



ATTORNEYS AT LAW
PATENT AGENTS

July 19, 2018

ARGENTINA

PTO issues Resolution 183/2018 establishing procedure for resolution of TM oppositions

We inform you that on July 19, 2018 the PTO has finally published in the Official Gazette Resolution P-183 which regulates the new system for the resolution of oppositions as included in Law 27.444 enacted by Congress which ratified the contents of Decree 27/18.

As indicated in our newsletters of January 11th and 23rd, 2018, all oppositions which were previously decided before the Federal Courts will as from now on be decided administratively by the PTO. Eventual appeals against the PTO's decisions shall be decided by the Federal Chamber of Appeals.

In a nutshell, the new opposition process is the following:

a) Term for amicable settlement

Once the PTO notifies the opposition/s to the applicant by means of its/their publication in the Trademark Gazette, the latter shall have a term of 60 running days plus 3 months to try to obtain an amicable withdrawal of the opposition/s. If no settlement/s is/are possible, then upon expiration of the cited term the PTO shall decide the matter/s according to an administrative procedure which, in short is hereinbelow referred to.

b) Ratification of opposition, enhancement of grounds and offering of proofs by opponent

Assuming that there was no possibility of amicable settlement, at the end of the above cited term, the PTO shall notify and provide to each of the opponent/s an unextendable 15 working day term for the latter/s to ratify the opposition/s and/or enhance its/their grounds. Within the cited 15 working day term the opponent/s should also offer all the probatory means supporting the opposition/s.

Additionally, each opponent will have to pay an official fee of AR\$ 8.500 (approximately US\$ 305 at today's exchange rate) for such purpose. If the official fee is not timely paid, then the PTO shall disregard the opposition/s as such and will consider it/them as a mere out of term filing/s in the understanding that the opponent/s has/have lost interest in the opposition/s.



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c) Notification of oppositions to applicant and offering of proofs and filing of response by applicant

In order to secure the right for both parties to be heard, the PTO shall then notify the opposition/s and all relevant proofs as filed by the opponent/s to the applicant for an unextendable 15 working day term so that the applicant may submit a response to each opposition and offer the corresponding probatory means. No official fee has been fixed for this step.

d) Rendering of proofs

After this, the PTO shall decide which probatory means are accepted and shall fix the term for their rendering, which cannot exceed 40 working days. This term shall start running upon notification by the PTO to each party.

e) Filing of summary pleas

At the end of the term for rendering all the proofs, the PTO shall notify each party that a common 10 working day term shall start running for each of them to file its summary plea.

f) Issuance of decision by PTO and eventual Appeal

Once said term has expired, the PTO shall decide and rule whether the opposition/s is/are grounded or not.

Against the above cited final resolution, a direct appeal to the Federal Chamber of Appeals can be filed within a 30 working day term counted as from the PTO's notification of the final resolution. The appeal must be filed before the PTO which thereafter, within a 10 working day term shall deliver the file to the cited judicial body.

In addition, please be advised that if the cancellation for non-use or the nullity of any trademark/s involved in the opposition process is requested by any party, the PTO shall nonetheless continue the process towards a resolution of the issue of trademark confusion.

According to the text of Resolution P-183 issued by the PTO, any such cancellation or nullity requests must continue to be initiated before the Federal Courts where the matter should be decided until the PTO regulates the corresponding process. However, we advise you that Law No. 27.444 issued by Congress clearly establishes that claims for cancellation for non-use and nullity of trademarks filed in contradiction to the Trademark Law should now be decided and resolved by the PTO. Nullity of trademarks for reasons other than those filed in contradiction to the Trademark Law shall continue to be decided in Courts as was the case until now.



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In this regard, the PTO's position as expressed in Resolution P-183 contradicts Law No. 27.444 as enacted by Congress, which according to our legal system, carries more weight and is of a higher legal hierarchy.

We foresee that the Federal Courts will declare themselves incompetent in matters where such claims for cancellation for non-use and nullity of trademarks filed in contradiction to the Trademark Law are directly entered before them, and that they will return the files to the PTO for the latter's prosecution and resolution in accordance with Law No. 27.444.

Finally, please be advised that the new procedure for the resolution of oppositions shall be in force as of September 17, 2018 and shall be applicable to all pending oppositions which have already been notified by the PTO and wherein an amicable settlement has not been reached.

We are following developments regarding this new regulation closely. As soon as further news worth reporting take place, we will come back to you.

Trademark Department

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