



PALACIO  
& Asociados

*Mid-Term Sworn Statement of Trademark  
use in Argentina*

*Frequently Asked Questions*

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## **1 - Which trademarks are included in the obligation to file the Statement of use?**

The new trademark act stipulates that all trademarks and renewals that, as from January 12 2018, have turned five years as from the registration date must comply with this requirement before finishing the sixth year.

For those trademarks or trademark renewals that have turned five years from registration date between January 12, 2018 and January 12, 2019, a grace period was granted until January 12 2020 to fulfill this requirement.

## **2 - What is the term to file the Sworn Statement of Use?**

The trademark act stipulates that, as from the fifth year from registration, the term to file the statement is of one year. This is before turning six years as from registration.

Those Trademarks and Trademark Renewals granted between January 12th, 2013 and January 12th 2014, were granted a grace period until January 12<sup>th</sup>, 2020 to fulfill said obligation.



### **3- Who should file the Sworn Statement?**

The Sworn statement must be filed by a representative with sufficient Power to act on behalf of the owner of the trademark. The Power of Attorney form used by PALACIO & ASOCIADOS usually includes the faculty to make such sworn statement, so as to meet the requirements for filing a renewal. That same faculty is sufficient for us to comply with the Mid-Term Sworn Statement of Use and paying the corresponding fees.

### **4- Is it necessary to submit or file evidence of such use?**

In order to comply with the requirement of the Mid-Term Sworn Statement of Use it is NOT necessary to submit or file evidence of use. It is sufficient to file the Sworn Statement in relation to the use that has been made of the trademark.

### **5 - What happens if the Sworn Statement is not filed within the one year term provided?**

In the event that the Sworn Statement of use is not filed in due time and manner, it could be filed at a later date, paying an additional and cumulative fee.



## **6 - What happens if the trademark has not been used within the first five years?**

As long as there are no pending claims of cancellation due to lack of use, the trademark will remain in force.

Once the use of the trademark has started –after the fifth year of being granted- and as long as there are no pending claims to cancel the registration, the subsequent use regularizes the situation of the registration and protects it against future claims of total or partial cancellations due to lack of use.



## **7 - What happens if the trademark has been used only for a limited number of goods and/or services?**

A Sworn Statement of Use, limited to a certain number of good and/or services, does not carry any immediate consequences to the trademark registration. The trademark will continue to be in force for all goods and services as it had been granted and it will be able to be renewed for all the goods and/or services for which it had been originally registered. It is possible that a trademark has only been used for certain goods and/or services until the fifth year, and after that moment, the trademark is used for other goods and services included in the registration.

Only in the event that a partial cancellation request is filed by a third party, a Limited Sworn Statement becomes a presumption which can be overcome by actual evidence of use, both in favor or against.



## **8 - What happens if the trademark is used for goods and/or services from a different class?**

As mentioned previously, the Sworn Statement of Use has no immediate effect over the granted rights.

Only if a request for cancellation (total or partial) is filed by a third party, the Examiner will evaluate if the use declared –or duly evidenced by means of proof- shows a reasonable relation between said use and those goods and/or services for which the trademark has been registered. If it is the case of related or similar goods, services or trade name, such use will be sufficient to repel the cancellation request.

Nonetheless, the third party requesting the cancellation will have to prove that it has a sufficient legitimate interest in requesting the cancellation.

## **9 - What happens if the trademark was used in relation to an activity or commerce related to the goods protected by the trademark?**

The use of a trademark in an activity or commerce related to the goods covered in a trademark registration, for example in retail or wholesale of said goods, protects the trademark and it is considered sufficient use as per the stipulations of Section 26, 3rd paragraph, final sentence.



## **10 - What happens if the trademark is used only after its fifth year as from registration date?**

The use of a trademark after the fifth year of use –and as long as there are no prior pending requests to cancel it- regularizes the situation of such registration and protects it against subsequent claims to cancel it.

## **11 - Can the Trademark Office declare the cancellation of a trademark? In which cases is it allowed?**

The trademark Office is technically allowed to request and declare the cancellation of a trademark registration which has not been used in the five year-period previous to said request, and only after the fifth year of granting of the application or renewal of the trademark.

Notwithstanding the above, the Trademark Office is bound by the obligations of any Administrative resolution, according to the Law of Administrative Procedures (Section 21, Law 19,549, which –according to the Trademark Act- will rule the Cancellation procedures until a specific regulation is issued) and, therefore, prior to declaring the cancellation of a trademark, it will have to grant the Owner of the registration the chance to defend their right, provide evidence and arguments on its behalf before ruling on such request. The cancellation resolution can be appealed before the Federal Court of Appeals in a direct appeal.



**12 - Should the owner of a trademark gather or maintain evidence of the use of its trademarks?**

Though it is not mandatory, it is advisable to gather and keep evidence of the use of a trademark, at least once a year, in relation to as many goods and/or services as possible. It is also advisable to keep copies in relation to any advertisement done, especially when shown in third parties publications or advertising campaigns in public media.



### **13 - What happens if the trademark was in use, but the Sworn Statement of use was not filed?**

Failing to file the Sworn statement of use only constitutes a legal presumption that the trademark has not been used. Said presumption admits evidence to the contrary. In this case, two different scenarios are possible:

On the one hand, if there are no pending requests to cancel the trademark- it is sufficient to file the Sworn statement of use and pay the official fees with the corresponding surcharges, before the time of renewal.

On the other hand, and if there is any pending request for the cancellation of the trademark, together with complying with the sworn statement and payment of fees, we will have to submit sufficient evidence to prove that the trademark has been used prior to the cancellation request.



**14 - Can renewal of a registration be filed if the Sworn Statement of Use has not been filed? Which trademarks are not required to comply with this requirement?**

According to the Trademark Act, to renew a trademark registration it is mandatory to have complied with the Sworn Statement of use and having paid the corresponding Official Fees. Although, it is worth mentioning that this requisite is only applicable to trademarks granted after January 12<sup>th</sup> 2013. Trademarks granted before said date will be allowed to be renewed without fulfilling this requirement.

