

PALACIO & Asociados

Opposition System in Argentina Points to be considered and Frequently Asked Questions

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About the Opposition System in Argentina

Due to the importance of trademarks for the development of businesses, it is of utmost importance to preserve their distinctive capacity, avoiding the appearance of confusing TMs that induce the consumer public to error, dilution of their distinctive capacity and, therefore, their value.

To this end, the watch service we offer in Palacio & Asociados is vital, controlling the publication of any trademark application, aiming to detect any request that is similarly confusing to that of our clients, enabling them to file an opposition in defense of their interests.

On July 12, 2018, the local PTO (INPI) issued resolution P-183, establishing a new process for oppositions in the trademark application process in accordance with Law No. 27.444, which brought about two substantial changes:

- 1.** It establishes an administrative procedure replacing the previous one by which the court had to rule a decision
- 2.** It shifts the burden of urging the process to the opponent, whereas in the past it was the applicant who was obliged to act.

In this sense, the Law recognizes to any person with a “legitimate interest” the right to oppose to the registration of a trademark, which must be made in writing before the Trademark Office and within 30 days of publishing the application.

Once the opposition is filed in a timely manner, the registration process is interrupted and the Trademark Office notifies both parties, through a publication in the Official Bulletin, granting them a period of 3 months to negotiate a friendly settlement of the conflict.

Various types of agreements can be reached, although in most cases they are achieved through a limitation in the scope of protection, the exclusion of some product or service, commitment to use the trademark in a certain way, etc.

Upon expiration of the 3-month period without the parties having reached an agreement, the Trademark Office will notify the opponent, so that within 15 business days they file or expand the grounds of the opposition, offer proof and pay an additional official fee to ratify the opposition. Failure to pay the aforementioned fee will cause the opposition to fall and will be considered by the Trademark Office as a precedent to be taken into account when analyzing the application.

Once the fee has been paid and the 15-day term has expired, the Trademark Office will notify the applicant of the trademark that the opposition is in force and that the grounds have been filed, so that within 15 working days they present their defense and offer the evidence they deem necessary.

In both cases, the documentary and instrumental evidence must be filed along with the aforementioned writs. The remaining offered evidence, if accepted by the Trademark Office, must be produced within a period of 40 business days, period which is common to both parties.

Once the proof period expires, the Trademark Office will inform the parties giving them a common period of 10 business days to file the final arguments.

After the 10-business-day period has expired, the Trademark Office will decide whether the opposition is founded or not.

The ruling of the Trademark Office will be appealable before the Federal Civil and Commercial Court of Appeals of the Federal Capital, within 30 business days of being notified.

1 - Is it possible to extend the deadline for filing oppositions?

No. Once a trademark application has been published in the corresponding Bulletin, the Law grants a period of 30 days for the filing of oppositions and said deadline is not extendable. Once the deadline for filing objections has elapsed, a request for refusal can also be submitted, by means of a writ to alert the examiner of the existence of a confusing similar registration, in which the grounds are included in order to convince the examiner that the requested trademark should not be granted. It will be optional for the examiner to accept said order or not, and in case the mark is granted there will be a possibility of requesting its annulment.

2 - Is it possible to extend any of the deadlines in the opposition process?

No, none of the deadlines mentioned in the opposition process are extendable. They are all non-extendable.

3- Should we provide evidence in the initial opposition writ?

It can be done but it is not strictly necessary and, in fact, it is rarely done at this stage due to the short time period provided. For the opposition filing, it is sufficient to indicate the grounds. At the time of ratifying or answering the opposition, it is necessary to have the documentary and instrumental evidence and to offer the rest of the evidence, which must be subsequently produced within 40 business days, a term that is common to both parties.

4- Is it mandatory to conduct preliminary negotiations?

The 3-month period to find a friendly solution to the conflict is optional and the convenience of conducting preliminary negotiations will depend on each specific situation. Consequently, if it is expected that the negotiations will not yield any results, the subsequent stage of ratification or response of the opposition can be directly resorted to.

5- Is it necessary to wait for the Trademark Office to notify the opposition to start negotiating with the opponent?

No. Since negotiations are conducted directly between the parties, it is possible to start them without waiting for official notification, which generally takes many months.

6 - What happens if an agreement is reached during preliminary negotiations?

If such a friendly agreement is reached, evidence of the agreement reached between the parties must be submitted in due time to the local PTO and the subsequent administrative oppositions process will not be necessary. Note that an agreement can be submitted at any time.

7 - What happens if the opponent does not ratify the opposition?

The lack of ratification of the opposition and payment of the corresponding fee will cause the opposition to fall and will be considered by the Trademark Office as a precedent to be taken into account when analyzing the applied trademark.

8 - Is the Trademark Office obliged to accept an agreement between the parties?

The Trademark Office does not intervene in the negotiation process but it has the right to review the agreements reached between the parties. In this sense, it has an obligation to ensure compliance with the public interest and, therefore, it may occur that it does not accept coexistence agreements when the trademarks are similar and the consumer public may be led to confusion. It should be noted that any negative decision of the Trademark Office is appealable, but this issue exceeds the purpose of these lines.

9 - Does the process provide for other alternative dispute resolution processes?

During the filing of the final arguments stage, the parties may notify the Trademark Office that they have agreed to submit the case to a mediation, conciliation or other alternative dispute resolution method. This notification will suspend the process for 30 business days.