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ARGENTINA

Government issues Regulatory Decree 242/2019

This is to kindly inform you that, following the issuance on May 30, 2018 of the new Trademark Law No. 27.444, on April 3, 2019, the Government has published Decree No. 242/2019 which regulates the provisions of the new Trademark Law.

The Decree will enter into force on June 3, 2019.

The most significant points of the new Regulation are the following:

- * Secondary meaning: Signs which shape and form have acquired distinctiveness through use are now registrable.
- * Geographical indications recognized by the Argentine Government shall be considered as foreign or national appellations of origin that cannot be registered as trademarks.
- * Renewals: They must be filed within the term to be fixed by the PTO which may grant a grace period for their filing without prejudice of the validity of third parties' rights emerged between the expiration date of the trademark under renewal and the date on which the renewal application has been filed within the cited grace period. The PTO has not yet indicated or established the grace period's term, nor under which special circumstances same would be applied nor when this modification would be implemented.
- * Cancellation and nullity procedures: The PTO shall establish the procedure for the administrative resolution of cancellation due to nonuse requests and invalidation actions on absolute grounds. Until this happens, the Administrative Procedure Law shall be applied to such requests. Until June 3, 2019, both requests are to be filed judicially and from then onwards they are to be filed with the PTO.
- * A sworn declaration of use must be recorded with respect to all marks that have been on the Registry for 5 years. Such declaration must be submitted within the 5th and 6th year of the mark's life term.

This sworn declaration of use is to be filed in connection with all trademarks in which the first 5 years of their life term have already passed at the time of enactment of the new Trademark Law 27.444. Failure to submit such declaration of use will derive in the



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rebuttable presumption that the mark has not been used in commerce and the PTO shall suspend the renewal process until the sworn declaration is filed and the official fee fixed for such purpose is duly paid.

In our view the last paragraph contradicts a prior Resolution issued on January 16, 2018 by the PTO which clearly stated which articles of Law 27.444 were operative, which did not include the above cited provision.

Moreover, there is no provision establishing a term or grace period to file such declaration of use in all the cases which are beyond the 6th year of the mark's life term. The PTO should immediately clarify this issue.

Unfortunately, Decree 242/2019 is not precise. Clarifications are expected to be issued by the PTO as requested by the local Association of Trademark practitioners which we are part of.

We will keep you duly informed on any developments taking place in this connection.

Trademark Department

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