

Eye on Argentina: why the country is serious about trademark protection

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O'Connor & Power managing partner Santiago R O'Connor reflects on recent changes to Argentina's trademark processes and the country's achievements in modernising its IP system

Argentina is Latin America's second largest economy, with a population of 47.5 million inhabitants. As a highly educated and multicultural country with strong European influences, Argentina is a unique destination in Latin America and an interesting market for investors, business and commerce, and thus trademark activity.

Since 2018, the country has experienced many changes to its IP processes, as it modernises and improves its trademark protection standards to meet modern business needs.

Changes to trademark prosecution

The first wind of change started with the implementation of Decree 27/2018 on 10 January 2018, which amended articles of the Trademark Law 22.362. All procedures at the trademark office became electronic and paperless. Meanwhile, the trademark office became responsible for making decisions on trademark oppositions, replacing a procedure that had been in force for almost 120 years. Nullity and cancellation actions due to non-use, which are subject to direct appeal before the federal chamber of the civil and commercial courts, also came under the purview of the trademark office.

These changes had a beneficial impact on trademark procedures, particularly those relating to oppositions. Now, opponents must have a good argument to file an objection. To keep an objection in force, they must opportunely file additional arguments and pay high official fees. This aims to avoid speculative oppositions that cause delays and block normal trademark prosecution.

In addition, when filing an application, applicants must specify the goods and services according to the guidelines of TMClassTool. The need for an apostilled power of attorney remains an obstacle, although a scanned copy is sufficient and there is no need to file the original document.

While the time frame to publish a trademark has been reduced from five months to 10 days, delays emerge when examiners analyse files and "sleep" on the registration procedure for five to eight months, even though the application has met no opposition.

The trademark use principle remains the same. A registered trademark is exposed to a cancellation action due to lack of use from its fifth year of registration. Any party that files a non-use cancellation action must demonstrate that the registered trademark was not used during the five years before the filing of the cancellation action.

With the introduction of the mid-term sworn declaration of use (MTDU), non-filing of the document does not affect the validity of a trademark, unlike in other jurisdictions. The MTDU must be filed for trademarks granted for the first time after 12 January 2013. For renewed trademarks that expire after 12 January 2023, it must be filed between the fifth and sixth year of registration. If the MTDU is not filed, the trademark renewal will not be granted. An application for trademark renewal may be submitted six months before and/or six months after its expiration date, with a doubled official fee if submitted after expiration.

As Argentina heads toward becoming an open market economy, its first-to-file trademark system means that companies should proactively protect their marks and intangible assets, in order to avoid the unpleasant experience of having an unknown third party steal them.

Stronger legal protection for trademarks

Argentina has highly professional federal courts that act strongly in IP infringement cases. For instance, livestreaming platform Futbol Libre was found to have committed copyright infringement and online piracy. Still, counterfeit hotspots continue to exist, particularly within the extensive province of Buenos Aires and the Triple Frontier (which borders Argentina, Brazil and Paraguay), comprising La Salada, Avenida Avellaneda and Liniers.

Counterfeiters often target football brands, sports apparel and shoes. Argentina is also the biggest producer and manufacturer of Paraguayan tea (yerba mate in Spanish), a green herbal tea consumed by many successful football players (eg, Lionel Messi). As a result, the country has seen a proliferation of counterfeit STANLEY thermos, which is mandatory equipment for these consumers. To combat such activity, companies should register their trademarks with the Customs Alert System. Major online marketplace Mercado Libre, which has its roots in Argentina, also has a highly efficient and helpful notice-and-takedown system through its Brand Protection Programme.

Other remedies are available as well. The trademark office has reasonably resolved several cases at an administrative level, including *Apple v FixApple Service Provider* and *Tienda Ruma v Puma*. These cases were solved in favour of the rights holder.

In terms of government, the domain name dispute system NIC.ar assists brand owners in trademark protection efforts, as domain names are increasingly considered to be trademarks. Seven bills relating to AI are also pending discussion in Congress.

Since Javier Milei became the new Argentine president in December 2023, many changes have been taking place. We are happy to report that they are in favour of strong protection for trademark rights.

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