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January 23, 2018

**ARGENTINA**

**PTO issues Resolution 1/2018 following the issuance of Decree 27/2018**

This is to kindly inform you that, following the issuance on January 11, 2018 of Decree 27/2018, on January 23, 2018 the PTO has published Resolution 1/2018 in the Official Gazette

By means of this Resolution the PTO seeks to clarify which of the amendments introduced by Decree 27/2018 in the trademark, design and patent Laws are already operational and in force and which other amendments will be applicable once the corresponding implementing regulations are issued.

Please find below the description of the most relevant details for each system:

1) Trademarks

The trademark and opposition systems are the ones most affected by the changes introduced by Decree 27/2018. In light of this, apart from some minor adjustments, most provisions will not enter into force until further implementing regulations are issued.

The provisions of the Decree which are not yet operational are the following ones:

- a. When filing a trademark applicants will have to declare an electronic domicile.
- b. Oppositions will have to be filed electronically before the PTO.
- c. The term for obtaining the withdrawal of oppositions will be reduced to 3 months counted as from the time the applicant is served notice of the corresponding opposition.

However, for those oppositions that have already been served notice prior to January 12, 2018, the one year term which was in force until the issuance of Decree 27/2018 will continue to run unless the applicant declares that no agreement has been reached or the opponent voluntarily decides to enhance the grounds of the opposition.

- d. The PTO will now be in charge of resolving oppositions which withdrawal has not been obtained within the 3 month term mentioned above. The corresponding procedure will be established by the PTO and will have to guarantee the opponent the right to



ATTORNEYS AT LAW  
PATENT AGENTS

enhance the grounds of the opposition, the right of the trademark's applicant to respond to the opposition and the right of both parties to offer proofs. Both parties will also have the right to appeal the Resolution issued by the PTO directly to the Chamber of Appeals of the Federal Courts. The appeal will have to be filed before the PTO who will send the file to the Court.

e. The PTO will also be in charge of resolving trademark invalidations in those cases in which the trademarks have been granted in breach of the Trademark Law. The parties will also have the right to appeal the Resolution issued by the PTO directly to the Chamber of Appeals of the Federal Courts. The appeal will have to be filed before the PTO.

f. The PTO will be able to declare the lapse of trademark registrations, fully or partially, in connection with products or services for which the trademark has not been used within the 5 year term counted as from the date of filing of the lapse request, unless force majeure reasons can be invoked. The parties will also have the right to appeal the Resolution issued by the PTO directly to the Chamber of Appeals of the Federal Courts. The appeal will have to be filed before the PTO.

Trademarks that have been registered but not used in one class or for certain products or services will not lapse if the same trademark has been used in connection with similar or related products or services, even if in other classes, or as a tradename.

Applicants will have to file a sworn declaration of use within the 5<sup>th</sup> and 6<sup>th</sup> anniversaries of the trademark's grant.

## 2) Designs

The following amendments to the design Law and procedure are already operational and in force:

a. The scope of the 6 month grace period counted as from the application's filing date or priority date if applicable is broadened covering the following cases: i) designs published or publicly exploited by the applicant or its successor in right; ii) disclosures by third parties in breach of an agreement, a confidentiality obligation or in bad faith and, iii) publications made by mistake by the PTO.

b. The inclusion of a description in design applications is now optional for the applicant.

c. Renewals of designs must be requested during the last 6 months of its legal term, that is to say, within 6 months prior to its expiry date.



ATTORNEYS AT LAW  
PATENT AGENTS

d. When a patent or utility model application is requested by mistake instead of a design application, the applicant will be able to request its conversion into a design application.

Decree 27/2018 also establishes the following provisions which for the time being are not operational nor in force pending the issuance of the corresponding implementing regulations:

a. Applications will be able to contain up to 20 designs belonging to the same class of the Locarno classification. If needed, the Examiner will request the division of the initial application having more than 2 designs into different applications. Such divisional applications, which will now be accepted by the PTO, will preserve the priority and filing date of the application from which they have been divided.

b. Renewals will also be able to be requested within a grace period of 6 months after the expiry date provided an extra fee is paid.

c. Applicants will be able to request the delay of the publication of the grant of the application for up to 6 months provided the corresponding request is made at the time of filing the application and the corresponding fee is paid.

### 3) Patents

The following amendments to the patent law and procedure are already operational and in force:

a. In those applications where at least one priority is claimed it will be enough to invoke the priority without filing any supporting documents. During the examination stage of the application the Examiner may request the certified copy of the priority document with its corresponding Spanish translation when drafted in another language. Additionally, when needed the corresponding assignment document will need to be filed.

b. The term for converting a patent into a utility model and vice versa is reduced to 30 days counted as from the filing date of the application or as from the request issued by the Examiner.

c. The term for filing a response to the preliminary (formal) examination is reduced to 30 days.

d. The term for requesting examination of patent applications is reduced to 18 months counted as from the application's filing date. In the case of utility models the term is reduced to 3 months counted as from the application's filing date.



ATTORNEYS AT LAW  
PATENT AGENTS

In those cases which are currently pending the terms will be reduced if as of January 12, 2018 the remainder of the prior term of 3 years counted as from the application's filing date is longer than 18 months in the case of patents or longer than 3 months in the case of utility models. We will shortly issue separate letters to you in those cases entrusted to us where these terms change.

- e. The requirement of absolute novelty is now clearly established for utility models.
- f. In the case of utility models the prosecution stages are changed and now the application will be studied prior to publication and not after publication. The term for third parties to file observations is reduced to 30 days as from the publication date.
- g. It will no longer be needed to file a copy of the corresponding POA in each application being enough to indicate that we are empowered agents. However, in those cases in which at the time of filing the application we have not yet been empowered, we will continue to have to file a copy of the POA as issued within 40 working days.

Decree 27/2018 also establishes that granted patents will be fully published in the PTO's webpage. Further changes need to be introduced in the PTO's systems for this provision to be operational and in force.

As soon as the mentioned regulations implementing the amendments which for the time being are not in force are issued we will report.

Should you have any comments or questions in the meantime, please feel free to contact us at any time.

**RICHELET & RICHELET**