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Lawyer

Cross-class protection of reputable trademarks



Mr. Zhenkun Fu, Senior Partner at Corner Stone and Partners, offers first-hand evidence of why a well-known trademark is crucial for protecting your brand against infringers.

2020 In-House Practitioners Benchmarking Report

Page 10



Trademark Modernization Act

Page 15



ECTA 39th Annual Conference

Page 26



Denomination of Origin and Geographical Indications: their impact in commerce

Florencia D. Sosa and Mariano A. Toppino, of O'Connor Power, explain why trademark owners need to be aware of the growing importance of DOs and GIs in Argentina and beyond.

Denomination of Origin and Geographical Indications are increasing their importance in worldwide commerce.

Thus, in their relationship with trademarks, the latter has also been emphasized by the effect of the COVID-19 pandemic, by which consumers look for healthier products and thus go back to organic goods.

Argentina and South America are not an exception in this phenomenon.

As one of the largest food producers in the world, Argentina is characterized not only by its important harvests of soya bean, wheat and corn, etc., but also for its splendid wines -the majority that read this article I hope have enjoyed a red Malbec wine-, meat, ham, cheese, teas, "yerba mate" ("Paraguayan tea"), the latter protected by several denominations of origin ("D.O.") and geographical indications ("G.I.").

Law No. 25,380 and its amendment **Law No. 25,966**, establish on the legal regime for "G.I." and "D.O." of agricultural products and foodstuffs.



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Article 2 of this law establishes a differentiation between two concepts which, although they may seem similar at first sight, are not.

"ARTICLE 2" — For the purposes of this law, it is understood as follows:

a) Geographical Indication: that which identifies a product as originating from the territory of a country, or from a region or locality of that territory, when certain quality or other characteristics of the product are fundamentally attributable to its geographical origin. **(Subsection substituted by section 2 of Law No. 25,966).**

b) Denomination of Origin: The name of a region, province, department, district, locality or of an area of the national territory duly registered that serves to designate a product originating therein and whose qualities or characteristics are

due exclusively or essentially to the geographical environment, including natural and human factors..."

In connection to trademarks, Art. 47 of Trademark Law No. 22,362 establishes:

"ARTICLE 47. — A trademark may not be registered as a mark to distinguish products corresponding to a duly registered Appellation of Origin of Agricultural and Food Products that has been notified to the National Institute of Industrial Property.

ARTICLE 48. — In the event that an already registered trademark is intended to be registered as a Designation of Origin, for the entry into force of the designation it shall be necessary that the right to the trademark be extinguished, either by waiver of the owner, by expiration of the term, or any other cause of expiration."

The Argentine Directorate of Value Addition and Quality Management of the secretariat of food, bioeconomy and regional development of the Ministry of Agriculture, Livestock and Fisheries is in charge of carrying out the functions of the Registry of Geographical Indications and Denominations of Origin of Agricultural Products and Foodstuffs (Resolution 13/2021)

Food Products:

To date, the following have recognized as "G.I.":

- "Salame Típico de Colonia Caroya" (Typical Salami from Colonia Caroya, Province of Córdoba)
- "Platense Artichokes"
- "Melon de Media Agua" (Variety of melon produced in the Province of San Juan)
- "Patagonian Lamb"
- "Yerba mate" (a type of tea made from the leaves and stems of the *Ilex paraguariensis* plant).

“

The name of a country, region, place or specific geographical area used to designate a product originating from one of them whose qualities.

”

As "D.O's" we find:

- "Salame from Tandil" (Salami from Tandil)
- "Chivito Criollo del Norte Neuquino (North Neuquén)"

Wine Industry:

On the other hand, Law No. 25,163 "aims to establish a system for the recognition, protection and registration of Argentine geographical names, **to designate the origin of wines and spirits of vinous nature**" (Art. 1) establishing in its Article 2 three categories: **Indication of Origin (IP), Geographical Indication (GI) Controlled Denomination of Origin (CDO).**

These categories are defined in the same regulation:

"The use of an indication of provenance is reserved exclusively for table wines or regional wines". (art. 3 of the aforementioned regulation)"

"For the purposes of this law, a "G.I." means: the name that identifies a product originating from a region, a locality or a delimited production area of the national territory no larger than the surface of a province or of an interprovincial area already recognized, the GI will only be justified when a certain quality and characteristics of the product are fundamentally attributable to its geographical origin". (art. 4 of the aforementioned regulation)."

"For the purposes of this law, a Controlled Designation of Origin (DOC) is the name that identifies a product originating in a region, locality or delimited production area of the national territory, whose particular qualities or characteristics are due exclusively or essentially to the geographical environment, including natural and human factors."

Résumés

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With regard to trademarks specifically, the following articles of the Regulatory Decree No. 57/2004 should be highlighted:

"ARTICLE 32.— When the IP, GI or DOC to be registered is identical or similar to that of a previously registered trademark to distinguish products of a viticultural nature or origin, the authority of application may only admit its registration with the express authorization of the owner of the trademark.

ARTICLE 54.— Pursuant to supplementary laws: (...)

b) In order to comply with the provisions of Section 12, second paragraph of Trademark Law No. 22. 362, the National Institute of Industrial Property, under the Secretariat of Industry, Commerce and Small and Medium-size Enterprises of The Ministry of Economy and production **will request from The National Institute Of Vitiviniculture** the information relating to applications for registration of intl. Class 33 trademarks, in accordance with the nomenclature provided for in Law No. 22. 362, in

Designation	Indication Type	Department and Province of Argentina
25 de Mayo	G.I.	San Juan
9 de Julio	G.I.	San Juan
Agrelo	G.I.	Luján de Cuyo, Mendoza
Albardón	G.I.	San Juan
Alto valle de Río Negro	G.I.	Río Negro
Angaco	G.I.	San Juan
Añelo	G.I.	Neuquén
Arauco	G.I.	La Rioja
Avellaneda	G.I.	Río Negro
Barrancas	G.I.	Maipú, Mendoza
Barreal	G.I.	Calingasta, San Juan
Belén	G.I.	Catamarca
Cachi	G.I.	Salta
Cafayate Valle de Cafayate	G.I.	Salta
Calingasta Valle de Calingasta	G.I.	San Juan
Canota Valle de Canota	G.I.	Las Heras, Mendoza
Castro Barros	G.I.	La Rioja
Catamarca	G.I.	Catamarca
Caucete	G.I.	San Juan
Chapadmalal	G.I.	Buenos Aires
Chilecito	G.I.	La Rioja
Chimbas	G.I.	San Juan
Colón	G.I.	Córdoba
Colonia Caroya	G.I.	Colón, Córdoba
Confluencia	G.I.	Neuquén
Córdoba Argentina	G.I.	Córdoba
Cruz del Eje	G.I.	Córdoba
Cuyo	G.I.	Region that includes the provinces of Mendoza, San Juan and La Rioja winemakers.
Distrito Medrano	G.I.	Located in the departments of Rivadavia and Junin, of the province of Mendoza.
El Paraíso	G.I.	Maipú, Mendoza
Famatina	G.I.	La Rioja
Felipe Varela	G.I.	La Rioja
General Alvear	G.I.	Mendoza
General Conesa	G.I.	Río Negro
General Lamadrid	G.I.	La Rioja
General Roca	G.I.	Río Negro
Godoy Cruz	G.I.	Mendoza
Guaymallén	G.I.	Mendoza
Iglesia	G.I.	San Juan
Jáchal	G.I.	San Juan
Jujuy	G.I.	Jujuy
Junin	G.I.	Mendoza
La Consulta	G.I.	San Carlos, Mendoza
La Paz	G.I.	Mendoza
La Rioja Argentina	G.I.	La Rioja
Las Compuertas	G.I.	Luján de Cuyo, Mendoza
Las Heras	G.I.	Mendoza
Lavalle Desierto de Lavalle	G.I.	Mendoza
Los Chacayes	G.I.	Tunuyán, Mendoza
Luján de Cuyo	G.I.	Mendoza
Luján de Cuyo	D.O.C.	Mendoza
Lunlunta	G.I.	Maipú, Mendoza
Maipú	G.I.	Mendoza
Mendoza	G.I.	Mendoza

relation to the products covered by Law No. 25,163, in accordance with the procedure jointly established by both governmental agencies. The opinions issued by the National Institute of Vitiviniculture will be binding when deciding on the approval of the trademarks applied for.

Likewise, the National Institute of Vitiviniculture, before registering an IP, GI or DOC, shall consult the National Institute of Industrial Property, on whether the

designation applied for is registered as a trademark, in accordance with the procedure established jointly by both governmental bodies."

The enforcement authority is the Instituto Nacional De Vitivinicultura ("INV", that is the National Institute of Vitiviniculture), as established in article 36 of the above mentioned law.

To date, the wine Argentine recognized and protected Geographical Indications and Denominations of Origin are as below:

Molinos	G.I.	Salta	Santa Lucía	G.I.	San Juan
Neuquén	G.I.	Neuquén	Santa María	G.I.	Catamarca
Pampa el Cepillo	G.I.	San Carlos, Mendoza	Santa Rosa	G.I.	Mendoza
Paraje Altamira	G.I.	San Carlos, Mendoza	Sarmiento	G.I.	San Juan
Patagonia	G.I.	Interjurisdic region	Tafi	G.I.	Tucumán
Patagonia Argentina		that includes different provinces.	Tinogasta	G.I.	Catamarca
Pichimahuida	G.I.	Rio Negro	Trevelin	G.I.	Futaleufú, Chubut
Pocito	G.I.	San Juan	Tucumán	G.I.	Tucumán
Pomán	G.I.	Catamarca	Tunuyán	G.I.	Mendoza
Pozo de los Algarrobos	G.I.	Caucete, San Juan	Tupungato Valle de Tupungato	G.I.	Mendoza
Quebrada de Humahuaca	G.I.	Jujuy	Ullum	G.I.	San Juan
Rawson	G.I.	San Juan	Valle de Chañarmuyo	G.I.	Famatina, La Rioja
Río Negro	G.I.	Rio Negro	Valle de Uco	G.I.	Region formed by the Departments of San Carlos, Tunuyán and Tupungato of the Province of Mendoza.
Rivadavia	G.I.	Mendoza	Valle del Pedernal	G.I.	Sarmiento, San Juan
Rivadavia	G.I.	San Juan	Valle del Tulum	G.I.	San Juan
Russel	G.I.	Maipú, Mendoza	Valle Fértil	G.I.	San Juan
Salta	G.I.	Salta	Valle de Zonda	G.I.	Zonda, San Juan
San Blas de los Sauces	G.I.	La Rioja	Valles Calchaquíes	G.I.	Valleys that include
San Carlos	G.I.	Mendoza	Valle Calchaquí		from different provinces and that constitute the same wine area.
San Carlos	G.I.	Salta	Valles del Famatina	G.I.	Valleys that include different locations in the province of La Rioja and that constitute the same winegrowing area.
San Javier	G.I.	Cordoba	Vinchina	G.I.	La Rioja
San Juan	G.I.	San Juan	Villa Ventana	G.I.	Buenos Aires
San Luis	G.I.	San Luis	Vista Flores	G.I.	Tunuyán, Mendoza.
San Martín	G.I.	Mendoza	Zonda	G.I.	San Juan
San Martín	G.I.	San Juan			
San Rafael	G.I.	Mendoza			
San Rafael	D.O.C.	Mendoza			
San Pablo	G.I.	Tunuyán, Mendoza			
Sanagasta	G.I.	La Rioja			

The Trademark and Designations Law No. 22,362 also makes reference to G.I. and D.O.:

Article 3.c. of Law No. 22,362 establishes Article 3.c., Law No. 22,362: "The following may not be registered: (...) National or foreign appellations of origin. Appellation of origin" means the name of a country, region, place or specific geographical area used to designate a product originating from one of them whose qualities and characteristics are due exclusively to the geographical environment. The name referring to a specific geographical area for the purposes of certain products (...) shall also be considered an appellation of origin".

Likewise, Article D indicates: "(d) trademarks that are likely to mislead as to the nature, properties, merit, quality, processing techniques, function, price origin or other characteristics of the goods or services to be distinguished."

Other regulations such as Decree No. 274/2019 deal with commercial loyalty use similar criteria when regulating geographical designations:

"ARTICLE 23.- Prohibition of use. Without prejudice to the provisions of Laws Nos. 22,362, as amended, 24,425, 25,163, 25,380, as amended, and 26,355, a national or foreign appellation of origin may not be used to identify a good or service when it does not originate from the respective area. For this purpose, appellation of origin is understood as the geographical denomination of a country, a region, or a specific place, which serves to designate a product or service originating therein and whose particular qualities or characteristics are exclusively or essentially due to the geographical environment and which includes natural and human factors."

Comparing the four regulations mentioned above, we can observe that when defining the Appellation of Origin, all of them make special emphasis on the term "exclusive" or "essential" to differentiate the figure from other assumptions.

At the domestic level, Argentina accepted the TRIPS Agreement through Law 24,425, being this agreement of vital importance. The Third Section deals with Geographical Indications. The section is divided into three articles: Art. 22 regulates the protection of geographical indications; Art. 23 is referred to the additional protection of geographical indications for wines and spirits; finally, Art. 24 is entitled "International Negotiations: exceptions".

This last section establishes an exception to the protection of geographical indications:

"Nothing in this Section shall impose any obligation on a Member to prevent the continued and similar use of a particular



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geographical indication of another Member, identifying wines or spirits in relation to goods or services, by any of its nationals or domiciliary who have used that geographical indication continuously for the same or related goods or services in the territory of that Member (a) for at least 10 years prior to the date of April 15, 1994, or (b) in good faith, prior to that date."



"Alimentos Argentinos": a Natural Choice Seal

The Seal "Alimentos Argentinos una Elección Natural" is a voluntary country brand for quality food and beverages, produced under the fulfillment of demanding norms and high standards.

Such points are detailed in protocols that contain the necessary requirements to produce a special food through the fulfillment of different particular attributes and characteristics of the product, its manufacturing, and packaging. The 53 official protocols are public and can be used by Argentine companies.

Since its creation, more than 50 companies have obtained the seal for more than 700 products.

This seal follows the trend of offering consumers more information about the food they purchase. Specifically, it facilitates the identification of the Argentine origin, which is beneficial given the excellent production conditions and the abundance of resources that our country offers. In addition, all foods that have it are controlled during the production process and elaborated under the implementation of a quality management system, as required by the main world markets.





As mentioned above, GIs and DOs are gaining an increasing importance in worldwide commerce and their interaction with trademark protection.

Argentina, together with Brazil, Paraguay and Uruguay form the Mercosur trade bloc. In the month of June, 2019, the European Union reached

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with the Mercosur countries an agreement on trade, which covers a population of 780 millions.

Intellectual Property rights are detailed in Chapter XX of said Agreement, and Geographical Indications are specifically foreseen in Sub-Section 4.

In view of the importance of GIs and DOs in the economy of both Mercosur and EU countries, presently discussions and negotiations are taking place on the implementation of the same.

The same scenario and consultation process is underway between the United States and the EU, as well as between the EU and China, which in some cases include GIs for non-agricultural products.

Undoubtedly, Geographical Indications and Denominations of Origin are presently and in the near future an important brand building tool, of which trademark companies should be alert.

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