process due to lack of use

- The grace period of five years from the grant date is maintained, but as with nullity actions, they must be filed with the INPI as of January 12th. In this case, as the appropriate rules that develop the procedure have been developed, they are also suspended until the aforementioned regulations are implemented.
- Until now, the use of a product or service in a class validated the non-use of the other products or services claimed in the same class. This practice is abolished with the effects of last January 12th, implementing the logical system that applies in most countries, so that the use of certain products/services in a class, benefits them and others that could be considered related, even claimed in other classes, but not the rest. Likewise, the INPI's decisions on this matter may be appealed in the National Chamber.

Declaration of Use between the 5th & 6th year from the date of grant

- Although the new law imposes the obligation to present an affidavit regarding the use of the Trademark up to that point, it does not establish a sanctioning regimen in case of failure to do so. To this point we do not know if the declaration should be accompanied by the appropriate proofs of such use, although everything seems to indicate that this will not be the case. It is understood that all this will be defined through the appropriate regulatory development and it will also be established the date from which the aforementioned declaration must be presented, since it is not clear whether it affects all trademarks granted more than five years ago, only those whose period of validity is between five and six years, or solely those that meet for the first time the term of five years of concession, since in the latter case, there would always be a year ahead to meet this requirement.

PATENTS & UTILITY MODELS

Presentation of Documents

- It is not necessary to present a certified copy of the priority document or its translation, unless the examiner specifically requests it. Similarly, it is not necessary to provide the authorization, unless specifically requested by the examiner.

Reduction of Terms

- Several of the processing periods of a patent are reduced with the implementation of this new regulatory framework. We highlight below some of them:
- The term for the application and payment of fees for the background examination is reduced from 36 to 18 months from the date of application.
- The reply period for the preliminary examination is reduced from 180 to 30 days.
- The deadline for the late submission of formal drawings, sequence listings, etc. is reduced to 30 days.
- The deadline for the payment of the background examination fee of the three-month utility models is reduced.

Presentation of Third Party Observations

- Finally, from now on, it is possible to present observations of third parties against the request for utility models. The deadline is 30 days from the publication of the application.

DESIGNS

Multiple Applications

- The submission of multiple applications is permitted, included up to a maximum of 20 designs and models, as long as they belong to the same class within the Locarno Classification.

Divisionals

- Divisional applications are also accepted.

Deferred Publication

- Deferred publication of granted designs is allowed, delaying the publication until a maximum of six months from the date of grant.

Renewal

- Renewals must be made within the final six months of validity, and a grace period of six months from that date is also introduced for the restitution of the right.

Grace Period

- A grace period of six months is established for the application of designs previously disclosed by the applicant.

Other

- In addition to drawings, photographs and / or digital reproductions of the design are accepted, while descriptions become optional.
- The administrative procedure before the INPI must be exhausted before resorting to the courts.

These provisions are in force as of January 12th, 2018. For the time being, and notwithstanding the necessary regulatory development mentioned above, Resolution No. 01/2018 specifies, among others, the following transitory rules:

The cited Resolution No. 01/2018 also presents a list of those articles that are already fully operational (listed in Art. 4 Resolution No. 01/2018) and those whose application will require prior regulation (Article 5 Resolution No. 01/2018). Among the latter are the following:

Patents and utility models: Formal requirements for obtaining a patent registry; publication of patent grants on the INPI website.

Designs: Official rates for multiple designs, divisional applications, etc.; requests for multiple designs, divisional applications; restitution of expired designs; deferred publication.

Trademarks: Formal requirements for obtaining a trademark registration; formal requirements for the presentation of trademark oppositions; a period of three months for the resolution of oppositions between the parties and, subsequently, by the INPI; administrative procedure for resolution of trademark oppositions; only the portion that deals with the administrative procedure of cancellation of trademark registrations for reasons of disability; administrative procedure for cancellation of trademark registrations for reasons of lack of use.

- The deadline for the procedures that were already being developed at the time of entry into effect of the new decree whose term is determined in days does not change.
- The due date for the procedures that were already being developed upon the entry into effect of the new decree, whose term is determined in months or years, will be the first to occur between the one established before and the one resulting from applying the modifications incorporated by Decree N ° 27/2018, counted from the date of its validity.
- Oppositions to trademarks are an exception. In this case, for the procedures that had already been communicated prior to the entry into effect of the new decree, the expiration will not change, unless beforehand, the applicant makes known the lack of agreement or the opponent voluntarily opts to expand the fundamentals of the opposition.

Once the INPI has established the Regulation for the application of all the measures adopted in the Decree, we will offer supplementary information on any progress. Meanwhile, we remain at your disposal for any question you may have.