



Trademark cancellation in Argentina

Frequently asked questions

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1. For what trademarks may a petition for cancellation due to lack of use be filed against?

Non-use cancellation actions may only be filed before the Trademark Office against registrations over five years old. A petition for cancellation may be filed both against new trademarks and renewals.

2. What are the requirements for filing a cancellation action?

For filing a cancellation action, the trademark must not have been used in Argentina within the 5-year period preceding the cancellation request, unless non-use of the trademark was due to force majeure.

Cancellations requested by a petitioner may only proceed on the grounds of infringement of the petitioner's subjective rights.

In most cases, this subjective right refers to a subsequent trademark application that is being hindered by the trademark against which the cancellation claim has been filed. However, there may be other ways in which a subjective right may be infringed, and which will allow the filling of a cancellation action.

3. Who has standing to file a cancellation petition?

Any person or entity may request cancellation for non-use on the grounds of infringement of a subjective right.

In addition, the Trademark Office may request cancellation ex officio if the following requirements are simultaneously met:

- a) There has been no use of the trademark in the last five years.
- b) The trademark owner has not submitted the sworn mid-term statement of use set forth in Section 26 of the Argentine Trademark Act.
- c) The trademark is not a well-known trademark under the Paris Convention and ADPIC; and
- d) The trademark owner does not have an identical trademark registered in a related class or connected class; or, if the owner does, that they have failed to comply with the sworn mid-term statement of use requirement for that trademark as well.

4. May partial cancellation of a trademark be requested?

The new Trademark Act introduced the possibility of filing a partial cancellation action against a trademark, but this, by decision of the Trademark Office, will only be possible as of June 12, 2023.

A partial cancellation request seeks to partially cancel a trademark that has not been used in relation to certain goods or services within the 5-year period preceding the request. The registration will keep in force for those goods or services not included in the cancellation request. Conversely, a total cancellation request seeks to cancel a registration for all those goods and services which protects.

Analogously, we understand that defense trademarks, i.e., those registered in classes other than those in use, should not be exposed to cancellation until June 12, 2023. In both cases, the last resort would seek to avoid that the norm becomes retroactive and therefore unconstitutional.

5. What happens when a cancellation petition is filed during opposition proceedings?

When a cancellation claim is lodged during opposition proceedings, such claim must be filed simultaneously. The TMO may deal with it in a single resolution, or issue two separate resolutions.

It is our understanding that cancellation requests filed against the opponent's trademark will be frequent when such trademark is vulnerable to cancellation and not in use, in order to overcome the opposition and be granted registration.

6. What requirements must the cancellation action meet?

The cancellation request must indicate:

- a) Petitioner's name and address.
- b) Name and address of the owner of the registration.
- c) The subjective right infringed (or the legitimate interest).
- d) The trademark for which cancellation is sought, the grounds for cancellation, and supporting evidence thereof; and
- e) Payment of the required fees must be made.

7. Can the Trademark Office reject the petition for trademark cancellation?

As per resolution 279/2019, the Trademark Office may reject a petition for trademark cancellation that:

- a) Does not comply with any one of the above-mentioned petitions requirements.
- b) Has been already settled within the previous 5 years.
- c) Has been lodged and/or ruled within Administrative Opposition Proceedings.
- d) Seeks partial cancellation and has been filed before the 5-year period after the introduction of cancellation actions into the Trademark Act had elapsed.

Regarding the cause of rejection mentioned in letter b), we understand that it has no legal logic because it exceeds its regulatory capacity and contravenes Section 26 of the trademark Act. If this cause is accepted, an unusual case could arise in which they reject a cancellation request filed in the ninth year due to a previous filing in the seventh year and which was rejected because use had been accredited until the third year.

8. What are the steps in a trademark cancellation process before the Trademark Office?

After the cancellation request has been filed, the owner of the registration shall be notified for the purpose of filing an answer and submitting supporting evidence within 15 working days.

When the cancellation proceedings are initiated ex officio, the TM Office shall state that all requirements are met, and notify the owner of the registration, for the same purpose and for the same time period.

Once an answer has been filed or the period for filing an answer has expired, the Trademark Office shall settle the dispute after consideration of the evidence, the facts, and the arguments raised by the parties.

9. Is it mandatory to submit evidence of use?

Proof is essential in a cancellation action since it is a question of proving the use of a trademark or the lack of it. The burden of proof rests mostly on the owner of the challenged trademark since it is a question of positive facts, to demonstrate that there is or was use, while for the applicant would be a question of proving a negative fact, that there is no or there was no use. For this reason, it is understood that there is a shifting in the burden of proof.

We emphasize that the applicant can present evidence to try to demonstrate that the trademark that is being canceled is not in use; however, since proving a negative fact constitutes diabolical proof, it has always been jurisprudentially accepted that the holder is the one who is in the best conditions to prove the use; by virtue of the dynamic burden of proof, it is understood that it is the holder who should demonstrate the use within or during the last five years. The rule regarding the cancellation of trademarks is the shifting of the burden of proof.

10. What happens if the trademark was only used for some products or services in the class during the previous 5 years?

Since partial trademark cancellation will only be available as of June 12, 2023, any use within the class will be sufficient to maintain the validity of the entire registration. Use of the trademark as part of a company name or activity will also suffice.

As of June 12, 2023, the trademark will be in force only for the products sold or services provided and those related or similar to them; or in the case that it had been used as a commercial or activity designation, only in relation to the products or services related or similar to it.



11. What happens if the trademark was only used for some product or services in another class during the last 5 years?

In this situation, the registration will be maintained if the goods sold, or the service rendered in the other class is related to the goods or services of the relevant class. Use of the trademark as part of a company name or activity related to the class will also suffice.

It is worth mentioning that even if the goods sold or services rendered in the other class are not related to the goods or services covered by the registration, total trademark cancellation would not be successful until June 12, 2023, as per the answer provided to question 4. In other words, while the grace period lasts until June 12, 2023, any use would allow the validity of the trademarks in any of the 45 existing classes.

12. What happens if the trademark starts being used after the petition for trademark cancellation is filed?

Later use should not be taken into account by the Trademark Office and the cancellation petition should be successful.

To this end, the date of submission of the cancellation request before the Trademark Office must be taken into account. However, part of the academic legal opinion considers that the date to be considered should be the date of notification by the Trademark Office to the owner of the registration and not the formal date of filing. With this in mind, we consider it advisable to reliably notify the owner of the trademark regarding the presentation of the expiration order, in order to avoid that a possible use before notification may affect the results of the expiration action.

13. Should I gather evidence of use of my trademarks?

Although it is not compulsory, it is a good idea to gather and keep evidence of trademark use, at least once a year, in relation to as many goods and services as possible. It is also advisable to keep copies of any trademark advertising released.

14. Can the decisions made by the Trademark Office be appealed?

All decisions made by the Trademark Office withing the cancellation process may be challenged through a motion for reconsideration (10 working days) and/or an appeal before a higher administrative authority (15 working days). The final decision may be challenged through a motion for reconsideration or an appeal before a higher administrative authority, or a motion may be filed before the Federal Court of Appeals in Civil and Commercial Matters (30 working days) set forth by Section 26 of Law No. 22362, which shall be filed before the local TMO.

If a motion for reconsideration and/or an appeal is filed before a higher administrative authority and the original decision is upheld, the motion or appeal may later be filed before the Federal Court of Appeals in Civil and Commercial Matters.

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Applicables Laws:

Trademark Act No. 22362, Section 26. (Section replaced by section 74 of Law No. 27444).

Executive order 242/2019, Section 26. (Regulation Act 22362)

Argentine Trademark and Patent Office Resolution 183/2018, annex IV (incorporated by Resolution P279 / 2019, annex II).